

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF WEST VIRGINIA
MARTINSBURG

FILED
JAN 25 2000
U.S. DISTRICT COURT
MARTINSBURG WV 25401

THE UNIVERSITY OF WEST VIRGINIA
BOARD OF TRUSTEES,
Plaintiff,

v.

KURT L. VANVOORHIES,
Defendant,

CIVIL ACTION NO. 1:97-CV-144
(BROADWATER)

v.

WEST VIRGINIA UNIVERSITY
RESEARCH CORPORATION, et al.

ORDER

On this day, the 11th of January, 2000, came the plaintiff, represented by Andrew G. Fusco, David E. Tungate, and Jeffrey A. Ray, defendant, represented by William A. Kolibash, third-party defendant James Earl Smith, represented by Gordon H. Copland, and third-party defendant West Virginia University Research Corporation, represented by Andrew G. Fusco, for a motion hearing.¹

The Court addressed the following issues: (1) Pending

¹ Doc. #294.

The matter was originally scheduled for trial, Doc. #284, however, the parties informed the Court that they had entered into an agreement dispensing with the necessity of a jury trial. Accordingly, the Court Ordered the parties to appear for a motion hearing to advise the Court of any pending motions and for the Court to advise the parties of same. Doc. #294.

Motions; (2) Counsel for the Defendant's Motion *In Limine* Paragraph 7 and Motion to Compel;² (3) Pending Objections to the Magistrate Judge's Orders; (4) The Status of *VorteKx et. al. v. IAS Communications*, 3:1999cv61; and (5) An Outline of the Final Stages in this Litigation.

1. Pending Motions.

The Court addressed the following pending motions: (1) Motion for Enlargement of Time;³ (2) Second Motion *In Limine* of Third-Party Defendants James E. Smith and ICI;⁴ (3) Motion *in Limine* to Preclude Evidence Relating to the Alleged Misjoinder of Inventors in U.S. Patent Application Serial No. 07/992,970 and Memorandum of Law in Support Thereof;⁵ (4) Motion *in Limine* to Preclude the Use or Admission of Smith Deposition Exhibit 45 and Memorandum of Law in Support Thereof;⁶ (5) Motion to Compel Resumption of Deposition of Defendant Kurt L. VanVoorhies;⁷ and (6) Motion to Dismiss and Memorandum Pursuant to Fed.R.Civ.P.12(h)(3) Asserting that the Court Lacks Subject

² Doc. #212.

³ Doc. #203.

⁴ Doc. #228.

⁵ Doc. #236.

⁶ Doc. #237.

⁷ Doc. #285.

Matter Jurisdiction Over Count 14 of VanVoorhies' Amended Counterclaim.⁸

The Court issued rulings as to the Motion for Enlargement of Time⁹ and the Motion in Limine to Preclude the Use or Admission of Smith Deposition Exhibit 45 and Memorandum of Law in Support Thereof.¹⁰ Counsel for the third-party defendant James Earl Smith, represented by Gordon H. Copland, advised the Court that this motion was rendered moot. Upon consideration of the motion, the Court **ORDERED** that the Motion for Enlargement of Time¹¹ be **DENIED** as moot.

The Court then addressed the Motion in Limine to Preclude the Use or Admission of Smith Deposition Exhibit 45 and Memorandum of Law in Support Thereof.¹² Upon consideration of the arguments concerning this motion, the Court **ORDERED** that the motion be **GRANTED** in part and **DENIED** in part. Specifically, the Court had previously stated, on the record at the pretrial conference, that the defendant could use the exhibit as a demonstrative flow chart, but that the testimonial and/or conclusory statements on the exhibit must be deleted.

The Court advised the parties that it would consider the

⁸ Doc. #288.

⁹ Doc. #203.

¹⁰ Doc. #237.

¹¹ Doc. #203.

¹² Doc. #237.

remaining motions under advisement.

2. Counsel for the Defendant's Motion In Limine Paragraph 7 and Motion to Compel.¹³

Counsel for the plaintiff argued that counsel for the defendant never properly followed the requisite procedures in order to obtain certain documents from the plaintiff. In support of its argument, counsel for the plaintiff argued that plaintiff properly listed documents, specifically the January 24, 1995 letter from Smith to Attorney Silverman, on its privilege log. Further, counsel for the plaintiff argued that counsel for the defendant should have filed a motion to compel in order to procure this document. However, counsel for the plaintiff advised the Court that counsel for the defendant never filed a motion to compel the production of this document. Instead of filing a motion to compel the production of this document, counsel for the plaintiff argued that counsel for the defendant filed a Motion *In Limine* to exclude plaintiff's use of this document.¹⁴

In contrast, counsel for the defendant argued that it did file a motion to compel the production of this document.¹⁵ In

¹³ Doc. #212.

