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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

UNITED STATES OF AMERICA, Plaintiff, v. AMR MOHSEN and ALY MOHSEN, Defendants.	CR 03–0095 WBS **UNITED STATES' MOTIONS *IN LIMINE***

Jury selection in this matter is scheduled to begin on January 31, 2006. Testimony in the government's case-in-chief is scheduled to begin on February 6, 2006. In advance of trial, the United States hereby submits the following motions *in limine*.

In summary, and as set forth in more detail below, the United States respectfully moves that this Court *preclude* the defense from: (1) eliciting, on either cross- or direct examination, any out-of-court statements made by the defendants, including all statements made by the defendants in their depositions and in-court testimony and in recorded telephone calls Amr Mohsen made from Santa Rita jail; (2) introducing evidence of any automobile break-ins or thefts on or near the premises of Aptix Corporation, other than

the alleged theft of items from Amr Mohsen's vehicle on December 14, 1998; (3) making any reference to alleged racial, ethnic, or religious bias on the part of the government or the Court, or any reference to selective prosecution; (4) making any reference to unrelated FBI and/or Secret Service cases or incidents; (5) making any reference to possible punishment; (6) presenting an insanity or mental health defense for which there has been improper/non-compliance with Rule 12.2; (7) introducing expert testimony as to the ultimate issue of "materiality"; and (8) introducing speculative legal conclusions in the form of expert testimony as to what might have been relevant in the future in the civil patent infringement case or what the likely or probable outcome of any patent infringement trial would have been.

ARGUMENT

I. DEFENDANTS SHOULD BE PRECLUDED FROM ELICITING OUT-OF-COURT STATEMENTS MADE BY THE DEFENDANTS

1. The defendant's statements are admissions of a party-opponent if sponsored by the United States; however, they are inadmissible hearsay if sponsored by the defense.

The United States intends to offer evidence of excerpts from the videotapes and written transcripts of defendants' deposition and evidentiary hearing testimony given in the underlying civil litigation. The government also intends to offer recordings of various telephone calls Amr Mohsen initiated from jail. To the extent that the United States introduces into evidence the defendants' testimony, or any other statements, these statements are admissions of a party-opponent and therefore not hearsay. FED. R. EVID. 801(d)(2)(A).

However, to the extent that the *defense* seeks admission of the defendants' statements, the statements constitute inadmissible hearsay. Accordingly, the United States hereby moves *in limine* for an order precluding the defense from eliciting any of the defendants' statements, unless there are non-hearsay grounds for the admission of a particular statement.

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2. The "prior consistent statement" doctrine is inapplicable

Even if the defendants testify and are cross-examined concerning the truthfulness of their testimony, their prior deposition testimony, evidentiary hearing testimony, and Amr Mohsen's recorded jail telephone calls are not admissible as "prior consistent statements." For a statement to be deemed "not hearsay" under FRE 801(d)(1)(B), the statement must be "offered to rebut an express or implied charge against the declarant of *recent fabrication or improper influence or motive*." For any "prior consistent statements" to qualify as non-hearsay under this rule, the United States Supreme Court has held, the statement must have been made *before* the alleged fabrication, influence or motive came into being. *Tome v. United States,* 513 U.S. 150, 167 (1995); *see also United States v. Collicott,* 92 F.3d 973, 979 (9th Cir. 1996) (in order to be admitted, "the prior consistent statement must be made *prior* to the time that the supposed motive to falsify arose") (emphasis added). Prior consistent statements by a witness "may not be admitted to counter all forms of impeachment or to bolster the witness merely because she has been discredited." *Tome,* 513 U.S. at 157. Accordingly, "the prior consistent statements *must* rebut the charge of improper motive, not merely 'bolster[ ] the veracity of the story told.'" *Collicott,* 92 F.3d at 979.

