

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.

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**MICROSOFT CORPORATION'S RESPONSE IN OPPOSITION TO
MOTOROLA MOBILITY, INC.'S MOTION TO
EXCLUDE MICROSOFT'S EXPERT LOREN G. TERVEEN**

Defendant / Counterclaim Plaintiff Microsoft Corporation (“Microsoft”) respectfully submits this response in opposition to Plaintiff / Counterclaim Defendant Motorola Mobility, Inc.’s (“Motorola”) Motion to Exclude Microsoft’s Expert Loren G. Terveen (“Mot. to Exclude”).

I. INTRODUCTION

Motorola, in a desperate attempt to exclude Microsoft’s expert for the ’901 and ’904 Patents, Loren G. Terveen, improperly proffers a narrow and unreasonable field of relevant art for the patents. Motorola asserts that the field of relevant art is directed only to “set top boxes,” ignoring the plain language in the patents that clearly state that the field of relevant art is not only limited to set top boxes, but many other devices implementing the underlying technology, which is directed to graphical user interface. There is no denying that Dr. Terveen, who has extensive experience in design and implementation of graphical user interface, is qualified to competently testify about the issues regarding the ’901 and ’904 Patents.

Motorola also improperly attacks Dr. Terveen’s analysis, rather than whether the *methodology* used by Dr. Terveen is reliable. Such argument is not proper for a *Daubert* motion because it is a question of the opinion’s weight rather than its admissibility, which is proper for cross-examination. Moreover, all of Motorola’s complaints of Dr. Terveen’s deficiencies are without any merit and, contrary to Motorola’s assertions, they were sufficiently addressed by Dr. Terveen.

Accordingly, Motorola’s motion to exclude Dr. Terveen should be denied.

II. BACKGROUND

A. The ’901 Patent.

The ’901 Patent is generally directed to systems and methods for locking and unlocking programming content based on data including program ratings, content identifiers, channel and program. (Motorola’s Tab 2, the ’901 Patent.) The ’901 Patent also generally provides that a record button is not displayed to a user if the programming content is locked. (*Id.*) The subject

matter of the '901 Patent is not strictly limited to set top boxes. For example, the '901 Patent states:

Those skilled in the art will appreciate that the invention may be practiced in network computing environments with *many types of computer system configurations, including* personal computers, hand-held devices, multi-processor systems, microprocessor-based or programmable consumer electronics, network PCs, minicomputers, mainframe computers, *set top boxes*, and the like.

(*Id.* at 4:17-23, emphasis added.)

The underlying technology of the '901 Patent is directed to graphical user interface. (*See, e.g., id.* at Fig. 3, 6:27-40.) The '901 Patent describes “guide data,” usually presented to a user in a grid or table format, that “allows a viewer to view what is contained in the programming content and informs a user of many different characteristics of the programming content such as the start and end times of a program, the duration of a program, which programs are on which channels and the like.” (*Id.* at 2:6-12.) In displaying the guide data, “the user interface can convey information regarding the status of programming content in multiple ways, including alphanumerical and visual cues.” (*Id.* at 6:37-40.)

Indeed, the asserted claims of the '901 Patent require the use of graphical user interface.

For example, claim 1 states:

In a *set top box having a graphical user interface including a display*, a method of controlling access by a user to programming content, the method comprising the steps of:

- [1] *displaying guide data on the display* to the user, wherein the guide data describes the programming content;
- [2] receiving input from the user identifying one or more portions of the programming content to be recorded;
- [3] determining if the one or more portions of the programming content identified by the user are locked; and
- [4] refraining from displaying a record button *on the display* to the user if the one or more portions of the programming content are locked.

(*Id.* at 12:34-49, emphasis added.)

B. The '904 Patent.

The '904 Patent is generally directed to systems and methods for selecting among multiple tuners to tune to a particular channel, for allowing a user to record a program with a tuner while watching a different program with another tuner without requiring any user input concerning selection of tuners, and when the user switches back to a channel that is being recorded, for providing an indication that the user is now watching a recorded program. (Motorola's Tab 3, the '904 Patent.) The subject matter of the '904 Patent is not strictly limited to set top boxes. Rather, the '901 Patent is directed to "televisions, set top boxes, and *other client devices* that contain multiple tuners." (See, e.g., *id.* at 1:22-24, emphasis added.)

