

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

TIMEBASE PTY LTD.,)
)
 Plaintiff,)
 vs.)
)
 THE THOMSON CORPORATION,)
 WEST PUBLISHING CORPORATION,)
 and WEST SERVICES, INC.,)
)
 Defendants.)

Civil Action Nos. 07-cv-1687 (JNE/JJG)

**TIMEBASE’S RESPONSE TO
DEFENDANTS’ MOTION TO EXCLUDE
TESTIMONY OF DR. OPHIR FRIEDER**

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I. INTRODUCTION

As this Court has recognized, "a patentee may prove infringement by any method of analysis that is probative of the fact of infringement, and circumstantial evidence may be sufficient." *Am. Med. Sys., Inc. v. Laser Peripherals, LLC*, 712 F. Supp. 2d 885, 895 (D. Minn. 2010) (Ericksen, J.) (quoting *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1372 (Fed. Cir. 2009)). At trial, TimeBase intends to rely upon the opinions of its technical expert, Dr. Ophir Frieder, as one means – but not the only means – by which TimeBase will introduce evidence to the jury to prove its claims of patent infringement. The defendants seek to have the **entirety** of Dr. Frieder's opinions relating to infringement excluded on the basis that **certain** of his opinions are purportedly flawed. Perhaps realizing the futility of this request, the defendants alternatively ask the Court to exclude Dr. Frieder's opinions relating to the word "each" as recited in the claims of the '592 patent, and to the word "displaying" as recited in the claims of the '228 patent.

Dr. Frieder's opinions relating to the topic of infringement are reliable. In the course of forming his opinions, Dr. Frieder spent several days examining the content of Westlaw for purposes of comparing the content of that system to the claims of the patents-in-suit. Dr. Frieder also spent dozens of hours examining the defendants' documents which have been produced in this case, as well as testimony provided by the defendants' own employee witnesses. While the parties fundamentally disagree

over the scope of the claims of the patents-in-suit – even after the Court's construction of the disputed claim terms – that disagreement does not provide a basis by which to exclude any aspect of Dr. Frieder's opinions, much less the entirety of his opinions. And given that the defendants will have every opportunity to challenge the reliability of Dr. Frieder's opinions at trial by way of vigorous cross-examination, there is no basis for the Court to impose the draconian measure of excluding Dr. Frieder's opinions outright. The defendants' motion to exclude should be denied.

II. APPLICABLE LEGAL STANDARD

Consistent with the "fundamental principle that Rule 702 is generally one of inclusion rather than exclusion," expert testimony such as Dr. Frieder's should not be easily barred. *EZ Dock, Inc., v. Schafer Systems, Inc.*, 2003 WL 1610781, *2 (D. Minn. Mar. 8, 2003). That is particularly so in view of the "liberal thrust" of the Federal Rules of Evidence. *Daubert v. Merrill Dow Pharm.*, 509 U.S. 579, 588 (1993). Pursuant to Federal Rule of Civil Procedure 702, Dr. Frieder's expert testimony must meet three prerequisites to be admissible. First, the evidence must be useful to the fact-finder in deciding the ultimate issue of fact. *Lauzon v. Senco Prods., Inc.*, 270 F.3d 681, 686 (8th Cir. 2001). Second, the expert must be qualified. *Id.* Third, the evidence must be reliable. *Id.*

Here, the defendants do not allege that Dr. Frieder is unqualified to provide opinions relating to infringement of the patents-in-suit, nor do the defendants allege that Dr. Frieder's opinions in that regard would be of no assistance to the jury.

Accordingly, the sole basis for the defendants' motion to exclude is the notion that Dr. Frieder's opinions are unreliable. "As a general rule, the factual basis of an expert opinion goes to the credibility of the testimony, not the admissibility, and it is up to the opposing party to examine the factual basis for the opinion in cross-examination." *Bonner v. ISP Techs., Inc.*, 259 F.3d 924, 929 (8th Cir. 2001). An expert's opinion should be excluded as unreliable only if that "opinion is so fundamentally unsupported that it can offer no assistance to the jury." *Id.* at 929-30.

III. THERE IS NO BASIS TO EXCLUDE THE ENTIRETY OF DR. FRIEDER'S OPINIONS RELATING TO INFRINGEMENT

The defendants ask the Court to "exclude Dr. Frieder's testimony completely." (Dkt. 237, Defendants' Memo, at 7). There is no basis to do so. Even if certain of Dr. Frieder's opinions relating to specific elements of the asserted patent claims were held to be inadmissible – which, as discussed below, clearly should not be the case – those shortcomings still fail to provide a valid basis to exclude Dr. Frieder's opinions relating to other elements of the claims. To the contrary, this Court has routinely allowed expert's to testify as to facts underlying an ultimate conclusion even when the expert has not been allowed to testify as to the ultimate conclusion itself. See e.g., *EZ Dock*, 2003 WL 1610781 at *7 (suggesting that expert would not be permitted to "testify about patent law," but allowing expert "to testify to facts pertaining to the comparison of the patent-in-suit to the accused products or to prior art references."); *Roederer v. J. Garcia Carrion, S.A.*, 2010 WL 489529, *3 (D. Minn. Feb. 4, 2010) (Ericksen, J.) (excluding expert from testifying on the ultimate

factual issue of likelihood of confusion, but allowing that expert to testify on the factual elements that go into that ultimate factual issue).

