

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.
Petitioner

v.

UNILOC LUXEMBOURG, S.A.¹
Patent Owner

Case: IPR2017-01797
U.S. Patent No. 8,724,622

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

¹ Uniloc's updated mandatory notice filed on August 27, 2018, indicates that the owner of U.S. Patent No. 8,724,622 is now Uniloc 2017 LLC. (Paper 19.)

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT.....	2
A.	Uniloc’s Motion Fails to Meet the Requirements and Should Be Summarily Denied.....	3
B.	Mr. Easttom Opined Broadly on the Challenged Patent and the Prior Art in His Direct Testimony.....	5
C.	Given the Breadth of Mr. Easttom’s Direct Testimony, Samsung’s Cross-Examination Questions Were Within the Scope	7
III.	CONCLUSION.....	13

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Canon Inc., v. Intellectual Ventures II LLC</i> , IPR2014-00531, Paper 50 (P.T.A.B. Aug. 19, 2015).....	2
<i>Int’l Bus. Mach. Corp. v. Intellectual Ventures II LLC</i> , IPR2014-00587, Paper No. 27 (P.T.A.B. Nov. 28, 2014).....	13
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	4
<i>Medtronic, Inc. v. Endotach, LLC</i> , IPR2014-00100, Paper 32 (P.T.A.B. Aug. 28, 2014).....	2
<i>Microsoft Corp. v. Proxyconn, Inc.</i> , IPR2012-00026, Paper No. 66 (P.T.A.B. Nov. 1, 2013).....	2
<i>Schering Corp. v. Roussel-UCLAF SA</i> , 104 F.3d 341 (Fed. Cir. 1997)	8
<i>Sipnet EU S.R.O. v. Straight Path IP Group, Inc.</i> , IPR2013-00246, Paper 63 (P.T.A.B. Oct. 9, 2014).....	3
<i>Sumitomo Elec. Indus., Ltd. v. United Techs. Corp.</i> , IPR2017-00966, Paper 29 (P.T.A.B. Sept. 12, 2018).....	4
<i>United States v. Henderson</i> , 409 F.3d 1293 (11th Cir. 2005)	8
Regulations	
37 C.F.R. § 42.23(b)	4
37 C.F.R. § 42.53(d)(5)(ii).....	2
37 C.F.R. § 42.64(c).....	3
77 Fed. Reg. 48,756, 47,867 (Aug. 14, 2012)	3, 4

Petitioner Samsung Electronics America, Inc. (“Samsung”) submits the following response to Patent Owner Uniloc 2017 LLC’s (“Uniloc’s”) motion to exclude (“Motion”). (Paper 21.)

I. INTRODUCTION

Uniloc’s perfunctory motion to exclude a substantial portion of the deposition testimony of its own expert, Mr. Easttom, should be summarily denied because it fails to satisfy the requirements of a motion to exclude. In particular, the motion does not sufficiently explain the basis of each objection or identify where in the record the objected-to deposition testimony is relied upon. Thus, its motion should be rejected outright as facially deficient. Uniloc cannot cure these deficiencies in its reply as it would be improperly presenting arguments in a reply brief that should have been presented in its motion.

Regardless, even if the Board considers the merits, Samsung’s questions were well within the scope of Mr. Easttom’s declarations. The notion that asking about intrinsic evidence that contradicts direct testimony could be outside the scope of that testimony fails on its face. In effect, Uniloc seeks to restrict the scope of cross-examination to parroting material from the declaration. This is contrary to

37 C.F.R. § 42.53(d)(5)(ii) and the Board's practice.² When a witness testifies on direct that a prior art reference lacks a certain element of a patent claim, and bases that testimony on an incorrect interpretation of the claim language, that opens the door to cross examination on the correct interpretation of that claim language. *See Microsoft Corp. v. Proxyconn, Inc.*, IPR2012-00026, Paper No. 66 at 2-3 (P.T.A.B. Nov. 1, 2013); *Canon Inc., v. Intellectual Ventures II LLC*, IPR2014-00531, Paper 50 at 45 (P.T.A.B. Aug. 19, 2015). That indisputable proposition and that hypotheticals are certainly proper for an expert defeat Uniloc's motion.

II. ARGUMENT

Ignoring the requirements for a motion to exclude, Uniloc indiscriminately seeks to exclude eighty-nine (89) portions of Mr. Easttom's deposition testimony, which amounts to hundreds of lines of deposition testimony. (Exs. 1040 (71 portions), 1041 (13 portions), 1042 (5 portions).) The cited portions of Mr. Easttom's deposition testimony, however, call into question his earlier opinions

² For instance, the Board has held that limiting cross-examination to the scope of direct testimony under 37 C.F.R. § 42.53(d)(5)(ii) does not necessarily limit such cross-examination to documents cited in the direct testimony. *See Medtronic, Inc. v. Endotach, LLC*, IPR2014-00100, Paper 32 at 2-3 (P.T.A.B. Aug. 28, 2014).

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.