

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 7,498,749

**PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE PETITIONER'S EXHIBIT 1019**

Patent Owner's Motion to Exclude Exhibit 1019 — Petitioner's Second Declaration of Dr. Mark Horenstein — should be denied because the proper and fair remedy for the clerical error identified by Patent Owner is to file a corrected declaration, which Petitioner has already done. Furthermore, Patent Owner's allegation that the correction of Dr. Horenstein's declarations casts doubts on Dr. Horenstein's credibility goes to the weight, not admissibility, of his testimony.

The Board has repeatedly resolved disputes over missing attestation paragraphs in declarations by accepting corrected versions of the declarations adding the missing paragraph. This remedy is appropriate because it leaves the substance of the declaration unchanged, and therefore does not prejudice the party opposing the correction. *See, e.g., Array BioPharma Inc. v. Takeda Pharmaceutical Co. Ltd.*, IPR2015-00754, Paper No. 20 at 4-5 (October 21, 2015) (granting Petitioner's Motion to Submit Corrected Exhibits with attestation paragraph and finding that "Patent Owner has [not] argued persuasively that the corrections Petitioner proposes amount to substantive changes or would cause Patent Owner to suffer any prejudice"); *Microsoft Corp. v. Enfish, LLC*, IPR2013-00559-63, Paper No. 13 at 4 (January 23, 2014) ("the rule permitting correction of clerical errors is remedial in nature, and is, therefore, entitled to a liberal construction") (internal citations omitted); *Indoor Skydiving Germany GmbH v. Ifly Holdings LLC*, IPR2015-01272, Paper 11 at 2-3 (Sept. 30, 2015) ("correcting

the original Declaration, for example, by adding ‘I declare under penalty of perjury that the foregoing is true and correct’ . . . would not change the substance of the statements set forth in paragraphs 1–47 of the original Declaration. Accordingly, we determine that granting Petitioner’s request would correct a clerical mistake, without prejudice to Patent Owner.”).¹

On July 8, 2016, after receiving permission from the Board, Petitioner filed a corrected version of Exhibit 1019 that included an attestation paragraph missing from an earlier version of Exhibit 1019 filed on June 2, 2016. *See* Ex. 1023 (July 6, 2016 Email from Andrew Kellogg, PTAB Supervisory Paralegal). The inclusion of the attestation paragraph in corrected Exhibit 1019 did not amount to a substantive change in part because, as Dr. Horenstein testified, “[o]f course [he] wouldn’t sign a document that [he] didn’t testify before or stand behind.” Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at 18:8-9. Dr. Horenstein also testified that “[y]es,” he reviewed the declarations he signed on June 1, 2016. *Id.* at 81:11-14. Patent Owner is also not prejudiced by Petitioner’s filing of the corrected version of Exhibit 1019 because Patent Owner preserved the

¹ Correction of Exhibit 1019 is also appropriate under 35 U.S.C. § 26. *See Array BioPharma Inc. v. Takeda Pharmaceutical Co. Ltd.*, IPR2015-00754, Paper No. 17 at 5 (October 9, 2015) (relying on 35 U.S.C. § 26); *Presidio Components, Inc. v. AVX Corp.*, IPR2015-01332, Paper 13 at 3 (Aug. 21, 2015) (same).

record by depositing Dr. Horenstein on the substance of his Second Declaration on June 28, 2016 and submitting a transcript thereof as Exhibit 2007.

Lastly, Patent Owner's Motion should be denied because if the arguments are valid at all, then they go to the weight of Dr. Horenstein's testimony, rather than its admissibility. *Informatica Corp. v. Protegrity Corp.*, CBM 2015-00021, Paper No. 38 at 1 (May 31, 2016) ("[T]he Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to the evidence presented in this trial, without resorting to formal exclusion that might later be held reversible error.") (internal citations omitted); *see also Daiichi Sankyo Co., Ltd. v. Alethia Biotherapeutics, Inc.*, IPR2015-00291, Paper No. 75 at 24 (June 14, 2016). Patent Owner is free to present its credibility arguments at the hearing in this matter if it so chooses.²

² Patent Owner's suggestion that the rules require Dr. Horenstein to sign his declarations in ink is directly contradicted by the same rule that Patent Owner cites. IPR2015-01148, Paper No. 25 at 2. 37 C.F.R. 1.4 (d) provides that "[c]orrespondence permitted via the Office electronic filing system may be signed by a **graphic representation of a handwritten signature**." 37 C.F.R. 1.4(d)(3) (emphasis added); *see also Seoul Semiconductor Co., Ltd. v. Enplas Corp.*, IPR2014-00878, Paper No. 34 at 7-8 (October 15, 2015) (disregarding Patent Owner's argument that Petitioner's expert testimony was not trustworthy or

For the foregoing reasons, Petitioner respectfully requests that Patent Owner's Motion to Exclude Exhibit 1019 be denied.

Dated: July 13, 2016

Respectfully submitted,

/Daniel J. Goettle/

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credible in part because the expert's signature was an electronic image of a signature). In any event, Dr. Horenstein signed the corrected version of Exhibit 1019 in ink.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that true and correct copies of the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE PETITIONER'S EXHIBIT 1019** was served via email this 13th day of July, 2016, on the following:

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