Here, the defendants' allegedly prior consistent statements were made during the commission of the charged fraud, i.e. during deposition testimony in the underlying civil litigation. The underlying civil lawsuit was, in fact, the instrumentality that the defendants used to commit their fraud. Thus, defendants' testimony which was given in furtherance of the fraudulent enterprise (the civil lawsuit) was not "made *prior* to the time that the supposed motive to falsify arose" (*see Caldicott*, 92 F.3d at 979). Rather the statements were made *after* the filing of the lawsuit and in furtherance of the scheme to defraud QuickTurn Design Systems and the District Court. Thus, the motive to fabricate "came into being" at the moment Aptix Corporation filed the civil lawsuit and Amr Mohsen proffered the phony July 31, 1988 date of conception. The defendants' testimony in the civil lawsuit contains nothing to rebut a charge that their motives for making

certain statements was to deceive and defraud. Accordingly, the defendants should be precluded from recounting their deposition testimony, unless there are non-hearsay grounds to do so.

The same analysis applies to any attempt by Amr Mohsen to use recorded jail telephone calls to exculpate himself in either Part 1 or Part 2 of the trial. The telephone at Santa Rita jail was the instrumentality that Amr used to help facilitate his witness intimidation from the jail. For example, the government intends to offer telephone recordings which establish, among other things, that (1) Amr used the jail phone to call Tom Huang and his wife to determine the Huangs' address and their schedule to determine when it would be most opportune to vandalize the Huangs' cars in furtherance of his bogus "mistaken car identity" defense to Counts 1-19; (2) Amr used the jail phone to tamper with his sister (Magda Metwally) to falsely exculpate himself on Count 20; and (3) Amr used the jail phone to help fabricate his phony insanity and/or incompetency defense.

3. The "rule of completeness" is inapplicable

The United States anticipates that the defendants may attempt to rely on FRE 106, to introduce portions of Amr Mohsen's recorded phone calls that are not offered by the United States. The United States submits that Rule 106, commonly referred to as the rule of completeness, does not require or suggest that result. Application of the rule of completeness, which requires that a redacted version of a statement not distort the meaning of the statement, is a matter for the trial judge's discretion. *See United States v. Dorell, III*, 758 F.2d 427, 434 (9th Cir. 1985) (upholding redaction of defendant's handwritten statement to exclude reference to political and religious motivations for actions) .

The parties have already litigated the Rule of Completeness vis-a-vis the deposition and May 2000 evidentiary hearing excerpts that the government intends to introduce. *See* CR 85-89. The government has prepared Computer Discs ("CD") containing the excerpts the Court (Judge Alsup) previously ruled were admissible in the

government's case-in-chief and provided those CD's to Aly Mohsen's counsel and prior counsel for Amr Mohsen. The government will provide similar excerpts of the recorded jail phone calls to the defense in advance of trial. (Copies of recordings of all known telephone calls Mohsen made from Santa Rita jail have previously been provided to the defense during the discovery process).

II. DEFENDANTS SHOULD BE PRECLUDED FROM INTRODUCING EVIDENCE OF ANY AUTOMOBILE BREAK-INS OR THEFTS OTHER THAN THE ONE OF DECEMBER 14, 1998

Defendant Amr Mohsen has indicated that he may seek to introduce evidence of an automobile break-in at the Aptix parking lot approximately one week subsequent to the alleged theft of original notebooks from Amr Mohsen's automobile. The United States respectfully moves *in limine* for an order precluding any such evidence.

Under FRE 401, "relevant evidence" encompasses only evidence that has "any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence." Here, there is a substantial disconnect between the evidence—that of a subsequent automobile break-in—and the conclusion for which it is advanced, *i.e.,* that Amr Mohsen did not stage the theft of the original engineering notebooks from his vehicle on December 14, 1998. There is simply no basis for a factfinder to draw the conclusions necessary for the relevance of the evidence—(1) that the subsequent theft was committed by the same person who perpetrated the alleged theft of the notebooks; and (2) that to the extent that the perpetrator was one and the same, it was somebody other than Amr Mohsen.

