United States District Court,
D. Minnesota.

ROSEN'S, INC., Pathfinder Systems, Inc., and Frank Reinsch, an individual,
Plaintiffs.
v.
VAN DIEST SUPPLY COMPANY; West Central, Inc., d/b/a West Central Chemicals, Inc.; and Pro Tech, Inc., d/b/a Spray Solutions and Sprayer Solutions,
Defendants.

Civil No. 03-3206 (DWF/JSM)

Jan. 13, 2004.

Mathias W. Samuel, Esq., Chad A. Hanson, Esq., Ann N. Cathcart Chaplin, and Rabea J. Zayed, Esq., Fish & Richardson, Minneapolis, MN, for Plaintiffs.

Peter M. Lancaster, Esq., and Kenneth E. Levitt, Esq., Dorsey & Whitney, Minneapolis, MN, for Defendants.

PRETRIAL *MARKMAN* ORDER AND MEMORANDUM

DONOVAN W. FRANK**, District Judge.**

The above-entitled matter is before the Court on Plaintiffs' motion to present extrinsic evidence at the *Markman* hearing presently scheduled for January 30, 2004, and to present a short tutorial on technology, either at the beginning of the *Markman* hearing or prior to the *Markman* hearing, that would necessarily involve a private review by the Court. Defendants oppose, in substantial part, Plaintiffs' request for the reasons stated in their January 12, 2004, letter faxed to the Court.

A Second Amended Pretrial Scheduling Order was filed on November 21, 2003, over the signature of United States Magistrate Judge Janie S. Mayeron. Paragraphs 4 through 8 of that Second Amended Pretrial Scheduling Order set forth what the contents of the joint claim construction statement shall be. The parties filed a joint claim construction statement on October 29, 2003, pursuant to the prior pretrial scheduling orders.

Based upon the presentations of the parties, the Court having reviewed the contents of the file, including all pretrial scheduling orders, and the Court being otherwise duly advised in the premises, the Court hereby enters the following:

ORDER

1. Tutorial

The parties shall each be entitled to present a tutorial on the technology at issue to the Court. Each tutorial should be no longer than one hour and should be submitted to the Court no later than January 23, 2004. The tutorial shall be submitted to the chambers of the undersigned on either a CD-ROM (compact disc read only memory) or VHS videotape. Consistent with the prior practice of the Court, this tutorial is designed to be informational and educational in nature.

However, in the interests of fairness to both parties, to the extent that the existing scheduling orders did not require or otherwise request a tutorial, and in the event counsel for Plaintiffs or Defendants request additional time to prepare and provide to the Court such a tutorial, the Court will allow reasonable departures from this time frame. In any event, the presentation of the tutorial shall not occur at the *Markman* hearing.

2. Extrinsic Evidence: Scope of *Markman* Hearing

Plaintiffs' motion and request to present extrinsic evidence is **GRANTED IN PART** and **DENIED IN PART** as follows.

a. The Court will permit the Plaintiffs to introduce, either by live testimony, deposition, or affidavit, the inventor's testimony so long as the purpose of the testimony is not to contradict the claim construction at issue.

b. The Court will only receive extrinsic evidence, be it by affidavit, live testimony, or deposition, if its express purpose is to aid the Court to better understand the underlying technology in question.

3. Length of *Markman* Hearing

The Court respectfully requests that the parties contact Calendar Clerk Lowell Lindquist at 651-848-1296, regarding counsel's availability for January 29, 2004. The Court will set aside a substantial portion of the day for that purpose. This provision contemplates that the parties will be allowed 30 minutes each for their summary judgment motion, separate from the *Markman* hearing.

MEMORANDUM

Tutorial

It has been this Court's practice for a number of years to encourage the parties to present a tutorial directly to the Court, generally no more than one-hour in length, and to submit it in advance of the *Markman* hearing. The Court takes full responsibility for not requesting that that provision be included in the scheduling orders issued by the Magistrate Judge. Ironically, it is the undersigned that brought back from the Northern District of California, a few years ago, the idea of a tutorial, along with the pretrial scheduling orders that are now in use in the District of Minnesota in various forms by all of the Judges. The Court has found these tutorials to be very instructive in previous patent cases. For these reasons, this Court has allowed some leeway to the Defendants if they choose to submit a tutorial.

Extrinsic Evidence

Paragraph 3 of the Second Amended Pretrial Scheduling Order requires each party to provide a preliminary identification of extrinsic evidence, including, without limitation, dictionary definitions, citations to learned

treatises and prior art, and testimony of witnesses that the parties contend support their respective claim constructions. This Order, at paragraph 8, contemplates that the Court will then issue an order as to whether it will receive extrinsic evidence and, if so, the particular evidence it will receive. It is unclear to the Court whether the parties intend to supplement the record with extrinsic evidence in the form of affidavits, deposition testimony, or live testimony. Obviously, the Plaintiffs have indicated their intent to call the inventor to testify. A court may utilize, from time to time, an inventor's testimony in determining such things as the background of the technology or the meaning of the patent claim, so long as that testimony does not contradict the intrinsic evidence in the case. If, and only if, the intrinsic evidence is insufficient for determining the acquired meaning of the claims, then extrinsic evidence may be used or otherwise consulted if its purpose is to contradict the claim construction at issue.

Whether the Court looks to Vitronics Corp. v. Conceptronic, Inc ., 90 F.3d 1576 (Fed.Cir.1996) or Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298 (Fed.Cir.1999), the role of expert testimony is limited in a claim construction hearing unless its primary purpose is to enlighten the Court on the technology involved in the case or unless the particular use of the disputed claim language, when all of the intrinsic evidence is scrutinized, is insufficient to determine the acquired meaning of that language. Extrinsic evidence, however, cannot be relied upon to contradict the meaning of the disputed claim language if it is clearly discernable from the intrinsic evidence. For this reason, the purpose for which the testimony is being offered becomes critical as to its admissibility.

The Court will set aside a substantial portion of January 29, 2004, assuming that the parties are available to move the *Markman* hearing up to Thursday. If the parties are unable to agree on a format for the *Markman* hearing, including the scope of the *Markman* hearing, Calendar Clerk Lowell Lindquist can be contacted so that either an additional letter brief can be submitted to the Court or a short telephone conference can be set up. Even though the Court has set aside a substantial portion of January 29th, that does not necessarily imply that the Court has concluded that a full day is necessary for the summary judgment motion and the *Markman* hearing.

D.Minn.,2004.
Rosen's, Inc. v. Van Diest Supply Co.