IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

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

LEADER TECHNOLOGIES, INC.'S MOTION *IN LIMINE* NO. 2
TO EXCLUDE PORTIONS OF EXPERT TESTIMONY OF MICHAEL KEARNS

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I. INTRODUCTION

Facebook, Inc. ("Facebook") is attempting to get two bites at the apple on the issue of invalidity. Essentially, Facebook is attempting to offer invalidity testimony in 1) its case-in-chief through its invalidity expert and 2) its rebuttal case through its non-infringement expert. Facebook's tactics are highly prejudicial to Leader and violate applicable statutes, the Court's Scheduling Order and the case law. Accordingly, Leader Technologies, Inc. ("Leader") is seeking to exclude Facebook, Inc. ("Facebook") from eliciting any purported invalidity testimony from its rebuttal non-infringement expert.

In addition, Facebook appears to be attempting to offer testimony regarding Leader's products from its non-infringement expert. Facebook's rebuttal expert should only be discussing Facebook's products, not Leader's products. As such, Leader hereby moves to exclude Facebook from eliciting any testimony regarding Leader's products from its rebuttal non-infringement expert.

II. STATEMENT OF FACTS

Leader submitted an expert report from Dr. Giovanni Vigna regarding Facebook's infringement of the United States Patent No. 7,139,761 ("the '761 Patent") on April 8, 2010. On April 22, 2010, Facebook submitted an expert report from Dr. Michael Kearns in rebuttal to Dr. Vigna's expert report (the "Kearns Report"), attached hereto as Exhibit 5 to the Declaration of Paul J. Andre in Support of Leader's Motion *In Limine* Nos. 1-7 ("Andre Decl.").

At first glance, Dr. Kearns' expert report appears to be a non-infringement report which attempts to rebut the opinions of Dr. Vigna. A closer look, however, reveals that Dr. Kearns is also attempting to offer a purported invalidity opinion. Specifically, Dr.

Kearns' expert report repeatedly asserts that the '761 Patent is "invalid" and "obvious" in light of numerous alleged prior art references, most of which Facebook never disclosed to Leader during discovery. Andre Decl., ¶ 6, Ex. 5 (Kearns Report at 41-43, 45, 52, 61); *id.*, ¶ 7, Ex. 6 at 36-118.

Dr. Kearns was deposed on May 6, 2010. During his deposition, Dr. Kearns testified that he [redacted] Andre Decl., ¶ 8, Ex. 7 (Deposition of Michael Kearns ("Kearns Depo") at 7:24-8:6; 126:22-128:14; 178:14-25; 180:4-181:19; 207:17-208:1). Moreover, Dr. Kearns admitted that [redacted] *Id.* at 26:8-27:4.

In passing, Dr. Kearns' expert report also contains a reference to Leader's Leader2Leader product. During his deposition, however, Dr. Kearns admitted [redacted] *Id.* at 50:15-51:4; 52:2-22.

III. ARGUMENT

A. FACEBOOK SHOULD NOT BE ALLOWED TO OFFER INVALIDITY EVIDENCE WITH ITS NON-INFRINGEMENT EXPERT

Facebook should not be permitted to offer purported invalidity testimony in its rebuttal case. Federal Rule of Civil Procedure 26(a)(2) and the Court's Scheduling Order require the party with the burden of proof to submit an opening expert report detailing the

expert's opinion. D.I. 76 at 2. Here, Facebook bears the burden of proving by clear and convincing evidence that the '761 Patent is invalid. *Phillips Elec. North America Corp. v. Contec Corp.*, 312 F. Supp. 2d 632, 634 (D. Del. 2004). Thus, Facebook was required to present its entire purported invalidity case with its opening expert report. Leader would then have been able to submit a rebuttal expert report to respond to any of the invalidity issues raised in Facebook's opening expert report.

Facebook is attempting to turn this process on its head. Namely, Facebook is attempting to have its rebuttal expert offer purported invalidity testimony for which Facebook bears the burden of proof. Specifically, Facebook is attempting to have Dr. Kearns discuss a number of alleged prior art references which were never disclosed to Leader during discovery that, according to Dr. Kearns, allegedly render the '761 Patent "invalid" and "obvious." Andre Decl., ¶ 6, Ex. 5 (Kearns Report at 41-43, 45, 52, 61). Not only is this in direct violation of Federal Rule of Civil Procedure 26(a)(2) and the Court's Scheduling Order, but this is highly prejudicial to Leader because it strips Leader of any opportunity to respond to Facebook's allegations and sandbags Leader with previously undisclosed references which Dr. Kearns calls prior art. Consequently, Dr. Kearns should not be allowed to offer any purported testimony on the subject of invalidity, or testify regarding any alleged prior art references, during trial.

B. FACEBOOK SHOULD NOT BE ALLOWED TO OFFER INVALIDITY EVIDENCE BECAUSE IT IS NOT A RELIABLE OPINION

Federal Rule of Evidence 702 entrusts the Court to admit expert testimony that is "not only relevant, but reliable." *See Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 589 (1993). Expert testimony cannot be mere "subjective belief or unsupported speculation." *Id.* at 590. Federal Rule of Evidence 702 requires that the testimony must

be "based upon sufficient facts or data" and "the product of reliable principles and methods." Fed. R. Evid. 702. In reaching an expert opinion, the expert must have "applied the principles and methods reliably to the facts of the case." *Id.* Ultimately, the proffered testimony must "assist the trier of fact to understand the evidence or to determine a fact in issue...." *Id.*

Dr. Kearns attempts to offer a purported invalidity opinion, yet provides no invalidity analysis to support his naked conclusion. In his report, Dr. Kearns simply names [redacted] See Andre Decl., ¶ 6, Ex. 5 (Kearns Report at ¶¶ 80-89, 108, 110 & 136). Dr. Kearns does not provide any analysis [redacted] He also does not compare [redacted] which is necessarily required for any basic invalidity analysis.

