

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION  
Petitioner

v.

PROXYCONN, INC.  
Patent Owner

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

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Before SALLY C. MEDLEY, THOMAS L. GIANNETTI, and MITCHELL G.  
WEATHERLY, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER  
Decision on Motion to Exclude  
*37 C.F.R. § 42.64*

Patent Owner, Proxyconn, Inc., moves to exclude certain cross-examination testimony of its technical expert, Dr. Alon Konchitsky. Paper 59 (“Motion”). Petitioner, Microsoft Corporation, opposes the motion. Paper 60 (“Opposition”). For the following reasons, Patent Owner’s motion is denied.

#### DISCUSSION

Patent Owner alleges that the testimony it seeks to exclude was elicited during “improper cross-examination.” Motion 2. Petitioner contends that in cross-examining Dr. Konchitsky, Patent Owner’s counsel exceeded the scope of direct examination by questioning the expert witness about claim construction opinions “unrelated” to the opinions expressed in his declaration (Ex. 2002). *Id.* Patent Owner points to six instances of such testimony. *Id.* at 3-10.

Petitioner responds that Patent Owner opened the door to such cross-examination by eliciting testimony from Dr. Konchitsky on claim scope and claim construction. Opposition 1. In particular, Petitioner contends that in distinguishing challenged claims of the ’717 patent<sup>1</sup> from certain prior art, Dr. Konchitsky took positions on the meaning of certain terms in the claims that opened him to cross-examination on those matters. Petitioner points to the terms “search” (identified with five of the deposition excerpts Petitioner seeks to exclude), and “data access” (identified with the sixth excerpt). *Id.* at 1, 4.

We agree with Petitioner that Dr. Konchitsky’s testimony should not be excluded. We have reviewed the excerpts and conclude that they are related sufficiently to the subject matter of Dr. Konchitsky’s direct testimony, concerning the relation of the ’717 patent claims to the prior art, to make them fair game for cross-examination. Dr. Konchitsky’s testimony that certain prior art does not

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<sup>1</sup> U.S. Patent 6,757,717.

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

disclose certain steps such as “search,” opened him to cross-examination on the meaning he attaches to those terms.

Patent Owner, in reply, asserts that because Dr. Konchitsky’s direct testimony “did not address claim construction,” the motion should be granted. Paper 64 (“Reply”). We disagree with this characterization of the direct testimony. Dr. Konchitsky necessarily construed the claims in opining on whether certain claim elements are disclosed in the prior art. Petitioner was entitled to explore those opinions fully on cross-examination, including questioning the expert on the constructions he applied. Patent Owner, likewise, had the opportunity to conduct further examination as necessary on redirect.

Patent Owner’s reliance (Reply 2-3) on a *Mobile Hi-Tech Wheels v. CIA Wheel Group*, 514 F.Supp.2d 1172 (C.D. Cal. 2007), is misplaced. The issue before the district court there was not the proper scope of cross-examination. The case concludes, instead, that the jury was not confused by the testimony of a witness (the plaintiff’s vice president, Mr. Pruden) concerning the development of the patented design. *Id.* at 1192. The court concluded that the witness’ description of the design did not constitute a “claim construction.” *Id.* at 1193. It is not clear from the decision whether Mr. Pruden was testifying as an expert. In any event, the testimony quoted in the decision is not comparable to the expert opinions provided by Dr. Konchitsky on direct. Further, the decision says nothing about limiting the scope of Mr. Pruden’s cross-examination.

In summary, the fact that Dr. Konchitsky did not expressly render claim construction opinions on direct does not preclude cross-examination on that topic, given the nature of the opinions that he expressed on direct.

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

In view of the foregoing, it is hereby

ORDERED that Patent Owner's Motion to Exclude Deposition Testimony

(Paper 59) is denied.

For Patent Owner

Matthew L. Cutler  
Harness, Dickey & Pierce, PLC  
mcutler@hdp.com

Bryan K. Wheelock  
Harness, Dickey & Pierce, PLC  
bwheelock@hdp.com

Douglas A. Robinson  
Harness, Dickey & Pierce, PLC  
drobinson@hdp.com

For Petitioner

John D. Vandenberg  
Klarquist Sparkman LLP  
john.vandenberg@klarquist.com

Stephen J. Joncus  
Klarquist Sparkman LLP  
stephen.joncus@klarquist.com