Like the '901 Patent, the underlying technology of the '904 Patent is directed to graphical user interface. (See, e.g., *id.* at 2:62-65, 3:36-40, 4:7-11, 7:13-19.) For example, the '904 Patent describes "*interface features*" that "indicate to the user that, upon switching back to a channel that is being recorded, the user is now watching a recorded show. This indication reassures the user that their recording is proceeding properly. This indication also reminds the user that they have the ability to access previously recorded portions of the program, if desired." (*Id.* at 7:13-19; see also 2:62-65, 3:36-40, and 4:7-11 (describing "*graphical user interface*").)

Indeed, the asserted claims of the '904 Patent are necessarily directed to the use of graphical user interface because the claims require displaying an indicator that the user is now watching a recorded show after switching back to a channel that is being recorded. For example, claim 12 states:

A method comprising:

- [1] receiving a request to record a program on a first channel;
- [2] assigning a first tuner to tune the first channel;
- [3] receiving a request to tune a second channel;
- [4] assigning a second tuner to tune the second channel if the second tuner is available for tuning;
- [5] receiving a request to tune the first channel;
- [6] switching to the first tuner; and

[7] displaying an indicator that the user is now watching a recorded program.

(*Id.* at 8:49-59, emphasis added.)

C. Dr. Terveen's Qualifications.

Dr. Terveen, a professor at the University of Minnesota, has extensive experience in user interface design, user-interface implementation (including graphical user interface design and implementation), social computing, and fundamental data structures and algorithms. (Motorola's Tab 1, Terveen Report at ¶¶ 2-7; *see also* Exhibit A to Tab 1, Dr. Terveen's CV.) Although Dr. Terveen does not have specific experience in designing set top boxes, Dr. Terveen has expertise in the underlying technology of the '901 and '904 Patents—the graphical user interface design and implementation.

[REDACTED]

(*See, e.g.,* Motorola's Tab 1, Terveen Report at ¶ 25.) Through his extensive experience with graphical user interface design and implementation, Dr. Terveen is very familiar with the underlying technology of the '901 and '904 Patents. (Motorola's Tab 1, Terveen Report at ¶¶ 2-7; *see also* Exhibit A to Tab 1, Dr. Terveen's CV.)

III. ARGUMENT

A. Legal Standard.

Under Federal Rule of Evidence 702 and *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579 (1993), “[e]xpert testimony may be admitted into evidence if: (1) the expert is qualified to testify competently regarding the matters he intends to address; (2) the methodology by which the expert reaches his conclusions is sufficiently reliable as determined by the sort of inquiry mandated in *Daubert*; and (3) the testimony assists the trier of fact, through the application of

scientific, technical, or specialized expertise, to understand the evidence or to determine a fact in issue.” *City of Tuscaloosa v. Harcross Chem., Inc.*, 158 F.3d 548, 562-63 (11th Cir. 1999).

Exclusion of expert testimony is an “exception rather than the rule.” *United States v. Frazier*, 387 F.3d 1244, 1294, (11th Cir. 2004), cert. denied, 544 U.S. 1063 (2005). While rulings on admissibility under *Daubert* require the trial court to conduct an analysis of the expert’s methodology, “it is not the role of the district court to make ultimate conclusions as to the persuasiveness of the proffered evidence.” *Quiet Technology DC-8, Inc. v. Hurel-Dubois UK Ltd.*, 326 F.3d 1333, 1341 (11th Cir. 2003).

