

United States District Court,
N.D. Illinois, Eastern Division.

HEIDELBERGER DRUCKMASCHINEN AG a corporation of Germany,
Plaintiff.

v.

OHIO ELECTRONIC ENGRAVERS, INC., an Ohio corporation,
Defendant.

May 12, 2000.

MEMORANDUM OPINION AND ORDER

HART, J.

Plaintiff Heidelberg Druckmaschinen AG alleges that defendant Ohio Electronic Engravers, Inc. infringed plaintiff's patent, U.S. Patent No. 4,259,697 (the " '697 patent"). Through the course of this litigation, plaintiff has narrowed its claim of infringement to a contention that defendant infringed claim 7 of the '697 patent, a method for improved reproduction of edges during the engraving of screened printing forms. Plaintiff alleges that defendant produces an engraving machine that directly infringes the patent and that defendant has induced and contributed to infringement by selling its engraving machine. Plaintiff has moved for summary judgment that the accused device literally infringes the '697 patent. Plaintiff also moves for summary judgment that claim 7 was not anticipated, which is one of the defenses raised by defendant. FN1 In two related motions, plaintiff moves to exclude or strike certain evidence that plaintiff has presented in response to summary judgment. Additionally, at the court's request, the parties have presented nominees to be a court-appointed expert in the event that the court determines such an appointment would be appropriate.

FN1. Since defendant raises additional defenses that are not a subject of the summary judgment motions, success on the pending summary judgment motions would not necessarily result in a finding of liability in plaintiff's favor.

On a motion for summary judgment, the entire record is considered with all reasonable inferences drawn in favor of the nonmovant and all factual disputes resolved in favor of the nonmovant. *Augustine Medical, Inc. v. Progressive Dynamics, Inc.*, 194 F.3d 1367, 1370 (Fed.Cir.1999); *Schneiker v. Fortis Insurance Co.*, 200 F.3d 1055, 1057 (7th Cir.2000); *Baron v. City of Highland Park*, 195 F.3d 333, 337-38 (7th Cir.1999). The burden of establishing a lack of any genuine issue of material fact rests on the movant. *Vivid Technologies, Inc. v. American Science & Engineering, Inc.*, 200 F.3d 795, 806-07 (Fed.Cir.1999); *Wollin v. Gondert*, 192 F.3d 616, 621-22 (7th Cir.1999); *Essex v. United Parcel Service, Inc.*, 111 F.3d 1304, 1308 (7th Cir.1997). The nonmovant, however, must make a showing sufficient to establish any essential element for which it will bear the burden of proof at trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986); *Shank v. William R. Hague, Inc.*, 192 F.3d 675, 681 (7th Cir.1999); *Wintz v. Northrop Corp.*, 110 F.3d 508, 512 (7th

Cir.1997). The movant need not provide affidavits or deposition testimony showing the nonexistence of such essential elements. *Celotex*, 477 U.S. at 324. Also, it is not sufficient to show evidence of purportedly disputed facts if those facts are not plausible in light of the entire record. *See Paragon Podiatry Laboratory, Inc. v. KLM Laboratories, Inc.*, 984 F.2d 1182, 1191 (Fed.Cir.1993); *NLFC, Inc. v. Devcom Mid-America, Inc.*, 45 F.3d 231, 236 (7th Cir.), *cert. denied*, 515 U.S. 1104 (1995); *Covalt v. Carey Canada, Inc.*, 950 F.2d 481, 485 (7th Cir.1991); *Collins v. Associated Pathologists, Ltd.*, 844 F.2d 473, 476-77 (7th Cir.), *cert. denied*, 488 U.S. 852 (1988). As the Seventh Circuit has summarized:

The moving party bears the initial burden of directing the district court to the determinative issues and the available evidence that pertains to each. "[A] party seeking summary judgment always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any' which it believes demonstrate the absence of a genuine issue of material fact ." *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *id.* at 325 ("the burden on the moving party may be discharged by 'showing'-that is, pointing out to the district court-that there is an absence of evidence to support the nonmoving party's case"). Then, with respect to issues that the non-moving party will bear the burden of proving at trial, the non-moving party must come forward with affidavits, depositions, answers to interrogatories or admissions and designate specific facts which establish that there is a genuine issue for trial. *Id.* at 324. The non-moving party cannot rest on the pleadings alone, but must designate specific facts in affidavits, depositions, answers to interrogatories or admissions that establish that there is a genuine triable issue. *Id.* The non-moving party "must do more than simply show that there is some metaphysical doubt as to the material facts." *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). "The mere existence of a scintilla of evidence in support of the [non-moving party's] position will be insufficient; there must be evidence on which the jury could reasonably find for the [non-moving party]." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986).

Selan v. Kiley, 969 F.2d 560, 564 (7th Cir.1992).

Claim 7 of the '697 patent reads as follows:

A method for improved reproduction of edges in originals during the engraving of screened printing forms, wherein an engraving tool of an electromagnetic engraving member controlled by an engraving signal cuts a plurality of cups into said printing forms, the method comprising the steps of:

(a) generating a screen signal which represents the printing screen and said screen signal causes an oscillating movement of said engraving tool at the frequency of the screen signal, whereby the engraving tool in each case has its largest deflection in the direction of the printing form at a periodically recurrent amplitude value of the screen signal,

(b) scanning the original image point by point to obtain an analog image signal,

(c) converting said analog image signal to a digital image signal,

(d) sampling said image signal at a frequency which is higher than the frequency of the screen signal to obtain digital principal image values corresponding to the first image points in the original and additional intermediate digital image values corresponding to image points of the original lying between said first image points in the scanning direction,

(e) reconverting said principal digital image values and said intermediate digital image values into an analog image signal, whereby a single signal jump which occurs during scanning an edge in the original is divided up into consecutive partial signal jumps, said reconverted image signal determining the depth of the cups to be engraved and the density level to be reproduced,

(f) superimposing said reconverted analog image signal onto said screen signal to obtain said engraving signal in such a relation that the partial signal jumps associated with the principal image values are phase shifted to lead in time to the recurrent amplitude values of the screen signal, whereby the cups representing an edge in the original are shifted relatively to the printing screen toward the higher level of density so as to accomplish improved reproduction of edges.

Before turning to the facts assumed to be true for purposes of summary judgment, plaintiff's objections to defendant's evidence will be considered. Plaintiff objects that certain evidence was not timely disclosed during discovery and that one of defendant's experts, Dalbert Shefte, is not qualified to opine on certain issues . FN2

FN2. Plaintiff's motion to exclude the testimony of Shefte is broader than is appropriate to address at the present time. At the present time, it will only be considered whether his testimony is appropriate as regards literal infringement and anticipation, including the court's construction of the patent. To the extent plaintiff's motion to exclude addresses additional issues, it is denied without prejudice to submitting a motion in limine or objection to the witness at the time the final pretrial order is presented.

Plaintiff objects to defendant's use of Shefte as an expert. Shefte is an attorney who has specialized in intellectual property law, including patent law. He has an undergraduate degree in mechanical engineering. According to his curriculum vitae, Shefte's "practice includes the study and evaluation of inventions, the preparing and prosecuting of patent applications in the U.S. Patent Office, analyzing patent validity and infringement issues, litigating on behalf of patentees and alleged infringers, negotiating and drafting of licenses and other agreements, and counseling clients with regard to inventions and patents." Defendant contends Shefte is one of ordinary skill in the pertinent art based on his mechanical engineering degree and his work experience representing an engraver and a printing industry trade association.