First, so far as the United States is aware, there is nothing to indicate that the two break-ins were committed by the same person. Given the strong evidence that Amr Mohsen staged the break-in of December 14, 1998, it is likely that the second break-in was completely unrelated to the first. The mere fact of two break-ins in the same general space does not absolve any person of either one of the break-ins.

Second, even if one can infer that both break-ins were committed by the same person, there is no reason for the jury to infer that someone other than Amr Mohsen was

responsible for the break-ins. It is equally likely that Amr Mohsen, having staged one break-in and having gone to great lengths to document the alleged theft of his notebooks, then staged a subsequent break-in to create the illusion of random crime or vandalism. This particular inference is all the more reasonable in light of Amr Mohsen's May-June 2004 solicitation of the CI to find someone to vandalize to Tom Huang's and Huang's wife's cars to falsely create the inference that the December 14, 1998 break-in to Mohsen's car (and the theft of the fraudulent 1988 Notebook) was a case of mistaken car identity.

Even if evidence of the subsequent break-in were somehow relevant, any such relevance is "substantially outweighed" by the danger of "misleading the jury" and "waste of time." FED. R. EVID. 403. Accordingly, the United States moves to preclude this evidence on FRE 403 grounds as well.

III. DEFENDANTS SHOULD BE PRECLUDED FROM MENTIONING ALLEGED RACIAL, ETHNIC, OR RELIGIOUS BIAS

Claims of selective prosecution based on impermissible grounds, such as the defendant's race or ethnicity, are matters of law for the Court, not questions of fact relevant to a jury's determination of guilt or innocence. *See United States v. Armstrong,* 517 U.S. 456, 463 (1996) ("A selective-prosecution claim is not a defense on the merits to the criminal charge itself, but an independent assertion that the prosecutor has brought the charge for reasons forbidden by the Constitution."). Thus, it would be inappropriate, as well as highly prejudicial, for the defendants to suggest or imply in any manner before the trial jury that considerations of race, ethnicity, or religion played any role in the government's decision to indict the matter, or in the district court's referral of the matter to the government.

The news media is replete with reports of ethnic targeting in the wake of the Patriot Act and other national events. Whether or not those stories are true, they have no place in the trial of instant matter. To the extent that the defense refers to race, ethnicity or religion—or to possible bias on the government's or the Court's parts on those

bases—in the presence of the jury, the "bell" simply cannot be un-rung or the damage neutralized by a curative instruction, especially given strong emotions and sentiments on these subjects. Accordingly, to the extent that the defense wishes to make such a reference either during voir dire or during the trial itself, the United States respectfully respects that the Court order that the defense first make an offer of proof outside the presence of the jury.

IV. DEFENDANTS SHOULD BE PRECLUDED FROM MENTIONING UNRELATED FBI AND/OR SECRET SERVICE CASES OR INCIDENTS

Pursuant to FRE 402 and 403, the United States respectfully requests that the Court order the defense not to refer at any time during the trial, including during questioning and argument, to FBI and/or Secret Service incidents that are unrelated to this case. These FBI and/or Secret Service incidents include, but are not limited to, the following: The Wen Ho Lee case; the Ruby Ridge case, alleged discovery violations in the McVeigh case; the Richard Jewell case; the Robert Hanssen case; the Richard Whitehurst accusations and the allegation concerning misplaced laptop computers and firearms; any investigations into terrorism.

These and similar incidents involving the FBI and/or Secret Service are irrelevant to the current charges and merely serve to prejudice the jury against the FBI in general. The prejudice from such references substantially outweighs any probative value. These incidents involve accusations (many which are unsubstantiated) against particular FBI and Secret Service agents and experts. If told about these incidents, the jurors may unfairly impute the alleged behavior to the FBI agents and experts in this case.

