

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA**

ADC TELECOMMUNICATIONS, INC.,)	
)	
Plaintiff,)	
)	Civil Action No. 04-1590 (PJS/RLE)
v.)	
)	Judge Patrick J. Schiltz
SWITCHCRAFT, INC.,)	
)	
Defendant.)	
)	

**DEFENDANT’S OPPOSITION TO MOTION FOR JUDGMENT AS A MATTER
OF LAW OR NEW TRIAL ON INFRINGEMENT**

By its motion, Plaintiff ADC asks the Court to reverse the jury’s finding that ADC did not prove infringement by a preponderance of the evidence, on which it had the burden of proof, and to enter judgment for ADC as a matter of law, or alternatively, to order a new trial. As ADC concedes in its moving papers, this same motion for JMOL was made at the close of Switchcraft’s case and denied by the Court. Motion at 10. In properly denying the identical motion when all the evidence was in, the Court made its position clear:

You know, I've already picked my horse on this one and I'm going to ride it right to the end and I do think – my own conclusion is that this is an issue of fact, that you're presenting two different ways of looking at an issue of fact . . . at my best estimate we have here an issue of fact. We have two ways of looking at it that are both reasonable if not equally persuasive in my own view, so I'll let it go to the jury and I'll deny the motion for JMOL on infringement.

Trial Transcript at 2098:4-8, 2098:14-18 (Ex. A to Howarth Decl.).

Nothing has changed since this JMOL motion was fully briefed and argued, and for the same reasons it should be denied again. Judgment as a matter of law is appropriate only when “a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue.” Fed. R. Civ. Proc. 50(a)(1).

The same standards apply to the granting of judgment n.o.v. and a directed verdict. *Armstrong v. Republic Realty Mortgage Corp.*, 631 F.2d 1344, 1351 (8th Cir.1980). “[W]e must view the evidence in the light most favorable to the party who prevailed before the jury.” *Pumps & Power Co. v. Southern States Industries*, 787 F.2d 1252, 1258 (8th Cir.1986). This means that we (1) resolve direct factual conflicts in favor of the nonmovant, (2) assume as true all facts supporting the nonmovant which the evidence tended to prove, (3) give the nonmovant the benefit of all reasonable inferences, and (4) deny the motion if the evidence so viewed would allow reasonable jurors to differ as to the conclusions that could be drawn.

City of Omaha Employees Betterment Ass'n v. City of Omaha, 883 F.2d 650, 651-52 (8th Cir. 1989). “A determination of infringement, both literal and under the doctrine of equivalents, is a question of fact, reviewed for substantial evidence when tried to a jury.” *Teleflex, Inc., v. Ficosa North America Corp.*, 299 F.3d 1313, 1323 (Fed. Cir. 2002).

In a patent case the Court decides the claims construction and infringement is a fact question for the jury:

A two-step process is used in the analysis of patent infringement: first, the scope of the claims are determined as a matter of law, and second, the properly construed claims are compared to the allegedly infringing device to determine, as a matter of fact, whether all of the limitations of at least one claim are present, either literally or by a substantial equivalent, in the accused device. *See Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 988, 50 USPQ2d 1607, 1609 (Fed.Cir.1999). The first of these two steps is performed by the court and is subject to de novo review by this court. *Cybor*, 138 F.3d at 1456, 46 USPQ2d at 1174; *Markman*, 52 F.3d at 979, 34 USPQ2d at 1329. The second step in the infringement analysis requires a factual comparison of the claimed invention to the accused device, which is done by the fact finder. *See Winans v. Denmead*, 56 U.S. (15 How.) 330, 338, 14 L.Ed. 717 (1853).

Teleflex, 299 F.3d at 1323.

