

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Case No. 1:10-24063-CIV-MORENO

MOTOROLA MOBILITY, INC.,

Plaintiff / Counterclaim Defendant,

v.

MICROSOFT CORPORATION,

Defendants / Counterclaim Plaintiff.

**CONTAINS CONFIDENTIAL BUSINESS
INFORMATION**

FILED UNDER SEAL

**DEFENDANT MICROSOFT'S OPPOSITION TO PLAINTIFF MOTOROLA
MOBILITY, INC.'S MOTION TO EXCLUDE THE TESTIMONY OF
HOWARD JAY SIEGEL REGARDING INFRINGEMENT**

Defendant Microsoft Corporation ("Microsoft") submits the following opposition to Plaintiff Motorola Mobility, Inc.'s ("Motorola") Motion to Exclude the Testimony of Howard Jay Siegel ("Dr. Siegel") regarding infringement of U.S. Patent No. 7,024,214 ("the '214 Patent") and U.S. Patent No. 7,493,130 ("the '130 Patent") (collectively referred to as "the Loveland Patents") by the accused Motorola Android Devices ("Mot. to Exclude"). Dr. Siegel's testimony is relevant, reliable and the methodology used is sound. The opinion would assist the jury in making determinations on issues presented to it. Therefore, his testimony should be admitted in full for the reasons articulated herein.

I. BACKGROUND FACTS

Dr. Siegel has been retained by Counsel for Microsoft as an expert witness in this action and has provided two opinion reports on behalf of Microsoft, one regarding infringement of the asserted claims of the '214 Patent and '130 Patent by Motorola (the "Siegel Infringement Report", dated June 24, 2011) and a second regarding the validity of the asserted claims of the '214 Patent and '130 Patent (the "Siegel Validity Report", dated July 7, 2011). The current Motion to Exclude Testimony of Dr. Siegel filed by Motorola relates only to the first of these reports, namely, the Siegel Infringement Report.

The Siegel Infringement Report included an analysis of 52 claims of the Loveland Patents—*i.e.*, claims 1, 3-6, 10, 14, 17, 19, 22-29, 32-34, 38-39, 41-44, 46-52 and 54-56 of the '214 Patent and claims 1-2, 4-8, 10-11 and 13-19 of the '130 Patent—as they relate to 23 accused Motorola Android Devices. For this analysis, Dr. Siegel employed a methodology including at least the following considerations:

- Dr. Siegel reviewed thousands of pages of material on the accused products, including technical specifications, user guides, service manuals, and product brochures.

- Dr. Siegel reviewed technical and other information for the accused products available at numerous websites, including <http://www.motorola.com>, <http://developer.motorola.com>, and <http://support.vzw.com>.
- Dr. Siegel inspected and operated samples of three of the accused products—*i.e.*, Droid X, Droid 2, and Backflip.
- Dr. Siegel considered each asserted claim separately.
- Dr. Siegel considered infringement based on whether the accused devices infringe literally or under the doctrine of equivalents.
- Dr. Siegel used a proper construction of the claims taking into account intrinsic evidence, including, but not limited to, the claims, the specifications and the prosecution histories.
- Dr. Siegel considered the constructions of the claims proposed by both Motorola and Microsoft.

Based on this analysis and methodology, Dr. Siegel concluded that each of the asserted claims was infringed by all 23 accused Motorola Android Devices.

Motorola has filed its Motion challenging the opinion as not based on any reliable methodology. Microsoft would respectfully show the Court that Dr. Siegel's proposed expert testimony is methodologically sound and reliable, and should be admitted for the following reasons.

II. LEGAL STANDARDS

When an expert's qualifications are not in dispute, and the expert's report generally reflects a reasonable approach, then the general rule is that the testimony is admissible. *United States v. Frazier*, 387 F.3d 1244, 1294 (11th Cir. 2004), cert. denied, 544 U.S. 1063 (2005). "[T]he more qualified the expert, the more likely that expert is using reliable methods in a reliable manner —

highly qualified and respected experts don't get to be so by using unreliable methods or conducting research in an unreliable manner." *Malletier v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558, 616 (S.D.N.Y. 2007); *see also In re Fosomax Liab. Litig.*, 645 F. Supp. 2d 164 (S.D.N.Y. 2009). Under these facts, weaknesses in the underpinnings of the expert's opinion go to the opinion's weight rather than its admissibility. *Jones v. Otis Elevator Co.*, 861 F.2d 655, 663 (11th Cir. 1988). Accordingly, "[c]ourts have found that an abuse of discretion occurs when under *Daubert* the admissibility bar is too high." *Frazier*, 387 F.3d at 1294. Rejection of expert testimony is to be "the exception rather than the rule." *Id.*

