

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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Comcast Cable Communications, LLC  
Petitioner

v.

Promptu Systems Corporation  
Patent Owner

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Proceeding No. IPR2018-00344  
Patent No. 7,047,196

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

## I. INTRODUCTION

Paul Cook is Patent Owner's former CEO and is also a named-inventor on the challenged '196 Patent. In this proceeding challenging the validity of the '196 Patent, Patent Owner filed a declaration by Mr. Cook in which he authenticates and sponsors documents including contracts he signed and emails he authored that Patent Owner cites as evidence of purported secondary considerations of non-obviousness. Patent Owner expressly relies on Mr. Cook's declaration to argue that these documents are admissible business records and therefore can be considered for the truth of the matter asserted in them. Paper 45 at 3-4, 6-11.

In October 2018, the parties conducted a combined deposition of Mr. Cook for the related district court litigation and several *inter partes* review proceedings including this one. The parties agreed to delineate the district court portion of the deposition in order to track compliance with deposition time limits set by the district court. There was no agreement that the initial portion of Mr. Cook's deposition would be excluded from the *inter partes* review proceedings and no agreement that Petitioner's counsel would be required to repeat questioning relevant to both the district court action and the PTAB proceedings in order to use Mr. Cook's testimony for this proceeding. Contrary to Patent Owner's position, the parties agreed that discovery in the related district court action could be used in these proceedings. Indeed, it was at Patent Owner's initial request that the parties

came to such an agreement. That was why the parties jointly sought a modified protective order in this proceeding with two levels of protection equivalent to those provided in the district court protective order. Paper 17 at 2. Nevertheless, Patent Owner now seeks to exclude Mr. Cook's testimony contradicting its secondary considerations arguments, claiming his unfavorable testimony was outside the scope of his direct testimony and is therefore hearsay. Both assertions should be rejected.

**A. Mr. Cook's Deposition Testimony Is Both Within the Scope of His Direct Testimony and Responsive to Patent Owner's Non-Obviousness Arguments in This Proceeding**

Petitioner cited deposition testimony elicited from Mr. Cook that is within the scope of direct testimony in his declaration and directly responsive to Patent Owner's non-obviousness arguments. In his declaration, which Patent Owner served and later filed in response to Petitioner's objections to Patent Owner's evidence, Mr. Cook authenticates and sponsors many of Patent Owner's exhibits filed to support the secondary considerations arguments in its Response. Ex. 2042. For instance, Mr. Cook identifies Exhibit 2023 as the Marketing Trial Agreement for Voice Activated Television Control Service between AgileTV and Comcast, which he signed on behalf of AgileTV. Ex. 2042 ¶ 17. Mr. Cook's declaration also sponsors the License and Development Agreement between AgileTV and Comcast, and he confirms that he signed that agreement as well. Ex. 2042 ¶ 16.

Patent Owner cites these agreements not merely to show that they exist, but as purported evidence of the product evaluation Comcast conducted and its intentions and motivations for doing so. Thus, by submitting the direct testimony in Mr. Cook's declaration, Patent Owner itself put at issue facts concerning the AgileTV product, the marketing trial Comcast conducted of the product, and the dealings between the parties in connection with that product evaluation.

Deposition questions eliciting facts about the product, the product trial, the loan Comcast made so that AgileTV could conduct the trial, and the repayment of that loan when Comcast ended the trial are all within the scope of Mr. Cook's direct testimony, and all respond to arguments Patent Owner makes based on the same evidence.

Mr. Cook also identifies and sponsors an AgileTV Voice Navigation presentation filed by Patent Owner as Exhibit 2003. Ex. 2042 ¶ 7. Patent Owner argues that Mr. Cook's declaration establishes this presentation as an admissible business record for purposes of this proceeding. Paper 45 at 3-4. The presentation is more than 60-pages long addressing various topics including AgileTV's business, its television and other products, its dealings with Comcast and other cable network operators, and its revenues and other financial information. Patent Owner introduced this presentation as a deposition exhibit (Exhibit 84 in the Cook deposition is a copy of the presentation attached to an email), and both sides

questioned him based on the presentation. *See, e.g.*, Ex. 1030 at 34:20-35:22, 258:22-266:4, 297:23-301:23.<sup>1</sup> That testimony, which was elicited by both sides and appears in the portion of Mr. Cook’s transcript Patent Owner seeks to exclude, was within the scope of Mr. Cook’s direct testimony because he himself introduced the presentation—and Patent Owner relies on it to argue non-obviousness—in this proceeding. For instance, the presentation includes a slide purporting to show outside investment in AgileTV. Ex. 2003 at 34. Citing this slide, Patent Owner argues that outside investment in AgileTV supports its arguments of secondary considerations. Thus, Mr. Cook’s deposition testimony that AgileTV received outside investment in order to change course and pursue an automotive product rather than the television product it demonstrated to Comcast is therefore within the scope of his direct testimony and responsive to Patent Owner’s arguments. Similarly, the presentation provides certain background information about

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<sup>1</sup> In its motion to exclude, Patent Owner complains that Petitioner’s Exhibit 1024 includes “scattered excerpts of Mr. Cook’s lengthy deposition transcript ....” Paper 40 at 1. To avoid any dispute regarding the completeness of Petitioner’s evidence, Petitioner is filing with this brief Mr. Cook’s entire deposition transcript (which was previously served on Patent Owner in response to its objections). Ex. 1030.

