

Filed on Behalf of MPHJ TECHNOLOGY INVESTMENTS, INC
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RICOH AMERICAS CORPORATION AND XEROX CORPORATION,

Petitioners

V.

MPHJ TECHNOLOGY INVESTMENTS, LLC,

Patent Owner

Case IPR2013-00302

Patent 7,986,426

MPHJ'S MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. § 42.64(c)

I. INTRODUCTION

MPHJ Technology Investments, LLC (“MPHJ”) files this motion pursuant to 37 C.F.R. § 42.64(c) as authorized by the Scheduling Order (Paper 9). MPHJ moves to exclude portions of the deposition testimony of Dr. Roger Douglas Melen (Ex. 2003) offered in response to leading question posed by Petitioners’ counsel during his redirect examination. MPHJ also requests that the Patent Trial and Appeal Board (“Board”) prevent Petitioner from relying on such testimony in support of its Petition for *Inter Partes* Review of claims 1-11 of U.S. Patent No. 7,986,426 (“the ’426 patent”).

After Dr. Melen made several statements during his cross examination that undermined the positions taken in his declaration, Petitioners’ counsel attempted to rehabilitate Dr. Melen’s cross examination testimony by posing at least forty leading questions on redirect examination. Petitioners’ counsel’s objectionable questioning style improperly suggested to Dr. Melen how he should reply to counsel’s questions, which is exactly why leading questions are generally impermissible when questioning “friendly” witnesses and why the Court should therefore exclude such tainted testimony.

For these reasons, and for those discussed herein, MPHJ respectfully requests that the Board grant its Motion to Exclude Evidence under 37 C.F.R. § 42.64(c).

II. FACTUAL BACKGROUND

Petitioner retained Dr. Roger Douglas Melen, Ph.D., as an expert witness “to consider how a person having ordinary skill in the art (“PHOSITA”) would have understood the claims subject to *inter partes* review in light of the disclosure of the ’426 patent [as well as] . . . how a PHOSITA would have understood the XNS, GIS 150, and, Salgado references.” (Ex. 1008 at ¶ 8.) Dr. Melen was also asked “to consider whether a PHOSITA would have understood” these references to anticipate claims 1-11 of the ’426 patent. (*Id.*) Dr. Melen’s opinions were offered in his Declaration which was submitted by Petitioner as Ex. 1008.

MPHJ deposed Dr. Melen on February 5, 2014. (MPHJ 2003 at 1.) During cross examination, counsel for MPHJ asked Dr. Melen a series of questions concerning, among other things, claim 6 of the ’426 patent. (*Id.* at 69:20-171:9.) Specifically, counsel for MPHJ asked Dr. Melen to explain precisely which features, if any, of the XNS reference described each element of claim 6 of the ’426 patent:

Q. And what -- what in the XNS manual was the most convincing description you could find of one server module that had all four of those, as you described it, basic algorithms [of claim 6]?

DR. VARUGHESE: Objection to the form of the question.

BY MR. HILL:

Q. You can answer if you understand the question.

A. I did not look in detail to the XNS map -- manual for the answers to those questions but my industry experience as to what the capability of the XNS system are.

Q. You -- you're relying on your industry experience as to the capability of the XNS system in practical application is?

A. It -- and -- and, in specific, the ability to maintain a list and to maintain input and output process mod -- modules and -- such as described in Claim 6.

Q. When you say you relied on your industry experience, what do you mean by your industry experience with XNS?

A. I -- I've seen Xerox doc -- document systems running XNS in the early '9- --'90s.

Q. Okay. And did you look in the XNS manual to see whether or not all of these four functions that are recited in Claim 6 were described as being formed -- being performed in a single server module?

A. No.

Q. Okay. Was that because of a comfort level that you felt having actually worked with the XNS system?

A. Right.

Q. Okay. And based on your experience working with the XNS system -- and what years did you work with the XNS system, by the way?

A. I evaluate -- evaluated it and saw it demonstrate -- demonstrated roughly 1992, '3, some -- something like that.

Q. Okay. You understand the reference that we're -- the reference that's -- that's at issue in the proceedings before the Patent Office is the 1985 dated manual, correct?

A. That -- that -- that's the -- the description of -- of the XNS, yes.

Q. Did you have experience working with the XNS prior to 1992?

A. No.

Q. Okay. So you don't know one way or the other as to whether or not, in 1985, there was a single server module in XNS that performed the four functions of Claim 6; is that correct?

DR. VARUGHESE: Objection to the form of the question and mischaracterizes the witness' testimony.

THE WITNESS: I don't know.

BY MR. HILL:

Q. You don't know?

A. Right.

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