III. ARGUMENT

A. **Dr. Siegel Is Well Qualified To Opine As To Infringement of the Loveland Patents, and Thus His Opinions Should Be Admitted In Full.**

Motorola does not and cannot contest that Dr. Siegel is eminently qualified in the area of computer and communications system design and analysis. Dr. Siegel has 35 years of extensive experience in the area of optimum allocation of resources, performance evaluation, operating systems, distributed processing, network protocols, programming and communications networks. *See Ex. 1, Siegel Infringement Report*, at Ex. C. He has a Bachelor of Science degree in Electrical Engineering and a Bachelor of Science degree in Management, both from the Massachusetts Institute of Technology ("MIT") in Cambridge, Massachusetts. *Id.* Dr. Siegel also has a Masters of Arts degree, a Masters of Science in Engineering degree, and a Ph.D. from Princeton University. *Id.* He has taught classes in the relevant subject matter at Purdue University and Colorado State University; worked and consulted in the industry for companies and agencies such as IBM, Super Computing Research Center, Department of Defense, DARPA, and Hewlett-Packard; and authored or co-authored almost 400 published technical papers. *Id.* Dr. Siegel is a member of the Institute of Electrical and Electronics Engineers (IEEE) and the

Association of Computing Machinery (ACM) (*Id.*), having been elected to the highest level of membership in each. *See* Ex. 4, Deposition of Dr. Tal Lavian (“Lavian Dep.”), at 150, 154. He is a named inventor on one issued patent and on pending applications. *See* Ex. 2, Deposition of Dr. Howard Jay Siegel (“Siegel Dep.”), at 100. As such, Dr. Siegel's qualifications and professional stature provides circumstantial evidence of the reliability of his methods and testimony.

Ambrosini v. Labarraque, 101 F.3d, 129, 140 (D.C. Cir. 1996), cert. dismissed, 520 U.S. 1205 (1997); *United States v. Downing*, 753 F.2d 1224, 1239 (3d Cir. 1985). Accordingly, Dr. Siegel's opinions should be admitted in full. To the extent that Motorola has any objections to Dr. Siegel's opinions, such objections should go to the *weight*, not the admissibility, of the evidence.

B. Dr. Siegel's Methodology Is Reliable.

The sole basis of Motorola's objection to the methodology employed by Dr. Siegel is that he did not review any source code. As set forth below, however, no review of source code is necessary to the fully analyze any products to determine infringement of the claims of the Loveland Patents.

This is due to the nature of the claims presented in the Loveland Patents, a fact completely overlooked by Motorola in its Motion. It is a fundamental tenet in patent law that the measure of the exclusive right conferred by a patent is the language of the claim or claims. The patent scope is determined by the wording of the claims and therefore the focus is necessarily on whether the accused product practices the invention as claimed. The issue is claim coverage, and not whether the accused product is the same or similar to what is described in the patent specification or similar to any product. *See e.g., Phillips v. AWH Corp.* 415 F.3d 1303 (Fed. Cir. 2005) (en banc), cert. denied, 546 U.S. 1170, 126 S. Ct. 1332 (2006). Here, for the Loveland Patents, infringement can be analyzed without review of source code because no limitations in the claims require such review.

Motorola's Motion to Exclude only concerns claims 42-43 and 55-56 of the '214 patent and claims 2, 4-8, 10, 11, and 13-19 of the '130 patent, which are directed at "computer readable media" having stored thereon "computer-executable instructions" for carrying out the various steps recited in the claims. Motorola argues that an infringement analysis for these claims must include "looking at the device's computer-executable instructions (i.e., source code)." Mot. to Exclude at 1. Motorola is wrong for multiple reasons.

To begin with, source code is not "computer-executable instructions." Instead, source code is a collection of *human-readable* instructions that must be converted into another form before it is computer-executable. Moreover, the source code is not stored on any "computer readable media" of the Motorola Android Devices. The actual instructions stored on the accused devices is the computer-executable form which, unlike source code, is not readily read or analyzed by humans. As such, Motorola's major argument for why source code review is needed falls apart.