B. Dr. Terveen Is Qualified To Competently Testify About The Issue Regarding The '901 And '904 Patents.

Motorola’s argument that Dr. Terveen is not qualified to offer opinions in this case is based on the fundamentally flawed premise that the patents are directed only to a “set top box,” and thus only experts with specific experience in designing and developing set top boxes are qualified. Both the '901 Patent and the '904 Patent make clear that the patents are describing technology that can be implemented in many different devices, not only limited to set top boxes as Motorola contends. (*See, e.g.*, Motorola’s Tab 2, the '901 Patent at 4:17-23; Motorola’s Tab 3, the '904 Patent at 2:22-24.) Indeed, the underlying technology of the patents is directed to graphical user interface, which can be implemented to many devices, including but not limited to set top boxes. (*See, e.g.*, Motorola’s Tab 2, the '901 Patent at Fig. 3, 6:27-40; Motorola’s Tab 3, the '904 Patent at 2:62-65, 3:36-40, 4:7-11, 7:13-19.) Accordingly, Motorola’s attempt to narrow the field of art to only set top boxes is improper in view of the patents.

Under the properly defined field of art and technology at issue for the '901 and '904 Patents, there is no question that Dr. Terveen is qualified to offer his opinions in this case. Dr. Terveen has extensive experience with graphical user interface design and implementation – the very technology at issue for the patents. Thus, Motorola’s transparent attempt to exclude Dr. Terveen, who is qualified to competently testify about the issues regarding the '901 and '904 Patents, by improperly limiting the field of art directed to the '901 and '904 Patents should not

be allowed. *See, e.g., Arlaine & Gina Rockey, Inc. v. Cordis Corp.*, No. 02-22555-CIV, 2004 U.S. Dist. LEXIS 30763, at *51-52 (S.D. Fla. Jan. 5, 2005) (finding a proffered expert sufficiently skilled in the relevant art even though he had no specific experience in designing and studying the medical device at issue and permitting his expert testimony on infringement and validity).

C. Dr. Terveen Used Reliable Methodology To Reach His Conclusions.

Dr. Terveen used reliable methodology to reach his conclusions regarding the infringement and validity of the '901 and '904 Patents.

1. The '901 Patent.

Motorola attacks Dr. Terveen's testing by asserting that his test did not prove that the third limitation ("determining if the one or more portions of the programming content identified by the users are locked") of claim 1 of the '901 Patent is met.¹ (Mot. to Exclude at 6-7.) Motorola's complaints are nothing more than unsupported non-infringement arguments—that Dr. Terveen failed to show infringement. Such arguments—weaknesses in the underpinning 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); *Advanced Bodycare Solutions, LLC v. Thione Int'l, Inc.*, 615 F.3d 1352, (11th Cir. 2010) (agreeing with the district court's explanation for denying plaintiff's objection to defendant's expert's testimony that defendant's arguments about the expert's "flawed" data "went not to admissibility but to the 'weight to be attributed to [the expert's] testimony,' and plaintiff was 'free to challenge – on cross examination and on rebuttal – the reliability' of this data"); *see also Pinpoint, Inc. v. Amazon.com, Inc.*, No. 03 C 4954, 2004 U.S. Dist. LEXIS 24694 (N.D. Ill., Nov. 19, 2004) (denying defendant's motion to exclude patentee expert's testimony on infringement, in which the defendant contended that the expert allegedly did not provide an element-by-element analysis showing how the accused product infringed the claimed method, because such attacks on the expert's conclusions and supporting

¹ Microsoft is not asserting infringement under the doctrine of equivalents of the asserted claims of the '901 Patent.

reasons should be done during cross-examination, and noting the patentee's assertion that the defendant was "attempting to try the merits of its non-infringement defense through the exclusion of [the expert's] testimony."), *vacated on other grounds*, 347 F. Supp. 2d 579 (N.D. Ill., Dec. 6, 2004). The identification of flaws in generally reliable scientific evidence is precisely the role of cross-examination. *Quiet Technology*, 326 F.3d at 1341; *Daubert*, 509 U.S. at 596 ("Vigorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof are the traditional and appropriate means of attacking shaky but admissible evidence.").

