

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

WILLIAM C. FRAZIER,
FRAZIER INDUSTRIES, INC. and
AIRBURST TECHNOLOGIES, LLC,

Plaintiffs,

v.

LAYNE CHRISTENSEN COMPANY
and PROWELL TECHNOLOGIES, LTD.,

Defendants.

ORDER

04-C-315-C

This order address several pending motions in this case that pertain to evidence the parties wanted the court to disregard in considering the latest round of summary judgment motions. I have denied plaintiffs' motion for summary judgment with respect to defendants' counterclaim of invalidity of the '845 patent but I will treat the pending motions as motions in limine.

A. Defendants' Motion to Strike Declaration of John R. Jansen

_____ Defendants argue that the declaration of John R. Jansen should not be considered

in ruling on plaintiffs' motion for partial summary judgment. I will not consider it for that purpose because I have denied the motion for partial summary judgment. However, if plaintiffs intend to call Jansen at trial to testify to the statements he made in his declaration, it may be helpful for the parties to have a ruling on the propriety of such testimony.

Defendants argue that Jansen's declaration contains "scientific, technical or other specialized knowledge" that may be offered only by an expert witness and that plaintiffs did not disclose Jansen as an expert witness pursuant to Fed. R. Civ. P. 26(a)(2). Fed. R. Evid. 702. In his declaration, Jansen testifies about the viscosity of water and crude oil and how viscosity affects "the useful energy of the air bubble created by the discharge from the gas or air gun." *Aff. of John Jensen*, dkt. #256, ¶ 3. He states that an air gun would not be useful in breaking up impediments in an oil well because of the high viscosity of the oil and the malleable nature of the impeding substances. *Id.* at ¶¶ 7-9. He states that an burst of gas in a well filled with water can generate a high energy wave because water has low viscosity; on the other hand, the same burst of gas in well filled with crude oil will not produce a wave with the same energy because the oil is more resistant to the movement of the air bubble produced by the burst of gas. *Id.* at ¶¶ 5, 9. Finally, Jansen testifies about arc generating tools and the process of hydrofracturing. *Id.* at ¶¶ 13-14.

The contents of Jensen's declaration are specialized knowledge that is beyond the comprehension of the untrained layman. Fed. R. Evid. 702 states that if "scientific,

technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue,” an expert witness may present that knowledge to the jury “in the form of an opinion or otherwise.” Jansen’s statements concerning the principle of viscosity, its impact on the usefulness of a gas venting apparatus and arc generating tools and hydrofracturing are properly characterized as expert testimony. 4 Jack B. Weinstein & Margaret A. Berger, Weinstein’s Federal Evidence § 702.02[2] (2d ed. 1997) (“Under Rule 702, parties may use expert witnesses to provide the trier of fact with an explanation of scientific or other principles that are relevant to the case and leave it to the trier of fact to apply those principles to the facts of the case.”).

Plaintiffs argue that Jansen’s testimony is not that of an expert because Jansen does not testify in the form of an opinion and because the statements in his affidavit consist of facts that are (1) well known in the water and oil industry or (2) verifiable by reference to authorities that have been cited in this case. The fact that Jansen’s testimony consists of facts rather than opinions does not mean it is not expert testimony. Rule 702 does not limit expert testimony to opinions; in fact, it states that specialized knowledge may be presented “in the form of an opinion or otherwise.” Also, it is irrelevant whether the facts in Jansen’s affidavit are well known in the water and oil industry; the relevant inquiry is whether the facts are within the grasp of the average juror. In this case, they are not.

Because the testimony contained in Jansen’s affidavit is properly characterized as

expert testimony, plaintiffs should have identified him as a potential expert witness. Their failure to do may be excused under Rule 37(c)(1) only if it was “substantially justified” or harmless. Plaintiffs have not argued that their failure to designate Jensen as an expert witness was substantially justified and I am not convinced that it was harmless. Plaintiffs note that Jansen has been identified as one of the inventors of the ‘845 patent and as a potential witness from the start of this case and that defendants have deposed him. However, the Court of Appeals for the Seventh Circuit rejected a similar argument in Musser v. Gentiva Health Services, 356 F.3d 751, 757 (7th Cir. 2004). Therefore, pursuant to Rule 37(c)(1), I will grant defendants’ motion. John Jensen may not testify as an expert witness at the trial on invalidity. He may, however, testify about the work he did in developing the patented invention.

B. Plaintiffs’ Motion to Strike Exhibits Attached to Affidavit of Gennady Carmi

Plaintiffs argue that exhibits B and D-H, attached to the affidavit of Gennady Carmi, should not be considered. According to Carmi’s affidavit, exhibit H consists of fifteen Russian patents and excerpts from several Russian publications concerning the use of air guns to treat well screens. Carmi avers that exhibits B and D-G are true and correct English translations of the documents in exhibit H. Plaintiffs argue that exhibit H should be stricken because the Russian documents have not been properly authenticated under Fed. R. Evid.

901 and that exhibits B and D-G should be stricken because the translation of foreign documents requires an expert witness.

_____ Defendants argue that the exhibits attached to Carmi's affidavit have been sufficiently authenticated because Carmi averred that each of the documents attached is a true and correct copy of what it purports to be. Fed. R. Evid. 901(b)(1). Also, they note that Carmi's affidavit contains a statement concerning his proficiency in both Russian and English. Therefore, he has the ability to vouch for the accuracy of the translations.

