UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WAVEMARKET, INC. D/B/A LOCATION LABS
Petitioner

v.

LOCATIONET SYSTEMS, LTD.
Patent Owner

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Case IPR2014-00199
Patent 6,771,970

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S
MOTION TO EXCLUDE EVIDENCE**

Pursuant to the Scheduling Order (Paper No. 19) Petitioner Wavemarket d/b/a Location Labs timely opposes Patent Owner's Motion to Exclude Evidence filed December 30, 2014 ("Motion"). The Patent Owner has moved to exclude the entire Declaration of Petitioner's rebuttal witness, Dr. Craig Rosenberg (**Exhibit 1020**). For at least the reasons explained in detail below, Patent Owner's request to exclude this evidence is entirely without merit.

The Board instituted trial of claim 18 of the '970 Patent in its Decision of May 9, 2014 (Paper No. 18, "Decision"). The Board found that Petitioner had adequately shown that the Elliot reference (**Exhibit 1003**) discloses each and every element of claim 18, including the recited "map database" and "map engine for manipulating said map database." Decision, pp. 16-17. In doing so, the Board did not feel it necessary to construe the well-known terms "database" or "engine." Decision, p. 7. On August 11, 2014 the Patent Owner filed its Response to the petition ("Response"). The only defense offered in the Response is that Elliot fails to disclose a "map database" or "map engine for manipulating said map database." Given the breadth of the claim language on its face, the key to the Patent Owner's strategy is to import limitations into the claims from cherry-picked dictionary definitions introduced through its expert's testimony. On November 10, 2014, Petitioner filed its Reply to the Patent Owner's Response ("Reply"). As part of its Reply, Petitioner introduced the testimony of Dr. Craig Rosenberg ("Roseberg

Decl."; **Exhibit 1020**) as a rebuttal witness. In his role as a rebuttal witness, Dr. Rosenberg's testimony addresses those points raised in the Patent Owner's Response and in the Patent Owner's expert witness declaration. The Rosenberg Decl. is helpful to the finder of fact for at least the reasons that it includes an explanation of how Elliot does in fact disclose the claimed "map database" and "map engine for manipulating said map database," and further includes an explanation of how the Patent Owner's expert overlooks the teachings of Elliot and misinterprets the plain language of the claims.

I.   GENERAL PRINCIPLES

As the movant, the Patent Owner bears the burden of demonstrating that it is entitled to the drastic measure of excluding the entire Rosenberg Decl. 37 C.F.R. § 42.20(c).

The Board has made it clear that policy considerations favor inclusion and consideration of evidence that is available to the public during these proceedings:

> There is a strong public policy for making all information filed in a non-jury, quasi-judicial administrative proceeding available to the public, especially in an *inter partes* review which determines the patentability of claim in an issued patent. It is within the Board's discretion to assign the appropriate weight to be accorded to evidence.

Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co., CBM2012-00002, Paper No. 66, p. 60.

Moreover, these proceedings are heard by a panel of administrative patent judges possessing considerable substantive and procedural expertise who are capable of attributing appropriate weight to all of the evidence of record:

> We also agree with [patentee] that "the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to the evidence presented in this trial, without resorting to formal exclusion that might later be held reversible error." Opp. 1 (citing *e.g., S.E.C. v. Guenthner*, 395 F. Supp. 2d 835, 842 n.3 (D. Neb. 2005)).

Id. at p. 70.

Rule 702 of the Federal Rules of Evidence (FRE) governs admissibility of expert testimony in these proceedings. 37 C.F.R. § 42.62(a). Pursuant to Rule 702, a witness who is qualified as an expert by knowledge, skill, experience training or education may testify in the form of an opinion.

Finally, challenges to the credibility of a witness and weight of the evidence raised are not appropriate in a motion to exclude. 77 Fed. Reg. 48,612, 48,633 (Aug. 14, 2012); and 77 Fed. Reg. 48,765, 48,767 (Aug. 14, 2012).

II. DR. ROSENBERG IS QUALIFIED TO OFFER EXPERT TESTIMONY IN THIS TRIAL UNDER RULE 702

FRE 702 reads:

A witness who is qualified as an expert by knowledge, skill, experience, training, *or education* may testify in the form of an opinion or otherwise if:

(a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;

(b) the testimony is based on sufficient facts or data;

(c) the testimony is the product of reliable principles and methods; and

(d) the expert has reliably applied the principles and methods to the facts of the case.

(Emphasis added).

The Patent Owner argues that Dr. Roseberg does not qualify as a person of ordinary skill in the art, but does not address the correct legal issue of whether Dr. Rosenberg's testimony should be considered ***pursuant to FRE 702***. *See, Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2013-00004, Paper No. 53, p. 60 ("Liberty has not shown that Rule 702 of the Federal Rules of Evidence requires the witness to have particular experience with the specific subject matter of the . . . patent or requires the relevant experience of the witness to have been acquired during the January 1996 time-frame."); *Id.* at p. 59 ("It is only the 'hypothetical' person of ordinary skill in the art who possesses ordinary skill . . . [t]he qualifications of [the expert], as summarized in his curriculum vitae . . .

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