Mr. Cook himself. It notes that Mr. Cook was a founder of Diva Systems, and both sides questioned Mr. Cook about Diva Systems and its products during his deposition including the testimony cited by Petitioner in this proceeding. Ex. 1030 at 22:2-13, 249:6-19. This and other cross-examination regarding AgileTV, its dealings with Comcast and other cable operators, its ability to raise money, and its other product offerings are all within the scope of Mr. Cook's direct testimony and all relevant and responsive to Patent Owner's arguments about purported secondary considerations of non-obviousness.

Mr. Cook's declaration also authenticates several emails that he wrote or received as the CEO of AgileTV. Ex. 2042 ¶¶ 6, 10-15. For example, Mr. Cook's declaration sponsors Exhibit 2015, which is an email from Mr. Cook to all employees of AgileTV. In the email, Mr. Cook describes (in optimistic terms) his view of discussions with Comcast and recounts purported commitments and statements by Comcast employees. Mr. Cook also discusses the state of AgileTV's business and products, and he further discusses potential sources of investment in the company. Patent Owner relies on Mr. Cook's email as substantive evidence of the truth of the assertions he made in the email. According to Patent Owner, the email (and others like it) should be treated as Mr. Cook's testimony for purposes of this proceeding. Paper 45 at 8-9, 10. Thus, cross-examination regarding the topics addressed in the emails Patent Owner relies on are within the scope of his direct

testimony.<sup>2</sup> Yet, Patent Owner would have the Board accept Mr. Cook's emails as substantive proof of the statements therein but reject his deposition testimony given under oath regarding the very same topics. The Board should reject such an inequitable result.

**B. Mr. Cook's Deposition Testimony Is Not Hearsay**

For the reasons stated above, Mr. Cook's deposition testimony cited by Petitioner is within the scope of his direct testimony and therefore not hearsay. To the extent the Board may conclude otherwise, Mr. Cook's deposition testimony is subject to several exceptions to the hearsay rule and is therefore admissible.

Mr. Cook is Patent Owner's former CEO and continues to work with the company in exchange for monthly payments. Ex. 1030 at 163:7-18. His testimony should be treated as statements of a party opponent, which are not hearsay. FRE 801(d)(2).

Further, Mr. Cook's deposition testimony falls under the hearsay exception for former testimony. FRE 804(b)(1). His testimony was "given as a witness at ... a lawful deposition" and "is now offered against a party who had ... an opportunity and similar motive to develop it by direct, cross-, or redirect examination." *Id.*

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<sup>2</sup> If anything, Patent Owner's usage of such materials is more objectionable under the hearsay rules than Petitioner's use of Mr. Cook's testimony in response.

Indeed, Patent Owner noticed the deposition of Mr. Cook and conducted the initial examination of him. Ex. 1030 at 7, 9-167. Mr. Cook is 94 years old (Ex. 1030 at 11:24), and given his advanced age and the Board's general rule against live testimony, he should be considered an "unavailable" witness for purposes of the exception. FRE 804(a).

Mr. Cook's deposition testimony cited by Petitioner also falls within the residual exception to the hearsay rule. FRE 807. His testimony "has equivalent circumstantial guarantees of trustworthiness" because it was provided in a legally authorized deposition under oath. FRE 807(a)(1). Petitioner cites Mr. Cook's testimony in response to Patent Owner's arguments based on purported secondary considerations of non-obviousness—his testimony is therefore "offered as evidence of a material fact." FRE 807(a)(2). Patent Owner relies on Mr. Cook to authenticate and attempt to make admissible most of its evidence of secondary consideration in this proceeding. Therefore, Mr. Cook's deposition testimony undercutting many of Patent Owner's assertions is "more probative" on the points for which his testimony is offered than other evidence Petitioner could obtain



through reasonable efforts. FRE 807(a)(3).<sup>3</sup> Admitting Mr. Cook’s deposition testimony “will best serve the purposes of [the Federal Rules of Evidence] and the interests of justice.” FRE 807(a)(4). Patent Owner seeks to rely on Mr. Cook’s declaration and sponsored exhibits—including emails he authored and documents he signed—as substantive evidence supporting its secondary considerations arguments. The interests of justice and the public will be best served by admitting Mr. Cook’s deposition testimony, given under oath, addressing and contradicting Patent Owner’s arguments. Finally, Petitioner met the notice requirement of the residual exception by filing and citing the specific passages in Mr. Cook’s deposition in its Reply to Patent Owner’s Response.

Dated: January 10, 2019

Respectfully submitted,

By: /s/ James L. Day

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<sup>3</sup> Certainly, his testimony under oath is more probative than his emails in which he sometimes painted a “rosy” or “optimistic” picture for his employees in an effort to keep them motivated. Ex. 1030 at 184:2-17, 231:18-232:3.

**CERTIFICATE OF SERVICE**

I hereby certify that on January 10, 2019, the foregoing **PETITIONER'S  
OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE** was served  
by electronic mail:

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