This was exactly what happened here. The Court held a Markman hearing on June 22, 2005. Switchcraft took the position at the Markman stage that the patent language required a purposeful or intentional positioning of projections to achieve impedance matching in order for infringement to occur. *See* Markman Order at 9 (Sept. 9, 2005) (Ex. B to Howarth Decl.); Motion at 6. ADC argued that intent was not an element of infringement, and prevailed on this point at the Markman hearing. The Order states: “The Court construes ‘waveguide’ to be a ‘structure for tuning impedance in an electrical device for better carrying an electrical signal.’ In general, intent is not relevant to whether a product directly infringes a patent.” Markman Order at 9 (Sept. 9, 2005) (Ex. B to Howarth Decl.). The Court also stated: “[T]he 378 patent teaches that by adding specially shaped structures (sometimes called ‘waveguides’) at certain locations within the ADC switching jack, it is possible to tune impedance and improve the performance of the jack over larger bandwidths.” *Id.* at 2.

ADC asserts, with no citation to authority whatsoever, that the Court should have determined at the Markman hearing “how one determined whether a fin in fact tunes impedance or provides impedance matching.” Motion at 6. It would not have been proper for the Court at the Markman hearing, or thereafter, to invade the province of the trier of fact and choose among the competing tests offered by the parties. Switchcraft was entitled to put forth its view of how the claims in the ADC patent should be construed as a matter of law at the Markman stage. *See Teleflex*, 299 F.3d at 1323. The

Markman hearing and the evidentiary trial serve different purposes; the Markman hearing is for a legal determination of the scope of the patent, and the trial is for a factual decision whether under that standard the accused product infringes the patented feature. *Id.*; *Exxon Chem. Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995).

It was for this reason that the Court, after full briefing and argument, also properly denied ADC's Second Motion in Limine: To Establish the Proper Test for Determining Infringement and to Preclude Defendant From Presenting Improper Non-Infringement Arguments. *See Order Denying Plaintiffs Motion in Limine 2 (Jan. 8, 2007) (Ex. C to Howarth Decl.)*. And, also on the same basis, the Court properly denied Plaintiff's motion for directed verdict and judgment as a matter of law at trial. The Court stated:

The ADC position is very clear to decide whether or not the ribs improved impedance matching you take the commercial product. You open it up, you shave the fins off, you put it back together, you test it, you measure return loss with the fins versus return loss without the fins. If return loss is better with the fins, then it improves impedance matching and, therefore, it infringes. That's their position.

I also understand the Switchcraft position. Their position is you have to look from the bottom up or from the beginning forward, not from the end backwards. You take the PC board. You add fins. It hurts impedance matching. You tune the jack in order to compensate for the harm to impedance matching by the fins. You put the jack together. Their view is that means fins don't improve impedance matching.

Their further view is if you open a tuned jack and you take anything out of it including the fins, or put anything into it including the fins, it's going to have impact on impedance matching because it's an optimized jack and you necessarily de-optimize it when you take anything out of it.

They both seem to me to be reasonable positions. I think they have both been made clear to the jury and I think at the end it's going to be up to the jury to decide.

Trial Transcript at 1545:19-1546:18 (Ex. A to Howarth Decl.).

Once intent was eliminated when ADC prevailed on this point in the Markman ruling, the entire trial proceeded on the basis of whether or not infringement could be shown by a preponderance of the evidence as per the claim construction ADC had advocated. ADC did not ask the Court at the Markman hearing to determine the scientific test for determining infringement, and it would not have been proper for the Court to do so. It is not a part of claims construction for the Court to go outside the patent and determine what scientific evidence or test must be used among competing ones to resolve whether or not a particular “effect” is present in an accused product.

For example, in *Kemin Foods, L.C. v. Pigmentos Vegetales Del Centro S.A. De C.V.*, 464 F.3d 1339 (Fed. Cir. 2006), the Federal Circuit recently upheld a jury verdict of non-infringement, where the parties at trial each argued that their respective test or measurement for infringement of the claims was the proper one. Kemin sued PIVEG for infringing its patent on lutein crystals. The claim limitation at issue was construed to require “significantly less than 10% of other carotenoids.” *Kemin Foods*, 464 F.3d at 1345. The court held the decision of which test to apply to determine infringement was within the province of the jury, and ruled that the motion for judgment as a matter of law was properly denied.

