UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.
Petitioner

v.

UNILOC LUXEMBOURG, S.A.[1]
Patent Owner

Case: IPR2017-01801
U.S. Patent No. 8,995,433

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

[1] Uniloc's updated mandatory notice filed on August 27, 2018, indicates that the owner of U.S. Patent No. 8,995,433 is now Uniloc 2017 LLC. (Paper 18.)

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Petitioner Samsung Electronics America, Inc. ("Samsung") submits the following response to Patent Owner Uniloc 2017 LLC's ("Uniloc's") motion to exclude ("Motion"). (Paper 20.)

I. INTRODUCTION

Uniloc's perfunctory motion to exclude a substantial portion of the deposition testimony of its own expert, Mr. Easttom, should be summarily denied because it fails to satisfy the requirements of a motion to exclude. In particular, the motion does not sufficiently explain the basis of each objection or identify where in the record the objected-to deposition testimony is relied upon. Thus, its motion should be rejected outright as facially deficient. Uniloc cannot cure these deficiencies in its reply as it would be improperly presenting arguments in a reply brief that should have been presented in its motion.

Regardless, even if the Board considers the merits, Samsung's questions were well within the scope of Mr. Easttom's declarations. The notion that asking about intrinsic evidence that contradicts direct testimony could be outside the scope of that testimony fails on its face. In effect, Uniloc seeks to restrict the scope of cross-examination to parroting material from the declaration. This is contrary to

37 C.F.R. § 42.53(d)(5)(ii) and the Board's practice.[2] When a witness testifies on direct that a prior art reference lacks a certain element of a patent claim, and bases that testimony on an incorrect interpretation of the claim language, that opens the door to cross examination on the correct interpretation of that claim language. *See Microsoft Corp. v. Proxyconn, Inc.*, IPR2012-00026, Paper No. 66 at 2-3 (P.T.A.B. Nov. 1, 2013); *Canon Inc., v. Intellectual Ventures II LLC,* IPR2014-00531, Paper 50 at 45 (P.T.A.B. Aug. 19, 2015). That indisputable proposition and that hypotheticals are certainly proper for an expert defeat Uniloc's motion.

II. ARGUMENT

Ignoring the requirements for a motion to exclude, Uniloc indiscriminately seeks to exclude eighty-nine (89) portions of Mr. Easttom's deposition testimony, which amounts to hundreds of lines of deposition testimony. (Exs. 1040 (71 portions), 1041 (13 portions), 1042 (5 portions).) The cited portions of Mr. Easttom's deposition testimony, however, call into question his earlier opinions concerning the relation of the patent claims to the prior art (Ex. 2001), and thus are

[2] For instance, the Board has held that limiting cross-examination to the scope of direct testimony under 37 C.F.R. § 42.53(d)(5)(ii) does not necessarily limit such cross-examination to documents cited in the direct testimony. *See Medtronic, Inc. v. Endotach, LLC*, IPR2014-00100, Paper 32 at 2-3 (P.T.A.B. Aug. 28, 2014).

relevant and within the scope of the subject matter to which Mr. Easttom testified. For instance, his testimony that certain prior art does not disclose particular claim elements, such as "instant voice messaging," opened him to cross-examination of the meaning he attaches to those terms.

A. Uniloc's Motion Fails to Meet the Requirements and Should Be Summarily Denied

Uniloc's motion fails to satisfy the basic requirements for a motion to exclude. *See* 37 C.F.R. § 42.64(c); USPTO Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 47,867 (Aug. 14, 2012). Notably, other than a vague and broad statement that hypothetical questions are outside the scope, Uniloc provides no legal basis to support its motion seeking to exclude a substantial portion of the deposition testimony of Mr. Easttom. Pursuant to 37 C.F.R. § 42.64(c) governing motions to exclude, the moving party "must explain the objections." *See Sipnet EU S.R.O. v. Straight Path IP Group, Inc.*, IPR2013-00246, Paper 63 at 2 (P.T.A.B. Oct. 9, 2014) ("The party moving to exclude evidence bears the burden of proof to establish that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence."). Uniloc has utterly failed to do so here. Instead, without sufficient explanation or supporting precedent, Uniloc generally argues that hundreds of lines of deposition testimony should be excluded because of questions that were allegedly "outside the scope of

Mr. Easttom's direct testimony." (Mot. at 3.) Such a conclusory argument should be rejected.

Similarly, "[a] motion to exclude evidence must: … (b) [i]dentify where in the record the evidence sought to be excluded was relied upon by an opponent." Trial Practice Guide, 77 Fed. Reg. 48,756, 47,867. Instead of complying with this mandate, Uniloc tasks the Board with figuring out whether and where the objected-to portions of Mr. Easttom's testimony are relied upon in the record, which is improper.

