

IN THE UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA
FOURTH DIVISION

FIXTURES MANUFACTURING COMPANY,
a Missouri corporation,

Civ. Action No. 4-81-532

Plaintiff,

vs.

**DEFENDANT'S MOTION
IN LIMINE**

WENGER CORPORATION,
a Minnesota corporation,

Defendant.

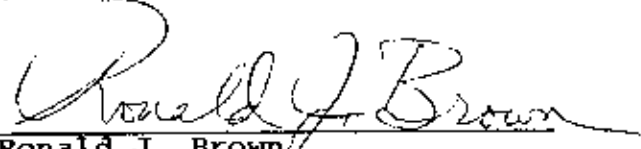
PLEASE TAKE NOTICE that at 8:00 a.m. on November 25, 1985, or as soon thereafter as counsel may be heard, before this Court, at the Federal Courthouse in the City of St. Paul, Minnesota, the undersigned will move this Court for an Order prohibiting John F. Witherspoon from testifying at trial on the ultimate issues of obviousness and closeness of prior art, or, in the alternative, limiting Witherspoon's testimony to the grounds articulated by Witherspoon in his deposition, specifically excluding as grounds his reliance on the testimony of other witnesses at trial.

In support of this motion, defendant relies upon the attached Memorandum of Law, all of the files and pleadings herein, and such argument as may be required or permitted by the court.

Dated: November 12, 1985

DORSEY & WHITNEY

By


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FIXTURES MANUFACTURING COMPANY,
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Plaintiff,

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WENGER CORPORATION,
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MEMORANDUM IN SUPPORT OF
DEFENDANT'S MOTION IN LIMINE

Defendant.

I. INTRODUCTION

Fixtures Manufacturing Company ("Fixtures") brought this action against Wenger Corporation ("Wenger") alleging that Wenger has infringed United States Letters Patent No. 3,368,842 (the "Polsky patent"). As one of the defenses against Fixtures' allegation of infringement, Wenger contends that the Polsky patent is invalid because under 35 U.S.C. § 103 the subject matter claimed by the patent is obvious in light of the prior art. Wenger will also argue that the presumption of validity is overcome because prior art known to Fixtures and never disclosed to the Examiner is closer to the claimed subject matter of the Polsky patent than the prior art located by the Examiner and over which the Polsky claims were allowed.

Fixtures has identified John F. Witherspoon as a legal expert who will testify on the § 103 question of obviousness.

At his deposition, Witherspoon indicated that he will testify (1) that the claimed subject matter of the Polsky patent is not obvious in light of the prior art and (2) that the prior art known to and located by the Examiner is closer to the claimed subject matter than the prior art known to and withheld by Fixtures.

Witherspoon should not be permitted to testify on these two issues for three reasons. First, he admits that he is not a person of ordinary skill in the field of chair design. Hence, he concededly lacks the necessary expertise required by § 103 to render an opinion on obviousness and the closeness of prior art. Second, he has refused to disclose prior to trial what his testimony will be, and this has substantially prejudiced Wenger's ability to cross-examine him. Third, Witherspoon intends to base his expert opinions primarily upon his observation of the testimony of the other witnesses at trial.

Such contemplated testimony by Witherspoon is clearly improper. Accordingly, although Witherspoon may be entitled to testify as to the legal standard of obviousness set forth in Graham v. John Deere Co., infra, and the general nature of the presumption of validity under recent Federal Circuit cases, the Court should prohibit him from testifying on the ultimate issues of obviousness and the closeness of the art. In the alternative, insofar as the Court allows Witherspoon to testify on the ultimate issues of obviousness and closeness of the art, it should restrict the grounds

in support of such testimony to those grounds articulated by Witherspoon in his deposition and specifically exclude as grounds his reliance on testimony at trial.

