** NOT FOR PRINTED PUBLICATION **

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
BEAUMONT DIVISION

MARK BARRY, M.D.,	§	
	§	
Plaintiff,	§	CIVIL ACTION No. 1:14-cv-104
	§	
v.	§	JUDGE RON CLARK
	§	
MEDTRONIC, INC.,	§	PRD
	§	
Defendant.	§	

IN LIMINE ORDER GRANTING DEFENDANT MEDTRONIC'S MOTION TO EXCLUDE THE TESTIMONY OF NICHOLAS GODICI

Defendant Medtronic, Inc. moves to exclude the opinions and testimony of Mr. Nicholas Godici. Dkt. # 299, ("Motion" or "Mot."). Mr. Godici is Plaintiff Dr. Mark Barry's rebuttal expert on patent practice and procedure.

Medtronic's Motion (Dkt. # 299) is GRANTED. Mr. Godici's opinions are inadmissible on several grounds. First, the majority of his opinions are now irrelevant because the court has excluded Medtronic's patent law expert, Mr. James Carmichael (Dkt. # 294). Second, Mr. Godici's opinions are independently inadmissible for many of the same reasons Mr. Carmichael's opinions were excluded (Dkt. # 294). For example, Mr. Godici's opinions will not be helpful to the jury on any jury issue and his opinions as to what *would* have been mental impressions of the PTO examiners are speculative. This Order is in limine, as Mr. Godici is a rebuttal witness, and the admissibility of his testimony is therefore inextricably linked to the evidence that Medtronic will actually enter and the issues actually presented at trial.

I. LEGAL STANDARD

Regional law governs a motion to exclude expert testimony on the basis of unreliability. *ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 516 (Fed. Cir. 2012). Federal Rule of Evidence 702 provides that a witness who is "qualified by knowledge, skill, experience, training, or education," may provide opinion testimony if that testimony will assist the trier of fact and: (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. FED. R. EVID. 702. The witness must possess "knowledge, skill, experience, training, or education" in the relevant field to be qualified to express his expert opinion on the topic in issue. *Id.* "Rule 702 does not mandate that an expert be highly qualified in order to testify about a given issue. Differences in expertise bear chiefly on the weight to be assigned to test testimony by the trier of fact, not its admissibility." *Huss v. Gayden*, 571 F.3d 442, 452 (5th Cir. 2009). "The proponent of expert testimony . . . has the burden of showing that the testimony is reliable." *United States v. Hicks*, 389 F.3d 514, 525 (5th Cir. 2004).

The Supreme Court in *Daubert* charged trial courts with determining whether scientific expert testimony under Rule 702 is "not only relevant, but reliable." *Daubert v. Merrill Dow Pharms., Inc.*, 509 U.S. 579, 589 (1993); *see also Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 149 (1999) (extending *Daubert* to all expert testimony).

> The *Daubert* opinion lists a number of factors that a trial court may use in determining an expert's reliability. Trial courts are to consider the extent to which a given technique can be tested, whether the technique is subject to peer review and publication, any known potential rate of error, the existence and maintenance of standards governing operation of the technique, and, finally, whether the method has been generally accepted in the relevant scientific community. These factors are not mandatory or exclusive; the district court must decide whether the factors discussed in *Daubert* are appropriate, use them as a starting point, and then ascertain if other factors should be considered. But the existence of sufficient facts and a reliable methodology is in all instances

> mandatory. Without more than credentials and a subjective opinion, an expert's testimony that "it is so" is not admissible.

Hathaway v. Bazany, 507 F.3d 312, 318 (5th Cir. 2007) (internal citations omitted).

Although Federal Rule of Evidence 704 states that testimony that is otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact, the Fifth Circuit has long held that expert "opinion on the legal conclusions to be drawn from the evidence both invades the court's province and is irrelevant." *Owen v. Kerr-McGee Corp.*, 698 F.2d 236, 240 (5th Cir. 1983).

II. ANALYSIS

Because the court has previously excluded the majority of opinions from Medtronic's patent law expert Mr. Carmichael, Mr. Godici's rebuttal testimony is irrelevant. In particular, it is difficult to discern what of Mr. Carmichael's testimony, if anything, is left for Mr. Godici to rebut. Moreover, even if it were somehow still relevant, Mr. Godici's testimony—much like Mr. Carmichael's—is independently inadmissible because it is not helpful to the jury or relevant to any jury issue, it is speculative, and it constitutes improper expert opinion. As such, the court excludes all of Mr. Godici's opinions and testimony.