On appeal, the parties disagree about the percentage of “other carotenoids” present in PIVEG's products. Both parties analyzed samples of those products and presented their analyses to the jury. In Kemin's view, the percentage of “other carotenoids” in PIVEG's products ranges from 6.14 to 9.86. In PIVEG's view, the percentage of “other carotenoids” in its products is greater than 9 and as high as 14. Kemin has not argued that the phrase “significantly less than 10%” has a precise upper limit. Thus, the question whether the concentration of “other carotenoids” in PIVEG's products is low enough to infringe the '714 patent was properly left to the jury. As we have noted, “it is possible that under such

circumstances different finders of fact could reach different conclusions. That possibility, however, is a necessary consequence of treating infringement as a question of fact subject to deferential review.” *PPG Indus.*, 156 F.3d at 1355. Therefore, even if the jury accepted Kemin's carotenoid measurements, it could reasonably conclude that although PIVEG's products had less than 10% of other carotenoids, they did not have “significantly less than 10% of other carotenoids.” Similarly, the jury could have concluded that the levels of other carotenoids in PIVEG's products were high enough that they were outside the scope of the doctrine of equivalents as applied to that limitation.

Id. at 1349.

Similarly, in *PPG Industries v. Guardian Industries Corp.*, 156 F.3d 1351 (Fed. Cir. 1998), the Federal Circuit held that trial court properly denied plaintiff's motion for judgment as a matter of law and upheld the jury's verdict of non-infringement based on determination that iron sulfide residue contained in solar control glass materially affected the characteristics of the accused product and therefore did not infringe the patent. The appellate court rejected plaintiff's argument that the trial court should have further instructed the jury, as part of its duties under Markman claims construction, as to what specific test the jury was supposed to use to decide if the iron sulfide had a material effect. *PPG Industries*, 156 F.3d at 1355-56. The Court held:

Claims are often drafted using terminology that is not as precise or specific as it might be. As long as the result complies with the statutory requirement to “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention,” 35 U.S.C. § 112, para. 2, that practice is permissible. That does not mean, however, that a court, under the rubric of claim construction, may give a claim whatever additional precision or specificity is necessary to facilitate a comparison between the claim and the accused product. Rather, after the court has defined the claim with whatever specificity and precision is warranted by the language of the claim and the evidence bearing on the proper construction, the task of determining whether the construed claim reads on the accused product is for the finder of fact. *See, e.g., W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1280, 6 U.S.P.Q.2d 1277, 1282

(Fed.Cir.1988) (whether claim limitation of “about 100% per second” is literally met is a question of fact).

The proper allocation of the tasks of construing a claim and determining infringement in a case in which a claim contains an imprecise limitation is demonstrated by our decision in *Modine Manufacturing Co. v. United States International Trade Commission*, 75 F.3d 1545, 37 USPQ2d 1609 (Fed.Cir.1996). In *Modine*, the patentee had claimed a condenser for an automotive air conditioning system with “relatively small” hydraulic diameters. *Id.* at 1549. From the specification and prosecution history of the patent, this court concluded that the term “relatively small” should be interpreted as referring to a range of diameters of “about 0.015-0.040” inches. *Id.* at 1554. Instead of attempting to define that range more precisely, we remanded the case for a factual determination of whether the claim limitation was literally infringed by accused products having diameters ranging from 0.0424 to 0.0682 inch. *Id.* at 1554-55.

Like the patents at issue in *Modine* and *Gore*, the '886 patent contains some inherent imprecision resulting from the use of the term “consisting essentially of.” As PPG points out, it is possible that under such circumstances different finders of fact could reach different conclusions regarding whether the effect of a particular unlisted ingredient in an accused product is material, and thus whether that product infringes. That possibility, however, is a necessary consequence of treating infringement as a question of fact subject to deferential review. It does not mean that the claim was improperly construed as an initial matter.