The parties agree that "[t]he art to which the '697 patent belongs is electronic halftoning generally and the application of electronic halftoning to engraving specifically." *See* Infringement Rule 56.1 Stmt. para. 18. The experts provided various definitions of one ordinarily skilled in the art, definitions which do not strictly correspond with the parties' description of the pertinent art. In his report, Shefte referred to the relevant art as "the art of printing, engraving and the graphic arts field, including lithography, chemical etching, offset printing, letterpress, color separation, film plotting and other graphic arts and printing processes." Shefte Rpt. 22-23. He described those ordinarily skilled in the art as having college degrees in a technical field and several years of experience in the relevant art. *Id.* at 23. After being asked about this definition at his deposition, Shefte testified that he is not one of ordinary skill in the art relevant to the '697 patent. Shefte Dep. 36. Shefte also testified that, using the definition of another one of defendant's experts (Ernst Hoffman) which was limited to gravure, Shefte did not qualify as one of ordinary skill in the art. *Id.* at 34. Defendant points to the testimony of one of plaintiff's experts, Robert Stevenson, indicating that the art applicable to the '697 patent is engraving which uses signal processing and image processing. Stevenson Dep. 24. Stevenson defined one who is skilled in the art as "[s]omeone who would pick up that FN3 and understand

that and be able to apply it; someone who has at least a bachelor's degree in engineering, mechanical or electrical, and some experience with signal processing beyond what you would get out of the bachelor's program." *Id.* at 24-25. Defendant contends Shefte satisfies that definition. Defendant, however, presents no specific evidence that Shefte's performance of legal work for printers and engravers resulted in his maintaining and acquiring sufficient skills as regards signal processing and image processing.

FN3. By "that," Stevenson apparently meant the '697 patent, but he may have meant signal processing and image processing in general.

Shefte has not been shown to be one of at least ordinary skill in the art applicable to the '697 patent.FN4 Neither has he been shown to have the qualifications to testify as an expert in the field of engraving, mechanical engineering, signal processing, or other technical fields pertinent to the '697 patent. He has been shown to be well qualified as an expert in the field of patent law. The question is whether, as an expert in that field, he can provide any useful testimony regarding the issues pertinent to summary judgment.

FN4. A person of ordinary skill in the art is a hypothetical person having ordinary skill in the field and knowledge of all the prior art; it does not necessarily describe a real person. *Endress + Hauser, Inc. v. Hawk Measurement Systems Pty. Ltd.*, 122 F.3d 1040, 1042 (Fed.Cir.1997). One with greater than ordinary skills can still provide useful testimony as to the hypothetical person of ordinary skill. *Id.* One with less than ordinary skill in the art, however, is not likely to be able to provide useful testimony.

To the extent it is appropriate to resort to extrinsic evidence in construing claim 7, expert testimony is one possible source to consider. *See Zodiac Pool Care, Inc. v. Hoffinger Industries, Inc.*, 206 F.3d 1408, 1414 (Fed.Cir.2000); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed.Cir.1999). As an aid to understanding the underlying technology, or sometimes as an aid to understanding technical terms, testimony from one skilled in the art may be helpful. *See id.* at 1308-09.

[I]t is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field. This is especially the case with respect to technical terms, as opposed to non-technical terms in general usage or terms of art in the claim-drafting art, such as "comprising." Indeed, a patent is both a technical and legal document. While a judge is well-equipped to interpret the legal aspects of the document, he or she must also interpret the technical aspects of the document, and indeed its overall meaning, from the vantage point of one skilled in the art.

Id. at 1309.

However, testimony from a patent lawyer, not skilled in the art, as to how to construe the language of the patent generally will not be helpful and may be excluded. *Endress + Hauser, Inc. v. Hawk Measurement Systems Pty. Ltd.*, 122 F.3d 1040, 1042 (Fed.Cir.1997); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370 (1996); *Abraskin v. Entrecap Corp.*, 55 F.Supp.2d 224, 228 (S.D.N.Y.1999).FN5 Nothing in Shefte's reports, his deposition testimony, or affidavit is found to be helpful in construing the meaning of claim 7. He simply attempts to construe the language as written. He does not provide any assistance within his particular expertise or knowledge as a patent lawyer. *See, e.g.*,

John B. Sgagna, Jr., *Presenting the Witnesses Special to a Patent Trial*, 572 Practising Law Institute/Patent Litigation 95, 109 (1999) (patent lawyer testimony regarding prosecution history). Shefte's testimony will not be considered for purposes of claim construction.