In addition to creating unfair prejudice, the introduction of the evidence discussed above would confuse the issues, mislead the jury and needlessly waste time. It would be unfair to allow the defendant to introduces evidence debasing the FBI and/or Secret Service without allowing the government to offer evidence in support of the FBI and/or Secret Service. Such a mini-trial on the integrity and competency of the FBI and/or Secret Service would be confusing, misleading and time consuming.

By the same token, the United States will not refer in any way to any non-related FBI investigations, including those concerning recent events involving international and domestic terrorism. Nor will the United States elicit from testifying FBI or Secret Service agents any testimony concerning their participation in terrorism investigations.

V. DEFENDANTS SHOULD BE PRECLUDED FROM MENTIONING PUNISHMENT

The United States respectfully moves *in limine* for an order barring the defense from making any reference before the jury to the issue of punishment during all parts of the trial (including jury selection, opening statements, examination of witnesses including the defendant if he elects to testify, and closing arguments).

"It has long been the law that it is inappropriate for a jury to consider or be informed of the consequences of their verdict." *United States v. Frank,* 956 F.2d 872, 879 (9th Cir. 1992). As explained by the Fifth Circuit in *Pope v. United States,* 298 F.2d 507 (5th Cir. 1962):

> To inform the jury that the court may impose minimum or maximum sentence, will or will not grant probation, when a defendant will be eligible for parole, or other matters relating to disposition of the defendant, tend to draw the attention of the jury away from their chief function as sole judges of the facts, open the door to compromise verdicts and to confuse the issue or issues to be decided.

Id. at 508. For this reason, it is the practice in the federal courts to instruct juries that they are not to be concerned with the consequences to the defendant of the verdict, except where required by statute. *Rogers v. United States,* 422 U.S. 35, 40 (1975) (jury should have been admonished "that the jury had no sentencing function and should reach its verdict without regard to what sentence might be imposed"); *United States v. Reed,* 726 F.2d 570, 579 (9th Cir. 1984) (trial judge properly instructed jury that the "punishment provided by law for the offenses charged in the indictment are matters exclusively within the province of the court. It should never be considered by the jury in any way in arriving at an impartial verdict as to the guilt or innocence of the accused.").

Here, the jury's sole function is to consider the evidence to determine whether the

defendants are guilty of the charged offenses. The jury should base its verdict on the facts presented at trial, rather than on speculation about the effect of a given verdict on the defendants and on society. For these reasons, the government is requesting the Court to give Ninth Circuit Model Instruction Number 7.4, instructing the jury not to consider punishment in deciding whether the government has proved its case against the defendant beyond a reasonable doubt.

The integrity of the jury process will be compromised if the defense makes any reference to punishment in the jury selection process or in front of the jury prior to their reaching a verdict. That reference could be as overt as "You understand the defendant is facing up to twenty years in prison if convicted," or more subtle such as "the defendant is facing a lot of time," "this case has serious consequences for the defendant," or "the defendant's liberty is at stake in this trial." Such comments regarding punishment are inappropriate in light of clear authority that the jury is not to consider punishment in determining whether the defendant is guilty of the charged offense.

VI. DEFENDANTS SHOULD BE PRECLUDED FROM RAISING CERTAIN DEFENSES FOR WHICH THEY GAVE NO NOTICE

Pursuant to Rule 12, a defendant must give written notice if he wishes to rely on the defenses of insanity or alibi. Here, Amr Mohsen has made a completely ambiguous Rule 12 disclosure which has not properly advised the United States as to whether he actually intends rely on an insanity defense. A true and correct copy of Amr Mohsen's December 9, 2005 12.2 Notice is attached hereto as Exhibit 1. The government has previously objected to the defendant Amr Mohsen's stated attempt to introduce "mental health" evidence in the defense case-in-chief unless that evidence comports with Rule 12. Specifically, Amr Mohsen has indicated that if the government introduces evidence in its case-in-chief suggesting that Mohsen was concocting a bogus insanity defense and/or attempting to feign incompetency to delay or derail his criminal trial, the defense will introduce evidence establishing that Mohsen actually suffered from some as of yet undisclosed mental health problem. It is unclear whether Mohsen intends to establish that

he was not fabricating a defense, but was merely engaged in an educational foray into the nuances of insanity to school himself on the nature of his "disease" **or** whether Mohsen intends to claim that he was actually insane while he was incarcerated rendering him not responsible for his crimes and/or his efforts to obstruct justice by fabricating bogus defenses.