II. FACTS

On June 1, 1983, Fixtures disclosed that John F. Witherspoon, a patent attorney in private practice, would be one of its expert witnesses at trial. Witherspoon apparently intends to offer expert opinions at trial (1) on the ultimate issue of obviousness, that the Polsky patent is not obvious in light of the prior art, and (2) on the ultimate issue of the closeness of art, that the art located by the Examiner and over which the Polsky claims were allowed are each closer than the art known to and withheld by Fixtures. His plan to offer these opinions is surprising in light of four admissions he made during his deposition on January 26, 1985. Witherspoon testified that:

1. he is not an expert in the field of chair design;
2. opinions on the subjects of obviousness and closeness of prior art should be given by someone who is an expert in the field of chair design;
3. he did not at the time of the deposition have a definite opinion on the subjects of obviousness and the closeness of prior art; and
4. he expects to base his opinions primarily upon his observation of the testimony of other witnesses at trial.

Witherspoon's deposition testimony on these subjects was as follows:

- Q. Mr. Witherspoon, do you consider yourself an expert in the field of chair design?
- A. No.

Q. Do you intend to testify at trial on the character or scope and content of the prior art that pertains to this case?

Have I phrased the question in a way which makes it difficult for you to answer?

A. No, I understand the question. And I believe the answer is no. I should say, to complete that answer, that it is possible that I would be testifying about it in the sense that I may be giving testimony which is based upon the scope and content as perhaps testified to by others.

I don't want to give the impression that my testimony may have absolutely nothing to do with the scope and content of prior art.

Q. In other words, you are not going to testify to the nitty-gritty of the patents that pertain to this case, or the prior art patents?

A. I am not sure I know what you mean by nitty-gritty.

Q. You are not going to discuss the structure in the prior art patents which may be considered relevant to the questions of obviousness.

A. I would not be expecting to testify in that regard. Shall we say, initially. Not being a person skilled in the art, I feel I would not be able to give testimony as to what a given prior art document would mean to a person of ordinary skill in the art in the absence of the benefit of the testimony from such person.

If asked, I could always give testimony about what a given prior art document means to me.

Q. But what it means to you would not be the same as to a person of ordinary skill in the art.

A. It might turn out to be the same.

Q. If it did, it would be coincidental.

A. My testimony would not be that of a person of ordinary skill in the art, however.

* * * *

- Q. What testimony do you anticipate giving that relates to those subjects that you have just mentioned?
- A. Possibly in the area of obviousness.
- Q. What, in particular?
- A. Whether, indeed, in my opinion a certain claim is directed to subject matter which is obvious in view of -- or within the meaning of Section 103.
- Q. Do you need any factual predicate to give that kind of opinion?
- A. Yes.
- Q. What is that factual predicate?
- A. Many of the factual predicate (sic) that this last line of questioning pertains to.
- Q. So then, you might be opining on whether or not the Polsky patent claims one and two are obvious in light of the prior art. Is that correct?
- A. It is my understanding that I might be giving testimony at trial in that regard.
- Q. And if you do, your testimony would be based on that of Fixtures' technical expert.
- A. I should think at least in part.
- Q. What else would it be based on?
- A. Any testimony from whatever source that bears on these considerations, I should think, is testimony that I would have to give some consideration to.
- I am thinking, for example, of the testimony about secondary considerations which may or may not be coming from the Fixtures' technical expert. Perhaps from other witnesses. Anything that bears on the determination of obviousness following the methodology of the Graham test, whether it is from the Fixtures' technical expert or not.
- Q. But the foundation for your opinion on obviousness would necessarily be based on the testimony of others.

A. To the extent such testimony, yes, is given.

* * * *

Q. Do you have an opinion on whether the Polsky claims one and two are obvious in light of the prior art?

A. I have a current tentative opinion.

Q. What is your tentative opinion?

A. That they are directed to non-obvious subject matter.

* * * *

Q. In offering evidence as to the scope and content of the prior art, should that be done by a person skilled in the art?

A. That would certainly be helpful, I should think.

* * * *

Q. Let me ask you this question, then: Who is best qualified to give testimony as to the scope and content of prior art under the Graham [§ 103] test?

A. The person most knowledgeable of the prior art in the broad sense of the term "prior art."

Q. And as between a person skilled in the art and a person unskilled in the art, who would that be?

A. The person skilled.

Q. Now, who is most qualified to give testimony as to the differences between the prior art and the claims that are at issue?

