

UNITED STATES DISTRICT COURT
DISTRICT OF NEW MEXICO

STC.UNM,

Plaintiff,

v.

INTEL CORPORATION,

Defendant.

Civil No. 1:10-cv-01077-RB-WDS

INTEL'S RESPONSE TO STC'S REQUEST FOR
LIVE TESTIMONY RE CLAIM CONSTRUCTION

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In its reply brief, STC has requested for the first time that the Court hear live expert testimony at the hearing on claim construction. [Dkt. 147 at 1] Intel opposes STC's request. To the extent the Court desires a technology tutorial, counsel can provide it (ideally in advance). The parties can also bring their experts to the hearing in case the Court has particular questions. But Intel submits that live expert testimony is both unnecessary and inappropriate here. STC has not identified any technical fact dispute that the Court must resolve to construe the two asserted claims. Even if there were such an issue, the parties have had plenty of opportunity to test the experts in deposition and submit the testimony to the Court. Moreover, much of the testimony that Dr. Mack has offered in his declarations and deposition consists of thinly veiled, but legally unsound, attorney argument, dressed as his subjective interpretation of the patent and the inventors' intentions. Such testimony will merely distract the Court from the language of the claims and the other intrinsic evidence, which should be its primary focus.

As explained in Intel's claim construction briefs, claims must be interpreted first and foremost in view of the intrinsic evidence: the claims themselves, the specification of the patent, and the patent's prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc). "[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" *Id.* Although expert testimony can be considered, such extrinsic evidence is "less reliable than the patent and its prosecution history in determining how to read claim terms." *Id.* Whether to accept or exclude expert testimony is within the sound discretion of the Court. *INPRO II Licensing v. T-Mobile USA, Inc.*, 450 F.3d 1350, 1357 (Fed. Cir. 2006).

With this law in mind, Intel submitted expert declarations from Dr. Bruce Smith solely to provide background about the technology and to point out some of the inconsistencies between

STC's construction and the intrinsic record. [See Dkt. 111, 135] Unlike STC's expert, Dr. Smith did not march through the list of disputed terms and provide his subjective meaning of the claim terms as if his declaration were simply an opportunity to file yet another brief. [Compare Dkt. 111, 135 with Dkt. 113-5, 133-7]

After three rounds of briefing, it appears that the primary dispute between the parties is a legal one, not a technical one. STC and its expert Dr. Mack have proceeded as if there is a presumption that the one independent claim STC has asserted (Claim 6) must cover all or at least multiple disclosed embodiments, even if the language of the claim is to the contrary. As Intel has explained, and the Federal Circuit recently confirmed, that is not the law. [See Dkt. 148 at 1-3 (citing *August Tech. Corp. v Camtek, Ltd.*, No. 2010-1458, 2011 U.S. App. LEXIS 17451, at *14-15 (Fed. Cir. Aug. 22, 2011))] For this reason alone, the Court should not hear live testimony. Such testimony would not resolve this legal dispute, but instead would likely lead to Dr. Mack further polluting the record with opinions based upon legally erroneous assumptions. [Id. at 3]

Despite the differences between the parties' legal conclusions, the experts do not have material disagreements about the technology. Accordingly, there is no pressing need to evaluate the credibility of expert testimony. On the contrary, STC argued repeatedly in its last claim construction brief how Dr. Smith's admissions were consistent with statements from STC's Dr. Mack. [See, e.g., Dkt. 147 at 6 ("Dr. Mack's statement stands unquestioned.")] Likewise, Dr. Mack readily conceded that Dr. Smith's technical observations were correct. [Dkt. 148 at 3 (noting Dr. Mack's agreement with Intel and the file history that square and round shapes do not necessarily have different spatial frequencies, nor do greater amplitudes of frequencies correspond to sharp corners); id. at 7 (conceding that Intel's construction covers "multiplication

of patterns”)] There are no burning technical disputes dividing the experts to warrant live testimony at the hearing.

In any event, even if the parties had identified fundamental technical disputes between the experts, the parties have had full opportunity to cross-examine the experts in deposition. Although Dr. Smith submitted fewer than ten pages of declarations, STC deposed him for eight hours. Likewise, Intel deposed Dr. Mack regarding his fifteen pages of declarations, and both parties submitted relevant deposition excerpts to the Court. There is no need to occupy the Court’s time repeating what the parties have already submitted into the record.

In sum, after 50 pages of briefing, two expert declarations, dozens of pages of deposition transcripts and countless other exhibits to construe a mere seven terms, the issues that are joined are legal ones. STC has not identified a single material technical dispute between the experts that the Court must resolve. In this situation, it would be unwise to occupy the Court and the parties’ time with yet more extrinsic evidence for which there is no identified legitimate purpose.

Dated: October 19, 2011.

Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that on October 19, 2011, the foregoing document was electronically filed with the Clerk of Court using the CM/ECF system, which will automatically send notification of such filing to all counsel who have entered an appearance in this action.

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