

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.

Petitioner

v.

UNILOC LUXEMBOURG, S.A.

Patent Owner

IPR2017-01802

PATENT 7,535,890

**PATENT OWNER MOTION TO EXCLUDE
PURSUANT TO 37 C.F.R. § 42.64**

Pursuant to 37 CFR § 42.64, Patent Owner moves to exclude portions of the deposition transcripts that exceed the permissible scope of cross examination.

BACKGROUND

Petitioner cross examined Patent Owner’s witness, William C. Easttom II, during three separate depositions held on August 3 and 6, 2018. *See* Exhibits 1040, 1041, and 1042. Rather than question Mr. Easttom concerning the direct testimony contained in his declarations, however, Petitioner spent much of the time questioning Mr. Easttom concerning matters outside the scope of his direct testimony and therefore outside the scope of cross-examination testimony allowed under 37 CFR §§ 42.53(d)(4)(ii).

During the first deposition, held on August 3, for example, Petitioner directly mentioned Mr. Easttom’s declarations only to ask basic preliminary questions about the preparation and authenticity of the declarations. Petitioner then asked Mr. Easttom a series of questions outside the scope of his direct testimony, including various hypotheticals not contemplated in his direct testimony. *See e.g.* Ex. 1040 at 31:25-32:6 (“would the delay of an hour at the time be an instant message”); 32:13 – 32:24 (same); 33:6 – 33:12 (same); 105:18-105:23 (question concerning capabilities of hypothetical configurations); 106:3 – 106:20 (same). Mr. Easttom repeatedly informed Petitioner that these questions were outside the scope of his direct testimony. *See e.g.* Ex. 1040 at 32:2-3 (“It’s not really a concept I’ve

considered. I know all my opinions are in my declaration.”); 33:7-9 (“What I’ve actually said [is] I haven’t contemplated that. I haven’t opined on that. That’s not within my declaration.”); 105:21-23 (same); 106:6-7 (same).

After a series of hypotheticals outside the scope of Mr. Easttom’s direct testimony culminated in Petitioner’s insistence that Mr. Easttom answer “yes or no” to a question about a hypothetical e-mail system imagined by Petitioner, which Mr. Easttom described as “radically different than not only the way e-mail works but the way the protocols would even allow it to work,” counsel for Patent Owner suggested that Petitioner either move on to actual cross examination of Mr. Easttom’s direct testimony or the parties go to the board for intervention. Ex. 1040 at 57:3 – 59:25.

OBJECTIONS TO SCOPE

In accordance with § 42.64(a), Patent Owner preserved its objections to the scope of Petitioner’s questions by objecting to scope each time Petitioner’s cross examination exceeded the permissible scope of the deposition. In accordance with § 42.64(c), each of Patent Owner’s objections to scope is identified below, in the order they appear in the record.

I. Objections to Exhibit 1040

Patent Owner objected to the following sections of Exhibit 1040 and hereby moves to exclude them from Petitioner’s briefing and trial exhibits:

31:25 – 32:6	191:2 – 191:20	105:20 – 106:2
32:13 – 32:24	60:24 – 61:3	109:11 – 109:22

33:6 – 33:12	61:17 – 61:23	110:21 – 111:9
34:21 – 35:18	65:17 – 65:23	113:25 – 114:9
35:20 – 36:16	66:2 – 66:9	115:10 – 115:15
36:22 – 37:22	66:18 – 66:23	119:3 – 119:18
38:2 – 38:17	67:8 – 67:13	144:2 – 144:9
38:22 – 39:5	71:3 – 71:6	148:25- 149:1
39:19 – 39:21	83:5 – 84:5	149:19 – 150:2
40:3 – 40:15	84:13 – 85:5	119:23 – 120:1
41:5 – 41:12	85:10 – 85:16	121:20 – 122:4
41:23 – 42:6	86:3 – 86:9	126:12 – 127:1
42:15 – 42:24	86:16 – 86:23	128:15 – 129:4
44:6 – 44:15	87:20 – 87:22	129:8 – 130:6
45:3 – 45:7	92:9 – 92:19	131:11 – 131:19
45:11 – 45:17	93:2 – 93:7	132:19 – 133:12
47:11 – 48:4	93:16 – 94:13	133:19 – 134:09
52:3 – 52:15	94:24 – 95:8	140:4 – 140:15
52:22 – 53:6	95:12 – 95:19	141:22 – 141:22
53:10 – 53:12	95:25 – 96:3	152:25 – 153:8
53:17 – 53:23	96:15 – 96:23	154:15 – 155:2
54:11 – 54:17	96:20 – 96:23	
55:9 – 55:13	100:14 – 100:18	
55:25 – 57:1	101:6 – 101:10	
57:10 – 57:17	101:17 – 101:20	

The basis for each of the objections above is that the question exceeded the scope of Mr. Easttom’s direct testimony. Patent Owner’s numerous objections to the scope of questioning in Exhibit 1040 is a result of a lengthy line of questioning by Petitioner, including questions about hypothetical systems, that was entirely outside the scope of Mr. Easttom’s direct testimony in his declaration.

II. Objections to Exhibit 1041

Patent Owner identifies the following objections to the scope of Exhibit 1041 and moves to exclude these portions of the exhibit because they are outside the scope of Mr. Easttom's declaration (as he repeatedly reminded Petitioner).

19:6 – 19:11
20:14 – 20:19
21:6 – 21:24
22:16 – 22:21
22:24 – 23:21
23:22 – 24:4
26:5 – 26:18
27:2 – 27:5
28:9 – 28:15
28:20 – 29:8
29:12 – 29:14
29:19 – 30:1
30:6 – 30:20

III. Objections to Exhibit 1042

Patent Owner identifies the following objections to the scope of Exhibit 1042 and moves to exclude these portions of the exhibit because they are outside the scope of Mr. Easttom's declaration.

21:6 – 21:24
31:5 – 31:9
59:9 – 60:3
68:3 – 68:9
68:15 – 68:18

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