

**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. 2 TO EXCLUDE PORTIONS OF EXPERT TESTIMONY OF
MICHAEL KEARNS**

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LEADER TECHNOLOGIES, INC.,)	
a Delaware corporation,)	CIVIL ACTION
)	
Plaintiff and Counterdefendant,)	No. 1:08-cv-00862-JJF
)	
v.)	CONFIDENTIAL
)	FILED UNDER SEAL
FACEBOOK, INC.,)	
a Delaware corporation,)	
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I. INTRODUCTION

LTI's motion seeks to preclude Dr. Kearns, Facebook's expert on non-infringement, from (a) offering any opinions regarding invalidity of the asserted claims of the '761 patent; and (b) making any mention of the LTI product that, according to LTI, embodies the claims of the '761 patent. Both of these requests should be rejected.

First, LTI's motion to preclude Dr. Kearns from testifying about invalidity is based on the false premise that Dr. Kearns is providing an opinion regarding invalidity of the asserted claims. But Dr. Kearns has provided no opinion on invalidity and will offer no such opinions at trial. Dr. Kearns has instead offered a rebuttal to LTI's assertion, provided for the first time in its opening expert report, that Facebook infringes under the doctrine of equivalents.

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Dr. Kearns's analysis is proper rebuttal testimony that applies the established principle that "there can be no infringement under the doctrine of equivalents if the asserted scope of equivalency would encompass the prior art." *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1332 (Fed. Cir. 2001).

LTI's motion to preclude Dr. Kearns from referring to LTI's products is similarly misguided.

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Dr. Kearns's reference to and reliance on Leader2Leader

was proper rebuttal to LTI's expert opinion regarding the alleged effectiveness of the '761 patent. LTI's motion should be denied.

II. ARGUMENT

A. Dr. Kearns Is Not Providing an "Invalidity Opinion"

In its opening infringement expert report, LTI argued that Facebook infringes each asserted claim of the '761 patent both literally and under the doctrine of equivalents through a series of "Use Cases," to which Dr. Kearns responded in his rebuttal report. In response to LTI's contention that Facebook infringed the asserted claims under the doctrine of equivalents, Dr. Kearns opined that LTI overreached in applying the doctrine of equivalents to cover Facebook because doing so would ensnare the prior art. *See* Declaration of Kathryn Robinson in Support of Facebook's Oppositions to Leader Technology, Inc.'s Pretrial Motions ("Robinson Decl."), Ex. 7, *e.g.* ¶¶ 79-89 ("Kearns Report").

It is well-established that "there can be no infringement under the doctrine of equivalents if the asserted scope of equivalency would encompass the prior art." *DeMarini Sports, Inc.*, 239 F.3d at 1332; *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 683 (Fed. Cir. 1990), *disapproved in part on other grounds*, *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83 (1993). The rule is grounded on the principle that "a patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims." *Wilson Sporting Goods Co.*, 904 F.2d at 684. The Federal Circuit has provided the following framework for assessing if the prior art constrains the doctrine of equivalents:

To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a *hypothetical* patent claim, sufficient in scope to *literally* cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then *prior art* is not a bar to infringement under the doctrine of equivalents.

Id. at 684 (emphasis in original).

In making this determination, the patent owner bears the burden of showing that the hypothetical claim would have been patentable over the prior art. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1325 (Fed. Cir. 2009). If the hypothetical claim would be unpatentable because it is anticipated by or obvious in view of the prior art, “then the patentee has overreached, and the accused device is noninfringing as a matter of law.” *Id.* (internal quotations and citation omitted).

This is precisely the analysis that Dr. Kearns employed in his expert report. Dr. Kearns constructed a hypothetical claim that would literally cover the aspects of the Facebook website accused by LTI as described in LTI’s expert report. *See* Robinson Decl., Ex. 7 ¶¶ 80, 35-37. Dr. Kearns’s hypothetical claim follows the steps of the ’761 patent as they are being applied by LTI against Facebook, while removing claim elements that LTI has failed to establish were literally present. LTI makes no serious attempt to attack Dr. Kearns’s hypothetical claim or argue that it is an inappropriate starting point for an analysis under the doctrine of equivalents.

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LTI’s repeated contention in its motion that Dr. Kearns is providing an “invalidity

opinion” reflects a fundamental misunderstanding of the law of doctrine of equivalents and a gross mischaracterization of Dr. Kearns’s actual opinions. Dr. Kearns’s discussion of the prior art pertains only to non-infringement under the doctrine of equivalents, not invalidity.

Redacted

Because LTI’s motion to preclude Dr. Kearns from offering opinions on “invalidity” of is based on a fundamentally incorrect premise, it should be denied.

B. LTI’s Attack on Dr. Kearns’s Ensnarement Analysis is Meritless

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These objections should be rejected because, as explained below, they are all derived from the false premise that Dr. Kearns has provided an “invalidity” opinion.

