United States District Court,
N.D. California.

HARK CHAN, et al,
Plaintiffs.
v.
INTUIT, INC, et al,
Defendants.

No. C 02-2878 VRW (JL)

April 9, 2003.

Rita Coyle Demeules, Attorney at Law, Brian William Oberst, Emmett J. McMahon, Ronald J. Schutz, Robins, Kaplan, Miller & Ciresi, L.L.P., Misti N. Okerlund, Minneapolis, MN, William Horsley Orrick, III, Gail Get-Ying Quan, Coblentz, Patch, Duffy & Bass, LLP, San Francisco, CA, for Plaintiffs.

David Andrew Perlson, Quinn Emanuel Urquhart Oliver & Hedges L, Irvin E. Tyan, Farella Braun Martel, LLP, San Francisco, CA, Evette Dionna Pennypacker, Claude M. Stern, Quinn Emanuel Urquhart Oliver & Hedges LLP, Redwood Shores, CA, Brenda Marnie Simon, Fenwick & West LLP, Mountain View, CA, Stacey E. Stillman, Attorney at Law, Redwood City, CA, for Defendants.

ORDER RE PRELIMINARY CLAIMS CONSTRUCTION DISCLOSURES

Document # 69, 70, 71

JAMES LARSON**, United States Magistrate Judge.**

Introduction

Discovery in this case has been referred to this court by the district court (Hon. Vaughn R. Walker). The defendants Symantec, Intuit and Electronic Arts, Inc. ("EA") submitted letter briefs (document numbers 69 and 70) to the court describing a discovery dispute. Their briefs also refer to a previous discovery dispute as pending before the court (document numbers 57, 58, 59, 60, 61 and 62). Plaintiffs responded (document number 71), but characterized the latest matter as moot since the parties exchanged their Preliminary Claims Construction disclosures on April 2. The next step would be a further exchange of information at a conference as provided by Patent Local Rule 4-2(c). Symantec responded to an inquiry from the court that it denies the latest matter is moot. With respect to the parties' previous discovery disputes, Symantec refers the court to the March 20, 2003 order by Judge Walker that, with respect to their previous disputes, described in documents 57-62, the parties shall file formal noticed motions before this court. The court finds the latest matter suitable for decision without oral argument as provided by Civil Local Rule 7-2.

The Dispute

Defendants and plaintiffs exchanged their Preliminary Claims Construction and Extrinsic Evidence, as required by Patent Local Rule 4-2(a). Defendants' list included a significant number of claim terms that were not on plaintiffs' list. During a subsequent meet and confer by telephone, plaintiffs' counsel indicated that the only claim terms and elements that would be included in plaintiffs' Patent Local Rule 4-2(a) exchange would be those that had been identified by the plaintiffs. Plaintiffs stated that they would not offer a construction of any of the claim terms that had been identified by defendants. Counsel for defendants pointed out that the plain language of Patent Local Rule 4-2(a) requires all parties to provide a preliminary construction of all terms that have been identified by the parties collectively. Plaintiffs reiterated their position that they would not provide their construction of terms submitted by defendants.

Defendants claim that this tactic by plaintiffs will prejudice defendants in preparing for the claim construction hearing, since plaintiffs will have the advantage of defendants' construction while defendants will not have the benefit of plaintiffs' construction of the terms which defendants allege to be in dispute. Defendants ask the court to order plaintiffs to provide disclosures that include the claim terms and elements identified by defendants.

Plaintiffs rejoin that defendants mischaracterize plaintiffs' position, that plaintiffs offered to exchange information in draft form and defendants refused and that the issue is now moot since the parties have exchanged their preliminary Claims Construction Disclosures and the next step is a conference as provided by Patent Local Rule 4-2(c).

Analysis and Order

Defendants interpret the word "collectively" to encompass terms in dispute listed by either plaintiffs or defendants. In fact, the definition of the word "collective" indicates that it should be interpreted in this context to include only those terms in dispute listed by both plaintiffs and defendants.

Collective: 1. Formed by collecting; assembled or accumulated into a whole. 2. Of, pertaining to, characteristic of, or made by a number of individuals taken or acting as a group: *a collective decision*.

American Heritage Dictionary, New College Edition 1976.

In this instance, there is no collection of all the claims in dispute, there are only the two lists. The parties were not acting as a group when they arrived at their respective lists. Therefore, the two lists do not represent "each claim term, phrase or clause which the parties collectively have identified for claims construction purposes." (Patent Local Rule 4-2(a)).

Accordingly, plaintiffs are not obliged to construe claims submitted separately by defendants and defendants' request for an order from the court is denied. This resolves document numbers 69, 70 and 71 in the court's docket.

N.D.Cal.,2003.
Hark Chan v. Intuit, Inc.

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