FN5. Defendant's citation to *Yarway Corp. v. Eur-Control USA, Inc.*, 775 F.2d 268, 274-75 (Fed.Cir.1985), is not controlling. There, the Federal Circuit ruled on the appropriate legal standards and made reference to trial testimony of a patent lawyer who was noted as not being an engineer. The Federal Circuit did not directly rule on the question of whether such evidence was admissible.

Defendant also contends Shefte can provide evidence that is relevant to the defense of anticipation. As previously discussed, however, Shefte lacks skill in the art. His statements that the '697 patent was anticipated by the prior art therefore lack a sufficient foundation to be considered.FN6

FN6. Since this testimony otherwise is not being considered, it is unnecessary to consider plaintiff's additional argument that Shefte's opinions as to anticipation were not timely disclosed.

Much of plaintiff's motion to strike relates to documents that plaintiff contends were untimely disclosed by defendant. Discovery in this case closed on October 27, 1999. Document discovery closed prior to that time. Defendant represents that additional documents were discovered in November 1999 and timely disclosed to plaintiff as supplements to prior discovery responses. The additional documents were provided to plaintiff on December 2 and 3, a few days before the due date for defendant's answer to plaintiff's summary judgment motions. Defendant provides affidavits supporting that the additional documents were found in two places. One set of documents, which concern development of defendant's engraver more than 20 years ago, was found in a cabinet of an engraving technician who had left defendant's employ in December 1998. These documents were found approximately November 8 when the cabinet was being moved to install a work bench. The other set of documents was provided to David Seitz, defendant's Vice-President of Research and Development, on November 29. Seitz received the documents from Lester Buechler, the inventor of defendant's engraver and defendant's former owner. Buechler is now in his eighties and no longer employed by defendant, but he has cooperated in defendant's defense of this lawsuit. The documents were at Buechler's house and largely consist of old invoices, cancelled cheques, and receipts. Defendant relies on some of these documents as evidence of when Buechler developed defendant's engraver.

There is nothing to directly refute defendant's representation as to how and when these documents were found. Plaintiff argues that it is suspicious that they were found during the time period that defendant would have been preparing its response to the summary judgment motion. Plaintiff suggests that a more thorough search during the period of discovery also would have resulted in the documents being found. Defendant's version of the facts, however, is supported by affidavit and is not so incredible that it cannot be believed. It is accepted that defendant acted in good faith in performing its original document search and the additional documents were a surprise to defendant as well. Plaintiff also complains about the three to four week delay in turning over the first set of documents. While this may be longer than it should have taken defendant to turn over the documents, it is not so long that it can be characterized as undue delay. Additionally, plaintiff has shown no prejudice from receiving the documents after the close of discovery. This is not the eve of trial, so plaintiff is not prejudiced in preparing for trial. There is also no indication that plaintiff was unable to sufficiently prepare its reply in support of summary judgment nor does it contend that it would not have incurred the expense of moving for summary judgment had it known about the additional documents.

Further, there is no contention that the additional disclosures would result in plaintiff having to duplicate prior discovery.

It is found that defendant seasonably supplemented its discovery. No portion of defendant's response to summary judgment will be stricken based on untimely disclosure of the two sets of documents.

Plaintiff seeks to strike the affidavit of George Battrick on the ground that he was not previously disclosed as a witness. Battrick is an employee of the European Rotogravure Association ("ERA"). His affidavit authenticates the minutes of an ERA meeting from 1977. The minutes themselves were disclosed in discovery. Battrick's affidavit will not be stricken.

In addition to objecting to the affidavit of David Seitz on the ground that it relies on the belatedly disclosed documents, plaintiff objects that Seitz was not properly disclosed as an expert and did not provide an expert's report. Plaintiff also contends that, in part, Seitz's affidavit contradicts his prior deposition testimony.

Rule 26(a)(2)(B) requires that a report be provided by "a witness who is retained or specially employed to provide expert testimony in the case or whose duties as an employee of the party regularly involve giving expert testimony." Seitz is an employee of defendant, not specially retained. Also, being an expert witness is not a regular aspect of his employment. The report requirement of Rule 26(a)(2)(B) does not apply to him and plaintiff implicitly concedes this in its reply.

