



EDTX judge's new limine order takes name-calling off the table

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In a *sua sponte* order issued recently, Chief Judge Rodney Gilstrap of the US District Court for the Eastern District of Texas revised how motions *in limine* will be handled in patent infringement cases pending before him.

For chief IP officers with cases pending in the court, the immediate effect of the new order is a substantial saving of time and expense in their cases. Parties no longer need to research and prepare extensive lists of potential *limine* subjects and meet and confer on those subjects.

Motions *in limine* are a routine part of trial practice, and describe the orders entered by trial judges precluding lawyers and witnesses from referencing potentially unfairly prejudicial matters – often referred to as the “skunk in the jury box” – without first approaching and obtaining leave of court. Often confused with motions to exclude evidence, they are not usually true exclusions, and only require counsel to approach the bench and obtain permission before mentioning the potentially unfairly prejudicial subject, such as the existence of liability insurance, or references to the parties' prior unrelated medical conditions or activities. But the practice has expanded in patent cases to the point that *limine* disputes in a case can rival more substantive issues in terms of their cost.

Gilstrap wrote in his order:

“Too often in today’s practice, the Court finds itself confronted with excessive proposed limine motions. Often parties are tempted to engage in such improper conduct as using limine practice to seek a second review of a matter already covered by a substantive motion, such as a summary judgment motion, a motion to strike, or a Daubert motion. Other parties fail to resist the inclination to offer limine motions that do nothing other than ask the Court to order the parties to follow the already existing rules of practice embodied in the Federal Rules of Civil Procedure and the Federal Rules of Evidence. While this may be tempting in the competitive arena of trial practice, such creates an overly burdensome tax on the Court’s time and resources as well as those of the opposing parties.”

To address these practices, the order does two things.

Standard limine rulings

First, the court established a default list of 23 topics – many familiar to practitioners – which the parties may not raise before the jury without prior leave of the court. For example, No. 1 precludes the parties from discussing pretrial proceedings such as discovery disputes; while No. 2 precludes mentioning religious or political beliefs, race, gender, national origin, and sexual or vaccination status.

The topics also exclude certain substantive matters in the case, precluding, among other things, evidence of parties':

- overall financial size;
- wealth or executive compensation;
- prior art not previously disclosed;
- evidence relating only to equitable defences or proceedings before another court or forum;
- litigation funding;
- attorneys' fee agreements;
- the location or number of attorneys;
- the presence of jury consultants;
- the court's claim construction opinion; and
- experts testifying outside their reports.

Other trial conduct issues are addressed as well, with parties precluded from referring to any person or entity with terms such as "greedy," "corrupt," "evil," or "dishonest," or using any other pejorative term. The parties are also precluded from characterising an action as "stealing," "copying," "misappropriating," "pirating," "trespassing," or any similar terms. They cannot bolster or disparage the US Patent and Trademark Office, its examiners, or the process for prosecuting patent applications or granting patents in the United States.

Also off limits absent permission are potential arguments that are, on balance, too far removed from the merits of a patent action, including: prohibitions of claims; that there is anything legally improper in writing patent claims to cover an adverse party's product; that a verdict in one party's favour would impact the cost of goods or services or would have other commercial impacts; or that the other party had an affirmative duty to seek opinion of counsel.

Importantly, the court also draws the line on name-calling in more patent litigation-specific terms, precluding the parties from referring to any other person or entity in disparaging ways. Among other things, banned terms include:

- patent troll;
- pirate;
- bounty hunter;
- bandit;
- playing the lawsuit lottery;
- shell company;
- shakedown artist;
- patent assertion entity; or
- any similar terms.

But use of the term "non-practicing entity" is permitted, as are references to the plaintiff's business model.

Only five disputed limines each

The second part of the order limits parties to proposing and arguing (if opposed) only up to five of its own motions *in limine* at the pretrial conference, and prohibits "multifarious" motions. In addition to the routine matters addressed by the 23 default subjects, the court is also making clear that there is no need to reargue other motions – such as those on experts and summary judgment. This typically allows parties sufficient latitude to bring up whatever subjects they were not able to reach agreement on *in limine* regarding treatment.

Benefits of the ruling

The cost-savings for parties stem from the fact that meet-and-confers over *limine* motions often result in the need for additional calls or briefing to respond in many cases – not to the general propriety of a subject for *limine* treatment – but whether the particular language proposed by a party accurately tracks what the opposing party understands the court is likely to grant. With

an order providing default *limine* subjects, the need for this very expensive drafting and conferring process is largely eliminated in most cases.

But the default topics have a second benefit, and that is informing the parties early on that certain arguments will not be permitted at trial. Absent experienced counsel in the court who know which topics are unlikely to be allowed, parties may well be under the impression until very late in the case that they will be able to, for example, call the plaintiff a patent troll, or that the plaintiff may be allowed to characterise them as a foreign company with large numbers of out-of-state lawyers. Gilstrap's order represents a good example of the routine rulings on these subjects that regular practitioners in his court have come to expect over the years, but more importantly, it represents an opportunity for clients and their in-house counsel to understand – well in advance of trial – which arguments will be off the table in this particular court.

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