A. Well, that raises some other very interesting and complicating questions in my opinion because, on the one hand, one could say that the answer is essentially the same as the answer I just gave --

Q. A person skilled in the art?

A. Yes.

Q. And, on the other hand?

- A. On the other hand, we are dealing now with the claims of a patent and before that determination can be made, one really needs to understand what the claims are.

You are making a comparison between A and B, and one can't determine the differences very well between A and B until they have a clear understanding of A and of B.

- Q. So, it would be important for someone testifying as to the differences between the prior art and the claims to have a thorough understanding of the meaning of those claims.

- A. You certainly have to have an understanding of the meaning of the claims, and the more thorough and accurate and complete that is, the better would be the evaluation.

I am still basically answering the same way. The person who is best able to do this is the person who best understands what he is doing. I know that is a very broad and general answer, but that is really about the best answer I can give.

- Q. And as between a person who is skilled and a person who is unskilled in the art, that would be the person skilled in the art?

- A. That is correct. But let's be sure we understand what we mean by the art here. We are using it now in a little different sense because this also now includes the art, and it is an art, in a sense, of construing claims.

- Q. To whom are the claims directed in a patent?

- A. Well, there are pronouncements in cases which cite to a person having skill in the art.

- Q. Is there a supplement to your answer?

- A. No.

* * * *

- Q. And you may have told me earlier this morning, but I'd like to make sure I understand: What is the

testimony that you expect to give on the question of obviousness?

- A. Well, I am not aware of any art at this time which was not considered by the Examiner which would, in my opinion, be sufficient to satisfy the burden of the attacker of the patent.
- Q. Do you expect to give any other testimony related to the issue of obviousness?
- A. I may also be testifying that I do not find any error in the Examiner's having issued the patent in the first instance.
- Q. Anything else?
- A. I don't believe so.

* * * *

- Q. Do you consider Hamilton to be closer to the structure disclosed in the Polsky patent than the other patents cited with the exception of the Eves?
- A. I think it certainly is much less relevant than some of the art cited by the Examiner.
- Q. Which art is it less relevant than?
- A. In addition to Eves, it seems to me it's less relevant than Moore, Merchant, Haynes, the Italian patent. I'm not inclined to feel it's unreasonable to say it's less relevant than any. I find the art cited by the Examiner to vary insofar as its relevance is concerned. So the difference between Hamilton and the art cited by reference likewise varies. But the first ones that I mentioned I think are clearly more relevant than Hamilton.

* * * *

- Q. Well, are there any patents cited by the Examiner that are less pertinent or relevant than Hamilton?
- A. I don't think so.

* * * *

- Q. By May of 1984 had you agreed to consult on behalf of Fixtures?

A. Again I find the question, strangely or not, rather difficult. . . [T]here's always an understanding that it's an exploratory type thing and could be called off up until the day of trial, the minute before you take the stand, if something should develop which had not been earlier appreciated which caused us -- me to not be entirely comfortable with the testimony that had earlier been contemplated. So it's really kind of always a matter of working into a case on the basis of considering giving testimony along certain lines which is conditional. So it's a long answer to a short question, but it's the best I can do. There was no time when, even to this day, when I have felt I have agreed to take the stand on behalf of Fixtures and give testimony of such and such nature, as I believe I've indicated earlier. There's testimony from technical people which may influence my tentative opinions on things. It may reinforce them; it may not.

* * * *

Q. Well, do you presently have in mind the testimony that you intend to give at trial?

A. No.

Witherspoon deposition at 4-6, 7-9, 16, 19-21, 23-24, 30-31, 32, 93-94, 164.

Witherspoon's plan to base his opinion on his observation of the testimony of other witnesses is corroborated by a letter from Fixtures' counsel to the Court on May 1, 1985. In the letter, Fixtures' counsel indicated that Witherspoon would not, because of prior commitments, be available for trial during the court suggested months of May or June. Anticipating that counsel for Wenger would suggest that the trial be scheduled for May or June with trial deposition transcripts being substituted for personal appearances of legal experts, Fixtures' counsel argued that

substituting a trial deposition transcript in place of Witherspoon's personal appearance would be prejudicial to Fixtures because "Mr. Witherspoon's testimony will probably be based largely on testimony given by other witnesses during the trial." See Exhibit A.