Id. at 1355.

ADC cites *Exxon Chem. Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir. 1995) and *Grain Processing Corp. v. Am. Maize-Products Co.*, 1991 U.S. App. LEXIS 7313 (Fed. Cir. 1991) (unpublished), in support of its argument that the Court should have instructed the jury as to the only scientific test to use in determining infringement here. Neither of these cases supports ADC’s position.

In *Exxon*, the court reversed a judgment of infringement for plaintiff, holding that the trial court at the Markman hearing had misconstrued the patent claims (which had to do with a chemical formula for a substance used in the oil industry). The *Exxon* court

refused to remand for a new trial, finding that defendant was entitled to judgment as matter of law on infringement because *Exxon* could not prove its case even under the correct law: “Because of Exxon's failure of proof, Lubrizol is entitled to judgment as a matter of law.” *Exxon*, 64 F.3d at 1555, citing *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir. 1994). The court explained its holding:

Given the correct interpretation of Exxon's claims [which neither party advanced], the dispositive question before us is whether any jury could reasonably have found that Lubrizol's accused products literally infringe the claims of the '890 patent as properly construed. *Jamesbury Corp. v. Litton Indus. Prods.*, 756 F.2d 1556, 1560-61, 225 USPQ 253, 257 (Fed.Cir.1985) Consequently, on the facts of this case, we discern no reason to carve an exception into the settled law in order to provide Exxon an opportunity to escape from the flaws in its claim drafting (as described in Judge Plager's concurring opinion) and trial strategy. We therefore disagree with Judge Nies's view that our reversal without remand for a second trial is improper.”

Id. at 1558-61.

Exxon does not remotely show, as ADC claims, “that this Court should have told the jury how to determine whether a fin was a ‘waveguide’ or a ‘projection . . . positioned to provide impedance matching.” Motion at 12. *Exxon* applied specific rules of construction to the patent at question there, and ruled under a de novo review that the trial court misunderstood the claims when it accepted plaintiff’s version. The court held that plaintiff had not sustained its burden of proof under any claims construction (right or wrong) and Defendant was entitled to judgment as a matter of law. *Exxon*, 64 F.3d at 1560-61. ADC does not claim in its post trial motion that the Markman judge here got the claims construction wrong. Rather, ADC asserts that this Court should have gone further and decided the fact issue by telling the jury that among competing scientific

tests, only ADC's was valid. Such a ruling could not be premised on the patent, and the language of the patent describing "waveguides" simply does not compel one and only one method to determine "effect." Both parties offered evidence to determine the effect of the fins, which is what the patent covers. To the extent that *Exxon* is useful here at all, it is instructive on the point that where a plaintiff fails in its burden of proof on infringement, defendant is entitled to a judgment in its favor. *Id.*

The other case ADC cites, the unpublished, not to be used as precedent, *Grain Processing* opinion, also does not assist ADC. The question in *Grain Processing* was whether there was a violation of an injunction where the claim construction had determined that sale of a product of the type described (waxy starch hydrolysate) infringed if it exceeded a descriptive ratio (DR) of 2 using a particular assay technique. There the court simply held that defendant could not escape the reach of the patent by using another assay technique. Here, the patent and the claim construction provided that there was infringement if the fins improved impedance performance at all – not only at some particular level or at some level measured in a specific way. It is not claim construction to then say the Court should go on to determine whether the fins actually did or did not improve impedance performance – it is asking the Court to find the facts as well. In just the same way it would not have been claim construction – and would have been impermissible fact finding – for the court in *Grain Processing* to have made a determination that the product did or did not exceed the DR of 2 under the assay technique specified, or how the fact finder decided whether it did under that technique.

