

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

DIRECTSTREAM, LLC,
Patent Owner.

IPR2018-01605, -01606, -01607
U.S. Patent No. 7,620,800

PETITIONER MICROSOFT'S MOTION TO COMPEL AND STRIKE

Petitioner Microsoft Corp. (“Petitioner”) submits this Motion to Compel and Strike as authorized by the Board’s email of October 11, 2019.

I. MR. HUPPENTHAL SHOULD BE COMPELLED TO ANSWER ADDITIONAL QUESTIONS

During the October 8, 2019 cross-examination of Patent Owner’s declarant Jon Huppenthal, Mr. Huppenthal was instructed, based on form objections only, not to answer several questions about statements in his direct testimony. For example, in his declaration Mr. Huppenthal, who is a named inventor of the 152 patent, describes the development of a “crossbar switch” for a basic system his company was developing, IPR2018-01594, Ex. 2084 at 18-24,¹ and later describes modifications to that basic system that led to the 152 patent, *see id.*, at 32-33.

The crossbar switch described in Mr. Huppenthal’s declaration bears striking resemblance to a “memory interconnect fabric” disclosed in the 152 patent. Compare Ex. 2084 at 19 with Ex. 1001 at Figure 1. Petitioner’s counsel therefore sought to question Mr. Huppenthal about that “memory interconnect fabric” and relate it to the discussion in Mr. Huppenthal declaration, Huppenthal Tr. (Ex. 1073) at 57:21-59:11, testimony that could be relevant to a means-plus-function

¹ Mr. Huppenthal has submitted substantially the same declaration in each of the captioned proceedings, albeit with different exhibit numbers. We cite here to IPR2018-01594, Ex. 2084, as that was the document placed before him.

claim construction issue raised in Patent Owner's response. *See* Patent Owner Response, IPR2018-01599, Paper No. 37 at 48-53. However, Mr. Huppenthal was instructed not to answer any such questions, based solely on the objection that such questions were "outside the scope." *See* Huppenthal Tr. (Ex. 1073) at 57:21-59:11; *see also id.*, 99:25-100:10. Counsel further indicated he would not permit the witness to answer any questions about the patents. *See id.*, at 59:2-6.

Mr. Huppenthal's declaration also states: "*With the exception of some of the technology described in patent 6,076,152, none of this new technology existed in the prototype system delivered to ORNL.*" Ex. 2084 at 56 (emphasis added).

When counsel asked Mr. Huppenthal what "technology" was referred to in this quote, Mr. Huppenthal was again instructed not to answer based solely on a form objection. *See* Huppenthal Tr. (Ex. 1073) at 99:8-100:9.

These instructions were clearly improper. "Counsel may instruct a witness not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limited testimony."

Office Patent Trial Guide, 77 Fed. Reg. at 47,772-72; *see also Dynamic Drinkware, LLC v. National Graphics, Inc.*, Case IPR2013-00131, PTAB (April 29, 2014)(holding that noting an objection on the record is the proper method of defending irrelevant questioning during a cross-examination.) Counsel's questioning related directly to statements about his patents in Mr. Huppenthal's

declaration. Moreover, Mr. Huppenthal is an inventor on all of the patents at issue in these proceedings, and his declaration expressly relates his direct testimony to each one. *See, e.g.*, Ex. 2084 at ¶¶49, 62, 77, 79. The questions were clearly proper cross-examination, and the instructions not to answer improper. Mr. Huppenthal should therefore be compelled to answer counsel’s questions about his direct testimony, including how it relates to the patents at issue.

Moreover, Patent Owner should be compelled to produce Mr. Huppenthal at the offices of Petitioner’s counsel for such continued questioning. The rule against instructing a witness not to answer based on form objections is by now so -settled as to be beyond argument. There was simply no excuse for the violations of the rules that occurred here, and the burden of remedying them should be placed squarely on Patent Owner. *Cf.* Office Trial Practice Guide, 77 Fed. Reg. 48756, 48772. Accordingly, Petitioner respectfully seeks an order compelling Mr. Huppenthal to appear at the offices of Petitioner’s counsel in Washington DC for additional questioning related to his direct testimony.²

II. TESTIMONY REGARDING “CLASSIFIED” SYSTEMS SHOULD BE STRUCK, OR PRECLUDED

² Petitioner’s Reply related to the 152 patent is due November 18. To the extent the Board orders additional testimony from Mr. Huppenthal, Petitioner respectfully request that it be required to occur before November 13, 2019.

Petitioner also moves to strike portions of Mr. Huppenthal’s declaration (Ex. 2084 ¶¶ 80, 82-86) due to his refusal to answer questions concerning those portions of the declaration. In particular, his declaration asserts that certain systems made by his company were “covered by” the patents at issue in these proceedings, Ex. 2084 at ¶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. 2084 at ¶¶ 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, IPR2018-01594 at 63.

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.” Huppenthal Tr. at 97:8-100:1 (Rough). 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 113:12-114:9.

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.

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.