UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION and MICROSOFT MOBILE, INC.,
Petitioners,

v.

GLOBAL TOUCH SOLUTIONS, LLC,
Patent Owner.

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Case IPR2015-01149
Patent 7,329,970

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**PETITIONERS' RESPONSE TO PATENT OWNER'S MOTION FOR
OBSERVATION ON CROSS EXAMINATION OF PETITIONER'S REPLY
WITNESS DR. MARK HORENSTEIN**

Patent Owner's entire Motion for Observation on Cross Examination of Petitioner's Reply Witness Dr. Mark Horenstein should be disregarded because rather than provide "concise statement[s] of a precisely identified testimony to a precisely identified argument or portion of an exhibit," as the rules require, Patent Owner's Motion instead "raise[s] new issues" and "pursue[s] objections," which the rules forbid. Office Patent Trial Practice Guide, 77 Fed. Reg. 157 (August 14, 2012) at 48,768 (noting that an observation "is not an opportunity to raise new issues, re-argue issues, or pursue objections"). Patent Owner's Motion consists of an improper argumentative introduction, followed by observations addressed to entirely new issues or improper objections to Dr. Horenstein's signature and attestation. Therefore, it should be disregarded. *See id; see also Atrium Medical Corp. v. Davol*, IPR2013-00184, Paper No. 49 at 2 (February 28, 2014) ("The Board may decline consideration or entry of excessively long or argumentative observations.").

Response to Introduction

Patent Owner's Introduction to its Observations should be disregarded because it is not an observation, it raises new issues, and it pursues objections. The Trial Practice Guide explains that each observation should be in the form of "In exhibit __ on page __, lines__, the witness testified __. This testimony is

relevant to the __ on page __ of __. The testimony is relevant because __." 77 Fed. Reg. 157 at 48,768. Patent Owner's two-page introduction fails to follow this format, and raises new issues and improper objections such as whether Dr. Horenstein's "affixation of a graphic text" was sufficient to sign his declaration. IPR2015-01149, Paper No. 24 at 3.[1] Thus, Patent Owner's introduction should be disregarded. *See* IPR2013-00184, Paper No. 49 at 2.

Response to Observation 1

Observation 1: In Exhibit 2007, at 80:5-7, regarding Dr. Horenstein's Second Declaration (Exhibit 1020), Dr. Horenstein testified "I think it would be obvious to anyone reading paragraph seven that the first instance of number 520 is a typo and should be 516." This is relevant to Dr. Horenstein's credibility and the weight to be given to his testimony because Dr. Horenstein did not acknowledge this error upon signing the Second Declaration (Exhibit 1020) on June 1, 2016, or upon re-

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[1] Petitioner addresses the substance of Patent Owner's objections to Dr. Horenstein's signature and attestation in its response to Patent Owner's Motion to Exclude, which is focused on the same issues.

signing the Second Declaration (Exhibit 2008) on June 9, 2016, indicating he did not read either declaration.

Patent Owner's Observation 1 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. Moreover, contrary to Patent Owner's argument that Dr. Horenstein "did not read either declaration," Dr. Horenstein testified that "of course" he read the declarations prior to signing and that he simply "did not catch the typographical error." Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at 81:7-16.

Response to Observation 2

Observation 2: In Exhibit 2007, at 92:4-6, regarding Dr. Horenstein's Second Declaration (Exhibit 1020), Dr. Horenstein testified "In my mind, this is in context, it is an obvious typographical error that anyone could identify upon reading the document[.]" This is relevant to Dr. Horenstein's credibility and the weight to be given to his testimony because Dr. Horenstein did not acknowledge this error upon signing the Second Declaration (Exhibit 1020) on June 1, 2016, or upon re-signing the Second Declaration (Exhibit 2008) on June 9, 2016, indicating he did not read either declaration.

Patent Owner's Observation 2 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. Moreover, contrary to Patent Owner's argument that Dr. Horenstein "did not read either declaration," Dr. Horenstein testified that "of course" he read the declarations prior to signing and that he simply "did not catch the typographical error." Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at 81:7-16.

Response to Observation 3

Observation 3: In Exhibit 2007, at 97:21-98:1, regarding whether Dr. Horenstein knew about the error of paragraph 7 of Dr. Horenstein's Second Declaration (Exhibit 1020) by June 9, 2016, Dr. Horenstein testified "Apparently not because I signed the documents on June 9th with the boiler plate clause added." This is relevant to Dr. Horenstein's credibility and the weight to be given to his testimony because Dr. Horenstein did not acknowledge this error upon signing the Second Declaration (Exhibit 1020) on June 1, 2016, or upon re-signing the Second Declaration (Exhibit 2008) on June 9, 2016, indicating he did not read either declaration.

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