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

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PA ADVISORS, LLC,

Plaintiff,

vs.

Case No. 2-07CV-480-RRR

GOOGLE INC., ET AL.,

Defendants.

\_\_\_\_\_ /

DEPOSITION OF PAUL STANLEY PETERS, JR.

Tuesday, February 9, 2010

REPORTED BY:

HOLLY MOOSE, RDR-CRR-CRP

CSR NO. 6438

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3	<p>1 APPEARANCES (CONTINUED)</p> <p>2</p> <p>3 ALSO PRESENT: Carey Mook, Videographer</p> <p>4 Hundt Reporting</p> <p>5</p> <p>6 TAKEN AT:</p> <p>7 QUINN, EMANUEL, URQUHART, OLIVER &amp; HEDGES</p> <p>8 555 Twin Dolphin Drive, Suite 560</p> <p>9 Redwood Shores, CA 94065</p> <p>10 (650)801-5000</p> <p>11</p> <p>12 ---o0o---</p> <p>13</p> <p>14</p> <p>15</p> <p>16</p> <p>17</p> <p>18</p> <p>19</p> <p>20</p> <p>21</p> <p>22</p> <p>23</p> <p>24</p> <p>25</p>	5
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1 PROCEEDINGS 10:04 A.M.  
 2 THE VIDEOGRAPHER: Good morning. We are now on  
 3 the record. This is the digital video deposition of  
 4 Stanley Peters, testifying in the matter of PA Advisors  
 5 versus Google, et al., in the United States District  
 6 Court, Eastern District of Texas, Marshall Division,  
 7 case number 2:07-CV-480-DVF [sic].  
 8 This deposition is being held at Quinn Emanuel,  
 9 et al., 555 Twin Dolphin Drive, Fifth Floor, Redwood  
 10 Shores, California. Today's date is Tuesday,  
 11 February 9th, 2010, and the time on the video screen  
 12 is 10:04 a.m.  
 13 My name is Carey Mook, and I'm a certified  
 14 legal video specialist with Hundt Reporting. The  
 15 certified shorthand reporter today is Holly Moose, also  
 16 in association with Hundt Reporting.  
 17 Will all counsel now please state your  
 18 appearance for the record.  
 19 MR. FENSTER: Marc Fenster with Russ, August &  
 20 Kabat on behalf of the plaintiff.  
 21 MS. PALLIOS ROBERTS: Andrea Pallios Roberts  
 22 with Quinn Emanuel on behalf of Google.  
 23 MR. WHITE: Jason White with Howrey on behalf  
 24 of defendant Yahoo!.  
 25 MR. CANNON: This is Brian Cannon from Quinn

7

1 Emanuel.  
 2 THE VIDEOGRAPHER: Okay. If there are no  
 3 stipulations, would the court reporter please administer  
 4 the oath.  
 5 (Witness sworn.)  
 6 PAUL STANLEY PETERS, JR.,  
 7 having been first duly sworn, testified as follows:  
 8 EXAMINATION BY  
 9 MR. FENSTER: Q. Good morning, Dr. Peters.  
 10 A. Good morning.  
 11 Q. Can you state your name and address for the  
 12 record, please.  
 13 A. I'm Stanley Peters, and I live at 128 Hillside  
 14 Avenue, Menlo Park, California.  
 15 Q. Have you been deposed before?  
 16 A. Once, yes.  
 17 Q. In what context?  
 18 A. I was deposed as an expert in another case.  
 19 Q. What other case was that?  
 20 A. It was a patent case about four years ago.  
 21 Q. Okay. What was the name of the case?  
 22 A. Truth to tell, I don't remember. It was the  
 23 University of Texas suing some cell phone companies.  
 24 Q. And did you testify at trial in that case?  
 25 A. I testified in a Markman hearing.

8

1 Q. And on behalf of which party were you  
 2 testifying?  
 3 A. I was testifying on behalf of the defendant.  
 4 Q. And what was the subject matter of your  
 5 testimony?  
 6 A. It was about the construction of one of the  
 7 terms in the patent.  
 8 Q. Did you have any other -- were there any other  
 9 topics that you opined on other than claim construction?  
 10 A. No.  
 11 Q. And what law firm did you -- were you retained  
 12 by in that case?  
 13 A. In that case, I was retained by Quinn Emanuel.  
 14 Q. What attorneys did you work with in that case?  
 15 A. Trying to remember the name. Kevin Johnson, I  
 16 think it was, and Evette Pennypacker.  
 17 Q. Okay. Have you ever been retained as an expert  
 18 in any other cases besides this one and the University  
 19 of Texas case?  
 20 A. Just one other.  
 21 Q. And what was that?  
 22 A. That was a criminal case about 25 years ago.  
 23 Someone was charged with perjury.  
 24 Q. Okay. Have you done any -- so you haven't been  
 25 retained as an expert in a patent case in any other