In any event, the government has previously objected to the introduction of "mental health" testimony in the defense case-in-chief (*see* 12/20/05 RT 95-96 and government memorandum filed in response to defendant's motion to preclude introduction of "competency" evidence) on the grounds that the defense has not complied with Rule 12 and that such testimony is not relevant to any legitimate defense to the government's "fabrication" evidence. On December 21, 2005, the Court denied without prejudice Amr Mohsen's motion to preclude the government from introducing testimony or evidence from doctors and mental health professionals who previously examined Mohsen after the Court ordered a competency evaluation of Mohsen. The government renews its objection to the defense attempting to "rebut" the government's fabrication evidence with undisclosed testimony from a defense psychologist (Jay Jackman, Ph.D.) who has apparently recently examined Mohsen, but whose opinions and/or conclusions have not been disclosed to the government.

VII. DEFENSE PATENT EXPERTS SHOULD BE PRECLUDED FROM SPECULATING OR OPINING AS TO WHETHER CERTAIN MATTERS WOULD ULTIMATELY HAVE BEEN "RELEVANT" IN THE CIVIL PATENT INFRINGEMENT CASE OR WHAT THE LIKELY OR PROBABLE OUTCOME OF ANY PATENT INFRINGEMENT TRIAL WOULD HAVE BEEN

The United States moves *in limine* to exclude any defense evidence, in the form of expert opinion testimony or otherwise, regarding (1) the ultimate "relevance" of the 1988 and 1989 Notebooks in the event that Judge Alsup had not imposed terminating sanctions; (2) the ultimate "relevance" of prior art defenses raised by QuickTurn in the event that Judge Alsup had not imposed terminating sanctions; and (3) what the probable or likely outcome of the patent infringement case between Aptix and QuickTurn might

have been had Judge Alsup not imposed terminating sanctions.

There are two bases for the government's motion. First, any evidence or opinions regarding the *ultimate* relevance of the Notebooks or prior art claims/defenses and regarding the *likely outcome* of the civil patent infringement case are irrelevant to any issue in this criminal case, including the issue of materiality. Accordingly, any such evidence or opinions are inadmissible under Rule 402. Second, the ultimate relevance of the Notebooks or prior art claims/defenses and the likely outcome of the patent infringement case are not the proper subjects of expert testimony. This is because any such testimony would be based on mere speculation. Therefore, such evidence and opinions are inadmissible under Rule 702.

A. What Evidence Judge Alsup or a Jury *Might* Have Considered in the Future, and the Probable Outcome of the Patent Infringement Case are Irrelevant to any Issue in this Criminal Case.

The defendant Amr Mohsen has notified the government that he intends to call Roger W. Blakely, Jr., and Dr. Harry L. Tredennick III as expert witnesses in patent law. The defendant has notified the government that these experts will testify as to the relevance of (1) "the Mohsen notebooks" and (2) the prior art defenses raised by QuickTurn in the underlying patent litigation. *See* Ex. 2 (11/1/2005 Letter of Bruce Locke). Although the government recognizes that the defendant is entitled to present a defense with respect to the issue of materiality, the evidence that the defendant offers in support of any such defense must nevertheless be admissible under the Federal Rules of Evidence.

