IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

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EXTREME NETWORKS, INC.,

ORDER

Plaintiff,

07-cv-229-bbc

v.

ENTERASYS NETWORKS, INC.,

Defendant.

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Two issues are before the court: (1) whether plaintiff Extreme Networks, Inc. may expand on the claim construction provided by the Court of Appeals for the Federal Circuit for the term "digest" in U.S. Patent No. 5,195,181; and (2) whether the parties' experts may testify about the meaning of the '181 patent. I conclude that the answer to both questions is "no." (Defendant objects to the brief plaintiff filed on the second issue as going beyond the scope of the issues on which the court requested briefing at the final pretrial conference. Because I am denying plaintiff's request, it makes no difference whether the court invited plaintiff's brief.)

With respect to the first question, plaintiff wishes to construe the term "digest" as

something that is "separate and distinct" from "the message." The problem with this argument is that the court of appeals already construed the term digest to mean "a collection of information relating to network protocol processing of a particular message." Extreme Networks, Inc. v. Enterasys Networks, Inc., 395 Fed. Appx. 709, 714 (Fed. Cir. 2010).

Plaintiff is correct that the court of appeals did not address in its opinion the particular question plaintiff is raising now. However, the court did not suggest that its construction was incomplete and needed further clarification on remand. As both sides acknowledge, plaintiff included this issue in its briefs on appeal. If the court of appeals believed that the issue needed to be resolved by this court, it would have been easy enough for it to say as much in one sentence. Further, if plaintiff believed that the construction provided by the court of appeals was incomplete, it could have filed a motion for clarification with that court. I decline to expand on the construction the court of appeals provided.

Plaintiff cites Laitram Corp. v. NEC Corp., 115 F.3d 947 (Fed. Cir. 1997), in support of its argument, but that case is readily distinguishable. The issue was not whether the district court may impose new limitations on a claim term that the court of appeals declined to impose. Rather, the question was whether the district court could consider questions related to damages after the court of appeals resolved an issue of infringement. Those are two separate issues that can be decided independently. The same cannot be said of claim construction regarding the same term construed by the court of appeals.

I resolved the second question at the final pretrial conference: if the parties have any lingering disputes of claim construction, they must present them to the court. Claim construction is a question of law, not fact, Cordis Corp. v. Boston Scientific Corp., 561 F.3d 1319, 1325 (Fed. Cir. 2009), so experts may not present their opinions about disputed terms in the claims at trial.

In Kinetic Concepts, Inc. v. Blue Sky Medical Group, Inc., 554 F.3d 1010, 1027 (Fed. Cir. 2009), the court of appeals emphasized that it is a "clear error" to allow the parties to argue dueling claim constructions to the jury:

> We have held that "[w]hen the parties raise an actual dispute regarding the proper scope of [the patent] claims, the court, not the jury, must resolve that dispute." O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co., 521 F.3d 1351, 1360 (Fed. Cir. 2008). It is improper to argue claim construction to the jury because the "risk of confusing the jury is high when experts opine on claim construction." CytoLogix Corp. v. Ventana Med. Sys., Inc., 424 F.3d 1168, 1172–73 (Fed. Cir. 2005); see Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1364 n. 6 (Fed. Cir. 2008). In this case, the definition of the term "wound" was central to the case and a primary focal point of the Markman hearing; as a result, the court should have construed the term "wound."

Plaintiff cites no authority in its brief to support its contrary view.

Plaintiff says its expert "must" be allowed to interpret the patent because several disputed claim terms remain unconstrued. However, this is simply an admission that the parties have failed to exercise due care in presenting these issues to the court for resolution. I cannot disregard controlling law simply because one or both parties wish to do so. Instead,

I will give the parties an opportunity to submit briefs to raise any issues of claim construction that remain.

ORDER

IT IS ORDERED that

1. Defendant Enterasys Network, Inc.'s motion to preclude plaintiff Extreme Networks, Inc. from filing a brief regarding expert testimony on issues of claim construction, dkt. #678, is DENIED.

2. For the purpose of this trial, the term "digest" means "a collection of information relating to network protocol processing of a particular message."

3. The parties may have until Friday, October 28, 2011, at 6:00 a.m. to submit briefs on any disputed issues of claim construction that remain unresolved.

Entered this 26th day of October, 2011.

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