9

1 cases besides this one and the University of Texas case;  
 2 is that correct?  
 3 A. That's correct.  
 4 Q. Okay. Have you ever done any work regarding  
 5 invalidity prior to this case?  
 6 MS. PALLIOS ROBERTS: Objection. Form.  
 7 THE WITNESS: So have I testified about  
 8 invalidity; is that what you're asking? Or ...  
 9 MR. FENSTER: Q. Have you ever done any expert  
 10 opinion or consulting work regarding patent invalidity  
 11 prior to this case?  
 12 A. Well, the validity of the patent was part of  
 13 what the claims construction -- I guess it was at issue  
 14 in the claims construction case.  
 15 Q. Did you render any opinions in the University  
 16 of Texas case regarding validity?  
 17 A. I rendered an opinion that the term about which  
 18 I was asked to testify was indeterminate.  
 19 Q. Was that a means plus function claim; do you  
 20 recall?  
 21 A. I'm sorry, I don't know what that means.  
 22 MS. PALLIOS ROBERTS: Objection. Form.  
 23 MR. FENSTER: Okay.  
 24 Q. Have you ever done any consulting or expert  
 25 work regarding validity based on prior art prior to this

10	1 case? 2 A. Well, the question of prior art came up in that 3 other case as to whether the term was -- was definite in 4 terms of its use in prior art. But I don't know if 5 that's what you mean here. 6 Q. Have you ever been asked, prior to this case, 7 to do any analysis or render an opinion regarding 8 invalidity for obviousness? 9 A. No. 10 Q. Have you ever, prior to this case, been asked 11 to do any analysis or render an opinion regarding 12 invalidity under -- for anticipation? Do you know what 13 that is? 14 MS. PALLIOS ROBERTS: Objection. Form. 15 THE WITNESS: So do I know what anticipation 16 is. I think anticipation is a legal term that means 17 claim of a patent is entirely encompassed by some prior 18 patent or other prior art. 19 MR. FENSTER: Q. Prior to this case, have you 20 ever been asked to render any opinion or do any analysis 21 regarding invalidity for anticipation? 22 A. I guess I'm not quite clear on what the 23 question is. I'm not -- I was asked to render an 24 opinion in this case about the validity of the claims, 25 not about anticipation or any other specific thing.	12	1 that we get a clear record today. And so if at any 2 point you don't understand a question, will you ask me 3 to clarify it? 4 A. I will. 5 Q. Okay. And if you don't hear a question, will 6 you ask me to repeat it? 7 A. Yes. 8 Q. If you give an answer, is it fair to assume 9 that you've heard the question and you understood it? 10 A. I'm trying to give you the best answers that I 11 can to the questions as I understand them. And I 12 will -- that's why I was asking for clarification about 13 what you meant by had I been asked before this case to 14 render an opinion as to anticipation. 15 As I say, your question seems to presuppose I 16 was asked specifically about anticipation, and that's 17 not the case. That's why I did try to get you to 18 clarify the question in this case. 19 To the best of my ability, I'll answer every 20 question accurately and as I -- 21 Q. Fair enough. 22 A. -- best understand it. 23 Q. Is there anything that would prevent you from 24 giving your best testimony today? 25 A. No.
11	1 Q. You were asked to analyze the -- all aspects of 2 validity of the claims in this case? 3 MS. PALLIOS ROBERTS: Objection. Form. 4 THE WITNESS: I was asked -- I was asked about 5 the patent and the claims that are at issue and to study 6 them, and then I was asked to give my opinions about 7 validity. 8 MR. FENSTER: Q. Okay. And did you consider 9 all potential aspects of validity? 10 A. Insofar as I was aware of them. 11 Q. And you were aware of anticipation at the time? 12 A. Yes. 13 Q. So my question was, prior to this case have you 14 ever been asked to do any analysis or render any 15 opinions regarding invalidity for anticipation? 16 MS. PALLIOS ROBERTS: Objection. Form. 17 THE WITNESS: Well, I'm -- as I say -- so if -- 18 if you're assuming that I was asked about anticipation 19 as a part of the general question of validity in this 20 case, if that's what -- if that's the assumption you're 21 making, I was just asked the question in general terms 22 without any specific suggestions. 23 But no, I haven't -- I have not actually worked 24 on the question of anticipation in any other case. 25 MR. FENSTER: Q. Dr. Peters, it's important	13	1 Q. Okay. What did you do to prepare for your 2 deposition today? 3 A. Well, I reviewed my report; I reviewed the 4 patent; I reviewed some of the art that I had cited in 5 my report; I met yesterday, I think it was, with 6 attorneys. 7 Q. Who did you meet with? 8 A. Well, I met with the three attorneys here in 9 this room with us today. 10 Q. Ms. Roberts, Mr. White and Mr. Cannon? 11 A. Yes. 12 Q. Okay. Did you meet with anyone else in 13 preparation for your deposition? 14 A. No. 15 Q. Where did you meet yesterday? 16 A. We met here in these law offices. 17 Q. Okay. And how long did you meet yesterday? 18 A. Took pretty much of the day. I don't remember 19 exact times. 20 Q. Approximately how many hours did you meet 21 yesterday? 22 A. It probably was six or seven. 23 Q. Did you have any other meetings or do anything 24 else to prepare for your deposition, other than what 25 you've just described?