The defendant Amr Mohsen previously filed a motion to dismiss the mail fraud, perjury and other counts based on the argument that the government could not prove "materiality" with respect to any of those counts. *See* CR 369 (motion to dismiss). The defendant's "materiality" argument was based in large part on the Supreme Court's decision in *Kungys v. United States*, 485 U.S. 1537 (1988); *see also* CR 369, at 11–13. In its response to the defendant's materiality motion, the government argued that *Kungys* was distinguishable, because

> *Kungys's* holding regarding materiality is largely focused on what is "material" on a *citizenship application*. The *Kungys* Court did not make any specific pronouncements regarding the test for materiality in other contexts, such as in prosecutions for perjury and mail fraud.

CR 375, at 10 (emphasis in original). In his reply brief with respect to that motion to dismiss, the defendant flatly disputed the government's contention, stating that "it does not matter that *Kungys* was a citizenship case; 'materiality' does not have a different meaning in different statutes as the Government implies." CR 390, at 8:17–20.

The defendant is wrong. As the Ninth Circuit re-affirmed last week, materiality *does* have a different meaning in immigration contexts, such as the one in *Kungys*. *See United States v. Alferahin*, 2006 WL 51181 (9th Cir. Jan. 11, 2006). In *Alferahin*, the Ninth Circuit found that 18 U.S.C. § 1425(a) contained a materiality requirement. In considering whether the district court plainly erred in failing to instruct the jury on the element of materiality, the *Alferahin* court specifically noted that "the *Kungys* decision established a more rigorous definition of materiality that is unique to the context of denaturalization proceedings." *Id.*, at *4. Indeed, this has long been the law in the Ninth Circuit. *See United States v. Puerta*, 982 F.2d 1297 (9th Cir. 1992) (recognizing uniqueness of denaturalization proceedings and noting that court would "look to the standards governing materiality *in the denaturalization context* as a guide in determining what is 'contrary to law'" under § 1425(a)) (emphasis added). In making this observation, the *Alferahin* court noted that, in *Kungys*, Justice Brennan had opined that, in order to establish materiality in the denaturalization context, "the government also had to support its assertion of materiality with 'evidence sufficient to raise a fair inference that a statutorily disqualifying fact actually existed.'" *Alferahin*, 2006 WL 51181, at *4; *see also Puerta*, 982 F.2d at 1304 (noting that government had to provide evidence "giving rise to a 'fair inference' of ineligibility") (quoting *Kungys*, 485 U.S. at 783 (Brennan, J., concurring)); *id.* at 1304 (noting that Justice Brennan's "fair inference" opinion is the controlling opinion in *Kungys*).

Based on the defendant's theory of materiality, the government anticipates that the

defendant will seek to introduce testimony opining as to what facts Judge Alsup or a jury "*would have* to consider in making" his decision regarding the question of patent infringement, *see* CR 369, at 12:22–23 (emphasis added), and will argue that, unless Judge Alsup or a jury *would have* to consider those facts, those facts are not "material" for purposes of this criminal case. Such evidence and such argument, however, do not reflect the standard of materiality applicable outside of the denaturalization context. There is no requirement for the government to prove that any particular statement, claim, defense, item or issue *would have* been considered by Judge Alsup in order to establish that such statement, claim, defense, item or issue was "material." Rather, the government must only show that the statement, claim, defense, item or issue had "the natural tendency to influence or is capable of influencing another's decisions." *United States v. Halbert*, 712 F.2d 388, 390 (9th Cir.), *cert. denied*, 465 U.S. 1005. It is not necessary to show that anyone actually relied on any false statements, for example. *Id.* Nor is it necessary to establish that anyone was defrauded or sustained a monetary loss. *United States v. Telink*, 910 F.2d 598, 598–600 (9th Cir. 1990); *United States v. Vaughn*, 797 F.2d 1485, 1493 (9th Cir. 1986).

As the government has previously noted, the Ninth Circuit has unequivocally held that "materiality is tested at the time a false statement was made" and that a false statement can be "material" even if a truthful statement would not have been helpful to the decisionmaker. *United States v. McKenna*, 327 F.3d 830, 839 (9th Cir. 2003). The *McKenna* court noted that a false statement is material if

> it has a natural tendency to influence, or was capable of influencing the decision of the decision-making body to which it was addressed. To be material a false statement need only be relevant to any subsidiary issue under consideration. The government need not prove that the perjured testimony actually influenced the relevant decision-making body. Further, materiality is tested at the time the alleged false statement was made: Later proof that a truthful statement would not have helped the [decision-making body] does not render the false testimony immaterial.