The same principle applies here to Dr. Frieder's opinions. Even if Dr. Frieder is not permitted to offer an opinion at trial as to the ultimate issue of whether the defendants infringe any claims of the patents-in-suit, Dr. Frieder should still be permitted to testify to facts pertaining to the comparison of the claims of the patents-in-suit to the content of the accused Westlaw system. In the event that this Court finds one or more of Dr. Frieder's opinions in this regard to be inadmissible, that narrow ruling should not automatically preclude all of Dr. Frieder's remaining opinions as to other elements of the claims. The *Izumi* and *Sprint* cases cited by the defendants do not suggest otherwise.

IV. THERE IS NO BASIS TO EXCLUDE DR. FRIEDER'S OPINIONS RELATING TO THE WORDS "EACH" AND "DISPLAYING"

A. Dr. Frieder's Opinions In Relation To The Word "Each" Are Reliable

The defendants contend that "Dr. Frieder should not be allowed to testify that the accused Westlaw system meets the limitations [of the '592 patent claims] requiring that each predefined portion of text-based data be encoded with at least one linking means." (Dkt. 237, Defendants' Memo, at 8). As the underlying basis for this argument, the defendants contend that Dr. Frieder was required to examine every single portion of text-based data accessible via Westlaw and, based upon that examination, to opine as to whether every such portion is encoded with a linking

means. (Id. at 10). The defendants contend that absent such an analysis, Dr. Frieder's opinions directed to these claim limitations are unreliable.

The defendants' argument in this regard is based upon their own improper interpretation of the Court's order construing the disputed claims terms of the patents-in-suit. Simply stated, there is absolutely no requirement that every single portion of text-based data which is accessible via Westlaw must be encoded with a linking means. Rather, the claims of the '592 patent require that the accused systems and methods comprise a plurality (i.e., at least two) of predefined portions of text based data, and that each of the plurality of those portions be encoded with a linking means. For example, claim 1 of the '592 patent recites:

1. A computer-implemented system for publishing an electronic publication using text-based data, comprising:

a plurality of predefined portions of text-based data with each predefined portion being stored;

at least one predefined portion being modified and stored;

a plurality of linking means of a markup language, **each predefined portion of *said* text-based data** and said at least one modified predefined portion of text-based data **being encoded with at least one linking means**; and

a plurality of attributes, each attribute being a point on an axis of a multidimensional space for organising said plurality of predefined portions and said at least one modified predefined portion of said text-based data.

(Exhibit A, U.S. Patent No. 6,233,592 B1, at column 155, lines 2-14; emphasis added).¹ The "each" language that is the subject of the defendants' motion is a requirement applicable to the plurality of portions recited in the claims, and nothing further. Accordingly, not all portions of text-based data that are accessible via Westlaw must necessarily participate in the claimed systems recited in the '592 patent. To put it another way, infringement is not negated by the presence of one or more portions of text-based data within Westlaw that fail to satisfy other limitations of the patent claims, including the requirement that each of the claimed plurality of portions of text-based data be encoded with at least one linking means.² To the extent that the defendants contend otherwise, they are mistaken as to the proper application of law in this case.

Dr. Frieder is not qualified to offer legal opinions, and TimeBase certainly has no plans to introduce legal opinions by way of Dr. Frieder's testimony at trial. Issues of law, of course, are not properly the subject of expert testimony in the first instance. *EZ Dock*, 2003 WL 1610781 at *7. Dr. Frieder has been instructed by TimeBase's counsel as to how the law should be applied to the claims of the patents-in-suit. Based upon those instructions, Dr. Frieder has provided sound expert opinions as to the presence of a plurality of predefined portions of text-based data

¹ The exhibits referenced herein are attached to the concurrently filed Declaration of Jenna Bayer in Support of TimeBase's Response to Defendants' Motion to Exclude Testimony of Dr. Ophir Frieder.

² In the interest of brevity, TimeBase respectfully directs the Court to Sections II and III of TimeBase's concurrently filed Response to Defendants' Motion for Summary Judgment, which includes a more detailed analysis as to why the defendants' arguments directed to the word "each" are incorrect. TimeBase incorporates that analysis herein by reference.

within Westlaw. (See e.g., Exhibit B, Expert Report of Ophir Frieder dated February 28, 2011, at 8-10). Dr. Frieder has likewise provided sound expert opinions as to the manner in which those portions of text-based data are encoded with a linking means. (See e.g., Id. at 12-15).

