

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

UNILOC 2017 LLC,

Plaintiff,

vs.

PAYCHEX, INC.,

Defendant.

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Civil Action No. 1:19-CV-11272-RGS

**EXPEDITED CONSIDERATION
REQUESTED PURSUANT TO
LOCAL RULE 5.1(c)**

UNILOC 2017 LLC,

Plaintiff,

vs.

ATHENAHEALTH, INC.,

Defendant.

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Civil Action No. 1:19-CV-11278-RGS

**DEFENDANTS' EMERGENCY MOTION
TO STRIKE IMPROPER REBUTTAL EXPERT DECLARATION AND
TESTIMONY OF PLAINTIFF'S CLAIM CONSTRUCTION EXPERT**

I. INTRODUCTION

Plaintiff has attempted an end-run around L.R. 16.6(e)(3), which prohibits rebuttal expert testimony without good cause. The improper expert testimony should be struck. Because the parties' responsive claim construction briefs are due on February 20, Defendants request expedited briefing.¹

On February 10, 2020, after the Defendants concluded their cross examination of Plaintiff's claim construction expert, whose declaration was submitted with Plaintiff's opening claim construction brief on January 23, 2020, Plaintiff improperly: 1) introduced over 11 pages of single-spaced rebuttal opinions as "evidence"; and 2) conducted a direct examination concerning those previously-undisclosed rebuttal opinions formed after Defendants served their opening claim construction brief (and that naturally went beyond the scope of cross-examination, given Defendants had no notice of these opinions). The newly disclosed opinions accounted for 22 pages of the deposition transcript (out of a total of approximately 120 pages).

The testimony concerning the newly disclosed rebuttal opinions was guided by 11 pages of a typed witness statement—a witness statement that was not disclosed until Plaintiff began its redirect.

¹ Pursuant to Local Rule 5.1(c), Defendants respectfully request that this motion be given emergency consideration. The February 20, 2020 deadline for responsive claim construction briefs is quickly approaching, and Defendants requests final resolution of this issue. The Defendants only learned of Plaintiff's improper intended rebuttal testimony on February 10, 2020, while Plaintiff has had Defendants' claim construction brief since January 23, 2020, and more than enough opportunity to move for leave to submit the rebuttal opinions. Accordingly, Defendants request that, if Plaintiff intends to submit an opposition, the time period for that submission be limited to three calendar days, to February 17, 2020.

Plaintiff's actions were in direct violation of the local rules for patent cases. Plaintiff provided no advance notice to Defendants of the new rebuttal opinions. If Plaintiff sought to introduce a rebuttal declaration and testimony, then it needed to move for leave and establish good cause. Plaintiff did not, and cannot, do so. The local rules provide for the orderly presentation of claim construction arguments. If the rebuttal opinions are not stricken, Defendants will be prejudiced by not having received fair notice of the alleged "evidence" supporting Plaintiff's positions.

Defendants request expedited consideration because the parties' rebuttal claim construction briefs are due on February 20, 2020, and Defendants are seeking relief that will impact that briefing.

II. RELIEF REQUESTED

Defendants move the Court to strike: 1) the direct examination by Plaintiff's counsel, Mr. Foster, beginning on page 99 of the rough transcript (the final is not ready at the time of the filing of this motion) and continuing to the end of the transcript; and 2) exhibits 11 through 16 introduced by Mr. Foster, which amount to an improper expert witness statement disclosed out of time

Defendants further request that the Court instruct Plaintiff to refrain from filing the stricken testimony and exhibits with the Court or relying upon them in any way in support of claim construction.

III. ARGUMENT

A. Plaintiff Violated the Local Rules

Local Rule 16.6(e)(3) provides:

Expert Testimony. Any party seeking to rely on expert testimony to support claim construction must include with its opening brief an expert declaration. The offering party must make the expert available for

deposition not later than 21 days before the responsive due date. Either party may cite to the expert deposition testimony in its responsive brief. ***Other than the initial declaration and deposition testimony, no further expert testimony shall be permitted unless the court requests further testimony or for good cause shown.***

L.R. 16.6(e)(3) (emphasis added).

Plaintiff submitted a declaration of its expert, Dr. Shamos, with its opening claim construction brief on January 23, 2020, and Defendants deposed Dr. Shamos on February 10, 2020.

Plaintiff never sought leave of Court to submit additional expert opinions, and at no time before the deposition did Plaintiff inform Defendants of its intent to introduce additional expert opinions. Instead, Plaintiff prepared a series of exhibits constituting a rebuttal expert witness statement and then attempted to sneak them in as “deposition testimony” in an attempted end-run around the local rules. Without advance notice, Plaintiff chose to spring the improper opinions in redirect during the deposition.

More specifically, after the conclusion of Defendants’ cross-examination, Plaintiff introduced six exhibits of written expert testimony, created by Dr. Shamos in rebuttal to Defendants’ claim construction briefing:

[For Plaintiff] BY MR. FOSTER:

Q. Dr. Shamos, you understand you’re still under oath?

A. Yes, I do.

Q. All right. You have in front of you your computer with a number of documents that have been filed in court; is that right?

A. Yes.

Q. Would you open up on the computer the document entitled defendant’s joint opening brief on claim construction and indefiniteness.

A. Yes, I have that. I have a flash drive, if you want to look at these documents.

BY MR. FOSTER:

Q. Have you read that document?

A. Yes.

Q. Have you formed any opinions on statements that are contained in that document?

A. ***I have rebuttal argument to some of the points made in the brief.***

MR. FOSTER: Ask the reporter to mark as Exhibit 11 this document.

A. I'm ready.

BY MR FOSTER:

Q. Okay. Who prepared this document?

A. I did.

Q. And what was the purpose of your preparing it?

A. ***I was asked to look at defendant's Markman brief and see if I disagreed with anything in there.***

Ex. 1, Shamos Dep. (Rough) at 99:19-101:12 (attorney colloquy and objections omitted; emphasis added).

Plaintiff has no valid excuse for not including the entirety of Dr. Shamos' opinions with Plaintiff's opening claim construction brief. Under the claim construction procedures dictated by the local rules, Defendants disclosed their claim construction positions well before the parties filed their opening claim construction briefs. Thus, there were no surprises in Defendants' opening claim construction brief—Plaintiff already knew what Defendants' positions were.

Moreover, Plaintiff has no excuse for waiting until after the cross examination of its expert at deposition to disclose these newly minted opinions. Given Plaintiff's conduct, Plaintiff cannot establish good cause. *See Gouin v. Nolan Assocs., LLC*, 325 F.R.D. 521, 523 (D. Mass. 2017) (In FRCP 16 context, "In evaluating whether a party has shown good cause, courts consider 1) 'the diligence of the party seeking the amendment' and 2) whether

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