Id. at 839 (quotations omitted); *see also United States v. Lococo*, 450 F.2d 1196, 1199 n.3

(9th Cir. 1972) ("Materiality is tested as of the time the investigation is being made.").

For the reasons set out above, the United States moves *in limine* pursuant to Rule 402 to exclude any evidence or opinions regarding the *ultimate* relevance of the Notebooks or prior art claims/defenses and regarding the *likely outcome* of the civil patent infringement case. Such evidence and opinions should be excluded under Rule 402 because they are irrelevant to any issue in this criminal case, including the issue of materiality.

B. What Evidence Might Have Been Relevant or Admissible in a Patent Infringement Trial that was Never Held or Regarding the Probable Outcome of the Underlying Patent Infringement Case is not the Proper Subject of Expert Testimony.

The government also submits that it is *not* the proper subject of expert testimony under Rule 702 for any expert to opine as to whether any particular fact, claim, defense, item or issue would have been relevant in the future or what the probable or likely outcome of a case would have been if the facts had been different (*e.g.*, if the Mohsen brothers had not fabricated evidence or presented perjured testimony). As this Court is well aware, there are any number of considerations that factor into the resolution of any type of case, and it is not possible for any witness to reliably predict how future litigation might proceed. Although the defendant Amr Mohsen has argued that the fabricated notebooks would not *ultimately* have been relevant in the patent infringement case (because QuickTurn relied on a date of invention earlier than the earliest date of conception claimed by Amr Mohsen), there is no way for any expert witness to reliably know, for example, (1) whether Aptix would have contested QuickTurn's earlier claimed date of conception or (2) whether Aptix would have argued that QuickTurn had not reduced its earlier invention to practice. Under either of these scenarios, QuickTurn's prior art claim may have been invalidated, thus making the Notebooks relevant. Simply put, there are too many unknown variables for any expert witness to reliably offer an opinion as to whether the Notebooks would have been relevant or admissible at a future date or what the probable or likely outcome of the patent infringement case would have

been in the absence of Aptix's and Amr Mohsen's reliance on the 1988 and 1989 Notebooks.

Rule 702 requires expert testimony be based on "sufficient facts or data" and to be "the product of reliable principles and methods." For the reasons set forth above, the proffered testimony meets neither of these criteria. Accordingly, the United States moves *in limine* to exclude any testimony in the form of expert opinion or otherwise as to the ultimate relevance or admissibility of the Notebooks in a civil patent trial that never took place; the ultimate relevance of prior art claims/defenses in such a trial; or the likely or probable outcome of the patent infringement case absent the terminating sanctions imposed by Judge Alsup.

* * *

For all of these reasons, the United States respectfully requests that this Court exclude any testimony of defense experts that certain facts, statements, claims, defenses, issues or items would not ultimately have been relevant and/or would not have been considered by Judge Alsup or a jury in deciding the patent infringement issues in the underlying civil case. As set forth in Section A, *supra*, such testimony is simply irrelevant to any issue before the jury and should be excluded under Federal Rule of Evidence 403. Moreover, any such testimony would be merely conjectural, since Judge Alsup had no occasion to reach the patent infringement issues and since other actions taken by the parties could very well have made those facts, statements, claims, defenses, issues or items relevant in the civil trial had such trial taken place. As such, the proffered testimony does not meet the standards of Rule 702.