First, LTI repeatedly complains that Dr. Kearns did not compare the *issued claims* of the ’761 patent against *the prior art*. See D.I. 418, Leader Technologies, Inc.’s Motion *in Limine* No. 2 to Exclude Portions of Expert Testimony of Michael Kerns (“Motion”) at 4-6. But such an analysis was not required under the doctrine of equivalents, and in fact, would have been entirely improper. The impact of the prior art on the doctrine of equivalents turns on a comparison between “a hypothetical claim that literally covers the

accused device,” *DePuy Spine, Inc.*, 567 F.3d at 1324 (emphasis added), and the prior art. And that is exactly what Dr. Kearns provided as explained above. A comparison between the *issued claims* of the ’761 patent and the prior art would be appropriate only for an invalidity analysis under 35 U.S.C. §§ 102, 103, which Dr. Kearns is not offering.

LTI also suggests that Dr. Kearns provided only a conclusory discussion of the prior art websites. *See* Motion at 4-5. Not so.

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The detail provided in Dr. Kearns’s analysis of just the prior art websites, in fact, far exceeded the detail LTI provided in its opening report on the entire doctrine of equivalents issue.

Equally meritless is LTI’s complaint that Dr. Kearns should have taken the prosecution history of the ’761 patent into account because “the prosecution history has a direct impact on the breadth of the doctrine of equivalence [sic].” Motion at 6. LTI has apparently confused the question of ensnarement of the prior art with the separate and distinct doctrine of prosecution history estoppel. *See Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 827 (Fed. Cir. 1999) (“Case law has established that the prior art and prosecution history estoppel provide independent ‘policy oriented’ limitations on the doctrine of equivalents.”) (emphasis added). LTI can cite no authority for the proposition that a patent’s prosecution history has any bearing on the question of whether the prior art constrains the range of permissible equivalents. That is because there is no relevance. The prosecution history shows how the *issued* claims came into

existence, which has no relevance to the analysis of whether the prior art discloses the elements of the *hypothetical* claim provided by Dr. Kearns.

LTI also misleadingly argues that Dr. Kearns “does not know the invalidity legal standards or how to apply them.” Motion at 4. Again, Dr. Kearns was not asked to provide an opinion as to invalidity of the '761 patent, nor did he analyze the validity of the issued claims of that patent. He explained in his report that “if the claim, hypothetically rewritten to cover the accused system, would not have been allowed by the Patent Office (e.g., because each element of the claim was disclosed by a single prior art reference, or because the claim would have been obvious over the prior art), the doctrine of equivalents may not be applied.” Robinson Decl., Ex. 7 ¶ 79. His report goes on to explain how the prior art systems disclosed each element of his hypothetical claim.

Dr. Kearns’s report and deposition testimony made clear that he fully understood the relevant concepts in assessing how the prior art impacts the doctrine of equivalents. LTI has made no showing that any aspect of Dr. Kearns’s analysis is flawed or unreliable.

C. LTI’s “Sandbagging” Argument is Without Merit

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LTI neglects to mention, however, that the first time it ever offered any argument with respect to the doctrine of equivalents was in its opening expert report served on April 8, 2010. As explained in Facebook’s pending Motion *in Limine* No. 1, LTI never articulated a doctrine of equivalents theory during fact discovery, nor was the newly-minted argument in LTI’s expert report sufficient under

Daubert.¹ In any case, until receiving LTI's opening expert report on April 8, it was impossible for Facebook to know whether or not LTI would even rely on the doctrine of equivalents, let alone the claims to which LTI would attempt to apply it or the range of equivalents LTI would be seeking. LTI can hardly be heard to complain that Facebook provided an analysis of how the prior art impacts a doctrine of equivalents claim made for the first time in LTI's opening report.

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D. The Jury Should Be Permitted to Hear Dr. Kearns's Opinions on the Doctrine of Equivalents

LTI argues that it is improper for the jury to hear testimony regarding whether a range of equivalents would ensnare the prior art because it is a legal question. The Federal Circuit has squarely held, however, that the Court can present this issue to the jury, for example, through an advisory verdict. *See DePuy Spine, Inc.*, 567 F.3d at 1324. To the extent the jury is called upon to evaluate infringement under the doctrine of equivalents, it should hear evidence relating to this issue as well.

The impact of the prior art on the doctrine of equivalents is a common sense principle that will not confuse the jury.

Redacted

As their titles should

¹ As explained in Facebook's pending motion *in limine*, LTI should not be permitted to offer a doctrine of equivalents theory at trial because it was never disclosed during fact discovery and because the purported theory in LTI's expert report suffers from fatal flaws that render it inadmissible. If the Court grants Facebook's motion *in limine* on the doctrine of equivalents, the present motion would be rendered moot.

clearly suggest, these textbooks contain simple, straightforward descriptions

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E. Dr. Kearns's References to Leader2Leader Are Proper Rebuttal

Finally, LTI claims that Dr. Kearns should not be permitted to testify regarding Leader2Leader, the LTI product that allegedly practices each asserted claim of the patent-in-suit. As explained below, however, Dr. Kearns's references to Leader2Leader were proper rebuttal and LTI's objections are without merit.

Dr. Kearns's statements regarding Leader2Leader were provided in direct response to the following opinion offered in LTI's opening infringement expert report:

Redacted

²

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Facebook would not object to a limiting instruction clarifying that Dr. Kearns's testimony about those two systems is offered solely to rebut LTI's claim under the doctrine of equivalents and is not offered as evidence of the invalidity of the asserted claims.

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Dr. Kearns's statements were a proper rebuttal to an opinion expressed by LTI's expert. LTI cannot have it both ways.

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LTI's motion should be denied.

Dated: May 27, 2010

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