For these reasons, Uniloc's motion should be denied as facially deficient, and Uniloc should not be permitted to back-fill its motion on reply. *See* 37 C.F.R. § 42.23(b) ("All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition . . . ."); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016); *Sumitomo Elec. Indus., Ltd. v. United Techs. Corp.*, IPR2017-00966, Paper 29 at 27-28 (P.T.A.B. Sept. 12, 2018).

B. Mr. Easttom Opined Broadly on the Challenged Patent and the Prior Art in His Direct Testimony

As demonstrated by Mr. Easttom's declarations, the entire challenged patent and the prior art cited by Samsung are within the scope of Mr. Easttom's direct testimony.

In his direct testimony, Mr. Easttom testified that, he reviewed, among other things, the patents-at-issue and the prior art references cited by Samsung, "including *Zydney* and *Griffin*." (Ex. 2001 at ¶ 4.) This was confirmed during cross examination. (Ex. 1040 at 13:15-15:5 (discussing materials reviewed in preparation of declaration); 33:13-16 (confirming he considered "the meaning of all the terms that I [sic; are] recited in the claims of the '622 patent"); 66:24-67:4 (same); 180:3-181:4.) He also affirmed in his direct testimony that his conclusions were "[b]ased on" the challenged patents and the cited prior art references, as well as his "familiarity with those having ordinary skill in the art at the time the application was filed." (Ex. 2001 at ¶ 5.) Furthermore, he unequivocally testified that "every determination on obviousness requires a review of the scope and content of the asserted references, analysis of the differences between those references and the patent claim at issue, and the level of ordinary skill in the pertinent art at the time the invention was conceived" (*Id.* at ¶ 10), thus implying that his analysis and conclusions regarding obviousness involved the same review.

Mr. Easttom also acknowledged the importance of the state of the art at the time of the purported invention in the obviousness analysis, again implying that his opinions took account of the state of the art. (*Id.* at ¶¶ 13, 15.) His direct testimony further included an overview of the "technology claimed in claims 1-5, 7-2, 14-17, 25, and 26 of the '433 patent" and the prior art. (*Id.* at ¶¶ 18-51.)

As one example, Mr. Easttom opines that the primary reference in Samsung's petitions (*Griffin*) does not disclose an "instant voice message." (*Id.* at ¶ 37.) Mr. Easttom's opinion relies on an implicit interpretation of this term. (*Id.* at ¶¶ 33-40.) In particular, with respect to the '622 patent, Mr. Easttom opined that *Griffin* does not disclose "instant voice message" because "[t]he system described in *Griffin* has no knowledge of, or interest in, and no way to know whether a device is ready and able to 'hear' a message." (*Id.* at ¶ 35, 40.)

Thus, Mr. Easttom put his understanding of the entire disclosures of the challenged patent and the prior art asserted by Samsung at issue by providing an overview of each, testifying on the level of skill in the art, and analyzing whether the prior art discloses the limitations of the claims.

C. Given the Breadth of Mr. Easttom's Direct Testimony, Samsung's Cross-Examination Questions Were Within the Scope

While attempting to probe the boundaries of Mr. Easttom's understanding of the claim terms at issue and why the prior art purportedly does not disclose those terms, Uniloc repeatedly disrupted the deposition with a barrage of improper objections to "scope," and ultimately—in a long speaking objection in the presence of the witness—threatened to "shut down the deposition." (Ex. 1040 at 57:2-60:6.)

The objections Uniloc cites in its motion are in fact improper "scope" objections to Samsung's questions probing the expert's basic understanding of the prior art, challenged patents themselves, and specific claim terms at issue (about each of which Mr. Easttom testified). The following examples illustrate some of Uniloc's improper objections:

- "**Q**: Okay. If we can just go to figure 1 of the Griffin patent. And can you tell me what's shown in Figure 1?

  MR LOVELESS: Objection, form, scope." (Ex. 1040 at 148:22-25.)
- "**Q**. Would a person of ordinary skill in the art understand instant voice message in the context of the '622 patent to be any data that's -- any voice data that's communicated from one client to another client?

  MR. LOVELESS: Objection, form, scope." (*Id.* at 85:6-10.)

- **Q**. "What does 'messaging' mean here in this sentence [in the '622 patent specification]?

  MR. LOVELESS: Objection, form, scope." (*Id.* at 92:7-9.)

- "**Q**. In order for it to be an instant voice messaging system as recited in the claims of the '622 patent, must the message be received by the client's device?

  MR. LOVELESS: Objection, form, scope." (*Id.* at 96:11-15.)

