

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

LEADER TECHNOLOGIES, INC., a  
Delaware corporation,

Plaintiff and Counterdefendant,

v.

FACEBOOK, INC., a Delaware  
corporation,

Defendant and Counterclaimant.

Civil Action No. 1:08-cv-00862-JJF

**PUBLIC VERSION**

**FACEBOOK INC.'S OPPOSITION TO PLAINTIFF'S  
MOTION IN LIMINE NO. 1 TO EXCLUDE PORTIONS OF  
EXPERT TESTIMONY OF SAUL GREENBERG**

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Filed: May 27, 2010  
Public Version Filed: June 3, 2010

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a Delaware corporation,	)	<b>CIVIL ACTION</b>
	)	
Plaintiff and Counterdefendant,	)	<b>No. 1:08-cv-00862-JJF</b>
	)	
v.	)	<b>CONFIDENTIAL</b>
	)	<b>FILED UNDER SEAL</b>
FACEBOOK, INC.,	)	
a Delaware corporation,	)	
	)	
Defendant and Counterclaimant.	)	
_____	)	

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## I. INTRODUCTION

LTI's motion seeks to preclude Dr. Greenberg, Facebook's expert on non-infringement, from (a) offering certain opinions regarding obviousness of the asserted claims of the '761 patent; (b) testifying about whether certain prior art references "incorporate by reference" other documents for purposes of anticipation; and (c) making any mention of what occurred in the prosecution of the '761 patent. These requests are without merit and should be rejected.

## II. ARGUMENT

### A. LTI's Objection to Dr. Greenberg's Opinions on the "Web Based" Features of the Asserted Claims is Without Merit

LTI has taken the position that some of the anticipatory prior art references identified by Dr. Greenberg were not "web-based" systems, as recited in independent claims 9, 21 and 23 of the '761 patent. Dr. Greenberg responded to this point by noting that to the extent it was argued that references he identified as anticipatory were not "web-based" systems, adapting them to use the World Wide Web would have been entirely obvious to one of ordinary skill in the art. *See* Declaration of Kathryn Robinson in Support of Facebook's Oppositions to Leader Technology, Inc.'s Pretrial Motions ("Robinson Decl."), Ex. 1 ¶¶ 64-66.

LTI's complaint regarding Dr. Greenberg's analysis is based on a misstatement of his actual opinions. Dr. Greenberg did not opine that basic Internet functionality *by itself* renders the '761 patent obvious. He instead opined that to the extent LTI contends that the anticipatory systems upon which he relies are not "web-based" as claimed in the '761 patent, the combination of such systems with well-known Internet and web technologies would render the claims obvious to one of ordinary skill in the art. *Id.* ¶ 66. The only allegedly missing element Dr. Greenberg addressed in this aspect of his opinion was the use of a "web-based" system. LTI's assertion that Dr. Greenberg did not provide a "claim chart" or "element by element analysis" is simply wrong and misguided. He

provided more than 160 pages of detailed claim charts explaining where each element of each asserted claims was found within the seven anticipatory prior art references he relies upon. An additional element-by-element claim chart was hardly required to address a single allegedly missing element, which he fully addressed in his report.

Dr. Greenberg provided a detailed analysis and explanation of how the use of a “web-based” system did not present a non-obvious distinction between the anticipatory prior art and the claims of the ’761 patent. He observed that (1) websites and web browsers had been in existence since at least 1989; (2) millions of websites were in existence at the time the ’761 patent was filed; (3) the use of Internet and World Wide Web technologies was standard curriculum in computer science courses at that time; and (4) the techniques to incorporate these technologies were widely available and accessible. *See* Robinson Decl., Ex. 1 ¶¶ 65-66. He further explained that adapting a non-web-based system to use the World Wide Web would have entailed a simple substitution of known elements producing predictable results, and identifies several clear motivations to combine. *Id.* ¶ 66. LTI’s assertion that Dr. Greenberg did not provide a sufficient analysis as to how the additional element of “web-based” functionality would have been obvious is simply unfounded.