III. ARGUMENT

A. Witherspoon is not qualified to give an expert opinion on issues of obviousness and closeness of prior art.

A witness may offer testimony in the form of an expert opinion only if he is "qualified as an expert by knowledge, skill, experience, training, or education." Fed. R. Evid. 702. The qualifications of a particular witness to give an expert opinion, of course, must be judged by reference to the factual issues before the Court and the legal standards to be applied by the Court.

The requirement that a patented device be nonobvious is imposed by 35 U.S.C. § 103, which provides as follows:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

In determining whether or not claims 1 and 2 of the Polsky patent were obvious in light of the prior art, this Court must apply the traditional test enunciated in Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Under Graham:

the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in

the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In short, the Court must determine "whether a person of ordinary skill in the art, having all of the teachings of the references before him, is able to produce the structure defined by the claim." Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1013 (Fed. Cir. 1983).

Because the obviousness of an invention is judged through the perspective of a person of ordinary skill in the art, a witness who is not a person of ordinary skill in the art is not qualified to be an expert witness on the subject of obviousness. In Universal Athletic Sales Co. v. American Gym, Recreational & Athletic Equipment Corp., 546 F.2d 530 (3d Cir. 1976), cert. denied, 430 U.S. 984 (1977), plaintiff had alleged that a weight-lifting apparatus manufactured by defendants infringed its patent. After a nonjury trial, the district court entered judgment in favor of defendants, finding that two claims of plaintiff's patent were obvious in light of the prior art. The district court relied heavily on the defendants' principal expert witness, an attorney in the law firm representing defendants, who had testified that the subject matter of the plaintiff's patent was obvious.

The district court's judgment was vacated on appeal, largely because of the court's improper reliance on the testimony of defendants' expert. The Court of Appeals noted that the relevant art in the case was the design of body-training devices. The court

further noted that the defendants' expert "had little familiarity with the design of weight-lifting machines" and "no expertise whatsoever in weight training, as he repeatedly conceded during the course of his testimony." 546 F.2d at 537-8. The court held that because the defendants' expert was not skilled in the relevant art, the district court had erred in relying on his testimony on the subject of obviousness.

Another similar case was General Battery Corp. v. Gould, Inc., 545 F. Supp. 731 (D. Del. 1982). Plaintiff in that case had filed suit seeking a declaratory judgment that defendant's patents on automotive batteries were invalid and not infringed. Among other claims, plaintiff contended that the patents' subject matter was obvious.

The court found that the defendant's invention was not obvious, and commented on the qualifications of the expert witnesses proffered by the parties. The court ruled that a person of ordinary skill in the relevant art would have "two to five years of practical experience with lead-acid batteries or a technical degree and two years experience." 545 F.Supp. at 750. The court observed that five witnesses who appeared at trial were qualified to testify concerning the knowledge of one skilled in the art. The court continued:

Gould's patent law expert Martin Adelman, on the other hand, was not a person skilled in the art, but a patent lawyer, with no experience in battery manufacture. The Court disregards his testimony insofar as it purported to offer any expertise in regard to battery manufacturing.

Id., n.24.

John Witherspoon is undisputedly not a person of ordinary skill in the art of chair design. As noted above, he has conceded that he is "not . . . a person skilled in the art" and "[not] an expert in the field of chair design." Moreover, even he has admitted that it "would certainly be helpful" if the testimony concerning the scope and content of the prior art required under the Graham test were given by a person skilled in the art. Like the discredited expert witnesses in Universal Athletic, supra, and General Battery, supra, Witherspoon is a patent lawyer who simply lacks the experience or training to give the technical opinion which he intends to give.

Witherspoon is similarly unqualified to render an opinion on the closeness of prior art. Under 35 U.S.C. § 282, a patent is presumed valid. However, when the party challenging a patent introduces prior art which is more pertinent or more relevant (i.e. closer) than that considered by an Examiner in the Patent Office, the presumption loses its force. Connell v. Sears, Roebuck & Co., 722 F.2d 1542 (Fed. Cir. 1983). Accordingly, one issue at the trial of this case will be whether the prior art which Fixtures withheld from the Patent Examiner is closer to the claimed subject matter of the Polsky patent than is the prior art located by the Examiner.

