

Filed on behalf of Microsoft Corporation

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

PROXYCONN, INC.
Patent Owner

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

**MICROSOFT CORPORATION'S OPPOSITION TO PATENT
OWNER'S MOTION TO EXCLUDE DEPOSITION TESTIMONY**

Petitioner opposes Patent Owner's motion to exclude six excerpts of Dr. Konchitsky's cross-examination testimony "about claim construction issues" (Dkt. No. 59, p. 2), and requests that the Board deny the motion in its entirety.

When a witness testifies on direct that a prior art reference lacks a certain element of a patent claim, and bases that testimony on an incorrect construction of the claim language, that opens the door to cross examination on the correct construction of that claim language. That indisputable proposition defeats Patent Owner's motion to exclude.

"Search"

Original claim 22 recites "searching for data with the same digital digest in said network cache memory." Five of the six cross-examination excerpts Patent Owner moves to exclude concern the meaning of "search" in this patent. (Ex. 1024, 41:23–43:2, 43:14–44:17, 47:25–49:7, 54:4–12, 67:7–12.)

On direct, Dr. Konchitsky repeatedly testified that certain prior art did not disclose this "search" step. (Ex. 2002, ¶¶ 23, 37, 38, 39, 43, 45, 50 and 51.) In this testimony, he presumed and implied a narrow meaning of "search" in this patent. For example, he testified that "Perlman does not disclose the step of searching for data with the same digital digest in the network cache memory as required by Original Claims 22-24. In Perlman the receiving routers receive an identifier and each simply compares the received identifier with its existing identifier. The

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receiving routers are not searching for data files using the identifier as the key, or among multiple identifiers.” (Ex. 2002, ¶ 23.) This construes “search” in this patent as excluding looking for a desired item by comparing its unique identifier with the unique identifier of an already possessed item. Dr. Konchitsky rendered similar opinions about this “search” step, and prior art supposedly lacking this “search” step, in paragraphs 37, 38, 39, 43, 45, 50 and 51 of his direct testimony, as well. (Ex. 2002.) Each presumed a narrow construction of “search.”

Dr. Konchitsky also implied that his presumed constructions of claim scope, which he necessarily used to compare the claims to the prior art, were based on his understanding of the patent’s disclosure: “I have read U.S. Patent No. 6,757,717 (the “717 Patent”). . . . I have considered the patent's disclosures from the perspective of a person of ordinary skill in the art in 1998.” (Ex. 2002, ¶ 12.)

As noted, five of the six challenged cross-examination excerpts address this exact same issue, namely, the meaning of “search” in this patent. (Ex. 1024, 41:23–43:2, 43:14–44:17, 47:25–49:7, 54:4–12, 67:7–12.) More specifically, Petitioner obtained and cited that cross-examination testimony to undermine Dr. Konchitsky’s above-identified direct-examination testimony, by showing that “search” in this patent does not have the narrow meaning he presumed on direct. For example, Petitioner’s Reply cites two of the challenged excerpts from Dr. Konchitsky’s cross examination in support of this point: “Patent Owner implies

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that ‘search’ requires more than one digest-to-digest comparison operation (POR, pp. 20, 27)—but nothing in the patent so defines ‘search.’ (See Konchitsky TR 54:4-12 (’717 patent does not require as part of the search looking at multiple digest values stored at receiver), 67:7-12).” (Dkt. No. 46, p. 4.)

In part, Petitioner established through this cross examination that the intrinsic evidence of the patent’s disclosure does not support the narrow construction of “search” that Dr. Konchitsky had presumed on direct: “Not only does the ’717 patent not require the specific type of search Patent Owner assumes, it does not even describe such a search. The patent discloses no particular search algorithm or mechanism at all—beyond comparing two digest values for a match. (Cf. Konchitsky TR 41:23-43:7).” (Dkt. No. 46, p. 4.) As noted, Dr. Konchitsky purported to base his opinions on his understanding of the patent’s disclosure (Ex. 2002, ¶ 12), opening up the door to cross examination on that understanding.

After explaining the correct construction of “search,” and how Dr. Konchitsky’s cross examination supports that correct construction, Petitioner then explained how the prior art references disclosed the “search” step as that term is properly construed. For example, “Patent Owner’s first attempted distinction (POR, p. 19) rests on its incorrect construction of ‘data access,’ and its second alleged distinction (id., p. 20) rests, in part, on its incorrect construction of ‘search.’” (Dkt. No. 46, p. 10.) Similarly, “Patent Owner’s attempted distinction

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over Yohe rests entirely on its incorrect construction of search.’ (POR, pp. 27, 32).” (Dkt. No. 46, p. 11.)

In sum, the challenged cross-examination testimony about “search” directly refuted Dr. Konchitsky’s direct-examination testimony about “search” and therefore fell squarely within the scope of direct.

“Data Access”

The sixth challenged cross-examination excerpt (Ex. 1024, 36:11-16) concerns the meaning of “data access” in the claims. This testimony is admissible for the same reasons stated above for the “search” related testimony.

“Data access” appears in several challenged claims. For example, claim 11 recites “A method performed by a sender/computer in a packet-switched network for increasing data access,” On direct, Dr. Konchitsky testified that certain prior art failed to disclose this “data access” element, based on his presumed, narrow construction of the term. (Ex. 2002, ¶¶ 13, 15, 16, 19, 40.) For example, he testified: “In my opinion Perlman solves a different problem than the system of ’717 Patent claims 1 and 3 or the method of claims 22-24, because Perlman involves database synchronization by keeping all computers up to date. Where the ’717 Patent provides a data access response to request-for-information at a receiver-computer.” (Ex. 2002, ¶ 16.) Elsewhere, he seems to construe the claims as requiring a “specific request,” and distinguishes prior art on this basis. (Ex. MICROSOFT’S OPPOSITION TO PROXYCONN’S

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