

Case IPR2016-01688
Patent No. 9,300,792

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Twilio Inc.
Petitioner

v.

TeleSign Corporation
Patent Owner

Case No. IPR2016-01688
Patent: 9,300,792

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

First, Patent Owner seeks to exclude a portion of Patent Owner's expert deposition testimony because "it is beyond the scope of Dr. Nielson's declaration" (Paper 20 at ii). The testimony in question, however, is read *directly* from Dr. Nielson's declaration by Patent Owner's own expert.

In Patent Owner's Motion to Exclude, Patent Owner inserted other portions of Dr. Nielson's testimony instead of the testimony Patent Owner now moves to exclude. Below is the actual testimony that Patent Owner moves to exclude on page 10 of Petitioner's Reply. Notice that Dr. Nielson references section 9.2 of his declaration and then reads directly from it.

A So let me give an example here. **So in my declaration in Paragraph 9.2**, it's about -- it's the last sentence of the paragraph on that page **that says: That action, such as a large withdrawal, would not be allowed to take place without an acknowledgment by the user.** So that's an example of an action, withdrawal or a, for example, financial operation.

Q Okay. So that is an example of an action. What is the definition of "action" then?

A. Well, I was looking at it with what I would probably describe as just conventional, you know, how one of skill in the art would understand "action," which would be an operation transaction.

EX1035 at 18:15-9:5 (emphasis added).

During Dr. Nielson's deposition, Dr. Nielson was asked about "actions" and in response to the question Dr. Nielson read verbatim from his expert report. *Compare* Nielson Decl. (EX2008) at 9.2 *with* Nielson Depo (EX1035) at 18:15-20. Patent Owner now seeks to exclude testimony that was read directly from Dr. Nielson's expert declaration. The testimony relied on by Petitioner on page 10 of its Reply is not beyond the scope of Dr. Nielson's declaration—it **is** Dr. Nielson's declaration.

Second, the term "action" and its meaning is not outside the scope of Dr. Nielson's Declaration. The term "action" and "notification event" are closely related according to Dr. Nielson's declaration. For example, Dr. Nielson's Declaration includes a section 9 titled "Rebuttals to Certain Characterizations by Dr. Shamos." *See* EX2008 at 22-24. Within this section Dr. Nielson makes the following statements (emphasis added) about "actions" and "notification events":

- "Dr. Shamos continually describes an event being acknowledged by a user, **instead of an action associated with an established notification event.**" (EX2008 at 9.1)
- "The '792 claims, however, require that the acknowledgement by the user **be required for an action. That action** (such as a large withdrawal)" (EX2008 at 9.2)

- “But the claim does not require that the user acknowledge the **notification, it requires that the user acknowledge an action** associated with the established **notification event.**” (EX2008 at 9.3)
- “But the supposed events explained in the Petition **are not said to be associated with an action** that must be acknowledged.” (EX2008 at 9.4)

Dr. Nielson’s addresses the term “action” in his declaration and therefore the testimony relied on by Petitioner on page 10 of its Reply is not beyond the scope of Dr. Nielson’s Declaration.

Third, Patent Owner’s testimony regarding the term “actions” should not be excluded given the link Patent Owner (and it’s expert) has injected into this IPR between the terms “notification event” and “actions.” For example, when questioned during Dr. Nielson’s deposition about “notification events,” Dr. Nielson linked the term to “actions:”

Q And give me an example of the notification event.

A Well, it's kind of like if you've got a file with the contents of the file and the header of the file, **you might call them the same thing; right?** So you might have the action which is the actual transferring of the money. **And there may be a notification event that is called transferring money.** But the key point is that it's a notification event that is associated with that

action. So that when -- so that it says, as it says in the next claim element: **Upon receiving an indication of an occurrence of an established notification event -- in other words, we've now detected this transfer in progress -- transmitting a message addressed to the verified telephone number indicating the occurrence of the notification event.**

Petitioner's Reply (Paper 18) at 11-12; EX1035 at 21:23-22:16 (emphasis added).

Patent Owner has manufactured an additional dispute between "notification events" and "actions" and therefore any deposition testimony regarding the term "action" is directly relevant to this IPR and Dr. Nielson's declaration.

For at least the above reasons, the Board should deny Patent Owner's request to exclude the testimony of Dr. Nielson on page 10 of Petitioner's Reply.

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Respectfully submitted,

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