

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN EXPRESS COMPANY, AMERICAN EXPRESS TRAVEL
RELATED SERVICES COMPANY, INC., EXPEDIA, INC., HOTELS.COM LP,
HOTELS.COM GP, LLC, HOTWIRE, INC., ORBITZ WORLDWIDE, INC.,
PRICELINE.COM, INC., TRAVELOCITY.COM LP, and YAHOO! INC.

Petitioner

v.

METASEARCH SYSTEMS, LLC

Patent Owner

Case CBM2014-00001
Patent 8,326,924 B1

**PETITIONER'S RESPONSE TO PATENT OWNER'S
MOTION FOR OBSERVATIONS ON CROSS-EXAMINATION**

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IPR2013-00322, Paper 26 (PTAB May 7, 2014) 1, 2, 3

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Official Trial Practice Guide,
77 Fed. Reg. 48756 (Aug. 14, 2012) 1, 2, 4

Petitioner hereby responds to Patent Owner's ("Metasearch's") Motion for Observations on Cross-Examination of Petitioners' Reply Witness Mr. Gary Liao. (Paper 60.) Mr. Liao submitted in this proceeding a first declaration, Exhibit 1009, in support of the Petition and a supplemental declaration, Exhibit 1042, in support of Petitioner's Reply to Patent Owner's Response to the Petition ("Petitioner's Reply") (Paper 52) and Petitioner's Opposition to Patent Owner's Motion to Amend (Paper 51). Mr. Liao was deposed on September 26, 2014. The transcript of this deposition was filed as Exhibit 2043, and an errata sheet of the transcript is filed herewith as Exhibit 1050.

I. METASEARCH'S OBSERVATIONS ARE IMPROPER

A. Metasearch Delayed Deposing Mr. Liao

Motions for observations are intended to address cross-examination that must occur after the filing of a party's final substantive paper on an issue. Official Trial Practice Guide, 77 Fed. Reg. 48756, 48767-8 (Aug. 14, 2012) (Motions for observations are appropriate "[i]n the event that cross-examination occurs after a party has filed its last substantive paper on an issue." (emphasis added)).

Metasearch's motion is therefore properly limited to cross-examination testimony directed to issues raised first in Petitioner's Reply. See *Respironics, Inc. v. ZOLL Medical Corporation*, IPR2013-00322, Paper 26, 2-4 (PTAB May 7, 2014).

Although Mr. Liao's first declaration filed in this proceeding included

statements detailing Mr. Liao’s technical experience (Ex. 1009 ¶¶ 1-3), mapping the Knowledge Broker and Mamma.com references to claim 1 (id. at 14-17), and applying his understanding of the level of skill in the art to exhibits in the record (id. ¶¶ 4, 6 & 20), Metasearch chose not to depose Mr. Liao on this testimony during the appropriate discovery period. See Respironics, Inc., IPR2013-00322 at 2-3 (describing “two discovery periods for a patent owner” and not authorizing cross-examination of expert during second discovery period on declaration submitted with the Petition). Instead, Metasearch delayed deposing Mr. Liao until after Petitioner had filed its last substantive paper—Petitioner’s Reply—which is an improper use of a motion for observations. See id. at 4 (recognizing Patent Owner may have chosen to delay deposing expert and requiring observations be limited to testimony concerning Petitioner’s Reply). Metasearch’s Observations consequently raise new issues and are argumentative, which is also improper. Official Trial Practice Guide, 77 Fed. Reg. at 48768.

In particular, Observations # 1, 2, 3, 5, and 6 relate to issues first presented by Mr. Liao in his declaration submitted with the Petition (Ex. 1009). These Observations make new arguments not already in the record and are not limited to new material presented in Petitioner’s Reply. These Observations are therefore beyond the proper scope of a motion for observations. For at least these reasons, the Board should disregard these Observations.

PETITIONER’S RESPONSE TO PATENT OWNER’S

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