

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

LEADER TECHNOLOGIES, INC., a Delaware corporation,)	
)	
Plaintiff-Counterdefendant,)	Civil Action No. 08-862-JJF/LPS
)	
v.)	
)	PUBLIC VERSION
FACEBOOK, INC., a Delaware corporation,)	
)	
Defendant-Counterclaimant.)	

**LEADER TECHNOLOGIES, INC.'S MOTION *IN LIMINE* NO. 1
TO EXCLUDE PORTIONS OF EXPERT TESTIMONY OF SAUL GREENBERG**

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I. INTRODUCTION

Facebook, Inc.'s ("Facebook") position that the patent-in-suit, United States Patent No. 7,139,761 ("the '761 Patent"), is obvious is akin to throwing mud at a wall to see what sticks. Instead of mud, however, Facebook's invalidity expert, Dr. Saul Greenberg, attempts to use his anticipation charts to see what will stick for his purported obviousness opinion. Dr. Greenberg does not try to hide this fact. The extent of his obviousness opinion, which relies on a combination of references, is that [REDACTED]

[REDACTED] Declaration of Paul J. Andre in Support of Leader's Motion *In Limine* Nos. 1-7 ("Andre Decl."), ¶ 2, Ex. 1 (Greenberg Report at 38). This type of conclusory statement is precisely what the Federal Rules of Evidence and case law prohibit. Accordingly, Dr. Greenberg should not be permitted to testify regarding any combinations of prior art because he did not provide any analysis to support a reliable opinion based on sufficient facts or data in his report, as required by the Federal Rules of Civil Procedure.

The same holds true for Dr. Greenberg's opinion with regard to alleged [REDACTED]

[REDACTED] Rather than provide a detailed element by element analysis, Dr. Greenberg simply states that the asserted claims are obvious because [REDACTED]

[REDACTED] Andre Decl., ¶ 2, Ex. 1 (Greenberg Report at 34). Dr. Greenberg does not provide a chart, or any other type of analysis, indicating which prior art, or even [REDACTED]

[REDACTED] should be combined to render the '761 Patent obvious. Consequently, Dr. Greenberg should not be allowed to testify that basic Internet functionality renders the '761 Patent obvious.

In addition to the lack of analysis with regard to obviousness, Dr. Greenberg improperly relies upon the “incorporation by reference” doctrine in his anticipation analysis. Specifically, Dr. Greenberg bases his purported anticipation opinion on the premise that the mere recitation of another document is sufficient to incorporate the entire document by reference. Andre Decl., ¶ 5, Ex. 4 (Deposition of Saul Greenberg (“Greenberg Depo.”) at 27:22-31:7). This is contrary to the law which requires incorporation be done with detailed particularity. Since the prior art Dr. Greenberg relies upon does not identify what specific material it incorporates or where that material is found in the reference that Dr. Greenberg is attempting to incorporate, he is precluded as a matter of law from incorporating by reference for anticipation purposes. Thus, the portions of Dr. Greenberg’s opinion which are based on his faulty application of the incorporation by reference doctrine should be excluded at trial.

Finally, Dr. Greenberg should not be allowed to speculate as to what may have happened at the USPTO during the prosecution of the ‘761 Patent. Clearly, Dr. Greenberg has no basis for this opinion and its introduction at trial is severely prejudicial and will likely confuse the jury.

II. ARGUMENT

A. LEGAL STANDARD FOR ADMITTING EXPERT TESTIMONY

Federal Rule of Evidence 702 obligates judges to ensure that any scientific testimony or evidence is relevant and reliable. *See Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 589 (1993); Fed. R. Evid. 702. “The subject of an expert’s testimony must be grounded in the methods and procedures of science and based on more than a subjective belief or speculation.” *Oxford Gene Tech. Ltd. v. Mergen Ltd.*, 345 F. Supp. 2d 431, 434 (D. Del. 2004); *Daubert*, 509 U.S. at 589. Rule 702 further requires that expert testimony assist the trier of fact. In determining whether the expert’s testimony will assist the trier of fact, the court “must examine

the expert's conclusions in order to determine whether they could reliably follow from the facts known to the expert and the methodology used." *Heller v. Shaw Indus. Inc.*, 167 F.3d 146, 153 (3d Cir.1999). The party offering the expert testimony --here Facebook-- has the burden to prove that the proposed expert testimony is admissible, including the burden of proving that the proposed testimony will assist the trier of fact to decide factual issues. *See Oxford Gene Tech. Ltd.*, 345 F. Supp. 2d at 434.

