

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN VARIABLE SPEED WIND
TURBINES AND COMPONENTS THEREOF

Inv. No. 337-TA-641

**Order No. 34: Denying Complainant's Motion *In Limine* To
Prevent Patent Law Expert Lawrence J. Goffney From
Presenting Testimony That Violates Ground Rules 5(A) And
5(B)**

Complainant General Electric Company ("GE") moves for an order *in limine* prohibiting patent law expert Lawrence J. Goffney from presenting testimony that violates Ground Rules 5(A) and 5(B). (Motion No. 641-48) (Complainant's Motion *In Limine* No. 1). Respondents Mitsubishi Heavy Industries, Ltd., Mitsubishi Heavy Industries America, Inc., and Mitsubishi Power Systems Americas, Inc. (collectively, "MHI"), have filed an opposition. Subject to the exception discussed below, the motion is denied.

Ground Rule 5(a) states, "Only factual material and expert opinion shall be received into evidence. Legal argument should be presented in the briefs." Ground Rule 5(b) states, "Legal experts may only testify as to procedures of the U.S. Patent and Trademark Office." Lawrence J. Goffney has been identified by MHI as a patent law expert. Citing to Mr. Goffney's expert report, in its motion *in limine* GE argues that respondents' patent law expert offers opinions that violate Ground Rules 5(a) and 5(b).

In response, MHI agrees to strike paragraphs 4-6 of Goffney's witness statement, which it


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believes encompasses the matters to which GE has objected. Resp. at 1. In that regard, MHI lists the four areas to which Goffney is now expected to testify as follows:

1. General considerations pertaining to patents, including the role of the PTO in the U.S. patent system, the structure of the PTO, the training and skill of U.S. patent examiners and PTO resources available to them, patent applications and the U.S. patenting process, and substantive decisions by patent examiners;
2. PTO practices and procedures relating to the duty of candor and good faith in dealing with the PTO, including: the nature of the duty of candor and good faith in dealing with the PTO, the individuals having the duty of candor; disclosing information to the PTO, the duty to disclose information material to patentability, and the requirements for information;
3. The prosecution histories of the applications for U.S. Patent No. 7,321,221 (the “221 patent”) and U.S. Patent No. 6,921,985 (the “985 patent”); and
7. Matters raised on cross-examination, matters necessary to rebut matters testified to by Complainant’s experts, and matters otherwise raised at trial by counsel or the Court.

Resp. at 2.

On their face, none of the four areas of Mr. Goffney’s (revised) expected testimony violate Ground Rules 5(a) and 5(b). Accordingly, GE’s motion *in limine* is denied. (Motion No. 641-48). Nonetheless, GE may renew any such objections at the hearing should the specific expert testimony of Mr. Goffney, in its view, violate the ground rules.



Carl C. Charneski
Administrative Law Judge

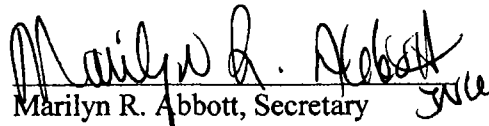
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PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** has been served upon the Commission Investigative Attorney, Erin D. Joffre, Esq., and the following parties as indicated, on

MAY 04 2009


Marilyn R. Abbott, Secretary
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