

**UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

TIMEBASE PTY LTD.,

Plaintiff,

vs.

THE THOMSON CORPORATION,
WEST PUBLISHING CORPORATION,
and WEST SERVICES, INC.,

Defendants.

Civil No. 07-1687 (JNE/JJG)

**DEFENDANTS' REPLY
MEMORANDUM IN SUPPORT OF
DEFENDANTS' MOTION TO
EXCLUDE TESTIMONY OF DR.
OPHIR FRIEDER**

Dr. Frieder did not perform the analysis required of an infringement expert—he did not compare the accused device to each claim limitation as construed by the Court. TimeBase admits that Dr. Frieder did not analyze the “each predefined portion” limitation of the ‘592 patent because “it would not have been feasible for him to review each and every portion of text-based data accessible via Westlaw.” (TimeBase Br. at 9.) TimeBase also admits that Dr. Frieder’s opinion on the ‘228 patent’s limitation of “displaying” was “provided in a ‘passive’ context” and therefore did not address who performed the act of “showing on an electronic video device.” (*Id.* at 11.) In addition to these failings, TimeBase offers no substantive explanation for Dr. Frieder’s failure to address other claim limitations, including the requirement in each of the claims of a “multidimensional space” as defined by the Court. (*Id.* at 12.) Despite all of these failures, TimeBase nonetheless requests that Dr. Frieder be permitted to testify about

other limitations in the claims, presumably so that TimeBase can create the impression for the jury of having an infringement expert. TimeBase's request should be rejected.

A. TIMEBASE ADMITS THAT DR. FRIEDER'S INFRINGEMENT ANALYSIS HAS GAPING HOLES.

TimeBase attempts to excuse the gaping holes in Dr. Frieder's infringement analysis by suggesting that they result from "the parties fundamentally disagree[ing] over the scope of the claims of the patents in suit." (*Id.* at 1-2.) But the claim language, as construed by the Court, is perfectly clear. As TimeBase admits, Dr. Frieder simply did not apply this language to the accused Westlaw system.

TimeBase Admits Dr. Frieder Did Not Analyze Each of the Millions of Predefined Portions to Determine Whether They Are Encoded with Linking Means.

TimeBase acknowledges that Westlaw "involves literally millions of portions of text-based data" (*id.* at 8) and argues that asking Dr. Frieder to examine each portion to determine whether it has linking means would be a "useless undertaking" (*id.* at 8 (quoting *Data Line Corp. v. Micro Techs., Inc.*, 813 F.2d 1196, 1200-01(Fed. Cir. 1987))). But the *Data Line* court excused an expert's failure to examine the accused product only *because there was other—better—evidence* concerning operation of the accused system. *Id.* In contrast, neither TimeBase nor Dr. Frieder can point to *any* evidence or analysis performed by Dr. Frieder regarding the "each predefined portion" limitation of the '592 patent.

TimeBase seeks to justify its failure to perform an analysis of every predefined portion of text by contending that it can show at trial that “it would not have been feasible for [Dr. Frieder] to review each and every portion of text-based data accessible via Westlaw.” (TimeBase Br. at 9.) Whether or not that is true, it does not excuse Dr. Frieder from having to perform a reliable analysis of each claim limitation. As Dr. Frieder himself noted in his expert report, “a claim is infringed when *all the elements* of that claim are present in the accused system or practiced by the accused method.” (Dkt. 238-1 at 6 (emphasis added).) Yet, as Dr. Frieder has admitted, he did not even attempt to determine whether each predefined portion of text within Westlaw is encoded with linking means. (Dkt. 238-2 at 158, 161.)

TimeBase now tries to backpedal from this admission with the confusing assertion that “Dr. Frieder [relied] upon deductive as opposed to inductive reasoning” in analyzing the “each” limitations. But nowhere has Dr. Frieder described how he performed *any* sort of analysis of the “each” limitation, whether inductive, deductive, or otherwise. Dr. Frieder’s expert report is completely silent on this point.¹ Dr. Frieder’s entire analysis of the “each predefined portion” limitation consists of the following passage:

¹ To the extent that Dr. Frieder might otherwise testify at trial that he performed some sort of deductive analysis to determine that the “each” limitations are found in the accused system, he has not disclosed this analysis as required by the Federal Rules. *See* Fed. R. Civ. P. 26(a)(2)(B)(i) (requiring “a complete statement of all opinions the [expert] witness will express *and the basis and reasons for them*”) (emphasis added). Under these circumstances, Dr. Frieder cannot provide testimony based on any such undisclosed analysis. *See O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1368-69 (Fed. Cir. 2006); *Air Turbine Tech., Inc. v. Atlas Copco AB*, 410 F.3d 701, 713 (Fed. Cir. 2005); *Am. Med. Sys., Inc. v. Laser Peripherals, LLC*, 712 F. Supp. 2d 885, 901 (D. Minn. 2010) (Ericksen, J.).