Indeed, Motorola failed to show that any *methodology* used by Dr. Terveen is unreliable or deficient in any way. Instead, Motorola argues that Dr. Terveen did not consider that the accused products performed the method in the specified order as required by the claim 1. [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED] (Ex. 1, 07/21/11 Terveen Dep. Tr. at 98:13-99:3.) Motorola also complains that the Dr. Terveen considered the "determining" step out of order. [REDACTED]

[REDACTED] (*Id.* at 89:1-90:25; *see also* Motorola's Tab 1, Terveen Report at ¶¶ 46-48.) Accordingly, Motorola's assertion that Dr. Terveen did not use any reliable method in formulating his opinions is without any basis.

2. The '904 Patent.

Like the '901 Patent, Motorola's complaints concerning Dr. Terveen's opinions regarding infringement of the '904 Patent are nothing more than disguised, unsupported non-infringement arguments. Motorola's contentions that Dr. Terveen failed to show that the accused products "switch to the first tuner" as required by sixth step of claim 12 of the '904 Patent is meritless.²

² Microsoft is not asserting infringement under the doctrine of equivalents of the asserted claims of the '904 Patent.

(Motorola's Br. at 5-6.) First, Dr. Terveen cited to the following evidence, among others, that the accused products with dual-tuner system meets the "switching to the first tuner" limitation:

Simultaneous Watch and Record. Record one program in the background while viewing another live broadcast at the same time.

(DCH6416 User Guide at MOTM_24063_127301.)

(Motorola's Tab 1, Terveen Report at ¶ 197.) Motorola's own expert Michael Barr, in his Invalidity Expert Report concerning the '904 Patent, cited to similar language from a purported prior art reference (Microsoft's UltimateTV User Guide) and concluded that such language meets the "switching to the first tuner" limitation:

"Thanks to the receiver's dual-tuner design, you can watch one show while recording another, record two shows at once, or watch two shows at once using Picture-In-Picture." User Guide, p. 1

A person of ordinary skill in the art at the time of the invention would have understood that it is inherent in this disclosure that the first tuner must be tied to the channel it is recording; *it is also inherent in this disclosure that a system with the ability to record two shows at once or to watch two shows at once would necessitate that switching back to the first channel would require switching back to the first tuner to do so.*

(Ex. 2, Barr Invalidity Report at Exhibit G, p. 3, emphasis added.) Ignoring its own expert's statement, Motorola now argues that such evidence is deficient.

Second, in conjunction with considering all the necessary documents and deposition testimony that show that the "switching to the first tuner" limitation is met, Dr. Terveen confirmed his findings by testing a real-life product. (Motorola's Tab 1, Terveen Report at ¶¶ 178-185, 197-198.) Motorola's assertion that Dr. Terveen "could not know whether the system switched to the first tuner or assigned the second tuner" is meritless. (Motorola's Br. at 6.)

Tab 1, Terveen Report at ¶¶ 178-202.)

Lastly, Motorola complains that Dr. Terveen did not use any design documents or source code. However, Motorola fails to explain how such documents are necessary in proving the asserted claims of the '904 Patent. Dr. Terveen considered and cited to documents and deposition testimonies adequate to prove infringement of the asserted claims of the '904 Patent. (*Id.* at ¶¶ 178-218.) Indeed, no source code was produced with regards to the accused products of the '904 Patent and Motorola's own expert, Mr. Michael Barr, also did not consider any source code for his non-infringement analysis. (Ex. 3, Barr Rebuttal Expert Report.)

Accordingly, Motorola's assertion that Dr. Terveen did not use any reliable method in formulating his opinions is without any merit.