In *Grain Processing*, there was no dispute but that the product exceeded a DR of 2 on the assay technique specified – the only question at issue was claim construction.

ADC further asserts, also without authority, that Switchcraft “waived” its defense that its product did not infringe because it did not have the effect of improving tuning impedance. Switchcraft always maintained that its product did not infringe the patent, whether by intent or effect. Switchcraft’s Answer specifically denies the allegation in the Complaint that it “has infringed and continues to infringe the ‘378 patent.” Answer ¶ 8 (Ex. D to Howarth Decl.). The joint statement of the case agreed upon by the parties provides, “Switchcraft denies that its jacks infringed ADC’s patent and denies that it acted improperly.” Joint Introduction of the Case at 1-2 (December 22, 2006) (Ex. E to Howarth Decl.). In its opening statement, Switchcraft made clear that its switching jacks did not improve impedance when the proper test was used:

What was wrong, the evidence will be, with ADC's test that they showed you? You have to compare the TX jack, that's our jack they say that was infringing, with the right baseline. ADC, in fact, compared the TX jack to a non-commercial fictional jack. Why do I say it's fictional? When ADC took the fins out, the evidence will be it did not take out the features inside that jack that were put there only to accommodate the fins. What are those features? There were slots that were put there for the fins to fit in, to accommodate the fins.

.....

The correct test, the evidence will be, is you have to isolate the effect of what we call the crosstalk ribs. I will explain to you why they are crosstalk ribs. You have to test the jack without the ribs and without the features that are added solely to accommodate the ribs.

Trial Transcript at 157:25-158:9, 159:4-159:8 (Ex. A to Howarth Decl.).

The Final Pretrial Order directed each party to submit a trial brief identifying the claims and defenses and all unresolved substantive issues that needed to be decided by the trier of fact. *See* Final Pretrial Order at 1-2 (October 12, 2006) (Ex. F to Howarth Decl.). The final pretrial order supersedes the pleadings. *See Anderson v. Genuine Parts Co., Inc.*, 128 F.3d 1267, 1271 (8th Cir. 1997). Pursuant to the Final Pretrial Order, ADC filed a trial brief on December 22, 2006, which stated that the issues on infringement were “whether or not these projections are either ‘waveguides’ (the limitation of Claim 1), or are ‘positioned to improve impedance matching (the limitation of Claim 16).” ADC’s Trial Brief at 8 (Ex. G to Howarth Decl.).

ADC argues that the Court should have given the jury an additional instruction, proffered by ADC, namely: “ ‘waveguide’ and ‘projections ... positioned to provide impedance matching’ ... mean that: the projections or fins give the accused product a better return loss than if they are not present in the same accused product.” Motion at 7-8. ADC claims this would have informed the jury of the proper “method of determining whether a fin is acting as a waveguide.” *Id.* The Court did instruct the jury in substance on this point: “[I]f you find that ADC has proved by a preponderance of the evidence that the limitation ‘said projections are positioned to provide impedance matching’ is present in the accused Switchcraft product, then you must find that the accused product infringes” Final Jury Instructions ¶ 8 (Jan. 22, 2007) (Ex. H to Howarth Decl.). And the case was tried entirely on this basis, whether the fins in the accused product improved return loss or not. For example, Switchcraft’s closing argument that stated:

The issue is do they [TX Jacks] infringe, and the parties agree that the standard -- you have heard it time and again throughout the trial -- is do the Switchcraft crosstalk ribs, in fact, improve return loss performance in the TX jack? Do they or do they not, in fact, improve the performance in the jack? You need to decide do they improve -- those ribs or fins, do they improve the return loss performance? If they do, in fact, in the TX jack, then there is infringement on both claims. If they do not, there is no infringement.

Trial Transcript at 2163:6-11, 2163:21-25 (Ex. A to Howarth Decl.)