Moreover, it is difficult to imagine that LTI actually intends to argue to the jury that providing user functionality through a website adequately distinguishes the ’761 patent from the prior art. This proposition is so baseless that Dr. Greenberg’s expert testimony is arguably not even required to rebut it. The Federal Circuit recognized as much in *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318 (Fed. Cir. 2008), which reversed a jury verdict of infringement and found the asserted claims in that case – which differed from the prior art only in that they used web-based technologies – obvious *as a matter of law*. *Id.* at 1325-26. The court noted that by May 1998 (the filing date of the patent at issue in that case), “adapting existing electronic processes to incorporate modern internet and web browser technology was similarly commonplace,” and did not present a

non-obvious distinction over the prior art. *Id.* at 1326-27. The same must certainly have been true by the time the application for the '761 patent was filed more than five years later.<sup>1</sup>

**B. LTI's Objection to Dr. Greenberg's Opinion Regarding Combinations of Anticipatory References is Without Merit**

LTI also complains that Dr. Greenberg did not provide an adequate analysis of how the combination of anticipatory prior art references renders the claims of the '761 patent obvious under 35 U.S.C. § 103. This argument fails for the same reasons discussed above. LTI's claim that Dr. Greenberg did not provide an element-by-element analysis of the prior art references overlooks the fact that Dr. Greenberg provided detailed element-by-element claim charts for each of the seven prior art references he relies upon in his report, each chart comparing a prior art reference with each asserted claim. LTI elevates form over substance by suggesting that Dr. Greenberg should have duplicated these detailed claim charts into multiple sections of his report.

For this reason, LTI's reliance on *Oxford Gene Technology Ltd. v. Mergen Ltd.*, 345 F. Supp. 2d 431 (D. Del. 2004) (Jordan, J.) is misplaced. The defendant in that case (who was represented by LTI's counsel in this case) failed to submit any claim charts with its invalidity expert's report. *Id.* at 437. The court faulted the expert's failure to provide an explanation as to where the elements of the asserted claims were found in the prior art, and found that this rendered the expert's opinions on anticipation "irretrievably inadequate." *Id.* In this case, however, Dr. Greenberg provided detailed claim charts clearly explaining precisely where each element of each asserted claim is located within each prior art reference. *Oxford Gene Technology* is inapposite.

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<sup>1</sup> Dr. Greenberg's report continues by opining that claim 16 (which claims a "portable wireless device"), claim 31 (which claims a "relational storage methodology"), and claim 32 (which claims "many-to-many functionality") are also obvious in view of the prior art. *See* Robinson Decl., Ex. 1 ¶¶ 67-73. LTI raises no objection to any of those opinions in its motion *in limine*.

Dr. Greenberg also explained that although each of those references anticipates under 35 U.S.C. § 102, they can also be combined to render the claims obvious. *See* Robinson Decl., Ex. 1 ¶ 74.

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LTI may not agree with Dr. Greenberg's position that these references render the '761 patent, but it has made no showing that his explanation is unreliable or otherwise inadmissible.

**C. The Court Should Resolve the "Incorporation By Reference" of Prior Art References as a Matter of Law Before Trial**

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Each of these references "incorporates by reference" the disclosures of an earlier patent application filed by the same inventor or applicant.

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"Material not explicitly contained in the single, prior art document may still be considered for purposes of anticipation if that material is incorporated by reference into the document." *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000); *see also Telemac Cellular Corp. v. Topp*



*Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001) (“When a document is ‘incorporated by reference’ into a host document, such as a patent, the referenced document becomes effectively part of the host document as if it were explicitly contained therein.”).

Facebook agrees with LTI that “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 D.I. 417, Leader Technologies, Inc.’s Motion *in Limine* No. 1 to Exclude Portions of Expert Testimony of Saul Greenberg (“Motion”) at 5 n.1. Facebook also agrees with LTI that “incorporation by reference is not an issue for the jury to decide.” *Id.* In fact, the Federal Circuit has held that it is reversible error for a district court to charge the jury with the task of determining whether or not material was incorporated by reference into another document for purposes of anticipation. See *Advanced Display Sys., Inc.*, 212 F.3d at 1283-84. For this reason, Facebook has brought its own motion *in limine* to preclude LTI’s invalidity expert, James Herbsleb, from testifying on this issue. This Court should therefore determine, as a matter of law prior to the commencement of trial in this action:

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LTI’s arguments are based on the faulty premise that a host document cannot “incorporate by reference” the disclosures of a second document unless the host document identifies the exact sentences or passages that are incorporated from the second document. This is clearly not the law. The Federal Circuit in *Harari v. Hollmer*, 602 F.3d 1348 (Fed. Cir. 2010), for example, held that a patent application properly incorporated by reference the entirety of two earlier patent applications by simply identifying the earlier applications by title and inventor and stating that “[t]he disclosures of the two applications are hereby incorporated by reference.” *Id.* at 1350. The court held that “[i]t is not inappropriate for an application to identify for the purposes of

incorporation by reference a co-pending application by title, inventors, and a context-specific filing date, where such information is sufficient to identify the application at the time the information is presented.” *Id.* at 1353-54.

exceed the requirement set forth in *Harari* by identifying the actual U.S. Patent Office serial number that was assigned to the prior applications at the time they were filed.

