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: IPR2017-01799
U.S. Patent No. 8,199,747

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. 8,199,747 is now Uniloc 2017 LLC. (Paper 26.)

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Petitioner Samsung Electronics America, Inc. ("Samsung") submits the following response to Patent Owner Uniloc 2017 LLC's ("Uniloc's") motion to exclude ("Motion"). (Paper 28.)

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 concerning the relation of the patent claims to the prior art (Ex. 2001), and thus are

[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).

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