A. Mr. Godici's testimony is irrelevant in light of the court's prior Order.

Mr. Godici's testimony is irrelevant given the court's prior exclusion of Mr. Carmichael's testimony. Evidence is relevant only if it has a tendency to make a fact of consequence more or less probable. FED. R. EVID. 401. Irrelevant evidence is inadmissible. FED. R. EVID. 402.

Dr. Barry previously sought to exclude, and the court excluded, most of the opinions offered by Mr. Carmichael. The court's prior order excluded Mr. Carmichael's opinions regarding the time limits faced by PTO examiners, the duties owed to the PTO, possible

examiner responses to prior art,[1] HIPAA confidentiality obligations, and fraud. Dkt. # 294 (Order Excluding Carmichael Testimony) at 1. Given what was excluded, it is difficult to see what is left to be rebutted by Mr. Godici. For example, as Dr. Barry properly states, Mr. Godici's opinions regarding public use were only relevant to rebut Mr. Carmichael's excluded opinions. Dkt. # 302 (Opp.) at 5. This is true regardless of whether Mr. Godici is even qualified to testify to such opinions in the first place (which, like Mr. Carmichael, he is not).

Both parties mistakenly insinuate that Mr. Carmichael has opinions left to offer that were not excluded but would otherwise be helpful for the jury to hear. But given Mr. Carmichael's report, the court does not see what non-excluded testimony from him would be helpful to even a single jury issue. To the extent that a party—or both parties—seek to elicit testimony on general PTO procedures,[2] the jury will be shown the Patent Video and provided with a list of glossary terms, which may include general definitions of terms used at the PTO. Counsel is free to use closing argument to point out the paper of the file wrapper that records what the PTO did or said,

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[1] The parties seem to disagree as to whether Mr. Carmichael's opinions on prior use were excluded. Dkt. # 311 (Reply) at 1. The prior order excluded testimony based on speculation of the mental impressions of PTO examiners in part because Mr. Carmichael had no personal knowledge himself of the technology or the alleged prior use. All of Mr. Carmichael's opinions about prior use were based on this excluded testimony. Thus, Mr. Carmichael's opinions regarding prior use are inherently inadmissible per the court's prior order. Because Mr. Carmichael's opinions are inadmissible and Mr. Godici's opinions as to prior use only served to rebut those opinions, Mr. Godici's opinions are irrelevant and therefore also inadmissible.

[2] Courts have allowed certain qualified experts to testify on general PTO procedures involved in the patent application process. *See, e.g.*, *Bausch & Lomb, Inc. v. Alcon Labs., Inc.*, 79 F. Supp. 2d 252, 254–56 (W.D.N.Y. 2000) ("it may be helpful to the jury to hear someone experienced in [PTO] procedures explain how they operate in terms that a layperson can understand"). However, Mr. Godici's report does not include testimony regarding general PTO procedures that would be helpful to the trier of fact. To the extent that any general procedures would be helpful to the jury, it would be cumulative of what jurors will learn from the Patent Video. Certainly, Mr. Godici would not be permitted to testify as to "problems in the PTO," which this court and several others routinely exclude. *See Bausch*, 79 F. Supp. 2d at 255–56 (listing cases).

or other information about the prosecution history of the patents-in-suit. Using an expert to do so would be cumulative, unnecessary, and unhelpful given the numerous other issues that the jury *will* be asked to decide in this case.

As such, at this juncture, neither Mr. Godici nor Mr. Carmichael will be permitted to testify at trial.

B. Mr. Godici's testimony is independently inadmissible on similar grounds to those set forth in the court's order regarding Mr. Carmichael's testimony.

Notwithstanding its irrelevance, Mr. Godici's testimony is inadmissible for many of the same reasons that Mr. Carmichael's testimony was excluded. Namely, Mr. Godici's testimony is not helpful to the trier of fact, it is speculative, and Mr. Godici is unqualified to provide technical testimony or legal conclusions.

First, Mr. Godici's testimony would not be helpful to the jury. The majority of Mr. Godici's opinions relate to inequitable conduct, an issue for the Court not the jury. While district courts may delegate aspects of the inequitable conduct inquiry to juries, inequitable conduct has long been held to be "most appropriately reserved for the court." *Rothman v. Target Corp.*, 556 F.3d 1310, 1322 (Fed. Cir. 2009). Absent unusual circumstances, this court will not submit the issue of inequitable conduct to the jury. To the extent that Mr. Godici's testimony relates only to inequitable conduct, it is therefore not helpful to the jury's fact-finding.