Rule 26(a)(2)(A) does not limit its disclosure requirement to retained experts or employees whose regular duties include expert testimony. Defendant does not deny that it did not expressly disclose during discovery that Seitz would provide expert testimony. It contends, however, that, during his deposition, Seitz was thoroughly questioned by plaintiff regarding his opinions. Plaintiff does not specifically point to any opinion expressed in Seitz's affidavit for which it asked no questions during his deposition. Plaintiff does not show that it was deprived of any pertinent discovery due to the untimely disclosure nor that it was otherwise prejudiced. Seitz's affidavit will not be stricken on the ground of failure to timely disclose that he would be used as an expert.

As to any contradictions between Seitz's affidavit and prior deposition testimony, plaintiff's contentions would be considered in the process of determining the existence of genuine factual disputes .FN7 *See generally* Sinskey v. Pharmacia Ophthalmics, Inc., 982 F.2d 494, 498 (Fed.Cir.1992), *cert. denied*, 508 U.S. 912 (1993); Piscione v. Ernst & Young, L.L.P., 171 F.3d 527, 532-33 (7th Cir.1999).

FN7. In ruling on the summary judgment motions, plaintiff's contentions regarding the inconsistencies have been considered. This court does not favor motions to strike evidence in response to summary judgment motions or answers. Instead, this issue should have been raised in a Rule 56.1 Reply Statement and, if highlighting was necessary, in plaintiff's reply brief itself.

The objection to the Buechler affidavit is solely based on the delayed disclosure of documents. As previously discussed, that evidence will not be stricken. That objection is denied.

Resolving all genuine factual disputes and drawing all reasonable inferences in defendant's favor, the facts assumed to be true for purposes of summary judgment are as follows. The invention of the '697 patent is

generally related to an improved electronic halftoning technique for engraving devices. Engraving devices produce printing forms which are generally used in high volume printing devices. On these printing forms, the engraving devices engrave a series of cups.FN8 When the form is used on a printing device, the cups hold ink which is then transferred to the final printing surface. The engraving device determines the size, depth, and location of the cups, which determines how much ink is deposited at a particular location. The amount of ink determines the tone at that location.

FN8. An individual cup is sometimes referred to as an "engraved cell."

Often, the subject matter being printed is in the form of a continuous image, for example, a photograph. Such an image will have a continuance of values between white and black, often referred to as gray levels. Electronic halftoning is the process by which gray level information from a continuous tone image is used by an engraving machine to engrave cups corresponding in depth and width to the gray level information. The electronic halftoning technique contained in both claim 7 and the accused device involve scanning image information from an original source, converting the resulting analog signal into a digital signal, reconvertng the digital signal into an analog signal, and using the resulting analog signal to reproduce the original image. The signal that determines location of a cup on the printing form is referred to as the "screen signal." FN9

FN9. The printing form is on a cylinder. The cylinder revolves as the engraving device cuts cups in the printing form's surface. After one revolution, the engraving device moves to the next row. Thus, the screen signal directs the engraving device to its location at a particular engraving cell of a row on the cylinder/printing form. An image signal directs the engraving device as to the manner (depth and width) in which to cut the cup within that engraving cell.

Prior art sampled gray level information from an original image at a rate of once per engraved cell.FN10 In other words, the sampling frequency for the original image matched engraved cell frequency on the printing form. The '697 patent is different. It samples gray level information from the original image more than once per engraved cell. In other words, under the '697 patent, the sampling frequency for the original image is greater than the engraved cell frequency. Another way of describing this is that the original image is scanned at shorter intervals than an individual engraving cell. FN11 The scanning points on the image that correspond with the engraved cell are referred to as being represented by principal image values. The image scanning points that lie between are referred to as being represented by intermediate image values. The principal image value is combined with the intermediate image values that follow it in the scanning direction to produce an image signal value which instructs the engraving device as to how to engrave an individual cup. Further, as stated in claim 7, the higher frequency sampling is performed on a digital signal and converted back to an analog signal when recombined.

FN10. For purposes of literal infringement, it can be assumed that all prior art functioned in this manner, which is plaintiff's contention. Defendant contends other prior art also involved multiple sampling.