These are clearly not objectionable questions.

In its motion, the only basis Uniloc asserts that the questions purportedly were "outside the scope" of Mr. Easttom's declaration is that Samsung asked hypothetical questions. (Mot. at 2-3.) Uniloc provides no authority for its assertion that hypothetical questions are prohibited in a cross examination, presumably because there is no such authority. *See United States v. Henderson*, 409 F.3d 1293, 1300 (11th Cir. 2005) (holding the "essential difference" between expert and lay opinion witnesses is the expert's ability to answer hypothetical questions); *Schering Corp. v. Roussel-UCLAF SA*, 104 F.3d 341, 346 (Fed. Cir. 1997) (considering the merits of counsel's hypothetical scenario and answer by expert).

Hypothetical questions can elicit relevant evidence regarding the expert's understanding of the scope of certain claim terms and how they apply to the prior art. Here, a majority of the hypotheticals that Uniloc complains about were

directed toward Mr. Easttom's understanding of the term "instant voice message," and therefore went directly to testing the veracity of his statement that "Griffin does not disclose instant voice messages." (Ex. 2001 at ¶ 37.) For example, during his deposition, Mr. Easttom was asked a series of questions about his understanding of what the terms "instant" and "message" mean in the context of the '622 patent (which shares a specification with the '433 patent). (*See* Ex. 1040 at 20:6-85:24.) In response to these questions, Mr. Easttom enumerated several additional criteria of instant voice messaging that are not identified in his declaration or described in the '433 patent, including time lag, the intent of the end users, and whether messages must be retrieved from a server. (*Id.* at 55:14-56:25.) Accordingly, this line of questioning directly relates to the technological basis for Mr. Easttom's conclusion that Griffin allegedly does not disclose the "instant voice messaging" claim limitation, and therefore is squarely within the scope of his direct testimony.

The remaining objected-to portions of the deposition transcripts similarly explore Mr. Easttom's opinions set forth in his declarations. Although it was Uniloc's burden to explain why each objected-to portion should be excluded, which it plainly failed to do, Samsung presents the following table that indicates why each objected-to portion is properly within the scope along with exemplary citations to relevant portions of Mr. Easttom's declarations.

Exhibit 1040	
Depo Citation	Exemplary Scope of Direct
31:25 – 32:6	
32:13 – 32:24	
33:6 – 33:12	
34:21 – 35:18	
35:20 – 36:16	
36:22 – 37:22	
38:2 – 38:17	
38:22 – 39:5	
39:19 – 39:21	
40:3 – 40:15	
41:5 – 41:12	
41:23 – 42:6	
42:15 – 42:24	
44:6 – 44:15	
45:3 – 45:7	
45:11 – 45:17	Meaning of term "instant voice message" (e.g., IPR2017-01797, Ex. 2001, ¶¶ 24-31, 36-39; IPR2017-01798, Ex. 2001, ¶¶ 24-31, 44-47; IPR2017-01799, Ex. 2001, ¶¶ 27-35, 42-49; IPR2017-01800, Ex. 2001, ¶¶ 41-49; IPR2017-01801, Ex. 2001, ¶¶ 32-40, 42-51; IPR2017-01802, Ex. 2001, ¶¶ 22-30)
47:11 – 48:4	
52:3 – 52:15	
52:22 – 53:6	
53:10 – 53:12	
53:17 – 53:23	
54:11 – 54:17	
55:9 – 55:13	
55:25 – 57:1	
57:10 – 57:17	
60:24 – 61:3	
61:17 – 61:23	
65:17 – 65:23	
66:2 – 66:9	
66:18 – 66:23	
67:8 – 67:13	
71:3 – 71:6	
83:5 – 84:5	
84:13 – 85:5	
85:10 – 85:16	
92:9 – 92:19	