Furthermore, no review of source code is necessary because the asserted claims of the '214 and '130 patents are written at a *feature* level—they specify what the computer-executable instructions must do *when executed*, but not how the code must be written. For example, claim 2 of the '130 patent, which Motorola cites in its Motion, provides:

A first computer system in a network that includes the first computer system having a first data store and second computer system having a second data store, the first computer system comprising one or more computer-readable media having computer-executable instructions for implementing a method for synchronizing the first and second data stores in a flexible manner considering the circumstances that exist at the time of synchronization, wherein the method comprises:

an act of the first computer system determining that a data item is to be synchronized;

an act of the first computer system identifying which of a plurality of synchronization mechanisms, including one or more hardwired or wireless communication connections, are available to use for synchronization;

an act of the first computer system consulting a set of one or more flexible selection rules to select a synchronization mechanism, the set of one or more flexible rules taking into consideration value, from having access to synchronized data, relative to at least one of (i) an economic cost for synchronization using each available synchronization mechanism, (ii) network security for each available synchronization mechanism, (iii) security of the second computer system, or (iv) value of data being synchronized and thereby selecting an available synchronization mechanism appropriate for the data item given the one or more flexible selection rules;

and **an act** of the first computer system using the selected synchronization mechanism to synchronize the data item with the second computer.

Analysis of this claim 2 does not require reliance on source code, because the claimed features are readily seen in other materials for the accused products, including the technical specifications, user guides, service manuals, product brochures, and website information that Dr. Siegel actually reviewed and analyzed, and from the inspection and operation that Dr. Siegel performed on samples of the accused products. *See also* Ex. 2, Siegel Dep., at 263-64. Nor do any of the claims at issue specify how any code must actually be written or implemented. Indeed, the Loveland Patents themselves do not set forth any code – source or otherwise.

Dr. Siegel's extensive background in the technology, as well as his review of the numerous product documentation, is more than sufficient for him to understand that the accused Motorola Android Devices operate in accordance with the computer-executable instructions stored therein. Dr. Siegel's review of the documentation and operation of accused Devices is sufficient for him to determine whether the relevant claimed functionality is present when the computer-executable instructions are executed (i.e., by witnessing the acts, which are performed in accordance with the

computer-executable instructions). From this analysis, he has provided a fully competent opinion that will assist the jury in evaluating infringement.

C. **Motorola's Own Expert Confirmed That Review of Source Code Is Not Necessary.**

Moreover, Motorola's own expert, Dr. Tal Lavian, confirms that a review of source code is not necessary to determine whether the claimed limitations are met. During his deposition Dr. Lavian testified as follows with respect to the necessity of reviewing source code:



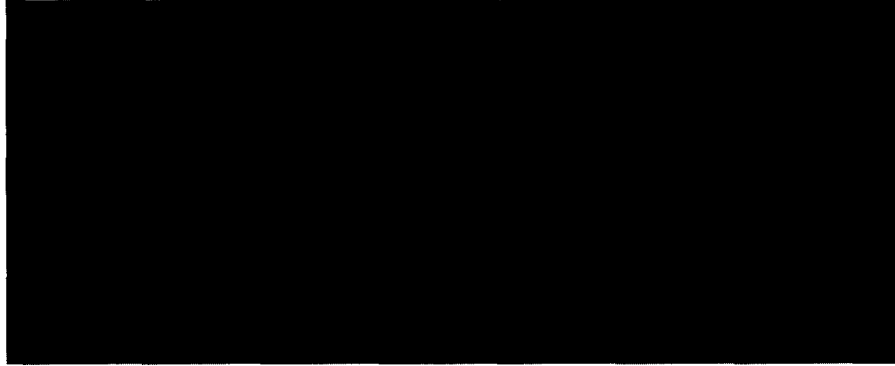
Ex. 4, Lavian Dep., at 53-54.



Id. at 180-88. As an

example, Dr. Lavian testified as follows:





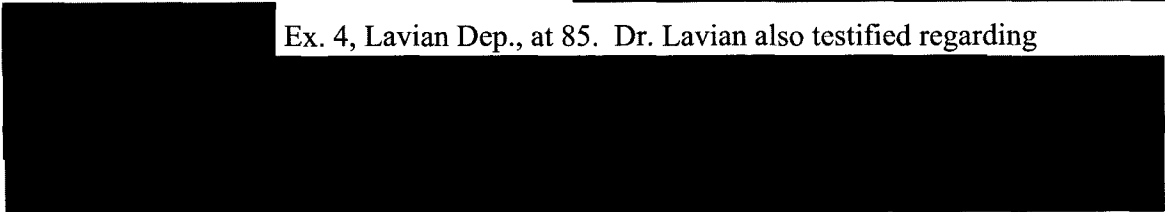
Id. at 187-88.