VIII. DEFENSE PATENT EXPERTS SHOULD BE PRECLUDED FROM SPECULATING OR OPINING ON THE ULTIMATE ISSUE OF MATERIALITY

The defendant Amr Mohsen has notified the government that he intends to call Roger W. Blakely, Jr., and Dr. Harry L. Tredennick III as expert witnesses in patent law. The defendant has notified the government that his experts will testify as to the relevance of (1) "the Mohsen notebooks" and (2) the prior art defenses raised by Quickturn in the

underlying patent litigation. *See* Ex. 2 attached hereto (11/1/2005 Letter of Bruce Locke).

The United States hereby moves to preclude Mr. Blakely and Dr. Tredennick, or any defense witness, from rendering an opinion that any particular testimony, statement, item, document or matter was "immaterial" or "material." The basis of this motion is that such an opinion is not the proper subject of expert testimony.

Federal Rule of Evidence 704(a) provides, in relevant part, that "testimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact." Rule 704(a) was designed to abolish the "ultimate issue" rule. *See* Fed. R. Evid. 704, advisory comm. notes. Nevertheless, opinion testimony that embraces an ultimate issue may be excludable on other grounds. *See Torres v. County of Oakland*, 758 F.2d 147, 150 (6th Cir. 1985) ("The effect of Rule 704 is merely to remove the proscription against opinions on 'ultimate issues' and to shift the focus to whether the testimony is 'otherwise admissible.'"); *see also* Fed. R. Evid. 704, advisory comm. notes (noting that rules of evidence, including Rule 702, "afford ample assurances against the admission of opinions which would merely tell the jury what result to reach").

Federal Rule of Evidence 702 provides that "[i]f scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert . . . may testify thereto in the form of an opinion or otherwise." Expert testimony on an ultimate issue is therefore excludable under Rule 702 if it does not aid the jury. *United States v. Barile*, 286 F.3d 749, 760 (4th Cir. 2002). As the Fourth Circuit noted in *Barile*, "[e]xpert testimony that merely states a legal conclusion is less likely to assist the jury in its determination." *Id.*; *see also Woods v. Lecureux*, 110 F.3d 1215, 1220 (6th Cir. 1997) ("It is, therefore, apparent that testimony offering nothing more than a legal conclusion — *i.e.*, testimony that does little more than tell the jury what result to reach — is properly excluded under the Rules."); *Barile*, 286 F.3d at 760 ("The most common reason for excluding opinion testimony that gives legal conclusion is lack of helpfulness. . . . The testimony supplies

the jury with no information other than the witness's view of how the verdict should read.") (quoting Weinstein's Federal Evidence § 704.04[2][a]); *Owen v. Kerr-McGee Corp.*, 698 F.2d 236, 240 (5th Cir. 1983) (noting that Rule 704 is not "intended to allow witness to give *legal* conclusions") (emphasis in original).

According to the Federal Rules of Evidence, an example of an improper question is "Did T have capacity to make a will?" Fed. R. Evid. 704, advisory comm. notes. Because this question is phrased in broad terms and uses a word with specialized legal meaning, it "could readily elicit a legal as well as a fact based response." *Owen*, 698 F.2d at 240. As the Fifth Circuit noted in *Owen*, "[a] direct response, whether it be negative or affirmative, would supply the jury with no information other than the expert's view of how its verdict should read."

Based on the principles set out above, it would be improper to ask any defense witness in this case (or any government witness, for that matter) whether any particular statement, item, or issue was "material" or "immaterial." *See Barile*, 286 F.3d at 761 (noting that asking expert to opine as to whether submissions to FDA contained "materially misleading statements" "arguably constitutes a legal conclusion because materiality has a specialized legal meaning, and it is therefore within the district court's discretion to exclude such testimony"). For these reasons, the United States respectfully requests that this Court enter an order precluding the defendants from asking any witness whether any particular statement, item, or issue was "material" or "immaterial" and precluding any witness from opining that any particular statement, item, or issue was "material" or "immaterial."

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CONCLUSION

For the foregoing reasons, the United States respectfully requests that the Court enter the *in limine* orders requested.

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Respectfully submitted,

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/S/
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