The case was properly tried on evidence as to whether or not Switchcraft's products contained "waveguides" or structures which "improved impedance matching." The Court allowed all counsel to argue to the jury precisely the point ADC raises, namely that whether or not there was infringement by the TX Jack is dependent on whether the jury found that the fins gave the TX Jack a better return loss than what the TX Jack would have had if fins had not been part of the design. The jury instructions were proper, including instructions on the issues of infringement submitted by Plaintiff (Final Jury Instructions ¶ 8 (Jan. 22, 2007) (Ex. H to Howarth Decl.)), and there was substantial evidence supporting the verdict that ADC did not prove infringement under the appropriate preponderance standard.

ADC at bottom argues that its scientific evidence and the way it tested for the effect of impedance is the only proper way, and any jury that disagreed had to have been acting irrationally. Motion at 16. In patent cases, often juries are expected to hear and evaluate disputed expert testimony on complex scientific issues. The losing party often argues that the jury got it wrong and was irrational, when in fact, the loser did not offer evidence which persuaded the jury to its view.

For example, in *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613 (Fed. Cir. 1985), both sides presented expert testimony on technical issues to determine whether a patent was invalid for obviousness based on prior art.

Conflicting expert opinion was presented on these points, and also concerning whether the teachings found in various references could be combined. . . . In the face of conflicting evidence, testimony, expert opinion, and argument, the jury found each of the four Apparatus and four Method claims valid. As this court said in *Railroad Dynamics*, 727 F.2d at 1514, 220 USPQ at 937, “[t]hat there may have been trial evidence favorable to both sides . . . is simply irrelevant.” We do not determine whether a jury could have reached a different verdict, but whether there is substantial evidence for the verdict that it reached. *Lavender v. Kurn*, 327 U.S. 645, 653, 66 S.Ct. 740, 744, 90 L.Ed. 916 (1946). Our review of the record shows that there was substantial evidence on which a reasonable jury could have found facts consistent with its conclusion of non-obviousness.

Shatterproof Glass, 758 F.2d at 620-21.

Similarly, in *Translogic Technology, Inc. v. Hitachi, Ltd.*, 404 F. Supp. 2d 1250 (D. Or. 2005), the court stated that even with complex technical evidence the issue of infringement is for the jury.

[T]he claim defines a multiplexer circuit, and if the TGM stages are hooked up as recited in the remainder of the claim, the result will be a N:1 multiplexer circuit. The question then becomes: Does an intermediate output branching off to other circuitry destroy the character of the circuit as an N:1 multiplexer? Plaintiff concedes that it does where the other circuitry generates an output value. But is this so when the other circuitry does nothing with that intermediate output? In the view of the SM, this is a classic factual question of infringement. Experts can undoubtedly be of assistance to the Court and the jury in deciding whether a particular instance of intermediate branching does or does not result in something that can be regarded as an N:1 multiplexer circuit. . . . the claim limitation does not preclude intermediate outputs unless the presence of such an output would result in a circuit that is not a multiplexer. These ultimate determinations are **factual questions of infringement**.

Translogic Technology, Inc., 404 F. Supp. 2d at 1254-55 (emphasis in original).

The District Court adopted the Special Master's analysis in *Translogic*, instructed the jury accordingly, and denied defendant's motion for judgment as a matter of law after the jury found against it, stating:

The parties presented conflicting evidence on this issue at the validity trial. Both the inventor and plaintiff's expert testified that prior art circuits which used live intermediate outputs did not function as N:1 multiplexers. Defendants presented expert testimony to the contrary. The verdict indicates that the jurors agreed with plaintiff's position. The effect of live intermediate outputs presented a factual issue for the jury to resolve.

Id. at 1255.

In a patent case, the plaintiff has the burden of proving infringement on each claim limitation at issue; if plaintiff does not prove infringement on even one claim limitation, judgment must be entered for defendant.