Second, Mr. Godici's testimony is improperly speculative. For example,[3] Mr. Godici's opinions allegedly support Dr. Barry's theory that the alleged misconduct surrounding Figure 6 from the patent specifications does not constitute "egregious misconduct" but rather would be

[3] There are other opinions in Mr. Godici's report outside of these examples that are inadmissible and those cited in this Order are by no means exhaustive. *See, e.g.*, Dkt. # 299-2 (Godici report) at ¶ 79 (Godici opining that the mistaken submission of a photograph would be an error that could be corrected with a certificate of correction, which would "likely be granted by the PTO since such a correction would be minor.")

subject to a simple PTO "certificate of correction." Dkt. # 299, Mot., at 4, 6. Mr. Godici states that "there is no evidence that the description of [F]igure 6 in the patent specification misled the examiner" and that a drawing "that illustrates before and after depiction . . . *would be* at most [] ancillary." Dkt. # 299-2 (Godici report) at ¶ 74. However, his opinions on this issue entirely rely on speculative assertions about what a PTO examiner *would* or *should* have done. Just as Mr. Carmichael lacked expertise in the field of "retroactive mind reading" of the thoughts of patent examiners (Dkt. # 294 at 4), so does Mr. Godici. Indeed, other courts have found such testimony to be inadmissible.[4] As such, Mr. Godici's similar opinions are inadmissible.

Finally, given Mr. Godici's qualifications, any technical testimony or testimony on legal conclusions is also inadmissible. With regards to technical testimony, "[a]dmitting testimony from a person . . . with no skill in the pertinent art serves only to cause mischief and confuse the factfinder." *Sundance, Inv. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1361–62 (Fed. Cir. 2008) (concluding that the district court abused its discretion by allowing patent law expert with "no experience whatsoever" in the field of the patented technology to testify and explain technical evidence to a jury). Mr. Godici himself admitted that he is not an expert or a person of ordinary skill in the art. Dkt. # 299-2 (Godici report) at ¶ 74; Dkt. # 299-3 (Godici Depo. Tr. (Ex. B to Motion)) at 33:19–24. As such, Mr. Godici cannot testify as to technical aspects of the patented technology, including those details about the patent specifications or Figure 6.

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[4] *See Abbott Biotechnology Ltd. v. Centocor Ortho Biotech, Inc.*, No. CIV.A. 09-40089-FDS, 2014 WL 7330777, at *8 (D. Mass. Dec. 19, 2014) (holding that an expert "may not speculate as to what the examiner did or did not think, or how different information would have impacted the examiner's opinions or thoughts. . . . Speculation about the thought processes or reasoning of the examiner is inadmissible."); *The Medicines Co. v. Mylan Inc.*, No. 11-CV-1285, 2014 WL 1516599, at *4 (N.D. Ill. Apr. 17, 2014) (precluding an expert from "opining on what the Patent Office Examiner would have done or thought had she been given different information.").

Mr. Godici's articulation of the legal standards and his ultimate legal conclusions about inequitable conduct are also inadmissible. While expert testimony is not objectionable simply because it embraces an ultimate issue to be decided by the trier of fact, "Rule 704 does not allow experts to tell the jury what result to reach." *Vanderbilt Mortg. & Fin., Inc. v. Flores*, 2010 WL 4595592, at *4 (S.D. Tex. Nov. 1, 2010) (quoting in part *Owen*, 698 F.2d at 240 (internal quotations removed)). In his report, Mr. Godici lays out Federal Circuit law on the issue of inequitable conduct and then suggests how to apply this law to facts about which he has no personal knowledge. It is for the court or the jury to make these factual findings and apply the law, not for Mr. Godici to tell either the court or the jury how to do so. For these reasons, Mr. Godici's opinions run afoul of the rules on permissible expert opinion and should be excluded.

III. CONCLUSION

Mr. Godici's testimony and report are not admissible. It is therefore ORDERED that Medtronic's Motion to Exclude Opinions and Testimony from Mr. Nicholas Godici (Dkt. # 299) is GRANTED. This Order is subject to the presentation of evidence by Medtronic at trial. It is conceivable, though not likely, as to Mr. Godici and Mr. Carmichael, that one party may open the door to the testimony of some limited aspect of the other party's expert. But, again, the parties should keep in mind that inequitable conduct will almost certainly be tried to the bench.

So **ORDERED** and **SIGNED** this **20** day of **September, 2016.**

Ron Clark, United States District Judge