The relative closeness of prior art, like the obviousness of an invention, must be judged through the perspective of a person

of ordinary skill in the relevant art.^{1/} Witherspoon has conceded that the necessary qualifications of an expert in this area are "essentially the same"; as noted above, he has also conceded that he is not skilled in the art of chair design. As a result, he is clearly not qualified to give an expert opinion on the relative closeness of prior art.

The issues of obviousness and closeness present questions of fact to the Court. Wenger's legal expert, Donald Banner, former Commissioner of the Patent and Trademark Office, will testify concerning the § 103 obviousness test and the presumption of validity which is overcome once this Court is presented with prior art which is closer than the art before the Examiner. Wenger's legal expert, however, will not testify whether the claims of the Polsky patent are in fact obvious in light of the prior art, or whether the prior art known to and withheld by Fixtures is in fact closer to the claimed subject matter. On those issues, Wenger's legal expert will defer to Wenger's technical expert.^{2/} Under the authority discussed above, Witherspoon is required to do likewise.

^{1/} In order to decide whether one item of prior art is closer than another item, one must compare the two items to the claims of the patent at issue. It is well settled that the claims in a patent are directed to a person of ordinary skill in the art. See Witherspoon deposition at 21. Moreover, when the items of art being compared are themselves patents, their disclosures are also directed to a person of ordinary skill in the art. Accordingly, a determination of which item of art is closer to a patent claim can be made only by a person of ordinary skill in the art.

^{2/} Both Fixtures and Wenger have retained chair designers who will testify as technical experts at trial.

In sum, expert testimony on the subjects of obviousness and closeness of prior art in this case may be given only by someone skilled in the art of chair design. Witherspoon is concededly not skilled in this art, and he therefore should not be permitted to render an expert opinion on these subjects.

B. Witherspoon should not be permitted to testify because he has failed to disclose the content of his testimony prior to trial.

When Witherspoon was deposed on January 26, 1985, Wenger's counsel attempted to discover what his testimony at trial would be. These attempts, however, were thwarted by Witherspoon's forthright admission that he did not know what his opinion would be. As noted above, he stated that his intention to testify on behalf of Fixtures was "an exploratory type thing and could be called off up until the day of trial, the minute before you take the stand." He noted that he "might be giving testimony" on the subject of obviousness, and that "it is possible" that he might testify concerning the scope and content of the prior art. It is clear from his testimony during the January 26, 1985 deposition, however, that he had no meaningful idea of what his trial testimony may be. Yet, he was retained by Fixtures and designated as their expert on June 1, 1983.

Because Witherspoon has been unable or unwilling to disclose how he will testify at trial, Wenger is completely unable to prepare any rebuttal to whatever his testimony may ultimately be. This is clearly at odds with the policies of the Federal Rules of Civil Procedure and the Federal Rules of Evidence which allow

freer rein for expert opinion testimony than for testimony of fact witnesses, but only because of liberal pretrial discovery of expert witnesses.

Fed. R. Civ. P. 26(b)(4)(A) permits a party to discover the substance of and grounds for any expert opinion which will be given at trial. The Advisory Committee on Civil Rules has explained the need for such discovery as follows:

Effective cross-examination of an expert witness requires advance preparation. . . . Similarly, effective rebuttal requires advance knowledge of the line of testimony of the other side.

Advisory Committee Notes, Fed. R. Civ. P. 26.

The Federal Rules of Evidence similarly recognize the necessity of pretrial discovery of expert witnesses. Fed. R. Evid. 705 permits an expert witness to testify in the form of an opinion, without first disclosing the facts underlying his opinion. At the same time, however, the rule provides that the expert may be required to disclose the underlying facts on cross-examination. In explaining this rule, the Advisory Committee has noted that "advance knowledge through pretrial discovery of an expert witness's basis for his opinion is essential for effective cross-examination." Advisory Committee Notes, Fed. R. Evid. 705.

