

1 E. SCOTT DOSEK #012114
 JOHN P. PASSARELLI #16018 (NE)
 2 KUTAK ROCK LLP
 8601 North Scottsdale Road #300
 3 Scottsdale, AZ 85253-2742
 (480) 429-5000
 4 Facsimile: (480) 429-5001

5 *Attorneys for Plaintiff*
 SOILWORKS, LLC, an Arizona corporation

6 **UNITED STATES DISTRICT COURT**
 7 **IN AND FOR THE DISTRICT OF ARIZONA**

8 SOILWORKS, LLC, an Arizona
 9 corporation,

10 Plaintiff / Counterdefendant/
 Counterclaimant,

11 v.

12 MIDWEST INDUSTRIAL SUPPLY, INC.,
 an Ohio corporation authorized to do
 13 business in Arizona,

14 Defendant / Counterclaimant /
 Counterdefendant.

NO.: 2:06-CV-2141-DGC

**SOILWORKS, LLC'S OPPOSITION TO
 MIDWEST INDUSTRIAL SUPPLY,
 INC.'S MOTION *IN LIMINE* (DOC.104)
 TO BAR TESTIMONY AND
 EVIDENCE REGARDING THE
 VALIDITY OR CONSTRUCTION OF
 MIDWEST'S PATENTS**

(Before the Honorable David G. Campbell)

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 16 Midwest's Motion *in limine* to Bar Testimony and Evidence Regarding the Validity or
 17 Construction of Midwest's Patents ("Motion") should be denied because it ignores the record
 18 and facts before this Court and wholly misstates the law addressing expert testimony in
 19 claims construction.

20 Midwest argues that this Court should grant its Motion because Soilworks failed to
 21 provide "any relevant documents" that "identify the claims that are ambiguous or required
 22 definition or construction." Midwest's argument fails under the weight of its own trial
 23 exhibits. On July 23, 2007, a full five (5) months before Midwest provided any type of
 24 claims chart or construction of its own, Soilworks responded to Midwest's interrogatories
 25 and requests for production by producing a claims chart for each of the Midwest Patents
 26 ("Soilworks Claims Charts").¹ See Midwest's Trial Exhibit No. 87, as well as Soilworks'

27 ¹ It should not be lost on this Court that the party alleging patent infringement—who has the
 28 burden of proof on infringement—failed to produce any claims chart whatsoever until
 December 27, 2007, just 15 days before the close of discovery. To this day, Midwest has

1 Trial Exhibit Nos. 6 and 7.

2 The parties Joint Pretrial makes it clear that Midwest does not oppose the Soilworks
3 Claims Charts as admissible exhibits at trial! *Id.* Furthermore, Mr. Skeriotis, Midwest’s
4 outside counsel, used the Soilworks Claims Charts in his Fed.R.Civ.P.30(b)(6) deposition of
5 Soilworks, and his deposition of Soilworks’ President, Chad Falkenberg. Mr. Skeriotis
6 questioned Mr. Falkenberg extensively on the meaning of the Midwest Patents’ claims and
7 the Soilworks Claims Charts. (*See* Falkenberg Depo. at 161:18-25-187:1-25, attached hereto
8 as **Exhibit 1**). Mr. Falkenberg reasserted the same claim construction questions and
9 ambiguities identified in the Soilworks Claims Charts, to which Midwest has never
10 responded. Midwest’s statement of the facts must be ignored.

11 The Soilworks Claims Charts do exactly what Midwest’s Motion claims Soilworks
12 has *not* done: i.e., “identify the claims that are ambiguous or required definition.” (Motion at
13 2). Soilworks Claims Charts identify no less than five (5) ambiguous terms set forth in more
14 than half of the Midwest Patents’ claims. *See* Midwest’s Trial Exhibit No. 87, as well as
15 Soilworks’ Trial Exhibit Nos. 6 and 7. It shocks the conscious that Midwest would ask this
16 Court to Bar Soilworks from presenting evidence of its claim construction when Midwest
17 barely provided its own construction and never addressed the terms that Soilworks identified
18 as ambiguous or requiring definition. Midwest’s Motion should be denied.

19 Midwest next argues that Soilworks “should be barred from presenting any evidence
20 challenging or varying the construction of Midwest’s patents” because “a *Markman* hearing
21 necessarily requires expert testimony” and no such testimony is available. (Motion at 3).
22 Midwest has fabricated its own self-serving rule of law without any citation. This is
23 understandable because no such law exists. Instead, the Federal Circuit is unequivocal about
24 the roll of expert testimony in claim construction.

25 The Federal Circuit holds that “[a] trial judge has **sole discretion** to decide whether or
26 not he needs, or even just desires, an expert's assistance to understand a patent.” *Seattle Box*

27 _____
28 failed to provide Soilworks or this Court its basis/analysis for its infringement claims or
identified the claims which it asserts Soilworks’ Durasoil product infringes.

1 *Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984) (emphasis
2 added). “In determining the meaning of the claims, which is a question of law, **the court**
3 **should look at the claim language, the specification, and the prosecution history**” not
4 expert testimony. *Markman v. Westview Instr., Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)
5 (emphasis added) (citing *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir.
6 1991)). “**If** necessary to ascertain the true meaning of the disputed claims, the court, **in its**
7 **discretion**, may also look to extrinsic evidence such as expert [] testimony . . .” *Markman*,
8 52 F.3d at 980 (citing *Brown v. Piper*, 91 U.S. 37, 41, (1875)) (emphasis added). The
9 Federal Circuit’s foundational case regarding claims construction, *Markman*, holds that
10 expert testimony is not required. Instead the Court should first look to the claim language
11 itself, the specification and prosecution history as the primary sources for determining the
12 meaning of a patent’s claim language. Whether expert testimony is warranted is solely
13 within the discretion of this Court.

14 For these reasons, Midwest’s Motion should be denied.

15 Dated this 24th day of September, 2008.

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17 KUTAK ROCK LLP

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19 By /s E. Scott Dosek

20 E. Scott Dosek
21 John P. Passarelli (*Pro Hac Vice*)
22 Suite 300
23 8601 North Scottsdale road
24 Scottsdale, AZ 85253-2742

25
26 *Attorneys for Plaintiff Soilworks, LLC*
27
28

CERTIFICATE OF SERVICE

I hereby certify that on September 24, 2008, the foregoing **Soilworks, LLC's Opposition to Midwest Industrial Supply, Inc.'s Motion *In Limine* to Bar Testimony And Evidence Regarding the Validity or Construction of Midwest's Patents** was filed electronically. Notice of this filing will be sent to all parties by operations of the Court's electronic filing system. Parties may access this filing through the Court's system.

/s Amy S. Fletcher
Amy S. Fletcher

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