To be admissible in federal court, evidence must be authenticated. Fed. R. Evid. 901(a) requires, as a condition precedent to admission, that a piece of evidence be authenticated through "evidence sufficient to support a finding that the matter in question is what its proponent claims." Ordinarily, documents are authenticated by attaching them to an affidavit of an individual who swears that the documents are true and correct copies of the originals. However, the individual who authenticates the documents must have personal knowledge of their authenticity. Fed. R. Evid. 901(b)(1). In this case, I agree with plaintiffs that Carmi's affidavit is insufficient to authenticate the Russian patents and publications. Although Carmi avers that he is fluent in Russian and English, he does not provide any facts beyond the bare assertion of personal knowledge that would establish that the patents and publications are what they purport to be. As plaintiffs note, his affidavit contains no information that establishes *how* he knows that the purported patents are

actually Russian patents and *how* he knows that the purported excerpts from the Russian publications are what they purport to be.

Plaintiffs contend further that the purported Russian patents are not self-authenticating. A foreign document may be self-authenticating under Fed. R. Evid. 902(b)(3) if it purports to be

executed or attested in an official capacity by a person authorized by the laws of a foreign country to make the execution or attestation, and accompanied by a final certification as to genuineness of the signature and official position (A) of the executing or attesting person, or (B) of any foreign official whose certificate of genuineness of signature and official position relates to the execution or attestation or is in a chain of certificates of genuineness of signature and official position relating to the execution or attestation.

Fed. R. Evid. 902(b)(3). Defendants concede that the purported Russian patents attached to Carmi's affidavit are not self-authenticating under Rule 902(b)(3). However, they have tried to cure this deficiency by obtaining certified copies of some of the Russian patents. On February 8, 2006, defendants filed an affidavit from John W. Brown, a paralegal employed by the law firm representing defendants. Brown avers that he ordered certified copies of eight of the fifteen Russian patents (Nos. 844765, 173678, 848604, 945389, 794190, 909137, 474602 and 1215402) from the Russian Patent Office through a Russian law firm affiliated with the firm representing defendants. He avers further that the exhibits A-H attached to his affidavit are copies of the certified patents that he ordered.

Plaintiffs contend that these purported certified copies are not self-authenticating

foreign documents because they are not in English and it is impossible to determine whose signature appears on the purported certifications. I am willing to give defendants the benefit of the doubt with respect to the eight patents for which they have obtained certified copies. Brown's averments that (1) he requested certified copies from the Russian patent office and (2) the exhibits attached to his affidavit are what he received in response are sufficient to suggest that the certified copies are authentic.

The more important question is whether the translations of the eight Russian patents are admissible. Defendants have attached purported translations of the patents to the declarations of Gennady Carmi and Tatiana Scanlan. I agree with plaintiffs that Carmi's position as president of defendant ProWell Technologies makes the translations attached to his affidavit suspect. Defendants will not be able to introduce these translations at trial. I will discuss the translations submitted with Scanlan's declaration below.

C. Plaintiffs' Motion to Exclude Testimony and Translations of Tatiana Scanlan

Plaintiffs argue that the translations of the Russian patents offered by Tatiana Scanlan should be excluded and that Scanlan should not be allowed to testify at trial because a witness who offers translations of foreign documents must be qualified as an expert and defendants disclosed Scanlan's identity to plaintiffs on January 18, 2006, more than a year after the deadline for expert witness disclosure had passed. Defendants argue that

translations may be offered by a lay witness and that Scanlan is qualified to translate the Russian patents and has averred that her translations are accurate.

I will stay a decision on this motion until I have the opportunity at the final pre-trial conference to hear why defendants believe that Scanlan is qualified to translate technical documents written in Russian. However, I note that the court retains the discretion to allow a witness who was not timely disclosed to testify if it will not prejudice the opposing party. Further, I note that it appears that plaintiffs have had their own translator examine Scanlan's translations and that they were able to inquire about her qualifications at her deposition.

ORDER

IT IS ORDERED that

1. Defendants' motion to strike the declaration of John Jansen is GRANTED. Jansen will be not be allowed to testify at trial concerning the contents of his declaration but will be allowed to testify regarding the work he did in developing the patented invention.

2. Plaintiffs' motion to strike exhibits B, D, E, F, G and H attached to the affidavit of Gennadi Carmi is GRANTED IN PART and DENIED IN PART. Plaintiffs' motion to strike is DENIED with respect to the eight Russian patents, Nos. 844765, 173678, 848604, 945389, 794190, 909137, 474602 and 1215402, for which defendants have produced certified copies. Defendants will be permitted to introduce these patents at trial. Plaintiffs'

motion to strike is GRANTED with respect to the seven patents for which certified copies were not produced and the excerpts from the Russian publications. Defendants will not be allowed to introduce these documents at trial. Also, defendants will not be allowed to introduce the translations attached to the affidavit of Gennady Carmi at trial.

3. A decision on plaintiffs' motion to prohibit Tatiana Scanlan from testifying at the trial and to exclude her translations of the Russian patents is STAYED. The court will rule on this motion at the final pre-trial conference.

Entered this 21st day of February, 2006.

BY THE COURT:
/s/
BARBARA B. CRABB
District Judge