Commentators have also described the necessity of pretrial discovery of expert witnesses in order to allow for effective cross-examination. Professor Friedenthal has stated:

It is fundamental that opportunity be had for full cross-examination, and this cannot be done properly in many cases without resort to pretrial discovery. . . . Before an attorney can even hope to deal on cross-examination with an unfavorable expert opinion he must have some idea of the bases of that opinion and the data relied upon. If the attorney is required to await examination at trial to get this information, he often will have too little time to recognize and expose vulnerable spots in the testimony.

Friedenthal, Discovery and Use of an Adverse Party's Expert Information, 14 Stan. L. Rev. 455, 485 (1962). Judge Pratt has expressed a similar observation:

[A]ttorneys have fruitful opportunities available to them in presenting opinion testimony, and attorneys seeking to counter such testimony must in pretrial proceedings carefully discover the expert's opinion and its underlying basis in order to undercut that evidence at trial. . . . In order to determine how to attack an expert's opinion, and whether to explore the reasoning behind it or the facts underlying the opinion, the opposing attorney in a civil case must learn all of that information in advance. For Rule 705 to operate fairly, therefore, extensive pretrial discovery of experts is essential.

Pratt, A Judicial Perspective on Opinion Evidence Under the Federal Rules, 39 Wash. & Lee L. Rev. 313, 320 (1982).

When an opposing party has been prevented from learning the content of an expert opinion prior to trial, the expert's testimony should not be admitted. In Smith v. Ford Motor Co., 626 F.2d 784 (10th Cir. 1980), cert. denied, 450 U.S. 918 (1981), plaintiff brought suit alleging that he had suffered personal injuries as a result of the defective design of the seat belts

in an automobile manufactured by defendant. After the jury returned a verdict in favor of plaintiff, defendant appealed on the ground that one of plaintiff's expert witnesses should not have been permitted to testify.

In accordance with the district court's pretrial order, each party had identified its expert witnesses before trial and given a description of their proposed testimony. Plaintiff had identified as one of his experts a physician who intended to testify concerning "his medical treatment of the Plaintiff, as well as to his prognosis." 626 F.2d at 788. When the expert appeared at trial, however, he did not merely testify as to plaintiff's medical treatment; he also testified, over defendant's objection, that the plaintiff's injuries had been caused by the defective nature of defendant's seat belts.

The Court of Appeals reversed the jury verdict, finding that defendant had suffered substantial prejudice by not learning the content of the expert's testimony prior to trial. The court explained the necessity of pretrial discovery of expert witnesses, noting that the policy underlying the Federal Rules on this subject was to prevent "trial by ambush." 626 F.2d at 797. The court observed that the plaintiff's failure to disclose the expert's testimony prior to trial prevented defendant from being "well prepared at trial to cross-examine him about his conclusions." Id. at 798. The court held that defendant's ability to cross-examine the witness was so compromised that a new trial was required.

It is obvious upon reviewing the transcript of Witherspoon's deposition testimony that Wenger's ability to cross-examine him at trial will be similarly compromised. Wenger is entitled to know before trial what Witherspoon's testimony will be. However, even Witherspoon himself does not know how he will testify. Permitting Witherspoon to testify, in light of his refusal to disclose his testimony in advance, would surely result in a "trial by ambush." This result would be plainly unfair to Wenger, and Witherspoon should not be permitted to testify.

C. Witherspoon should not be permitted to offer an expert opinion based on his observation of or review of the testimony of other witnesses.

It is also obvious from Witherspoon's deposition testimony why he is unable to indicate precisely what his testimony at trial will be. Witherspoon has concededly not conducted any substantial independent research or inquiry on the subject of obviousness. Instead, he intends merely to listen to or review the testimony of Fixtures' other witnesses and Wenger's witnesses at trial, and then offer an expert opinion based on their testimony.

Witherspoon should not be allowed to testify in this fashion, for three reasons. First, if Witherspoon is truly unable to formulate an opinion until he hears the testimony of Fixtures' other witnesses and Wenger's witnesses, then whatever his testimony turns out to be will clearly be a surprise to Wenger. Counsel for Wenger will be, of necessity, completely unprepared to cross-examine him on his opinion. As noted above, Wenger is

entitled to know Witherspoon's opinion and its grounds prior to trial. If Witherspoon is permitted to wait until he has heard the testimony of Fixtures' other witnesses and Wenger's witnesses before formulating his opinion, however, counsel for Wenger will be deprived of the advance notice to which they are entitled.