While the defendants may object to the factual foundation for Dr. Frieder's opinions on these issues, those objections do not provide a basis for barring Dr. Frieder's testimony. Rather, as this Court has recognized on numerous occasions, the defendants are free to challenge the foundation and sufficiency of Dr. Frieder's opinions at trial:

Rockwood may challenge the foundation for Simac's opinions at trial. If that foundation is laid, Rockwood may test the credibility of Simac's testimony on cross examination, rebut the testimony with its own witnesses, and submit its own contrary expert evidence, and the jury can determine the weight and credibility to given Simac's testimony. Therefore, Rockwood's *Daubert* motion is denied.

Rockwood Retaining Walls, Inc. v. Patterson, Thuente, Skaar & Christensen, P.A., 2011 WL 2845529, *5 (D. Minn. July 18, 2011);

To the extent Dr. Rasty's testimony may include inaccuracies, discrepancies or conclusions lacking support, these would be proper subjects for cross-examination. See *Daubert*, 509 U.S. at 596. Accordingly, Octane's motion to strike the portions of Dr. Rasty's testimony on equivalence is denied.

Icon Health & Fitness, Inc., v. Octane Fitness, LLC, 2011 WL 2457914, *8 (D. Minn. June 17, 2011); see also, *Roederer*, 2010 WL 489529 at *4 (Ericksen, J.) (denying motion to exclude in part and holding that "Roederer may attack Simonson's testimony with vigorous cross-examination and the presentation of contrary evidence."); *In re: St. Jude Medical Inc. Silzone Heart Valves Products Liability*

Litigation, 493 F. Supp. 2d 1082, 1088 (D. Minn. 2007) (denying motion to exclude expert testimony and holding that "defendant's objections to the factual support for [the challenged expert's] opinion more appropriately go to the weight of the opinion than the admissibility."); *Edina Realty, Inc. v. TheMLSONline.com*, 2006 WL 737064, *3 (D. Minn. Mar. 20, 2006) (denying motion to exclude expert testimony and holding that "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.").

In fact, as the Federal Circuit has recognized, the inspection of the accused device is not a prerequisite to being able to offer testimony on infringement. See *Data Line Corp. v. Micro Technologies, Inc.*, 813 F.2d 1196, 1200 (Fed. Cir. 1987). In *Data Line*, the Federal Circuit affirmed the trial court's decision to permit expert testimony over the infringer's objections, even though the expert failed to physically inspect the accused device or read its source code. *Id.* Specifically, the Federal Circuit rejected the attacks on the patentee's expert, noting that "[t]he jury was presented with evidence that physical inspection of the [accused device] would be a useless undertaking."

This case, like *Data Line*, involves an attack on an expert for failing to engage in such a "useless undertaking." Westlaw involves literally millions of portions of text-based data. The fact that Westlaw might contain additional portions beyond "the plurality" required by the claims of the '592 patent is irrelevant – the addition of further elements (in this case, portions of text-based data) does not negate

infringement. *See, e.g., Data Line*, 813 F.2d at 1202 (noting that "a reasonable jury could have concluded that [] additional features do not produce a 'radically different' system and therefore are not inconsistent with the determination of infringement").

Even if this Court rewrote its claim construction to exclude any possibility of other, additional portions of text-based data lacking any linking means, Dr. Frieder's testimony would still be admissible to support TimeBase's infringement claim. Dr. Frieder's testimony shows that he spent several days examining the content of Westlaw for purposes of comparing the content of that system to the claims of the patents-in-suit. (Exhibit C, Deposition of Ophir Frieder, at 19-20). He also he spent dozens of hours examining the defendants' documents which have been produced in this case, as well as testimony provided by the defendants' own employee witnesses. (Id. at 19-20 and 255-56). At trial, the evidence will show that: (1) Dr. Frieder located a multitude of portions of text-based data within Westlaw that were encoded with at least one linking means as required by the claims of the '592 patent; and (2) it would not have been feasible for him to review each and every portion of text-based data accessible via Westlaw. Logic – let alone the technical expertise from a person of skill – would dictate that it would be reasonable under these circumstances for Dr. Frieder to deduce what the portions of text-based data in the Westlaw system include. In short, the defendants attack Dr. Frieder for relying upon deductive as opposed to inductive reasoning. Dr. Frieder, however, did inspect the accused Westlaw system extensively. He did far more than the technical experts

whose opinions were upheld by the Federal Circuit in *Data Line*. Thus, the defendants' attack on Dr. Frieder's opinions should be rejected.

