Filed on behalf of Proxyconn, Inc.
By: Matthew L. Cutler (mcutler@hdp.com)
Bryan K. Wheelock (bwheelock@hdp.com)
Douglas A. Robinson (drobinson@hdp.com)
Harness, Dickey & Pierce, PLC
7700 Bonhomme Ave., Suite 400
St. Louis, MO 63105
Tel: (314) 726-7500
Fax: (314) 726-7501

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

PROXYCONN, INC.
Patent Owner

Case IPR2012-00026, IPR2013-00109
Patent 6,757,717 B1

PATENT OWNER'S MOTION TO EXCLUDE DEPOSITION TESTIMONY

Petitioner Microsoft Corp. ("Microsoft") has relied upon deposition testimony from Dr. Alon Konchitsky, an expert witness retained by Patent Owner Proxyconn, Inc. ("Proxyconn"). Proxyconn now moves to exclude certain portions of that testimony because it was elicited during improper cross-examination. *See* 37 C.F.R. § 42.64(c).

Specifically, Dr. Konchitsky submitted direct testimony in the form of a declaration (Ex. 2002). His direct testimony was directed to the issue of differences between the Original Claims and the prior art relied on in the Grounds for rejection. *See*, *e.g.*, Ex. 2002 at ¶¶ 16, 20, 23 (regarding the Perlman reference), 29, 30, 37 (Yohe), 46 (Perlman and Yohe), 47, 50 (Santos), 53, 56, 58 60 (DRP), and 67–68 (Mattis).

At his deposition, though, Microsoft repeatedly questioned Dr. Konchitsky about claim construction issues that are unrelated to his declaration opinions, and thus outside the scope of direct testimony. That questioning thus violated 37 C.F.R. § 42.53(d)(5)(ii) ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony"). Proxyconn timely objected to each improper question during the deposition in accordance with § 41.155(a), and now moves to exclude the inadmissible testimony upon which Petitioner Microsoft relies.

Patent Owner now moves to exclude the following portions of Exhibit 1024 that reflect testimony outside the scope of Dr. Konchitsky's direct testimony (citing to page and line numbers of the deposition transcript).

Ex. 1024, Transcript ("Tr.") at 36:11–16, 41:23–43:2, 43:14–44:17, 47:25–49:7, 54:4–12, and 67:7–12

As shown below, each of these passages of Microsoft's Exhibit 1024 reflects testimony on issues not addressed in Dr. Konchitsky's declaration, and thus, outside the scope of his direct testimony

1. Ex. 1024, Tr. at 36:11–16

So if you just read the sentence, lines 65 and 66 and 67, "This transaction begins with a receiver/computer sending a request to sender/computer," that means at the time the transaction just begins, that would send this particular request. Later, it could just check for digest in cache, and then there will be pulled out in a pulling mechanism.
BY MR. VANDENBERG:
Q. And is this request to the sender from the receiver/computer, does that -- is that necessarily a request for particular data?
MR. WHEELOCK: Objection. Scope.
THE WITNESS: No, it's not a request for particular data.

For context, the reference to "lines 65 and 66 and 67" in the preceding passage refers to column 7 of the '717 patent (Ex. 1002) that is subject to this proceeding.

Nowhere in Dr. Konchitsky's declaration does he address the issue of whether the '717 patent's claims require a request for "particular" data. Rather, this issue of claim construction and specification support is outside the scope of his direct testimony, and Microsoft's deposition questioning on this topic should be excluded pursuant to 37 C.F.R. § 42.53(d)(5)(ii).

2. Ex. 1024, Tr. at 41:23–43:2

Q. Does the '717 patent, not just the claims, but the entire patent, does it describe any data structure for storing data in memory?

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(continued on next page)

MR. WHEELOCK: Objection. Form and scope.
THE WITNESS: I don't think so.
BY MR. VANDENBERG:
Q. Does the '717 patent describe any scheme for storing data without duplication?
A. Um --
MR. WHEELOCK: Objection. Form and scope.
THE WITNESS: Again, could you be more specific because, again, you took a general data structure, like linked list or binary tree, that to my best education, experience, actual implementations I've done in the past, that's not relevant to the system, to the mechanism, to the technique that is described here in '717.
I don't see how they are even related because here, it describes a way to go from transferring information from one place to another, based on particular procedure of calculating digital digest or -- or calculating some information on the data, based on particular or maybe method or state machine.
And the way that the data is organized or the way that the data -- that the machine or that the equipment is accessing the memory, that's -- that's very -- that is an element, that like saying if the car is driving, so it goes from one place to another, and

that's what it is. So I do not recall a particular technique to access this data in memory.

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