Dr. Kearns confirmed his lack of analysis during his deposition. He testified that [redacted] Andre Decl., ¶ 8, Ex. 7 (Kearns Depo. at 7:24-8:6; 126:22-128:14; 178:14-25; 180:4-181:19; 207:17-208:1). Not only was Dr. Kearns' purported invalidity opinion improperly disclosed in a rebuttal report, as described above, it is also not based on sufficient facts or data.

Further examples of the unreliable nature of Dr. Kearns' purported invalidity opinion are [redacted] In his report, Dr. Kearns claims that [redacted] Andre Decl., ¶ 6, Ex. 5 (Kearns Report at 42-44). Apart from the fact that this analysis is wholly inadequate for a scientific opinion, it is improper and highly prejudicial[3] because Dr. Kearns is comparing those references to exemplary use cases, as opposed to the actual asserted claims of the '761 Patent. Moreover, Dr. Kearns' commentary does not mention the backend component of the alleged prior art websites or their source code, even though the asserted claims are directed to these components. Accordingly, Dr. Kearns should be precluded from offering any proposed testimony on the issue of invalidity and any alleged prior art because such testimony is not reliable, is not based on any disclosed analysis, facts or data and will not assist the jury in understanding the evidence or determine a fact at issue. *See e.g.*, *General Elec. Co. v. Joiner*, 522 U.S. 136, 146 (1997); *see also* Fed. R. Evid. 702.

C. FACEBOOK'S PROFFERED TESTIMONY REGARDING THE DOCTRINE OF EQUIVALENCE IS IMPROPER

Facebook's apparent reason for having its non-infringement expert testify regarding a variety of prior art references is to restrict the doctrine of equivalence so that it does not allegedly "ensnare" the purported prior art. Facebook's attempt to introduce

[1] Notably, neither of these references are prior art because they are not enabling references.
[2] A use case is a narrative of the actions that can be performed by a user while using a product. As a use case is narrated from the perspective of the user, it does not fully illustrate all of the backend components of a system.
[3] Any proposed testimony by Dr. Kearns will also confuse the jury because it will lead the jury to believe that use cases can be compared to each other and that an element-by-element analysis of the claims to alleged prior art is not necessary, despite the law to the contrary.

these prior art references at trial should be denied because it is contrary to the case law. The Federal Circuit specifically held that it is not proper to bring evidence of ensnarement in front of a jury. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1324 (Fed. Cir. 2009). Thus, it is improper for Facebook to submit any invalidity testimony, or discussion of any prior art references, from its non-infringement expert during trial.

Furthermore, Facebook's attempts to restrict the doctrine of equivalence is wrong as a matter of law. As pointed out above, Dr. Kearns did not provide an element-by-element analysis with regard to [redacted] As such, Dr. Kearns cannot reliably conclude [redacted] Moreover, Dr. Kearns did not consider the prosecution history in forming his opinion. Andre Decl., ¶ 8, Ex. 7 (Kearns Depo. at 26:8-27:4). In fact, during his deposition, he did not know [redacted] *Id.* Because the prosecution history has a direct impact on the breadth of the doctrine of equivalence, Dr. Kearns cannot provide a reliable opinion that [redacted] Therefore, any proposed testimony by Dr. Kearns regarding purported invalidity issues or prior art should be excluded.

D. FACEBOOK'S NON-INFRINGEMENT EXPERT SHOULD NOT BE ALLOWED TO TESTIFY REGARDING LEADER'S PRODUCTS

Dr. Kearns should also not be allowed to testify regarding Leader's products. In Dr. Kearns' expert report, he mentions Leader's Leader2Leader product in his summary

of the '761 Patent. Specifically, he references the Leader2Leader product and opines that [redacted]

Dr. Kearns' proposed testimony is improper and should not be allowed in front of the jury. Dr. Kearns was commissioned to compare the Facebook website to the '761 Patent. Andre Decl., ¶ 8, Ex. 7 (Kearns Depo. at 7:24-8:6). He was not commissioned to compare Leader's products to the '761 Patent. *Id.* at 50:15-51:4; 52:2-22. In fact, during deposition, Dr. Kearns admitted tha[redacted] *Id.* Furthermore, Dr. Kearns' statement in his expert report suggests that he has formed an opinion regarding[redacted] However, during his deposition, Dr. Kearns confirmed that he [redacted] *Id.* at 50:25-51:4. Thus, any testimony offered by Dr. Kearns on the issue regarding Leader2Leader and its relationship to the '761 Patent would be misleading and only serve to confuse the jury. For at least these reasons, any proposed testimony by Dr. Kearns regarding Leader's product should not be allowed.

IV. CONCLUSION

For the reasons set forth above, Dr. Kearns should not be allowed to testify regarding any prior references or offer an opinion regarding the invalidity of the '761

[redacted]

Patent. In addition, Dr. Kearns should not be allowed to testify regarding Leader's products.

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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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