In order for a product to literally infringe a patent claim, the patentee must prove by a preponderance of the evidence that the accused product includes elements that are literally identical to each and every limitation of the patent claim. *See Biovail Corp. Int'l v. Andrx Pharms., Inc.*, 239 F.3d 1297, 1302 (Fed.Cir.2001); *Abbey v. Bill Ussey Motors, Inc.*, 74 F.Supp.2d 1217, 1221 (S.D.Fla.), *aff'd sub nom. Abbey v. Robert Bosch GMBH*, 217 F.3d 853 (Fed.Cir.1999). If an express claim limitation is absent from an accused product, there can be no literal infringement as a matter of law. *Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed. Cir.1994).

Bristol-Myers Squibb Co. v. Andrx Pharm., Inc., 343 F.Supp.2d 1124, 1133-34 (S.D. Fla. 2004); *see also Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir. 1994).

Once the court has construed the claims at a pretrial Markman hearing, whether or not there has been an infringement of these claims by the accused product is a matter for

the jury. The jury's findings on this matter are accorded great deference when challenged by the losing party at trial.

Kemin contends that no reasonable juror could have found that PIVEG's products fall outside the literal scope of the claim as construed. Whether a product falls within the literal scope of a properly construed claim is a question of fact, on which we accord a jury substantial deference. *See PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1355 (Fed.Cir.1998) (“[A]fter the court has defined the claim with whatever specificity and precision is warranted by the language of the claim and the evidence bearing on the proper construction, the task of determining whether the construed claim reads on the accused product is for the finder of fact.”).

Kemin Foods, 464 F.3d at 1349.

In this case, ADC called a patent lawyer, Mr. Nixon, to testify about infringement and the test he advocated to determine infringement. Motion at 16-17. Switchcraft called its company design engineer, Mr. Cooper, and Dr. Leipa, an expert engineer, on the issue of infringement. ADC argues at length that the jury was wrong in its determination that there was no infringement. ADC argues that its expert and his “test” isolated the effect of fins and Switchcraft's did not. Motion at 17-21.

Switchcraft put on evidence that in order to isolate the effect of its fins, the slots also had to be removed. As Mr. Cooper testified:

Q. We established yesterday that before the opinion that he issued that you didn't take that prototype design and take that design with fins, take the fins out of that design and test the two of them and compare them, right?

A. We established that because you can't take the fins out without taking the slots out.

Q. You can take fins out without taking the slots out.

A. No. No, you don't need the slots in there except for the ribs.

Q. You are talking about other parts of it, but physically you can take the fins out even though there are slots in there, isn't this true?

A. Yes, but that wouldn't be a fair test.

.....

A. You don't need slots. If you have fins, then you have to have slots. If you are going to do a comparison of with and without fins, you take the fins out, you have to take the slots out so you are looking at the same kind of comparison.

See Trial Transcript at 469:13-25, 493:16-20 (Ex. A to Howarth Decl.).

Switchcraft put on evidence that when both fins and slots are removed in its product, impedance matching is better than its product with fins and slots. Mr. Cooper testified:

Q. Let me show you Defendant's Exhibit 120. All right. Can you explain what's on that?

A. Yes, this is a comparison of return loss from the no fin PC board and the four fin PC board. And as you can see, that the four fin PC board was quite a bit worse than the no pin [sic] PC board.

Id. at 541:2-7.

ADC's Mr. Nixon conceded that to test the effect of the fins alone these have to be isolated:

Q. Are there any other things that you feel are relevant to how one would determine whether a Defendant's structure has waveguides or projections to provide impedance matching?

A. Yes. . . . We have a multi-variable problem here with the impedance matching is affected by a number of variables. It's not determined by a single variable. But if you want to test to determine what the effect of one of those variables is on that particular parameter of the device, the impedance matching, I don't know of any other way to do it, frankly, than to test it with that feature and without. That is, you change only the variable that you're testing.

Q. You isolate?

A. You isolate that variable. Everything else must remain constant. I think that would be the acceptable way to determine whether or not that single variable is having a negative or positive effect on that -- on the parameter that is affected simultaneously by a number of different variables.