93:2 – 93:7	
93:16 – 94:13	
94:24 – 95:8	
95:12 – 95:19	
95:25 – 96:3	
96:15 – 96:23	
109:11 – 109:22	
113:25 – 114:9	
115:10 – 115:15	
86:3 – 86:9	Meaning of term "attaching one or more files to the instant voice message" (e.g., IPR2017-01797, Ex. 2001, ¶¶ 50-58)
86:16 – 86:23	
87:20 – 87:22	
100:14 – 100:18	Discussion of "IVM client" in the specification of the challenged patents (e.g., IPR2017-01797, Ex. 2001, ¶¶ 22, 51)
101:6 – 101:10	
101:17 – 101:20	Meaning of term "network interface connected to a packet-switched network" (e.g., IPR2017-01797, Ex. 2001, ¶¶ 19-20, 40-49)
105:20 – 106:2	
110:21 – 111:9	Meaning of term "field" (e.g., IPR2017-01797, Ex. 2001, ¶¶ 56-57)
119:3 – 119:18	Discussion of "availabile" as described in the prior art and discussion of the displayed list of IVM recipients described in the challenged patents (e.g., IPR2017-01797, Ex. 2001, ¶¶ 27, 37, 61-63, 66)
119:23 – 120:1	
121:20 – 122:4	
126:12 –127:1	Discussion of the challenged patents (e.g., IPR2017-01797, Ex. 2001, ¶¶ 19-22) and meaning of term "generating an instant voice message" (e.g., IPR2017-01799, Ex. 2001, ¶¶ 39, 42-49, 62-67)
128:15 – 129:4	
129:8 – 130:6	
131:11 – 131:19	
132:19 – 133:12	Discussion of "IVM client" in the specification and discussion of the challenged patent (e.g., IPR2017-01797, Ex. 2001, ¶¶ 19-22, 51)
133:19 – 134:09	Discussion of "IVM client" in the specification and the term "document handler system for attaching one or more files to the instant voice message" (e.g., IPR2017-01797, Ex. 2001, ¶¶ 19-22, 50-58; IPR2017-01799, Ex. 2001, ¶¶ 42-49; IPR2017-01800, Ex. 2009, ¶¶ 67-72)
140:4 -140:15	Discussion of the challenged patents (e.g., IPR2017-01797, Ex. 2001, ¶¶ 19-22; IPR2017-01798, Ex. 2001, ¶¶ 19-22, 48-57)
141:22 – 141:22	

144:2 – 144:9	and meaning of the terms "local network" and "connected to" (e.g., IPR2017-01802, Ex. 2001, ¶¶ 18-21, 42)
148:25- 149:1	Discussion of Griffin (e.g., IPR2017-01797, Ex. 2001, ¶¶ 23-31)
149:19 – 150:2	
154:15 – 155:2	
152:25 – 153:8	
191:2 – 191:20	Discussion of Zydney (e.g., IPR2017-01797, Ex. 2001, ¶¶ 32-35, 61-63; IPR2017-01798, Ex. 2001, ¶¶ 32-35, 82; IPR2017-01801, Ex. 2001, ¶¶ 41-51, 54)
Exhibit 1041	
19:6 – 19:11	Discussion of the challenged patents and the meaning of the terms "local network" and "external network" (e.g., IPR2017-01802, Ex. 2001, ¶¶ 18-21, 42)
20:14 – 20:19	
21:6 – 21:24	
22:16 – 22:21	
22:24 – 23:21	
23:22 – 24:4	
26:5 – 26:18	
27:2 – 27:5	
28:9 – 28:15	
28:20 – 29:8	
29:12 – 29:14	
29:19 – 30:1	
30:6 – 30:20	
Exhibit 1042	
21:6 – 21:24	Discussion of Zydney and its software agent (e.g., IPR2017-01799, Ex. 2001, ¶¶ 36-40, 54-55, 65)
31:5 – 31:9	Discussion of Zydney and its intercom and pack-and-send modes of generating instant voice messages (e.g., IPR2017-01799, Ex. 2001, ¶¶ 36-40, 62-67)
59:9 – 60:3	
68:3 – 68:9	Meaning of the term "controlling a method of generating the instant voice message based upon the connectivity status of said one or more recipient" (e.g., IPR2017-01799, Ex. 2001, ¶¶ 62-67; IPR2017-01800, Ex. 2009, ¶¶ 73-78)
68:15 – 68:18	

Finally, in addition to being within the scope of Mr. Easttom's direct testimony, the fact that Mr. Easttom purportedly had not "considered" or "contemplated" the subject matter of the patents-at-issue or prior art (Mot. at 2-3, 5) is relevant to the credibility of his direct testimony, and therefore should not be excluded. *See Int'l Bus. Mach. Corp. v. Intellectual Ventures II LLC*, IPR2014-00587, Paper No. 27 at 3 (P.T.A.B. Nov. 28, 2014).

III. CONCLUSION

Uniloc's motion to exclude its own expert's testimony should be denied in its entirety. Notwithstanding that Uniloc's motion is deficient on its face, Samsung properly examined Mr. Easttom's opinions regarding his understanding of the claim terms on which he opined and the prior art that he considered in forming his opinion. At the end of the day, it appears that Uniloc does not like the answers Mr. Easttom provided during cross-examination, but that is no basis to exclude his testimony from the record.

Respectfully submitted,

Dated: October 12, 2018

By: /Naveen Modi/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Patent Owner a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Motion to Exclude Evidence by electronic means on October 12, 2018, at the following address of record:

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