Filed on Behalf of MPHJ TECHNOLOGY INVESTMENTS, INC
By: Scott A. Horstemeyer (scott.horstemeyer@thomashorstemeyer.com)
THOMAS | HORSTEMEYER, LLP
400 Interstate North Parkway, SE
Suite 1500
Atlanta, Georgia 30339
Tel: (770) 933-9500
Fax: (770) 951-0933

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
_____

**REPLY TO PETITIONER'S OPPOSITION TO
THE MOTION TO EXCLUDE**

Patent Owner MPHJ Technology Investments, LLC ("Patent Owner") filed a

motion to exclude portions of Dr. Melen's deposition transcript submitted as Ex.

2003. (Paper 40). Specifically, Patent Owner seeks to exclude 62 pages (Ex.

2003, pp.178-240) of leading questions in which Petitioners asked whether its

expert, Dr. Melen, agrees with "what is contained in the contents of this petition

for *inter partes* review." (Ex. 2003, p. 182, lines 8-12). Petitioner filed an

opposition to this motion. (Paper 43). Through this paper, Patent Owner replies to

Petitioner's Opposition.

I.   PATENT OWNER DOES NOT IMPERMISSIBLY CHALLENGE THE SUFFICIENCY OF DR. MELEN'S TESTIMONY

Petitioner alleges that Patent Owner's motion to exclude is an attempt to

reiterate or expand upon arguments raised in Patent Owner's Response. Patent

Owner's motion concerns 62 pages of redirect testimony in which Petitioner

impermissibly led its witness, Dr. Melen, to agree with the anticipation arguments

addressed in the petition. The Board deserves to understand the context which

prompted Petitioner to improperly question its own witness, Dr. Melen, for a time

that spans 62 out of 261 pages of deposition transcript. The insufficiency of Dr.

Melen's testimony evidence is automatically raised by merely reciting Dr. Melen's

cross examination testimony. The following is one among numerous examples

where Dr. Melen discredits his declaration:

> Q. Did you -- as specifically as you are able to, at the time you
> signed your name to the declaration that you've offered in this case,
> what software application of the XNS were you most convinced
> possessed the five modules of Claim 5?
>
> A. I did not analyze XNS on a module-by-module basis –
>
> Q. Okay.
>
> A. -- but XNS is based upon software and a collection of modules.
>
> Q. It actually says based on collection of software as well, right?
>
> A. Yes.
>
> Q. And collection of software is different than a collection of
> modules, isn't it?
>
> A. Right.

(Ex. 2003, p. 110, line 13 – p. 111, line 6). Dr. Melen discredits himself, which is

presumably why Petitioner attempted to rehabilitate him. The purpose of

Petitioner's leading questions *cannot be explained without addressing Dr.*

Melen's contradictory testimony.

First, Petitioner asserts that Patent Owner has abused motion practice by

challenging the sufficiency of the evidence. Thereafter, Petitioner disregards its

own belief of proper motion practice and seeks to rehabilitate Dr. Melen through

filing its opposition brief. (Paper 43, p. 7). Specifically, without providing any

support, Petitioner testifies as to what Dr. Melen was or was not suggesting. (*Id.*).

If Petitioner truly believed that Patent Owner's motion to exclude was an abuse of

motion practice, Petitioner would have limited its opposition brief to explaining

why 62 pages worth of leading questions are admissible rather than attempting to

remedy Dr. Melen's testimony through the elaborate, self-serving explanations

offered in its opposition brief.

II. DR. MELEN'S CROSS EXAMINTION TESTIMONY CITED IN THE MOTION TO EXCLUDE WAS NOT TAKEN OUT OF CONTEXT

As stated in the motion to exclude, Dr. Melen believes that Salgado "gets a

lot of his strength from the inclusion of XNS with Salgado." (Paper 40, p. 6). It

goes without saying that this alone is highly suggestive that Dr. Melen confuses the

rules of anticipation with obviousness (and this proceeding is strictly based on

anticipation). Petitioner uses its opposition to the motion to exclude to speculate

that Dr. Melen mentioned both XNS and Salgado "simply because he reviewed

both prior to being deposed, not because he believed Salgado fails to anticipate the

claims." (Paper 43, p. 7). However, the citations in the motion to exclude are not

taken out of context – Dr. Melen has confused obviousness with anticipation, as

demonstrated in other instance of his deposition transcript:

Q. Column 86 --

3

A.   Um-hum.

Q.   -- Lines 22 through 27. (Whereupon, the witness reviews the material provided.)

THE WITNESS: I would respond to that by saying that since Salgado -- Salgado supports XNS and XNS supports the Kurzweil scan -- scanning equipment, that that would contain a module for doing that.

BY MR. HILL:

Q.   *And where is that module described in Salgado?*

A.   *In its description of its support of XNS. XNS includes the Kurzweil system, and it's a third-party device.*

Q.   So in order to -- and that's from -- you're taking that from the XNS manual --

A.   Yes.

Q. -- that we were looking at before and you're combining that --

A.   Right.

Q.   -- that knowledge with what you're seeing here?

A.   That's right.

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

(Ex. 2003, p. 147, line 6 - p. 148, line 9 – emphasis added). Patent Owner invites the Board to review Dr. Melen's deposition transcript to verify that the citations of Dr. Melen that appear in the motion to exclude are not taken out of context.

III.   PATENT OWNER'S MOTION TO AMEND DOES NOT SUFFER FROM INCURABLE DEFICIENCIES

Patent Owner has identified pages 178 to 240 of Dr. Melen's deposition transcript (Ex. 2003) as containing 40 sequential objections. Accordingly, Patent

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.