

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

UNILOC 2017 LLC,

Plaintiff,

v.

PAYCHEX, INC.,

Defendant.

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

UNILOC 2017 LLC,

Plaintiff,

v.

ATHENAHEALTH, INC.,

Defendant.

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

**OPPOSITION OF UNILOC TO MOTION TO STRIKE REBUTTAL EXPERT  
DECLARATION AND TESTIMONY**

**1. There is no rebuttal expert declaration.**

The motion is somewhat misnamed, as there is no “rebuttal expert declaration.” Uniloc followed Local Rule 16.6(e)(3) to the letter by including with its Opening Brief, Dkt. No. 26<sup>1</sup>, an expert declaration of Dr. Michael Shamos, Dkt. No. 26-1, and then making Dr. Shamos available for deposition. (“The offering party must make the expert available for deposition.”) Defendants then opted to take his deposition. At the deposition, Defendants examined Dr. Shamos for three hours on the myriad technical issues the patents in this case present. Uniloc then cross-examined

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<sup>1</sup> Docket numbers are to the filings in 1:19-CV-11272-RGS

the witness for approximately one half hour. There was, and there is, no rebuttal expert declaration.

As there was no rebuttal expert declaration, the Motion is simply one to strike (*i.e.*, not allow citation to) Dr. Shamos's **deposition** testimony. The Local Rules, however, do not require a showing of good cause for either party to cite deposition testimony in a responsive brief, nor is there any reason why they should.

**a. Local Rule 16.6(e)(3) does not require a showing of good cause for either party to cite expert deposition testimony in a responsive brief.**

Local Rule 16.6(e)(3) does not impose a good cause requirement for either party to cite expert deposition testimony in a responsive brief:

The offering party must make the expert available for deposition .... **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 ... for good cause shown.

(Emphasis added). Defendants fail to discuss the portion of the rule emphasized above.

Defendants rely upon a portion of the above sentence in Local Rule 16.6(e)(3) that states "no further expert testimony shall be permitted unless ... for good cause shown." But the complete sentence, which begins with the phrase "[o]ther than ... deposition testimony," explicitly carves out deposition testimony from the good cause requirement.

An adverse party is not obligated to take an expert deposition. An adverse party that wants to limit the record can do so by forgoing taking the expert deposition. By contrast, opting to take the expert deposition creates the risk the expert, at his deposition, may give testimony unfavorable to the adverse party. Local Rule 16.6(e)(3) clearly warns of this risk by pointing out: "**Either party may cite to the expert deposition testimony in its responsive brief.**" (Emphasis

added). Here, Defendants would have known of this risk, and nevertheless opted to depose the witness. Their motion asks the Court to allow only one party to cite to the expert deposition testimony, which would ignore this provision of Local Rule 16.6(e)(3).

Where the adverse party opts to take the expert's deposition, Local Rule 16.6(e)(3) thus specifically allows either party to cite the deposition testimony of an expert in its responsive brief, without requiring a showing of good cause. Nor does the rule make a distinction based on which party elicits the cited testimony.

Defendants appear to have overlooked this foundational issue, as their entire Motion consists of argument that Uniloc has not shown good cause. It seems Defendants did not realize the Rule limits the requirement to show good cause to only expert declarations. The Rule excepts expert deposition testimony from that requirement.

**b. Local Rule 16.6(e)(3)'s allowing either party to cite deposition testimony in a responsive brief without a showing of good cause rests on sound policy.**

There is a reason why the rule allows either party to cite *deposition* testimony, while otherwise barring "further expert testimony," *i.e.*, declarations. Because a declaration cannot itself be cross-examined, allowing a declaration into evidence must allow for the witness to then be deposed. And both parties were represented at the deposition, free to ask whatever questions they wished. Rule 16.6(e)(3) thus requires all expert declarations to be served with the opening briefs so each party can decide at that point whether to take the adverse expert's deposition, in order to use that deposition to develop factual support for its own rebuttal arguments.

Rule 16.6(e)(3) thus provisionally bars "further [non-deposition] expert testimony" because allowing rebuttal declarations would frustrate that design. Thus, Rule 16.6(e)(3) expressly imposes a showing of good cause for rebuttal declarations.

But that reasoning does not apply to deposition testimony taken under this rule. Because the deposition has already been taken, allowing citation to the testimony will not lead to further depositions. Rule 16.6(e)(3) thus expressly allows citation to deposition testimony without showing good cause, because there would seem to be no reason to exclude it.

And there is much to be said for allowing citation to deposition testimony, without showing good cause. Depositions taken under Rule 16.6(e)(3) provide additional evidence for the Court and elucidate the parties' arguments. And, unlike a declaration, at a deposition the witness' testimony can be tested by vigorous cross-examination.

**2. Adding to the Local Rule a requirement that good cause be shown for citation of deposition testimony by either party in a responsive brief will accomplish nothing, and lead to less informed judicial decisions.**

As discussed above, in their Motion, Defendants did not discuss whether Local Rule 16.6(e)(3) actually required a showing of good faith for citation of expert deposition testimony by either party in a responsive brief. They simply assumed that was the case, even though it was not. If they were to now submit a reply brief, they would presumably urge the Court to read into Local Rule 16.6(e)(3) a requirement on the retaining party to show good cause to cite expert deposition testimony in a responsive brief. But upon close examination, that argument would make no sense.

As a general rule, courts will always allow the introduction of potentially helpful evidence, in the absence of some reason to exclude it. If citation to deposition testimony helps a court to make a more informed decision, citation should be allowed. As explained above, there is a reason for requiring a showing of good cause for citation to rebuttal *declarations*, namely, to enable early identification of the need for depositions. But where an adverse party makes a strategic decision to take an expert's deposition, allowing citation to his testimony by only one

party would only serve to arbitrarily deprive the court of useful information, without any corresponding benefit that would justify exclusion.

Further, at a deposition, an expert is commonly asked questions not only about his declaration, but also about any aspects of the technology of interest to the questioner. The attorney for the adverse party is not confined to asking questions about the expert's declaration. Rather, the attorney frequently will ask questions to elicit testimony to support its own position and arguments. And whatever the question, an expert may give an expansive answer that not only explicates portions of his declaration, but adds new facts, theories, observations, etc. And those questions could come from counsel for either party. It would be unfair to allow only one party to a deposition to cite the testimony of the expert, which may be why **Rule 16.6(e)(3) explicitly allows either party to cite the testimony.**

But the most powerful reason for not reading in such a requirement is that it accomplishes nothing. It would seem a court could only benefit by having this deposition testimony cited to it, particularly as both parties were able to question the witness. Nowhere in their Motion do Defendants identify any harm that would result from this Court's receiving the witness's deposition testimony. They thus they make no effort to justify extending to deposition testimony a requirement to show good cause.

**3. If required, good cause can be shown here.**

As discussed above, Defendants apparently did not realize Local Rule 16.6(e)(3) does not require good cause be shown for either party to cite to expert deposition testimony in a responsive brief. So they spent their entire Motion arguing Uniloc has not shown good cause,

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