D. Dr. Terveen's Testimony Will Assist The Trier Of Fact.

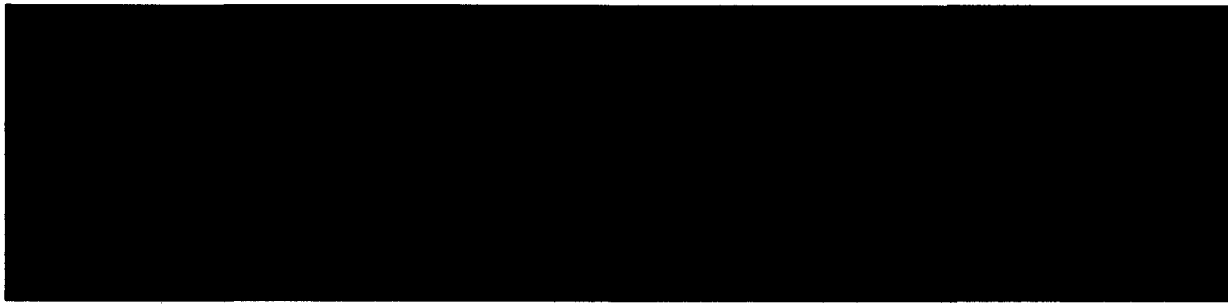
Motorola, without any reasonable basis, argues that Dr. Terveen's testimony is "subjective speculation" and that it will be of no assistance to the jury. (Mot. to Exclude at 7-8.) First, Motorola appears to argue that because Dr. Terveen did not consider the source code, Dr. Terveen cannot prove infringement. In view of the claims at issue, however, analysis of source code is not necessary to prove infringement. Motorola's own expert also did not use any source code to rebut Dr. Terveen's conclusions. Indeed, Dr. Terveen used more than adequate evidence to show that there is infringement of the asserted claims.

Second, Motorola attacks Dr. Terveen's validity opinion by arguing that Dr. Terveen reads an additional "determination" step into claim 12 of the '904 Patent. The limitation at issue states: "assigning a second tuner to tune the second channel *if the second tuner is available for tuning.*" In addition to opining that a prior art reference used by Motorola's expert, Sato, did not disclose assigning a second tuner to tune the second channel, Dr. Terveen also concluded that "[t]here is no disclosure in Sato that teaches or suggests checking the availability of the second tuner." (Motorola's Hoang Ex. M, Terveen Invalidity Report at ¶ 144.) Motorola argues that Dr.

Terveen's opinion on this point is thus legally flawed and irrelevant, but such determination—the scope of the claim—is determined by the Court. *See, e.g., Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1347 (Fed. Cir. 1998) (“[T]he interpretation and construction of patent claims, which define the scope of the patentee’s rights under the patent, is a matter of law, exclusively for the court.”) (citation omitted). If the Court determines that claim 12 does not require checking availability of the second tuner, then Dr. Terveen will address the claim as interpreted by the Court as he reserved to the right to do so. (*Id.* at ¶ 12.)

Lastly, Motorola complains that Dr. Terveen did not show that any party has actually practiced every step of the claim. This is meritless. Dr. Terveen showed that together with the user guides made publicly available to the users of the accused set top boxes and the testing of real-life accused products, the users of Motorola’s set top boxes necessarily practice each and every limitation of the asserted claims. Indeed, an expert’s testimony that he himself performed the patented method using the accused product and circumstantial evidence in the form of documents regarding sales of the accused products and product instruction manuals are sufficient to establish direct infringement by the users of the accused set-top boxes. *See, e.g., Lucent Techs., Inc. v. Microsoft Corp.*, 580 F.3d 1301, 1317-19 (Fed. Cir. 2009). [REDACTED]

[REDACTED] *See, e.g., Vita-Mix Corp. v. Basic Holdings, Inc.*, 581 F.3d 1317, 1325-26 (Fed. Cir. 2009) (indicating that testing by an accused infringer’s employee can be used to establish the direct infringement by the accused infringer); *see also Linear Tech. Corp. v. U.S. Int’l Trade Comm.*, 566 F.3d 1049, 1062 (Fed. Cir. 2009); *Embrex, Inc. v. Service Eng’g Corp.*, 216 F.3d 1343, 1347-49 (Fed. Cir. 2000).



Accordingly, there is no support for Motorola's argument that Dr. Terveen's testimony will fail to assist the trier of fact.

IV. CONCLUSION

For the reasons set forth above, Motorola's Motion to Exclude Microsoft's Expert Loren

G. Terveen should be DENIED.

DATED this 8th day of August, 2011.

Respectfully submitted,

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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,

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