

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Petitioner,
v.
UNM RAINFOREST INNOVATIONS,
Patent Owner.

Patent No. 8,265,096 B2

**PATENT OWNER'S OBJECTION TO
THE EXPERT REPORT OF DR. ROY (EX1002)**

Pursuant to 37 C.F.R. § 42.64, Patent Owner UNM Rainforest Innovations respectfully assert the following objection to evidence proffered by Petitioner Qualcomm submitted on December 23, 2021, and related deposition testimony taken on December 6, 2021. These objections are being provided within 10 business days of receipt of the evidence to which the objection is related and are thus timely pursuant to 37 C.F.R. § 42.64(b)(1). The Federal Rules of Evidence (F.R.E.) apply to these proceedings according to the provisions of 37 C.F.R. § 42.62(a), and these rules form the basis of the objections contained herein.

I. Objection to EX1002 based on related Deposition Testimony in EX2014

Patent Owner objects to EX1002 (Declaration of Dr. Sumit Roy, Ph.D.). Based on the deposition testimony taken on Dec. 6, 2021 (EX2014), EX1002 is objectionable and inadmissible as incomplete, irrelevant, misleading, improper expert testimony and lacking authenticity under F.R.E. 106, 401, 403, 702, and 901. Specifically, F.R.E. 702(d) concerning evidence in the form of expert testimony requires that “the expert has reliably applied the principles and methods to the facts of the case.” The deposition testimony has shown that the Qualcomm’s expert witness has failed to live up to the standard of F.R.E. 702 by failing to himself apply the principles and methods to the facts of the case, and further and more importantly, by affirmatively misrepresenting facts relating thereto under oath.

The touchstone for the admission of expert testimony in evidence is that it will “help the trier of fact to understand the evidence or to determine a fact in issue,” under Federal Rule of Evidence 702. Courts routinely require expert witnesses to properly support their work and opinions. For example, in the Second Circuit’s decision in *Puppolo v. Welch*, the court of appeals affirmed the district court’s exclusion of an expert opinion (and grant of partial summary judgment) where the expert merely reviewed and made minor revisions to an opinion provided to him by the plaintiff’s counsel. *Puppolo v. Welch*, 18-2601 (2nd Cir., June 20, 2019), affirming district court, 5:14-CV-95 (D. Vt. Sept. 12, 2017). Here, Dr. Roy simply signed off on an expert report provided to him by counsel with effectively no substantive changes. This problem is exacerbated severely by his failure to cite the original expert report in his materials considered list, and his blatant mischaracterization of the work and technical analysis he actual performed, as demonstrated below.

Dr. Roy testified under oath that he wrote Section IX, “The Challenged '096 Patent” on Page 47 as well as Section X, “Overview of the Prior Art References:”

Q. So did you write this background, or was this provided to you?

A. You know, I wrote it, again, you know, with -- with a draft based on -- based on a draft from counsel, but I did obviously add --I refined the draft and finalized it.

...

Q. And this Section IX, The Challenged '096 Patent on Page 47 -- does that -- is that your work and analysis of the '096 patent?

A. Yes, it is.

Q. Okay. So you wrote this section?

A. Uh-huh, again, you know, with inputs from counsel.

Q. Okay. So you wrote it and counsel edited it, or counsel wrote it and you edited it?

THE WITNESS: Sorry. Yeah. Both. It depends on different sections, yeah.

Q. Okay. And there's Section X, Overview of the Prior Art References.

Does this reflect your analysis of the prior art references?

A. Yes, it does.

Q. All right. And you wrote this section, right?

A. Again, yes, with help of counsel.

Roy depo. (EX2014), taken Dec. 6, 2021 (rough transcript) at 57: 2-58:13.

However, a comparison of the two reports shows that the only edits that were actually made in those two parts are regarding formats like punctuations, ways of enumeration, and from "POSITA" to "POSA". There are no substantive differences whatsoever between the two documents. *See Attachment A.*

Further, Dr. Roy testified under oath that he performed analysis on *Talukdar* and *Nystrom* and wrote it down in his report, and further revised and refined it:

Q. Okay. So you performed this analysis on Talukdar and Nystrom and wrote it down in your report?

A. That is correct, yes.

Q. Was -- and, again, was this written by you, or was this written by your attorneys?

A. Again, in consultation with the attorneys, you know, initial draft, which I revised, refined.

Q. Okay. Let's take a look at the --I'm sorry. Let me -- so you said which you revised and refined.

So I'm sorry. The original draft then came from your attorneys, and you revised it?

A. So in this -- I mean for this part, yes, I would recall that it came from them, and I revised and refined it, yes.

Q. Okay. How much -- how much revisions did you have? Did you change it a lot? Did you add a lot, or did you basically just read it and sign it?

A. I, of course, did read it, and there were some changes that I -- that I suggested that were incorporated --

Roy depo. (EX2014), taken Dec. 6, 2021 (rough transcript) at 68: 20- 69:22.

However, a comparison of the two reports shows that the only edits that were actually made in those two parts are regarding formats like punctuations, ways of enumeration, and from “POSITA” to “POSA”. There are no substantive differences whatsoever between the two documents. *See* Attachment A.

Dr. Roy testified under oath that his report reflected his own analysis of Li, Nystrom and Talukdar, and claimed that he spent >20 hours on drafting up his opinion and iterative revisions:

Q. your report reflects your analysis of *Li, Nystrom, and Talukdar*, right. . . . Did you hear me?

A. Oh, yes, Sorry. I responded correct, yes.

Q. Okay. I'm sorry. I did not hear your response how much time did you spend, you know, drafting up your opinion and analysis and putting it down in this report?

A. You mean in number of hours, you know, this was iterative over several weeks, so I would say again, 20, 25 hours in this.

Q. Okay. So there -- you said iterative, so there were versions you get a version edited and get a new version and go back and forth like that?

A. That's correct, yes, and then discuss the prior art or -- you know, other references that I may have discovered, so . . .

Roy depo. (EX2014), taken Dec. 6, 2021 (rough transcript) at 79: 9- 80:3.

However, a comparison of the two reports shows that the only edits that were

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