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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION and MICROSOFT MOBILE, INC.,
Petitioners

v.

GLOBAL TOUCH SOLUTIONS, LLC
Patent Owner

Case IPR2015-01148
Patent No. 7,498,749 B2

PATENT OWNER'S MOTION TO EXCLUDE

I. STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Global Touch Solutions, LLC (“PO” herein) moves to exclude the Second Declaration of Mark Horenstein, Exhibit 1019. PO timely objected to this “Declaration” on June 8, 2016 – see Patent Owner’s Objection to Evidence, Notice 21. Petitioners rely extensively on Exhibit 1019 in Petitioners’ Reply to Patent Owner’s Response to the Petition. *See, e.g.*, pages 2,10, and 12 (where a new argument is presented in Horenstein’s Declaration that is neither responsive to an argument presented by PO nor based on information discovered after Horenstein’s First Declaration, and is thus untimely).

The Second Declaration of Horenstein should be excluded. It lacks any sort of representation that the statements presented are true or even believed to be true, and cross-examination reflected the Declarant’s belief that such guarantees of trustworthiness and believability are “boilerplate” that he pays no attention to. Transcript of the Deposition of Horenstein, Exhibit 2007. Indeed, the witness testified that the “execution” of his Declaration (Exhibit 1019) lacks an original signature, a requirement of the Rules applicable herein, including 37 C.F.R. §1.68, and corresponding evidentiary requirements of the Federal Rules. The document that is Exhibit 1019 is nothing more than hearsay, and inadmissible. Exclusion is respectfully requested.

II. ARGUMENT IN SUPPORT OF THE REQUESTED RELIEF

PO submits that the governing law on the question of the inadmissible character of Petitioners' Exhibit 1019 is beyond dispute. Testimony that is not compelled, and the Second Declaration of Horenstein that is Exhibit 1019 was not compelled, must be submitted in the form of an affidavit. 37 C.F.R. §42.53(a).

Testimony that is not submitted in compliance with this Rule is inadmissible.

Lowe's Home Centers, LLC v. Reddy, 2016 WL 1275315 *8 (PTAB) and *Coalition for Affordable Drugs IX, LLC v. Bristol Myers Squibb, Co.*, 2016 WL 1082935 fn.4 ("Uncompelled direct testimony "must be submitted in the form of an affidavit" otherwise it is not admissible") citing 37 C.F.R. §42.53(a), 42.61(a).

Further, Exhibit 1019 lacks an original signature. The witness testified as to the true nature of the execution of Exhibit 1019 during his deposition, indicating he did not sign the document, but instead caused an electronic reproduction of a graphic image to attach to it. Exhibit 2007, 10:20 – 25. 37 C.F.R. § 1.4 (d) requires all documents that have to be signed to reflect the person's "original handwritten signature personally signed...by that person". While not controlling in an IPR, Federal Rule of Civil Procedure 26(b) includes a parallel provision for expert reports, which are not dissimilar from the type of expert Declaration submitted in this IPR. The requirement for an original signature is present for the

same type of credibility and reliability issues met by an original signature and jurat, both missing in the Second Declaration of Mark Horenstein, Exhibit 1019. Clearly, the Second Declaration of Horenstein, Exhibit 1019, does not meet the requirements of the Rules. Having been timely objected to the Exhibit during the deposition, exclusion on this basis is requested as well.

In this regard, PO notes that none of the Declarations submitted by Petitioners in the series of IPRs between PO and Petitioners (IPRs 2015-01147, 2015-01148, 2015-01149, 2015-01150, and 2015-01151) bear an original signature or a jurat or statement certifying their reliability. While not all of those Declarations were in fact objected to, none are competent to be considered, for the reasons discussed above. Simply because an Exhibit is not objected to does not mean this Board must accept it as admissible. The Board has discretion to decline to consider any document not admissible. Patent Owner urges the Board to decline to consider such clearly inadmissible documents as the Horenstein Declarations and the Second Horenstein Declarations in each of the identified IPRs. Lacking both an original signature and not in the form of an affidavit, these papers are inadmissible and should be excluded.

Respectfully submitted,

Date: July 6, 2016

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6 and 42.105, I hereby certify that on this 7th day of July 6, 2016, the foregoing **PATENT OWNER'S MOTION TO EXCLUDE** was served by e-mail on counsel for Petitioner:

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