Paper No. 60
Filed: January 15, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

DIRECTSTREAM, LLC,
Patent Owner.

Case Nos. IPR2018-01605, -01606, -01607
U.S. Patent No. 7,680,800

PETITIONER'S MOTION TO EXCLUDE

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I. Introduction

Pursuant to 37 C.F.R. §§ 42.62 and 42.64, Petitioner Microsoft Corporation hereby move to exclude certain evidence propounded by the Patent Owner DirectStream. Petitioner has timely objected to DirectStream's evidence (Paper 37 and Paper 42) and said evidence does not comport with the Federal Rules of Evidence ("FRE") or the rules of the Board. The Board should grant this Motion and exclude the evidence identified below from consideration.

II. Exhibit 2101

As authorized by the Board, Petitioner moves to exclude and/or strike portions of Mr. Huppenthal's declaration (Ex. 2101 ¶¶ 80, 82-86) due to his refusal to answer questions concerning those portions of the declaration. *See* Order Granting In Part Petitioner's Motion to Compel and Strike, Paper No. 48 at 7-8 ("[I]f Mr. Huppenthal cannot be meaningfully cross-examined regarding topics addressed in his declaration due to allegedly classified information, Petitioner may seek to exclude those portions of his declaration by filing a motion to exclude at the appropriate time."). In particular, Mr. Huppenthal's declaration asserts that certain systems made by his company were "covered by" the patents at issue in these proceedings, Ex. 2101, ¶80, and then describes the sale of systems to various government agencies and contractors, including the Army, Navy, Air Force and NSA, among others, Ex. 2101, ¶¶82-86. Patent Owner relies on this testimony for

support of its argument that secondary considerations of non-obviousness apply. *See, e.g.*, Patent Owner Response, IPR2018-01605, -01606, -01607 at 116-117.

However, when Petitioner's counsel sought to question Mr. Huppenthal about those systems sold to the government and its contractors, Mr. Huppenthal refused to answer in almost every case, asserting that "many of these are classified programs." Ex. 1073, (Huppenthal Tr.) 99:8-101:25. Moreover, when questioned about those same systems by his own counsel on re-direct, Mr. Huppenthal confirmed that at least some "aspects" of the "classified" systems were different from systems sold commercially. *Id.* at 115:16-116:14.

Petitioner has a right to cross-examine Mr. Huppenthal sufficient to create a full disclosure of the facts, *see* 5 U.S.C. § 556(d) ("A party is entitled to … conduct such cross-examination as may be required for a full and true disclosure of the facts."); *Bowman Transp., Inc. v. Arkansas-Best Freight Sys., Inc.*, 419 U.S. 281, 288 n.4 (1974) ("Indeed, the Due Process Clause forbids an agency to use evidence in a way that forecloses an opportunity to offer a contrary presentation."), and Mr. Huppenthal's assertion that his testimony is "classified" cannot overcome that right. Indeed, the privilege against discovery into classified material can be asserted solely by the United States. *U.S. v. Reynolds*, 345 U.S. 1 (1953). Neither Mr. Huppenthal nor Patent Owner has any standing to assert such a privilege. Mr. Huppenthal has therefore effectively made himself unavailable for questioning as

to the details of the systems sold to the government and its contractors. His testimony should therefore be excluded and/or struck, *HTC Corp. v. NFC Technology*, LLC, IPR2014-01198, Paper 41, and Patent Owner should be precluded from relying on it, *Aristocrat Technologies, Inc. v. IGT*, IPR2016-00252, Paper 17.

Petitioner further moves to exclude Exhibit 2101 (Declaration of John Huppenthal) in its entirety as not being relevant to any issue on which trial has been instituted, and for lacking foundation, containing hearsay, and/or causing undue prejudice. Dr. Huppenthal's declaration provides an irrelevant narrative discussion of his participation in reconfigurable computing. *See* Fed. R. Evid. 401-03. Further, Dr. Huppenthal admits that he never considered any of the information discussed in his declaration in relation to the claims of the 800 Patent (Ex. 1073 (Huppenthal Dep. Tr.), 106:7-112:23). Additionally, Dr. Huppenthal's declaration contains only threadbare citations to the 800 Patent itself, citations which are unexplained and undeveloped. Thus, Petitioner has had no fair opportunity to respond to Dr. Huppenthal's unstated and under developed contentions (if any) regarding the 800 Patent. Therefore, Exhibit 2101 is irrelevant.

Further, his testimony in at least paragraphs 27 and 80-86 contain statements that are either based on hearsay or lack of personal knowledge. *See* Fed. R. Evid.

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