For example, Figure 592-1-6 shows a stored predefined portion (26 U.S.C.A. 213 as it existed from January 1, 1997 to December 31, 2004) with a linking means, while Figure 592-1-7 shows a predefined portion stored in a modified form (26 U.S.C.A. 213 as effective since January 1, 2005) also having linking means. In both figures, the added red box (around “Prior”) highlights an example of the linking means.

(Dkt. 238-1 at 12-13.) The captions under Figure 592-1-6 and Figure 592-1-7 add that these figures are “representative” and that “[a]dditional exemplary linking means are also shown (e.g., ‘Previous Section’ and ‘Next Section’).” (*Id.* at 13-14.) That is it. Dr. Frieder makes some other comments about the structure and function of “linking means,” but he provides no further analysis of the “each” requirement. TimeBase cannot now be excused from Dr. Frieder’s choice not to apply the limitation requiring “each predefined portion” to be encoded with linking means to the accused Westlaw system.

TimeBase Admits Dr. Frieder Failed to Analyze Who Performs “Displaying.”

TimeBase admits that Dr. Frieder’s opinion on displaying was “provided in a ‘passive’ context,” and thereby concedes that he provided no reasoned opinion on who performs the act of “showing on an electronic video device.” (TimeBase Br. at 11.) Dr. Frieder similarly failed to provide any analysis of whether defendants control the step of “displaying” as it is performed by end-users. Instead, TimeBase seeks to overcome this failure by ignoring the Court’s claim construction and arguing that “displaying means providing.” (Dkt. 258, TimeBase Opposition to Summary Judgment at 36.) But the Court has already construed “displaying” to mean “showing on an electronic video device.” (Dkt. 219 at 25.) Dr. Frieder has not provided any analysis of how defendants perform, control, or direct the step of “showing on an electronic video device.”

TimeBase Does Not Address the Other Limitations Dr. Frieder Ignored. In their initial brief, defendants pointed to several additional examples of claim limitations that Dr. Frieder failed to analyze. (Dkt. 237 at 16-17.) These limitations included the requirement that each claim have a “multidimensional space,” which under the Court’s claim construction is “an area not having boundaries” and requires “point-to-point movement.” Rather than attempting to explain these further deficiencies, TimeBase responds by criticizing defendants’ chart as “anything but clear” and “redundant.” (TimeBase Br. at 12). TimeBase asserts that “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.” (*Id.*) TimeBase does not even attempt to identify in his expert report Dr. Frieder’s analysis of the specific limitations challenged by defendants, because no such analysis exists. Accordingly, TimeBase has no answer to any of the gaping holes in Dr. Frieder’s opinions.

B. ANY TESTIMONY DR. FRIEDER MIGHT OFFER DESPITE HIS FAILURE TO ANALYZE INFRINGEMENT WOULD BE UNRELIABLE, CONFUSING, AND UNFAIRLY PREJUDICIAL.

TimeBase has effectively conceded that unless the Court accepts TimeBase’s rewriting of the claims, Dr. Frieder’s opinions on infringement are fundamentally unsupported and therefore unreliable. Yet TimeBase then suggests that “[e]ven if Dr. Frieder is not permitted to offer an opinion at trial as to the ultimate issue of whether defendants infringe any claims of the patents-in-suit, Dr. Frieder should still be permitted to testify to facts pertaining to the comparison of claims of the patents-in-suit to the content of the accused Westlaw system.” (TimeBase Br. at 4.) The Court should reject

TimeBase's request. As Dr. Frieder himself has noted, "[his] role in this case is to provide expert opinions on infringement." (Dkt. 238-1 at 3.) Having failed to conduct an infringement analysis, Dr. Frieder has no relevant opinion on infringement.

Given the undisputed deficiencies in Dr. Frieder's proffered testimony, the Court should recognize the true nature of TimeBase's request. TimeBase seeks to confuse and mislead the jury and unfairly prejudice defendants' case by putting forth an expert to create the *impression* that TimeBase has an expert witness on infringement when, in fact, it does not. TimeBase cannot secure the benefit of presenting expert testimony when the expert has not performed the analysis required of him under the governing legal standards. *See Liquid Dynamics Corp. v. Vaughan Co.*, No. 01C6934, 2004 WL 2260626, at *4-5 (N.D. Ill. Oct. 1, 2004) (excluding an expert's testimony in its entirety as irrelevant, unfairly prejudicial, and confusing where the expert's opinion was based on an incorrect construction of a single key claim limitation), *aff'd*, 449 F.3d 1209, 1224 n.2 (Fed. Cir. 2006); *see also PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1348-49, 1354-55 (Fed. Cir. 2007) (affirming that the testimony of patentee's infringement expert should have been excluded because the expert performed no infringement analysis of a key claim limitation beyond drawing unreasonable inferences from defendants' marketing materials). Accordingly, the Court should exclude Dr. Frieder's testimony in its entirety.

Respectfully submitted,

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