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These statements clearly and unequivocally incorporate by reference the entirety of the disclosures in the prior-filed applications. Moreover, one of ordinary skill in the art could clearly have retrieved the incorporated documents based on their application numbers, which provide a clearer and more precise identification than one blessed by the Federal Circuit in *Harari*. LTI’s arguments to the contrary should be rejected.

The authorities cited by LTI do not undermine this result. LTI cites *In re of De Seversky*, 474 F.2d 671 (C.C.P.A. 1973), but the patent application in that case “contain[ed] no ‘incorporation-by-reference’ language whatsoever.” *Id.* at 674. *De Seversky* merely held that a host document’s mere *reference* to a second document (without language of incorporation) does not *ipso facto* incorporate the second document into the host document. *Id.*

LTI makes too much of the statement from *Advanced Display Systems, supra*, that “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.” 212 F.3d at 1282 (emphasis added). This statement does not impose a requirement that the host document contain a line-by-line identification or description of the material being incorporated. That would defeat the whole purpose of incorporation by reference. The Federal Circuit has made clear that this standard is satisfied when the host document “identifies with specificity both what material is being incorporated by reference . . . and where it may be found.” *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1346 (Fed. Cir. 2009).

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**D. LTI Should Not Be Allowed to Speculate that the Examiner Considered the Prior Art References Cited in Dr. Greenberg’s Report When She Clearly Did Not**

Finally, LTI seeks to preclude Dr. Greenberg from providing what LTI calls “speculation regarding the examination of the ’761 patent.” Motion at 7. LTI has again misstated the substance of Dr. Greenberg’s testimony. LTI’s motion selectively block-quotes a portion of Dr. Greenberg’s report but fails to include the preceding two sentences, which read: “At the time the application for the ’761 patent was filed, there

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<sup>2</sup> LTI also argues that Manual of Patent Examining Procedure (“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.” Motion at 7. This argument is beside the point, as Federal Circuit law itself makes clear that

In any event, LTI cites nothing to support its assertion regarding the scope of MPEP § 2163.07(b), nor has it provided any explanation as to why the standard for incorporation by reference under § 112 should be any different from § 102. Courts have used the standard set forth in MPEP § 2163.07(b) to assess incorporation by reference for purposes of anticipation. *See, e.g., SRI Int’l Inc. v. Internet Sec. Sys., Inc.*, 456 F. Supp. 2d 623, 626-27 & n.10 (D. Del. 2006), *aff’d in relevant part, vacated on other grounds*, 511 F.3d 1186 (Fed. Cir. 2008).

existed prior work, systems, publications, and patents that disclosed all of the elements of the asserted claims of the '761 patent. Several of these are described below in detail, and none of them were cited on the face of the '761 patent.” Robinson Decl., Ex. 1 ¶ 42. The next sentence concludes that “[f]rom this omission, I can only conclude that the patent examiner was unaware of and thus did not scrutinize the asserted '761 patent claims against the literature, system development, and patented inventions that preceded it.” *Id.*

Dr. Greenberg was not “speculating” as LTI contends. It is indisputable that the prior art references cited in Dr. Greenberg’s report were never considered during the prosecution of the '761 patent. This is clear from the face of the patent as well as its prosecution history, and there is nothing improper about Dr. Greenberg stating this fact during his testimony. Dr. Greenberg does *not* intend to testify at trial regarding what the patent examiner would, or would not, have done had she actually considered these prior art references during prosecution.

Neither Facebook nor LTI should be allowed to speculate at trial regarding what the examiner did or did not consider – the prosecution record itself is crystal clear on this point. But LTI’s deposition questions to Dr. Greenberg, reproduced on page 8 of its motion *in limine*, indicate that LTI intends to speculate that Dr. Greenberg’s prior art references were actually considered during prosecution, notwithstanding that it can point to nothing to such speculation. Patent Office procedure would have called for the examiner to cite any references made of record in the prosecution. *See* MPEP § 707.05.

LTI’s attempt to speculate as to what the Examiner considered should be rejected. If for any reason it is allowed, Facebook should be allowed to produce evidence from the orders granting *ex parte* and *inter partes* reexamination, which conclusively establish that the prior art cited in Greenberg’s report was *not* previously considered by the PTO. *See* Robinson Decl. Ex. 5 at ¶¶ 9-11; *id.*, Ex. 6 at ¶¶ 14-18.

**III. CONCLUSION**

For the foregoing reasons, Facebook respectfully requests the Court deny LTI's motion.

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