FN11. For example, if every engraved cell was one millimeter apart and the scanning frequency for the image was double that of the engraved cells, the image would be scanned every half-millimeter. Thus, the scanning points on the millimeters would directly correspond with an engraved cell while the scanning

points on the half-millimeters would not.

The technique claimed in the '697 patent is claimed to result in an improvement over prior art in the reproduction of high contrast areas by recombining the multiple image values in a manner that shifts the center of cups in high contrast areas toward the darker region. This is claimed to result in a printed image with a sharper contrast that is more pleasing to the human eye than those resulting from prior art.

As to the preceding description of claim 7, the parties are in agreement. They differ, however, as to the construction of other provisions of claim 7, including the meaning of partial signal jumps, phase shifting, and recurrent amplitude values.

The '697 patent refers to analog and digital signals, including conversions between the two types of signals. The parties agree that the "most relevant definition" of analog as used in the '697 patent is "pertaining to devices, data, circuits, or systems that operate with variables which are represented by continuously measured voltages of other quantities." In other words, an analog signal is a continuous signal with the magnitude varying up and down. In terms of the printing process, an analog signal is a continuous line or wave representing varying gray levels. For present purposes, the parties agree that digital means "pertaining to data in the form of digits." For example, one embodiment in the '697 patent refers to a digital converter with 8 bits resolution. This means that the continuum of gray levels from black (0) to white (255) would be represented by 256 different numbers.FN12 Unlike the analog representation, each digit represents a discrete point on the continuum from black to white; it is not one continuous, uninterrupted gradation. To convert the scanned image's resulting analog signal to a digital signal, the analog signal is sampled at equally spaced and discrete intervals and a corresponding numerical value is assigned for each interval sampled.FN13

FN12. Eight different on/off switches can be combined in 256 (2^8) different ways.

FN13. According to Seitz, an analog signal typically may have 10,000 or more distinguishable levels, depending on the resolution of the signal. Seitz opines that, with an 8-bit digital processor limited to only 256 levels, significant amounts of image data would be lost during the conversion process. To avoid data loss, the sampling must be of sufficient frequency, in accordance with the well accepted Nyquist Theorem.

Resolving the parties' dispute requires understanding what is meant by "superimposing said reconverted analog image signal onto said screen signal to obtain said engraving signal in such a relation that the partial signal jumps associated with the principal image values are phase shifted to lead in time to the recurrent amplitude values of the screen signal." As previously set forth, the screen signal locates the engraving device on the printing form. Superimposing the image signal onto the screen signal means that the image signal tells the engraving device how to cut the cup at a particular location identified by the screen signal.

As stated in paragraph (a) of claim 7, the "recurrent amplitude value of the screen signal" is the point at which the engraving device has "its largest deflection in the direction of the printing form." In other words, it is the point at which the engraving device finishes its cutting of a cup, which would be the point at which it is deepest into the printing form. Plaintiff contends this corresponds with the trough of the sine wave of the screen signal. Defendant contends it corresponds with the bottom of the sine wave.

The term "partial signal jumps" apparently corresponds to the intermediate values. The parties agree that elements 40 and 41 contained in Figures 3a(B) and 3b(B) of the '697 Patent are examples of partial signal jumps.

The parties disagree as to what claim 7 means by "phase shifted to lead in time." Plaintiff contends its proposed construction is evident from drawings contained in the patent. Defendant relies on testimony of the inventor. Plaintiff contends that a "phase shift" is a "relative time difference between two or more events." Infringement Rule 56.1 Stmt. para. 51. Defendant contends it is "an actual act of adjusting the relationship between the image signal and the screen signal and is not simply a temporal relationship between these two signals." Response to Infringement Rule 56.1 Stmt. para. 51. Plaintiff contends that "phase shifted to lead in time" means "the partial signal jumps associated with the principal image values of the reconverted image signal periodically occur before the recurrent amplitude values of the screen signal." Infringement Rule 56.1 Stmt. para. 52. Defendant disagrees.