The foregoing presupposes that Witherspoon is acting in good faith and that the prejudice to Wenger is merely coincidental. However, it should be apparent that this is a guise by which Witherspoon can thwart the effective cross-examination to which Wenger is entitled under the rules.

Second, any testimony which Witherspoon might give in this fashion is inherently unworthy of belief. Fixtures retained Witherspoon as an expert witness more than two years ago. Witherspoon has not, in the intervening two years, conducted any research upon which to base an expert opinion. Moreover, he apparently has no plans to do so; instead, he will simply use the testimony of Fixtures' other witnesses and Wenger's witnesses as the basis for his opinion, even though he does not know what their testimony will be.

The only logical inference to be drawn is that Witherspoon intends to testify that the Polsky patent claims are not obvious and that the art before the Examiner is closer than the art known to and withheld by Fixtures, whatever the testimony of Fixtures' other witnesses or Wenger's witnesses may be. It is inconceivable that Witherspoon will listen to the testimony of the other witnesses

and then give an expert opinion adverse to the party which has had him under retainer since 1983. Any expert opinion rendered by Witherspoon under these circumstances is so untrustworthy as to lack any probative value.

Fixtures is likely to attempt to bolster Witherspoon's credibility by emphasizing his experience as an Examiner-in-Chief in the Patent Office, and comparing this case to those upon which Witherspoon passed judgment in that capacity. Witherspoon is expected to state, after listening to the conflicting testimony of the technical experts and other fact witnesses, that if this case were brought before the Board of Appeals in the Patent Office on a written record, he would uphold the validity of the patent. This testimony, however, has one glaring weakness. As Examiner-in-Chief on the Board of Appeals, Witherspoon acted as an impartial arbiter. In this case, he is acting as a paid advocate for Fixtures. Permitting Witherspoon to render a paid "impartial" judgment after listening to the other witnesses at trial would be a charade which this Court should not permit.

Third, the testimony which Witherspoon intends to give would usurp the Court's function of weighing the witnesses' testimony and deciding the outcome of the case. See Marx & Co. v. Diners' Club, Inc., 550 F.2d 505, 510 (2d Cir. 1977), cert. denied, 434 U.S. 861 (1977):

As Professor McCormick notes, such testimony "amounts to no more than an expression of the [witness'] general belief as to how the case should be decided." . . . The admission of such testimony would give the appearance that the court was shifting to witnesses the responsibility to decide the case.

(citations omitted).

It would certainly be improper if Fixtures were to call as a witness a Judge of another Court who had listened to the testimony of the other witnesses at trial and wished to give his opinion of how the case should be decided. Yet this, thinly disguised, is what Fixtures intends to do by calling Witherspoon. It is the function of this Court, not of Witherspoon, to review the conflicting testimony of Fixtures' and Wenger's technical experts and to decide the outcome of the case by resolving those conflicts. Witherspoon should not be permitted to perform that function.


IV. CONCLUSION

Because Witherspoon is not skilled in the art of chair design, he is not qualified to give expert opinions on the obviousness of the Polsky patent and the relative closeness of the prior art. In addition, his refusal to indicate before trial how he will testify has prejudiced Wenger's right to effective cross-examination. Accordingly, Wenger respectfully requests that Witherspoon not be permitted to offer expert testimony on the

subjects of obviousness and closeness of prior art, or that his testimony be limited as described above.

