Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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XILINX, INC.
Petitioner

v.

INTELLECTUAL VENTURES I LLC
Patent Owner

_____

Case IPR2013-00112
Patent 5,779,334

_____

PATENT OWNER INTELLECTUAL VENTURES' REPLY IN SUPPORT OF MOTION TO EXCLUDE TESTIMONY OF A. BRUCE BUCKMAN, Ph.D.

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Cases

I. INTRODUCTION

The Board has yet to issue detailed guidelines regarding the application of Rule 702 and *Daubert*/*Kumho Tire* to expert testimony in IPR proceedings. Such guidelines are important because, taking this case as an example, it is unfair for IPR trials to be instituted and prosecuted against patent owners based on the opinions of petitioner's expert, which the expert later recants repeatedly, and without any explanation of the ***factual*** or ***scientific*** basis for the change in his opinions. (*See*, *e.g.*, Paper 14 at 21-22 (Board relied on Buckman opinion that Lee 19 is video controller in instituting trial); Ex. 2010 at 38:8-14 (Buckman admission that Lee 19 is not video controller).) In such an extreme—and extremely unusual—case, the most appropriate remedy is exclusion.

II. DR. BUCKMAN'S OPINIONS SHOULD BE EXCLUDED.

A. Dr. Buckman Is Not Qualified To Offer Expert Testimony.

Xilinx does not dispute that the '334 patent relates to ***video projection systems***, or that Dr. Buckman has never built, taught, or written about ***video projection systems***. (*See* Paper 42 at 3.) Instead, Xilinx argues that Dr. Buckman's experience with optics qualifies him as an expert because the '334 patent uses "standard optical components." (Paper 44 at 3.) But this is unavailing because "[g]eneral experience in a related field may not suffice when experience and skill in specific product design are necessary to resolve patent issues."

Extreme Networks, Inc. v. Enterasys Networks, Inc., 395 F. App'x 709, 715 (Fed. Cir. 2010) (non-precedential).

In *Flex-Rest, LLC v. SteelCase, Inc.*, 455 F.3d 1351 (Fed. Cir. 2006), the Federal Circuit upheld the trial court's exclusion of an expert regarding the design of keyboard support systems, rejecting plaintiff's argument that "the invention applies ergonomic principles to keyboard design, and that [its expert] is qualified in the ergonomics field." *Id*. at 1356, 1360-61. As in *Flex-Rest*, *id*. at 1360, the Board should reject Xilinx's assertion that, because Dr. Buckman "is qualified in the [optics] field," he also is qualified to testify about video projection systems.

Xilinx argues that, in *Shreve v. Sears Roebuck & Co*., 166 F. Supp. 2d 378, 393 (D. Md. 2001), "the proposed expert in snowthrower safety had never actually designed outdoor equipment[,]" including snowthrowers. (Paper 44 at 6.) But, like the expert excluded in *Shreve*, Dr. Buckman has never constructed a video projection system and has "no particular expertise concerning" such systems. *Shreve*, 166 F. Supp. 2d at 394.

Finally, Xilinx's case authority is inapposite. In *McCullock v. H.B. Fuller Co*., 61 F.3d 1038 (2d Cir. 1995), the expert was qualified to testify because he was a board-certified specialist treating ear, nose and ***throat*** conditions, and the subject of his testimony related to plaintiff's ***throat*** injury. *Id*. at 1043. Likewise, in *Effingo*, a witness who taught "product design classes," had "taken several

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