IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

BRIGHT RESPONSE, LLC, Plaintiff,	§	
v.	§	Civil Action No. 2:07-cv-371-ce
GOOGLE INC., et al., Defendants.	§	JURY TRIAL DEMANDED

BRIGHT RESPONSE, LLC'S MOTION TO EXCLUDE EXPERT TESTIMONY FROM DR. L. KARL BRANTING REGARDING WRITTEN DESCRIPTION UNDER *DAUBERT* AND RULE 702 OF THE FEDERAL RULES OF EVIDENCE

Plaintiff Bright Response, LLC ("Bright Response") files this motion to strike or exclude expert testimony from Dr. L. Karl Branting, Defendants' invalidity expert, regarding whether the '947 patent complies with the written description requirement of 35 U.S.C. § 112, ¶ 2 because it fails to meet the requirements of admissibility of expert testimony set forth in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993) and Rule 702 of the Federal Rules of Evidence ("Rule 702").

The purpose of expert testimony is to assist the trier of fact. In order to assist the trier of fact, expert testimony must be relevant and "reliable." It is the Court's role as gatekeeper to make sure that proffered expert testimony meets this standard. *Tyco Healthcare Group, LP v. Applied Med. Res. Corp.*, No. 9:06-CV-151, 2009 WL 5842063, at *1 (E.D. Tex. Mar. 30, 2009) ("The Supreme Court in *Daubert* charged trial courts with the task of determining whether expert testimony under Rule 702 is "not only relevant, but reliable") (citing *Daubert v. Merrill Dow Pharms.*, 509 U.S. 579, 589 (1993)). Reliable expert testimony must have some factual foundation or reasoning to support the expert's opinion. *See* Fed. R. Evid. 702 (expert testimony must be "based upon sufficient facts or data"); *Neutrino Dev. Corp. v. Sonosite, Inc.*, 410 F. Supp. 2d 529, 548 (S.D. Tex. 2006) ("Dr. Quistgaard…fails to explain how each claim of the

'021 patent is disclosed in the claims of the Diasonics patent. As such, Dr. Quistgaard's testimony on the issue of anticipation of the Diasonics device is not sufficiently reliable under Daubert and is therefore inadmissible."). *Cf. Elder v. Tanner*, 205 F.R.D. 190 (E.D. Tex. 2001) (testimony based on factual reasoning could be considered non-conclusory).

Of the 286 paragraphs that comprise Dr. Branting's report, only two of the paragraphs address his opinion regarding the sufficiency of the written description of the '947 patent. These paragraphs have been reproduced in full below:

> 276. I have been informed by counsel that to meet the written description requirement, an application must describe an invention, and do so in sufficient detail, that one skilled in the art can clearly conclude that the inventor invented the full scope of the claimed invention as of the filing date sought. I understand the question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification.
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> 277. I am of the opinion that at the time the '947 patent was filed, one of ordinary skill in the art would not understand that the specification described in sufficient detail an invention to receive, interpret, and retrieve one or more responses to an Internet search query, an Internet user's click or a web page, which I understand is what Plaintiff contends meets the noninteractive electronic message limitation in the accused products.

Wiley Decl. Ex. A. Paragraph 276 describes Dr. Branting's understanding of the relevant law. Therefore, the full extent of Dr. Branting factual analysis regarding written description can be found in paragraph 277 above.

As these paragraphs conclusively establish, Dr. Branting offers no factual underpinnings for his opinion. Aside from his conclusion regarding how one of ordinary skill in the art would view the written description of the "non-interactive electronic message" element of the asserted claims, Dr. Branting provides no citation to the specification of the '947 patent or the provisional applications to which the '947 patent claims priority. Dr. Branting provides no analysis describing what portions of the written description of the '947 patent would lead one of ordinary skill in the art to understand that the invention in the '947 patent would not apply broadly to all non-interactive electronic messages. Indeed, Dr. Branting's statement is barely more than a mere statement "there is no written description" as Section 112 requires or "the claims asserted are invalid for lack of written description/under Section 112." As in *Neutrino*, the Court should find

Dr. Branting's bare conclusion inadmissible and strike Dr. Branting's invalidity opinion addressing 35 U.S.C. § 112, ¶ 1.

Because Dr. Branting's opinion fails to meet the relevance and reliability standards of *Daubert* and Rule 702, Bright Response requests that the Court strike and preclude any testimony from Dr. Branting concerning the sufficiency of the written description of the '947 patent.

Dated: July 26, 2010

Respectfully submitted,

By: /s/ Elizabeth A. Wiley
Elizabeth A. Wiley

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CERTIFICATE OF SERVICE

I certify that counsel of record who are deemed to have consented to electronic service are being served this 26th day of July, 2010, with a copy of this document via the Court's CM/ECF systems per Local Rule CV-5(a)(3). Any other counsel will be served electronic mail, facsimile, overnight delivery and/or First Class Mail on this date.

\s\ Elizabeth A. Wiley
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