Plaintiff relies on drawings in the '697 patent to obtain its proposed construction. Perhaps these constructions are evident from the drawings. However, it takes some level of skill in the art to derive such meaning from the drawings. Neither the parties' briefs nor the reports or testimony of their experts and inventors provide sufficient aid to the court to determine whether one with ordinary skill in the art would derive plaintiff's proposed construction from the drawings or other evidence intrinsic to the '697 patent.

It appears that the parties' experts disagree as to whether defendant's device infringes the '697 patent and as to whether claim 7 was anticipated by the prior art.

On plaintiff's summary judgment motion, genuine factual disputes regarding whether the ERA documents were in existence prior to September 1, 1977 must be resolved in defendant's favor. For purposes of plaintiff's summary judgment motion, the art disclosed by those documents would have to be treated as prior art.

Thus, genuine factual disputes exist that would preclude the granting of either of plaintiff's summary judgment motions. However, resolution of the construction issues may result in a different conclusion. Both motions for summary judgment will be denied.

The court and jury would be aided in understanding the '697 patent and other issues in this case by the appointment of an independent expert. The parties have indicated that Hapet Albert Berberian is an expert in this field. The court will contact Berberian to learn whether he will accept appointment in this case, his availability, and his fee schedule. He will be directed to send a copy of his response to both the court and the parties. The parties shall share equally in the payment of his fee. If appointment is made, the parties shall provide the expert with the pertinent pleadings and discovery, including the parties' summary judgment briefs and exhibits.

The court's independent expert shall provide the court with a report as to his opinions on the issues pertinent to this lawsuit. A copy of the report shall also be provided to each party. The opinions stated in the report may be written in language that would be understandable to one of ordinary skill in the art. However, the expert shall also attempt to provide explanations in language that a layperson, such as the court or a juror, would be expected to understand.

Issues to be addressed by the expert include, but are not limited to, the following:

- (1) A definition of the art pertinent to the '697 patent and a definition of one of ordinary skill in the art.
- (2) A description of the method contained in claim 7 of the '697 patent, including the definition of terms contained therein, as it would be understood by one of ordinary skill in the pertinent art. There should be particular emphasis on those issues or terms for which the parties' submissions indicate differing interpretations, as well as any terms or issues that a reading of today's opinion may indicate the court misunderstood or did not fully understand. In providing these descriptions and definitions, the expert shall note or explain whether such could be unambiguously derived from the intrinsic evidence of the patent itself. To the extent extrinsic evidence is considered, the expert shall note any ambiguities in the patent itself and note what extrinsic evidence was relied upon.FN14

FN14. "Intrinsic evidence consists of the claim itself, the specification, and any prosecution history. Extrinsic evidence includes expert testimony, inventor testimony, dictionaries, treatises, and prior art not cited in the prosecution history." *Zodiac Pool*, 206 F.3d at 1414.

- (3) His opinion as to whether defendant's accused device infringes claim 7 of the '697 patent.
- (4) His opinions as to whether claim 7 of the '697 patent was anticipated or obvious in light of the prior art. In rendering these opinions, the expert shall specifically state whether his opinion would be different if the art represented by the 1977 ERA documents were not to be considered prior art.

Within seven days, each party may submit suggestions to the proposed expert as to additional issues it believes should be addressed. After the expert submits his report, the parties shall have an opportunity to depose him.

At the first status hearing after the expert's deposition, the parties shall be prepared to address the question of settlement and whether they believe a *Markman* hearing is necessary.

IT IS THEREFORE ORDERED that:

- (1) Plaintiff's motion to exclude the reports of Ohio's expert, Dalbert Shefte, and related testimony [45] is granted in part and denied in part without prejudice. Shefte's opinions as to construction of claim 7 of the patent and anticipation will not be considered in ruling on summary judgment.
- (2) Plaintiff's motion to strike defendant's response to plaintiff's motion for summary judgment [74] is granted in part and denied in part. Shefte's affidavit has not been considered in ruling on summary judgment.
- (3) Plaintiff's motions for summary judgment [52, 53] are denied.

N.D.Ill.,2000.
Heidelberger Druckmaschinen AG v. Ohio Elec. Engravers, Inc.

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