¹⁴ *Id.*

¹⁵ Doc. #143.

In this context, the Court addressed the Scheduling Orders. The Court initially Ordered that discovery be completed on October 6, 1998. Doc. #24. However, the Court then entered a

this motion, counsel for the defendant argued that it sought the production of documents that included the January 24, 1995 letter from Smith to Attorney Silverman.¹⁶ Upon consideration of the motion to compel, the Magistrate Ordered that the motion be granted.¹⁷ Plaintiff objected to this Order.¹⁸

The Court took the matters of the defendant's motion *in limine* and motion to compel under advisement.

3. Pending Objections to the Magistrate Judge's Orders.

The parties advised the Court that there are, at present, the following objections pending to the Magistrate Judge's Orders: (1) Objection of the University of West Virginia Board of Trustees on Behalf of West Virginia University and Third-Party Defendant West Virginia University Research Corporation to Order of Magistrate Granting in Part and Denying in Part Defendant's

Stipulation and Order Extending Scheduling Order, extending the discovery deadline to June 1, 1999. Doc. #69.

¹⁶ *Id.* ("**REQUEST FOR PRODUCTION 23:** Produce each and every document that mentions or references Professor Smith, including any and all correspondences to and from Professor Smith").

Plaintiff objected to this request as, *inter alia*, overbroad. Doc. #148.

¹⁷ Doc. #206 (granting the motion "insofar as any and all documents that mention or refer to Professor Smith and are related to the subject matter of this action because only such documents are likely to lead to the discovery of admissible evidence.").

¹⁸ Doc. #208.

Motion to Compel;¹⁹ (2) Appeal of Magistrate Judge's December 3, 1999 Order Requiring Defendant to Pay Plaintiff and Third-Party Defendant Reasonable Expenses Under Fed.R.Civ.P. 37 and Requiring Plaintiff and Third-Party Defendant to Provide Further Documentation;²⁰ and (3) Objections to the Supplemental Proposed Jury Instructions of Dr. VanVoorhies.²¹

The Court informed the parties that it was aware of same and would take these objections under advisement for a final ruling.

4. The Status of *VorteKx et. al. v. IAS Communications*, 3:1999cv61.

The Court previously Ordered the case of *VorteKx et. al. v. IAS Communications*, 3:1999cv61 to be consolidated with this case.²² Counsel for the plaintiff, David E. Tungate, advised the Court that while this case is upon appeal, pursuant to the parties' agreement waiving the necessity for a jury trial,²³ the Court should enter an Order issuing a stay of *VorteKx et. al. v. IAS Communications*, 3:1999cv61. Upon consideration of counsel for the plaintiff's request, and there being no objection by

¹⁹ *Id.*

²⁰ Doc. #273.

²¹ Doc. #289.

²² Doc. #199.

²³ Doc. #294.

counsel for the defendant, the Court **ORDERED** counsel for the plaintiff, David E. Tungate, to provide the Court with a proposed Order staying *VorteKx et. al. v. IAS Communications*, 3:1999cv61, while this case is upon appeal pursuant to the parties' agreement waiving the necessity for a jury trial.²⁴

5. An Outline of the Final Stages in this Litigation.

The Court advised the parties that there are three final steps in the final stages of this litigation. First, the Court informed the parties that it would await the Magistrate Judge's Order, concerning the amount of reasonable fees and expenses in which defendant must pay third-party defendants,²⁵ before entering an Order as to all pending motions. Second, the Court advised the parties that it would issue a final Order on the final issues pending in the motions for summary judgment. Third, the Court advised the parties that upon entry of the final Order, on the issues pending in the motions for summary judgment, the parties could then proceed with an appeal pursuant to the parties' agreement waiving the necessity of a jury trial.

²⁴ *Id.*

²⁵ Doc. #280.

The Clerk is directed to transmit true copies of this Order to counsel of record herein.

ENTER this 25th day of January, 2000.

W. Craig Broadwater

W. CRAIG BROADWATER
UNITED STATES DISTRICT JUDGE