B. PORTIONS OF DR. GREENBERG'S PROPOSED TESTIMONY REGARDING OBVIOUSNESS SHOULD BE EXCLUDED BECAUSE IT IS NOT THE PRODUCT OF RELIABLE PRINCIPLES AND METHODS

Dr. Greenberg should not be permitted to testify about 1) any combination of the references that he uses for anticipation in his purported obviousness analysis or 2) how basic Internet functionality allegedly renders the '761 Patent obvious. In order to opine on obviousness, Dr. Greenberg was required to provide an "element-by-element comparison to show that each and every limitation in the asserted claims of the ['761 Patent] is present in a combination of prior art references." *Oxford Gene Tech. Ltd.*, 345 F. Supp. 2d at 437 (granting motion to exclude expert's obviousness opinion because he did not perform an element-by-element comparison of each claim to combination of prior art references). Dr. Greenberg failed to make such an analysis and therefore his testimony regarding obviousness for these two issues should be excluded.

1. Dr. Greenberg's Proposed Testimony Regarding A Combination of Anticipation References Should Be Excluded Because He Fails To Undertake An Element by Element Analysis

Dr. Greenberg does not provide an element by element analysis detailing which references should be combined to render the claims of the '761 Patent obvious. In fact, Dr. Greenberg does not even identify which claims are rendered obvious using a combination of

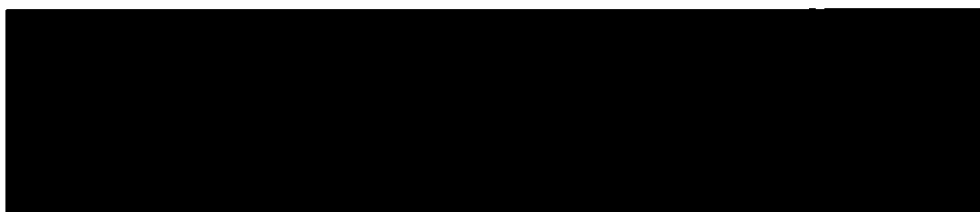
references. Instead, the sum total of Dr. Greenberg's opinion is found in the first sentence of his one paragraph analysis:



Andre Decl., ¶ 2, Ex. 1 (Greenberg Report at 38). The remainder of the paragraph, which contains Dr. Greenberg's complete opinion with regard to a combination of references, is an ambiguous discussion of the motivation that exists to combine the references. *Id.* at 38-39. However, Dr. Greenberg's "motivation" analysis also misses the mark because it generally talks about what the references disclose, rather than why the references should be combined to render a particular claim obvious. Because Dr. Greenberg's analysis is completely devoid of the required "element-by-element comparison to show that each and every limitation in the asserted claims of the ['761 Patent] is present in a combination of prior art references," Dr. Greenberg's opinion regarding a combination of references should be excluded under Rule 702 and Rule 26(a)(2)(B). *Oxford Gene Tech. Ltd.*, 345 F. Supp. 2d at 437.

2. Dr. Greenberg's Obviousness Testimony Regarding Basic Internet Functionality Should Be Excluded Because He Fails To Undertake An Element by Element Analysis

Similar to Dr. Greenberg's opinion regarding a combination of references, Dr. Greenberg completely fails to provide an element by element analysis with regard to his opinion regarding basic Internet functionality and how that functionality allegedly renders the '761 Patent obvious. In Dr. Greenberg's report, he provides:



[REDACTED]

Andre Decl., ¶ 2, Ex. 1 (Greenberg Report at 33). Rather than providing an element by element analysis, Dr. Greenberg simply states:

[REDACTED]

Id. at 34. As shown, Dr. Greenberg only offers a conclusion that it is possible to substitute [REDACTED] [REDACTED]. Not only is this technically wrong, it is insufficient as a matter of law because he has not provided a detailed element by element analysis of the prior art. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (holding “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (emphasis added). Therefore, Dr. Greenberg’s opinion that the ‘761 Patent is obvious in light of [REDACTED] should be also excluded.