B. Dr. Frieder's Opinions In Relation To The Word "Displaying" Are Reliable

The defendants also contend that "Dr. Frieder should not be allowed to testify that defendants perform or control the 'displaying' steps of the '228 patent." (Dkt. 237, Defendants' Memo, at 12). As the underlying basis for this argument, the defendants contend that Dr. Frieder was required to opine as to how the defendants specifically control or direct the act of "displaying" as that term has been construed by the Court. (Id. at 13). The defendants contend that absent such an analysis, Dr. Frieder's opinions directed to any limitations in the claims of the '228 patent which recite the step of "displaying" are unreliable.

Here, again, the defendants' argument is based upon their own improper interpretation of the Court's order construing the disputed claims terms of the patents-in-suit. The Court's construction of the term "displaying" requires the act of "showing [text-based data, search results, or links] on an electronic video device capable of changing in real time in response to inputs, such as a CRT monitor, an LCD monitor, or a projector and screen." (Dkt. 219, Order on Claim Construction, at 25). The key language in that construction is the word "showing." That is the act which TimeBase must ultimately demonstrate is directed or controlled by the defendants. It is not necessary for Dr. Frieder to opine – or for TimeBase to demonstrate at trial – that the defendants "provide the computer equipment necessary to complete the act of 'displaying.'" (Dkt. 237, Defendants' Memo, at 2).

To the extent that the defendants contend otherwise, they are once again mistaken as to the proper application of law in this case.

As discussed in greater detail in TimeBase's concurrently filed Response to Defendants' Motion for Summary Judgment, the defendants most certainly do control the act of "displaying" as recited in the claims of the '228 patent – that much is abundantly clear.³ Putting aside any disputes that the parties may have over how the law should be applied to this issue (an issue which is not properly the subject of expert testimony in the first instance, *EZ Dock*, 2003 WL 1610781 at *7), Dr. Frieder has provided sound expert opinions as to the "displaying" steps recited in the claimed methods of the '228 patent. More specifically, Dr. Frieder provided opinions on the application of this claim language to the defendants' acts in relation to operating Westlaw. (See e.g., Exhibit B, Expert Report of Ophir Frieder dated February 28, 2011, at 85-93).

The defendants acknowledge Dr. Frieder's opinions in this regard, but then proceed to complain that those opinions were provided in a "passive" context and were based upon Dr. Frieder's purported misunderstanding of the sworn testimony of the defendants' own employee witness. (Dkt. 237, Defendants' Memo, at 14-15). These objections do not form a basis for excluding Dr. Frieder's testimony, particularly when that testimony will be the subject of cross-examination, rebuttal testimony, contrary expert testimony, and other forms of attack when this case

³ In the interest of brevity, TimeBase respectfully directs the Court to Section IV of TimeBase's concurrently filed Response to Defendants' Motion for Summary Judgment, which includes a more detailed analysis as to why the defendants' arguments directed to the word "displaying" are incorrect. TimeBase incorporates that analysis herein by reference.

proceeds to trial. See *Rockwood Retaining*, 2011 WL 2845529 at *5; *Icon Health*, 2011 WL 2457914 at *8; *Roederer*, 2010 WL 489529 at *4; *In re: St. Jude Medical*, 493 F. Supp. 2d at 1088; *Edina Realty*, 2006 WL 737064 at *3.

V. THERE IS NO BASIS TO EXCLUDE ANY OF DR. FRIEDER'S "OTHER" OPINIONS RELATING TO INFRINGEMENT

In the final paragraph of their motion, the defendants suggest that there are other limitations in the asserted claims of the patents-in-suit (in addition to "each" and "displaying") which Dr. Frieder purportedly failed to address in his expert report. (Dkt. 237, Defendants' Memo, at 16-17). The defendants allege that the chart provided at pages 16-17 of their motion "makes clear that Dr. Frieder did not do the analysis required of an infringement expert in a patent case." (Id. at 17). TimeBase disagrees. The chart provided by the defendants is anything but clear. The defendants' chart is largely redundant of the issues already addressed by TimeBase above. Most, if not all, of the issues identified in the defendants' chart involve disputes over the proper application of law. Other aspects of the chart (such as the reference to what is or is not present in "blue underlined text within Westlaw") are certainly not "claim requirements" as mistakenly suggested by the defendants. In any event, even a cursory review of Dr. Frieder's expert report demonstrates that he opined on each term of the asserted claims of the patents-in-suit. The defendants' conclusory allegations to the contrary are without merit.

VI. CONCLUSION

The defendants have provided no valid basis to exclude any one of Dr. Frieder's opinions relating to the topic of infringement from being presented at trial,

much less the entirety of his opinions in this regard. The defendants will have the opportunity to test Dr. Frieder's testimony before the jury. For all of the foregoing reasons, the defendants' motion to exclude should be denied.

Dated: July 21, 2011

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