Dated: November 12, 1985

DORSEY & WHITNEY

By 

Ronald J. Brown

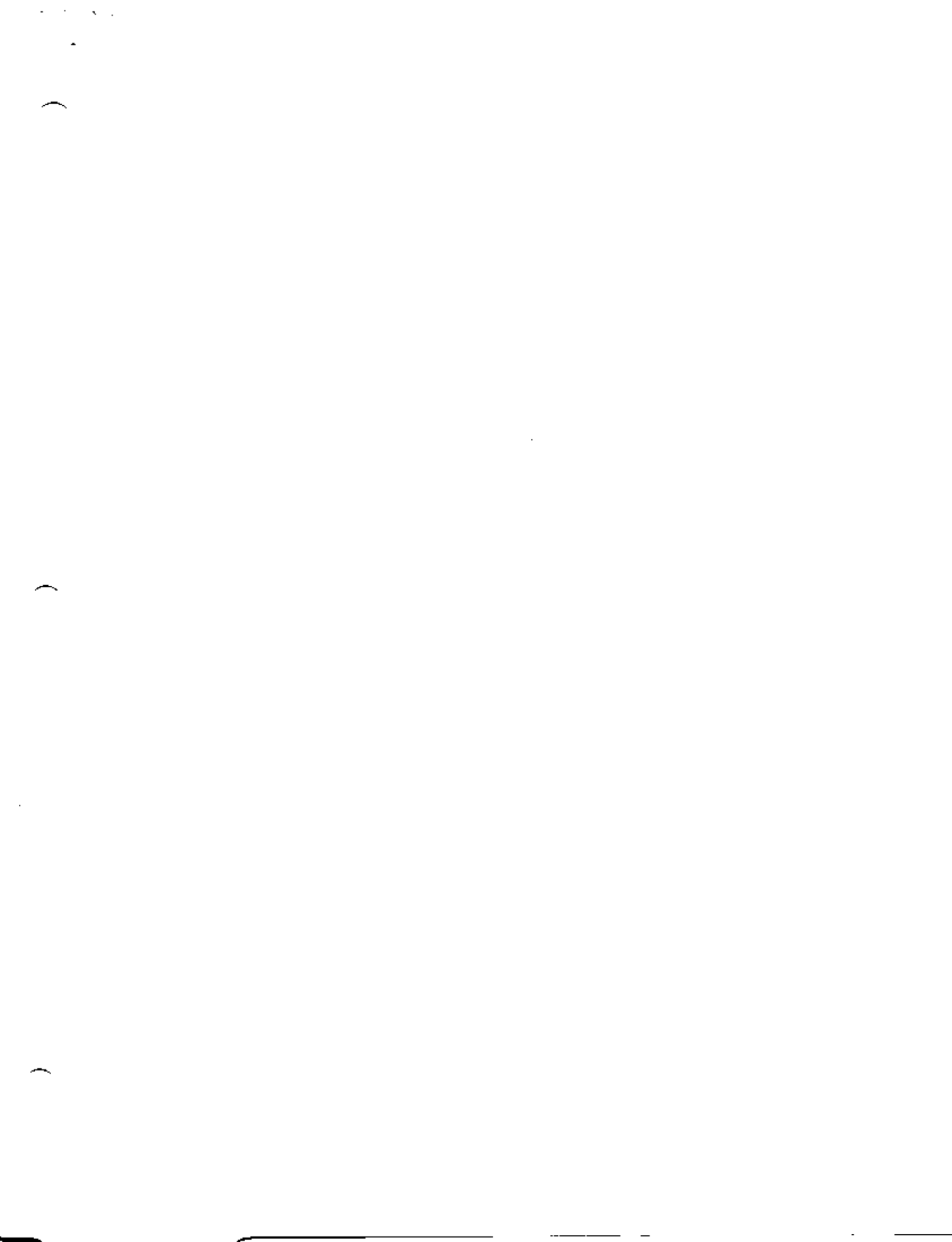
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VCVA 5/6/85

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May 1, 1985

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Hon. Paul Magnuson
Room 754
United States Courthouse and Federal Building
316 North Roberts Street
St. Paul, Minnesota 55101

Re: Fixtures v. Wenger, Civil Action No. 4-81-532

Dear Judge Magnuson:

The inventor and president of our client, Mr. Polsky, and a key witness, Mr. Witherspoon, have informed us that they are unavailable for a trial of the above-entitled matter during the months of May and June. Their itineraries are attached. Mr. Witherspoon's testimony will probably be based largely on testimony given by other witnesses during the trial; otherwise, we would consider offering his testimony by deposition.

Accordingly, if there is an opening on your docket during the first three weeks of July, we respectfully request that our case be heard then.

Sincerely yours,

LITMAN, DAY & McMAHON

BY

MAL:amo
Enclosures

Original Signed By
Malcolm A. Litman

cc: Ronald J. Brown, Esq. ✓
with enclosures