Dr. Lavian's deposition testimony is consistent with his Invalidity report. In that report, Dr. Lavian relied on patent documents and white papers – not on any source code – to conclude that all 19 of the claims at issue in Motorola's present Motion were invalid due to anticipation or obviousness. That is, Dr. Lavian opined, *without reviewing source code*, that patents and technical white papers disclosed claim elements directed at "computer-executable instructions." For example, without relying on source code, Dr. Lavian opined that U.S. Patent No. 5,406,643 ("Burke '643") disclosed "computer-executable instructions for identifying which of a plurality of synchronization mechanisms, including one or more hardwired or wireless communication connections, are available to use for synchronization." Instead, in support of his opinion, Dr. Lavian stated that "Step 86 of Figure 7 selects from available communication paths. This necessarily requires identifying which paths are available." *See* Ex. 3, Lavian Invalidity Report, at Ex. D at 214-33.

Furthermore, Dr. Lavian testified that



Ex. 4, Lavian Dep., at 85. Dr. Lavian also testified regarding



Id. at 115.



Thus, all of analysis and testimony of Motorola's own expert confirms that source code review is not necessary in order to determine whether the limitations of the asserted claims 1, 3-6, 10, 14, 17, 19, 22-29, 32-34, 38-39, 41-44, 46-52 and 54-56 of the '214 Patent and claims 1-2, 4-8,10-11 and 13-19 of the '130 Patent are met by the Motorola Android Devices.

IV. CONCLUSION

As demonstrated above, the analysis undertaken by Motorola's own expert uses equivalent methodology to the analysis undertaken by Dr. Siegel. Dr. Siegel's testimony is relevant, reliable and the methodology used is sound. The opinion would assist the jury in making determinations on issues presented to it. Therefore, Motorola's Motion to Exclude the Testimony of Howard Jay Siegel should be denied.

DATED this 8th day of August, 2011.

Respectfully submitted,

COLSON HICKS EIDSON
Roberto Martinez, Esq.
Curtis Miner, Esq.
255 Alhambra Circle, Penthouse
Coral Gables, Florida 33134
Tel. (305) 476-7400
Fax. (305) 476-7444

By: /s/ Curtis Miner
Curtis B. Miner
(Fla. Bar No. 885681)
E-mail: curt@colson.com

Of Counsel:

David T. Pritikin
Richard A. Cederoth
Douglas I. Lewis
John W. McBride
SIDLEY AUSTIN LLP
One South Dearborn
Chicago, IL 60603
Tel. (312) 853-7000

Brian R. Nester
SIDLEY AUSTIN LLP
1501 K Street NW
Washington, DC 20005
Tel. (202) 736-8000

CERTIFICATE OF SERVICE

I hereby certify that on August 8, 2011, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

Respectfully submitted,

/s/ Curtis Miner
Curtis B. Miner, Esq.

SERVICE LIST

Motorola Mobility, Inc. v. Microsoft Corp., Case No. 1:10-cv-24063-Moreno

Edward M. Mullins
emullins@astidavis.com
Hal M. Lucas
hlucas@astidavis.com
ASTIGARRAGA DAVIS
701 Brickell Avenue, 16th Floor
Miami, FL 33131
Tel.: (305) 372-8282

Steven Pepe
Steven.Pepe@ropesgray.com
Jesse J. Jenner
Jesse.Jenner@ropesgray.com
Leslie M. Spencer
Leslie.Spencer@ropesgray.com
ROPES & GRAY LLP
1211 Avenue of the Americas
New York, NY 10036-8704
Tel.: (212) 596-9046

Norman H. Beamer
Norman.Beamer@ropesgray.com
Mark D. Rowland
Mark.Rowland@ropesgray.com
Gabrielle E. Higgins
Gabrielle.Higgins@ropesgray.com
ROPES & GRAY LLP
1900 University Avenue, 6th Floor
East Palo Alto, CA 94303-2284
Tel.: (650) 617-4030

Kevin J. Post
kevin.post@ropesgray.com
Megan F. Raymond
megan.raymond@ropesgray.com
ROPES & GRAY LLP
One Metro Center
700 12th Street NW, Suite 900
Washington, DC 20005-3948
Tel.: (202) 508-4600

Counsel for Plaintiff Motorola Mobility, Inc.