

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

BISCOTTI INC.,	§	
	§	
v.	§	Case No. 2:13-CV-01015-JRG-RSP
	§	
MICROSOFT CORP.	§	

**ORDER ON MOTIONS *IN LIMINE***

Before the Court are Motions *in Limine* filed by Plaintiff Biscotti Inc. (“Biscotti”) (Dkt. 206) and by Defendant Microsoft Corporation (“Microsoft”) (Dkt. 205), in addition to the parties Agreed Motions in *Limine* (Dkt. 204). The Court heard argument on the motions during the pretrial conference on May 30, 2017. For the reasons explained at the hearing, the Court rules as follows. A party must approach the bench before introducing evidence or argument about the subject matter of a granted motion *in limine*.

**AGREED MOTIONS *IN LIMINE***

1. Agreed Motion in Limine No. 1: Exclude any argument, testimony, evidence, reference to, as well as suggestion that a party’s expert or other witness has or has not been hired in the inter partes reviews of the ’182 patent or has been retained by any party or its counsel in unrelated litigation matters.

**GRANTED.**

\* \* \*

**BISCOTTI’S MOTIONS *IN LIMINE***

1. Motion No. 1 to Exclude Uncorroborated Testimony from Prior Art Witnesses

**DENIED.**

2. Motion No. 2 to Exclude Testimony Regarding Microsoft’s Patents

**GRANTED BY AGREEMENT** as to Biscotti's request that Microsoft's patents not be admitted into evidence or used as demonstratives. The motion is otherwise **DENIED**. Biscotti may object to irrelevant testimony regarding the Microsoft patents at trial.

3. Motion No. 3 to Exclude any Testimony Suggesting Inequitable Conduct

**GRANTED.** Evidence relevant only to inequitable conduct will not be presented to the jury.

4. Motion No. 4 to Exclude Invalidity Theories Estopped by IPR Decision

**GRANTED IN PART.** While Microsoft will be permitted to present its defense of invalidity based on the LifeSize and Xbox 360 systems, Microsoft will be limited to using any documents that qualify as patents or printed publications solely for the purpose of establishing the date on which the LifeSize and Xbox 360 systems were in public use or on sale. **DENIED** as to Biscotti's argument that Microsoft is estopped from asserting the LifeSize and Xbox 360 systems as prior art. *See* Dkt. 191 (Report & Recommendation on IPR estoppel).

5. Motion No. 5 to Exclude the Declaration of Steve Venuti

**DENIED AS MOOT.**

\* \* \*

**MICROSOFT'S MOTIONS *IN LIMINE***

1. Preclude Evidence or Argument Suggesting That Any Non-Accused Technology Infringes

**GRANTED.**

2. Preclude Evidence or Argument Regarding Unasserted Legal Claims

**GRANTED BY AGREEMENT.**

3. Preclude Evidence or Argument Regarding Microsoft's Lack of Opinion of Counsel

**GRANTED BY AGREEMENT.**

4. Preclude References to Microsoft's Size, Market Power, or Overall Financial Status

**GRANTED** as to Microsoft's overall size, net worth, market capitalization, or stock value. **DENIED AS MOOT** as to Microsoft's total revenues or profits from the accused products. *See* Dkt. 203 at 12.

5. Preclude References to or Arguments Regarding the Findings or Outcomes of the Inter Partes Review Proceedings

**GRANTED.** The probative value in allowing Biscotti to reference Patent Trial and Appeal Board findings that were adverse to Microsoft or highlight the successful outcomes of inter partes review proceedings is substantially outweighed by the danger of unfair prejudice. *See Fed. R. Evid. 403.*

6. Preclude References to Discovery Disputes or Suggestions of Discovery Deficiencies or Litigation Misconduct

**GRANTED BY AGREEMENT.**

7. Preclude References, Evidence, or Argument Regarding Financial Arrangements between Biscotti and Its Outside Counsel or Any Difficulties in Obtaining Financing for This Litigation.

**GRANTED BY AGREEMENT.**

8. Preclude Suggestions That Microsoft Copied Third Parties' Technology or Otherwise Has Been Found to Engage in Unlawful Conduct

**GRANTED BY AGREEMENT.**

9. Preclude Biscotti from Making Arguments Regarding Willfulness to the Jury—Leaving Such Issues to be Resolved by the Court as a Matter of Law

**DENIED.** Microsoft's argument that willfulness is not a jury question is preserved.

10. Preclude Arguments That Microsoft Purchased and Copied Biscotti's Device, Which Has No Basis in the Evidence and Is Relevant Only to Willfulness, Which Should Be Decided by the Court

**DENIED.**

11. Preclude Biscotti from Using the Phrase "Presumption of Validity"

**DENIED.**

**SIGNED this 30th day of May, 2017.**

  
ROY S. PAYNE  
UNITED STATES MAGISTRATE JUDGE