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IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

TOUCHSTREAM TECHNOLOGIES, INC.,

Plaintiff,

v.

CHARTER COMMUNICATIONS, INC. et al.,

Defendants.

TOUCHSTREAM TECHNOLOGIES, INC.,

Plaintiff,

v.

COMCAST CABLE COMMUNICATIONS, LLC, D/B/A XFINITY, et al.,

Defendants.

Lead Case No. 2:23-cv-00059-JRG
Member Case No. 2:23-cv-00062-JRG

MOTION TO STRIKE THE OPINIONS OF
MICHAEL I. SHAMOS, PH.D.

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I. INTRODUCTION

Plaintiff Touchstream commenced this Action on February 16, 2023 against Defendant Charter, alleging infringement of three patents: U.S. Patent Nos. 8,356,251, 11,048,751, and 11,086,934 ("the Asserted Patents). (*See* Dkts. 1, 50). Touchstream accuses Charter of infringing certain claims of each of these Asserted Patents ("the Asserted Claims").

Charter's technical expert, Dr. Michael Shamos, served two expert reports in this case. First, he served an expert report opining on invalidity on June 24, 2024 ("Shamos Invalidity Report"). Second, he served a report rebutting the infringement opinions of Touchstream's expert, Dr. Wicker, on July 15, 2024. ("Shamos Non-Infringement Report").

Certain opinions in each report should be excluded. ***First***, the Court should exclude Dr. Shamos's "Three Anys" opinions, which draw legally insufficient technical conclusions about the scope of Touchstream's patents from cherry-picked Touchstream marketing statements that its commercial product enables ***any*** mobile device to direct content from ***any*** source to ***any*** display device. ***Second***, the Court should exclude Charter's and Dr. Shamos's "independent development" opinions as seeking to inject an undisclosed counter-invention invalidity theory into trial under the guise of damages and willfulness. ***Third***, the Court should exclude Dr. Shamos's invalidity opinions involving a Comcast Xfinity TV Remote app "system" as improperly cobbling together dozens of references on disparate products, developed over many months by different teams, each possessing distinct features and functionalities, and calling them a single "system" reference.

Because each of these opinions suffers from fundamental deficiencies, including under FRE 702, 402, 403, FRCP 37(c), and/or certain of the Court's standing MILs, Touchstream respectfully requests the Court to exclude them from the jury trial.

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II. LEGAL STANDARDS

A. Motion to Strike Standard

"If a party fails to provide information or identify a witness as required by Rule 26(a) or (e), the party is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless." FED. R. CIV. P. 37(c). Where there has been abuse of the discovery process, the Federal Rules of Civil Procedure authorize district courts to prohibit the admission of evidence proffered by the disobedient party. *Heidtman v. Cty. of El Paso*, 171 F.3d 1038, 1040 (5th Cir. 1999).

B. *Daubert* Standard

An expert witness may provide opinion testimony if "(a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case." FED. R. EVID. 702.

Federal Rule of Evidence 702 requires a district court to make a preliminary determination, when requested, as to whether the requirements are satisfied with an expert's proposed testimony. *See Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 149 (1999); *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 592–93 (1993). District courts are given broad discretion in making Rule 702 determinations of admissibility. *Kumho Tire*, 526 U.S. at 152.

III. ARGUMENT

A. The Court Should Strike Dr. Shamos's "Three Anys" Opinions as a Legally Erroneous Attempt to Argue Claim Construction to the Jury.

The Court should strike Dr. Shamos's opinions directed to the Touchstream "Three Anys." These legally erroneous opinions seek to argue claim construction to the jury and to confuse the

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jury about the proper legal framework for deciding infringement. Neither Charter nor Dr. Shamos offer these opinions for any legitimate purpose, and any marginal probative value of these opinions is grossly outweighed by the potential for juror confusion and prejudice to Touchstream. These opinions are improper for the jury and should be excluded.

It is well settled that claim construction is a legal issue decided by the Court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 387 (1996). It is improper for experts to argue claim construction to the jury because the "risk of confusing the jury is high when experts opine on claim construction." *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1337 (Fed. Cir. 2009) (quoting *CytoLogix Corp. v. Ventana Med. Sys., Inc.*, 424 F.3d 1168, 1172-73 (Fed. Cir. 2005)). Furthermore, "[n]o party may contradict the [C]ourt's [claim] construction to a jury." *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1321 (Fed. Cir. 2009). "Incorrect claim construction statements go to the relevance of the expert's opinion, and thus form a basis to exclude an expert's opinion." *Ultravision Techs., LLC v. GoVision LLC*, No. 2:18-cv-00100- JRG-RSP, 2021 WL 2144788 (E.D. Tex. May 26, 2021).

Relying on statements from undated Touchstream investor presentations and other marketing materials describing Touchstream's "patent-pending" commercial product offerings, Charter's technical expert, Dr. Shamos, opines that "[a] POSITA would recognize that ***the Asserted Claims*** attempt to claim methods that ***must permit*** use of ***any*** personal computing device to control the delivery and playback of content from ***any*** source to ***any*** display device." (Ex. 1, Shamos Invalidity Report ¶¶ 230-231, Ex. 2, Shamos Non-Infringement Report ¶¶ 134-135, Ex. 3, TS_COMCAST-0092857, Ex. 4, TS_COMCAST-00085928). Dr. Shamos coins this concept the Touchstream "Three Anys." (*See id.*). He then compares various terms from the Asserted Claims to these marketing statements, concluding that "a POSITA would understand that these limitations

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are directly related to ***enabling the Three Anys***." (Ex. 1, Shamos Invalidity Report ¶¶ 232-234; Ex. 2, Shamos Non-Infringement Report ¶¶ 136-138). Next, Dr. Shamos cites language from internal company correspondence authored by the named inventor of the Asserted Patents, David Strober, to other Touchstream employees discussing whether an unrelated product from an unrelated third party is "using our patent." In citing this correspondence—which predates issuance of the earliest Asserted Patent in this case by fifteen months—Dr. Shamos opines that it "is unsurprising" that "Charter does not infringe any Asserted Claim" since the Asserted Claims "are all set up to enable a system built around Touchstream's 'Three Anys.'" (Ex. 2, Shamos Non-Infringement Report ¶¶ 139-140).

Dr. Shamos's "Three Anys" opinions improperly invade claim construction issues reserved exclusively for the Court. As Dr. Shamos admits, none of the "Three Anys" language appears in any of the Asserted Claims. (Ex. 5, Shamos Dep. Tr. at 214:12-215:6). Insofar as Charter sought to import these requirements into the Asserted Claims—such as through a lexicography or disclaimer argument—it should have done so during claim construction. But claim construction is now complete and this case is set for trial in less than three months. Charter provides no legitimate basis to offer the jury expert opinions about requirements of the Asserted Claims derived from statements in Touchstream marketing materials without the Court having construed the claims in the manner Charter proposes. *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359 (Fed. Cir. 2017) (quoting *Omega Eng'g, Inc. v. Raytek Corp.*, 1323-24 (Fed. Cir. 2003)) (Prosecution disclaimer is "a fundamental precept in [the Federal Circuit's] claim construction jurisprudence.").

Even if Charter were permitted to reargue claim construction at this late stage, the "Three Anys" are irrelevant to the scope of the Asserted Claims for several reasons. First, this language does not appear in the Asserted Claims or the intrinsic record, and "expert testimony may not be

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