B. DR. GREENBERG’S PROPOSED TESTIMONY REGARDING INCORPORATION BY REFERENCE TO COMBINE REFERENCES FOR ANTICIPATION SHOULD BE EXCLUDED

Dr. Greenberg improperly uses the doctrine of incorporation by reference to combine (1)

[REDACTED]

the purposes of anticipation.¹ Thus, any proposed testimony of Dr. Greenberg, including any proposed claim charts on the topic, that rely on such improper analysis should be excluded at trial. *See* Andre Decl., ¶ 2, Ex. 1 (Greenberg Report at 24-26 and 31-32); *see also id.*, ¶¶ 3-4, Exs. 2-3 (Greenberg Report, Exs. C-1 and C-7). Rather than incorporating specific “subject

¹ Notably, the Federal Circuit dictates that the determination of whether and to what extent material was incorporated by reference into prior art that allegedly anticipates the patent at issue is a matter of law. *See Advanced Display Sys. Inc.*, 212 F.3d at 1283. Thus, incorporation by reference is not an issue for the jury to decide.

matter” by reference, Dr. Greenberg testified that he used incorporation by reference to incorporate a reference [REDACTED] *Advanced Display Sys. Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 Fed. Cir. 2000). For example, for his analysis of [REDACTED]

Dr. Greenberg states:

[REDACTED]

Id., ¶ 5, Ex. 4 (Greenberg Depo. at 34:14-18). Instead, it is well established that “mere reference to another application, or patent, or publication is not an *incorporation* of anything therein....” *In re De Seversky*, 474 F.2d 671, 674 (CCPA 1973)(emphasis in original). Instead, specific material from a document may be incorporated by reference only when a host document contains language “clearly identifying the subject matter which is incorporated and where it is to be found.” *Id.* at 674. Put differently, “the host document must identify with *detailed particularity* what specific material it incorporates and clearly indicate where that material is found in the various documents.” *See Advanced Display Sys. Inc.*, 212 F.3d at 1282.

Dr. Greenberg, however, failed to provide any analysis into whether [REDACTED]

[REDACTED]

[REDACTED] respectively. Shockingly, Dr. Greenberg’s analysis of [REDACTED]

[REDACTED] as it merely makes the following

conclusory statements:

[REDACTED]

Andre Decl., ¶ 2, Ex. 1 (Greenberg Report at 25). Furthermore, Dr. Greenberg’s understanding that the Manual of Patent Examination and Procedure (“MPEP”) § 2163.07(b) entitles him to

treat two patents as a single prior art reference is also misplaced, as this patent office provision has no bearing on determinations of anticipation. Instead, MPEP § 2163.07(b) is narrowly used to determine whether a patent applicant has complied with the requirements of 35 U.S.C. § 112, not anticipation. Accordingly, any of Dr. Greenberg's analysis that relies on his [REDACTED]

[REDACTED] is improper as a matter of law and lacks the sufficient analysis to make it reliable under Rule 702 or admissible under Federal Rule 26(a)(2)(B).

C. DR. GREENBERG'S SPECULATION REGARDING THE EXAMINATION OF THE '761 PATENT SHOULD BE EXCLUDED

Dr. Greenberg's opinion as to the '761 Patent's examination at the Patent Office is mere speculation and should be excluded. Specifically, Dr. Greenberg declares:

[REDACTED]

Andre Decl., ¶ 2, Ex. 1 (Greenberg Report at 24). "Such statements are inadmissible because they seek to call into question the statutory presumption of validity established in 35 U.S.C. § 282." *American Med. Sys., Inc., v. Laser Peripherals, LLC*, 2010 WL 1957479, at *11 (D. Minn. May 13, 2010) (citations omitted). This Court excludes precisely this type of baseless expert testimony. *See Dow Chemical Canada Inc. v. HRD Corporation*, 656 F. Supp. 2d 427, 435 (D. Del. 2009) (excluding expert's opinion that "[b]ased on USPTO evaluations of the HRD patent applications, it is reasonable to assume that the USPTO did not grant HRD a patent due to the information that was

omitted....”). In fact, Dr. Greenberg’s deposition confirms that his opinion is based on mere speculation:



Andre Decl., ¶ 5, Ex. 4 (Greenberg Depo. at 162:17-163:14). Dr. Greenberg’s speculative opinion is contrary to established law that requires the subject of an expert’s testimony be based on “more than a subjective belief or speculation.” *See Daubert*, 509 U.S. at 589-590. Accordingly, Dr. Greenberg’s speculation as to the examination of the ‘761 Patent should be excluded under Rule 702.

III. CONCLUSION

For the foregoing reasons, Leader respectfully requests the Court to grant its motion and exclude portions of Dr. Greenberg’s proposed testimony at trial.

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CERTIFICATE OF SERVICE

I, Philip A. Rovner, hereby certify that on May 26, 2010, the within document was filed with the Clerk of the Court using CM/ECF which will send notification of such filing(s) to the following; that the document was served on the following counsel as indicated; and that the document is available for viewing and downloading from CM/ECF.

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