. . .

I would think you must start with the commercial product and make a measurement there and compare that to something. And the something you must

compare it to is something that has been modified only with respect to the variable against which you're testing. In this case, it's the fins.

Id. at 676:8-677:4, 678:10-15.

Switchcraft's testimony was that ADC set up a comparison which did *not* in fact isolate on the effect of fins in the TX Jack. What ADC did not compare was the TX Jack without fins and without slots to see if impedance matching was improved. There was testimony that this was not a fair test. *See id.* at 469:13-25, 493:16-20.

ADC bears the burden of proof on infringement and if the jury did not believe ADC's evidence was credible, then its verdict had to be for Switchcraft, even if Switchcraft put on no evidence of non infringement at all. *See Exxon*, 64 F.3d at 1560-61. Here, Mr. Nixon admitted that he did not test without fins and without slots.

Q. If you remove the fin from the commercial TX jack in order to do a test, what's the effect of the air gap in the slot on impedance?

A. I did not test that.

Q. What would be the effect of it?

A. I don't know without testing.

Q. Do you know the physics that is involved in the air gap?

A. Yes, it changes the dielectric constant of the volume between the two conductors. The dielectric constant of the printed circuit board is quite high compared to the dielectric constant of air.

Q. What's its effect on the impedance through the jack?

A. I would have to do a test.

Q. What test would you do?

A. I would remove the slots and do a test, that is put filler in there or take a printed circuit board that didn't have any slot and do a test and then put one in that had the slot.

Q. Was any test like that done in connection with your testing of the TX jack to find out what effect the slot remaining and the increase in the slot area remaining in the TX jack had on impedance measurements?

A. No, I did not.

Trial Transcript at 760:25-761:22 (Ex. A to Howarth Decl.). A reasonable jury could certainly have found on this record that ADC's proof of infringement was insufficient.

Id. Switchcraft's closing argument to the jury ended with this very point:

So I am going to sit down, and they are going to give their closing after we have a little break. Listen to that closing. See if they have a test that didn't leave those slots open. See if there is something else in the evidence. You think about it. You go into that jury room and you sort it out.

Id. at 2210:2-7.

In fact, Switchcraft did more and offered proof of tests of its jacks without fins and without slots compared to fins and slots. Mr. Cooper testified to this testing and there was graphic evidence of these comparisons. *See id.* at 541:2-7; *see also* Jury Question and Court's Response (Jan. 23, 2007) (Ex. I to Howarth Decl.). The jury could certainly have believed that Switchcraft's evidence was more credible than ADC's, or that ADC did not persuade it to the relevant preponderance standard. Thus, the verdict may not be disturbed. *See PPG Industries*, 156 F.3d at 1357-58 ("The jury was entitled to credit that [expert] evidence over contrary [expert] evidence adduced by PPG. . . . We therefore must uphold the jury's conclusion that SMG glass does not infringe claim 4 of the '886 patent").

Plaintiff's request in the alternative that it be granted a new trial should be denied for the same reasons. The standard for a new trial is that the verdict "was against the great weight of the evidence, constituting a miscarriage of justice." *Id.*, *citing Richmond v. City of Brooklyn Ctr.*, 2005 WL 1843332 (D. Minn. 2005) (unpublished). ADC's motion has not met that standard; the jury was properly instructed, there was substantial

evidence to support the verdict, and the jury was entitled to find that ADC did not meet its burden of proof. That the jury found Defendant's experts and witnesses more convincing than Plaintiff's on disputed fact issues is not a miscarriage of justice.

The Court was correct in how it construed the claims under Markman, how it instructed the jury, and in submitting the fact issue of whether ADC proved that the fins impede performance to the jury. There is substantial evidence to uphold the jury's verdict of no infringement, there was substantial room for the jury to find that ADC did not meet its burden of proof, and this Court should deny ADC's motion.

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