14

1 A. No.  
2 Q. Did you review any other documents other than  
3 your report, the patent and some art in preparation for  
4 your deposition?  
5 A. Oh, well, I did review, for example, the  
6 rebuttal report, I think it's called, of Dr. Rhyne.  
7 Q. Anything else?  
8 A. Not that I can remember at this time.  
9 Q. What prior art did you review in preparation  
10 for your deposition today?  
11 A. Well, I looked back at some of the Salton books  
12 that I had cited. I looked back at a couple of the  
13 patents that are mentioned in my report.  
14 Q. Do you recall which ones?  
15 A. I looked at Culliss; I looked at Herz, as I  
16 recall.  
17 Q. Any other art that you reviewed?  
18 A. Not to the best of my recollection at this  
19 point.  
20 Q. Okay. When were you retained on this case?  
21 A. About a year ago. Maybe a little more.  
22 Q. Can you be any more specific?  
23 A. Well, as I recall, it was late 2008.  
24 Q. And who were you contacted by?  
25 A. I think I was contacted by Mr. Cannon.

15

1 Q. And what did he tell you about the case? What  
2 did he tell you when he first contacted you?  
3 A. Well, he told me that he was working on a case  
4 and that he thought that I might be able to help him  
5 understand some of the issues and that he would like to  
6 talk about it.  
7 Q. What happened next?  
8 A. Well, we met --  
9 MS. PALLIOS ROBERTS: Objection. Form.  
10 MR. FENSTER: Go ahead.  
11 THE WITNESS: We met and he showed me the  
12 patent, as I recall, and I read it and gave him my  
13 initial impressions of, you know, what the field was,  
14 what the patent was about.  
15 MR. FENSTER: Q. Did he tell you that he was  
16 looking for an opinion regarding invalidity?  
17 MS. PALLIOS ROBERTS: I'm going to object. I  
18 think we're getting close to the areas that the  
19 protective order says are not discoverable, namely  
20 communications between counsel and the experts, other  
21 than anything the expert may have relied upon in forming  
22 their opinions.  
23 MR. FENSTER: Q. Before you rendered your  
24 initial impressions, were you aware that Mr. Cannon  
25 represented the defendant in the case?

16

1 A. Well, I know he told me there was a lawsuit. I  
2 don't recall him telling me who the defendant was,  
3 although he might have. And -- no, I don't actually  
4 remember if he told me which side he was representing.  
5 But since he didn't really -- he was asking me  
6 for information about the patent. It wasn't much of an  
7 inference for me to guess that he was not representing  
8 the plaintiff.  
9 Q. You understood before you gave your initial  
10 impressions that Mr. Cannon represented the defendant in  
11 the case; is that correct?  
12 MS. PALLIOS ROBERTS: Objection. Form.  
13 THE WITNESS: When I talked to Mr. Cannon, I  
14 talked to him about the substance of the patent. We're  
15 talking about the initial conversation now, right?  
16 MR. FENSTER: Mm-hm.  
17 THE WITNESS: I just talked to him about the  
18 substance of the patent. I really wasn't much  
19 interested in which party he was representing. I was  
20 happy to try and shed some light on what the patent was  
21 about.  
22 MR. FENSTER: Q. Dr. Peters, can you answer my  
23 question, please. My question is, when you first  
24 talked -- strike that.  
25 My question is you understood, before you gave

17

1 your initial impressions, that Mr. Cannon represented  
2 the defendant in this case; is that correct?  
3 MS. PALLIOS ROBERTS: Objection. Form.  
4 THE WITNESS: I don't know that it is. I don't  
5 know at what point I came to the conjecture that he  
6 represented the defendant.  
7 MR. FENSTER: Q. Did you run a conflict check  
8 before you gave him your initial impressions?  
9 A. Probably. I don't -- you know, we're talking  
10 about more than a year ago. Probably, but I really  
11 don't remember.  
12 Q. Have you talked -- who else have you talked  
13 with about this case, other than the three attorneys you  
14 mentioned?  
15 A. One other attorney here at Quinn Emanuel.  
16 Q. Who's that?  
17 A. Cheryl Galvin.  
18 Q. Have you talked with anyone else other than  
19 those four attorneys about this case?  
20 A. Well, let's see. I've talked to attorneys from  
21 Quinn Emanuel and from Howrey. Principal contacts have  
22 been the people we've already talked about, as far as I  
23 can recall. Have I talked with other attorneys in those  
24 firms? Possibly.  
25 Q. Okay. Have you talked with anyone other than

18

1 attorneys inside either Quinn or Howrey about this case?

2 A. Well, let's see. I think there was -- there --

3 so who was present at every meeting; that's what you're

4 asking me, I guess.

5 Q. My question, Mr. Peters, is have you talked

6 with anyone else other than attorneys from Quinn or

7 Howrey regarding this case?

8 A. Well, if I had, it would have been an attorney

9 for one of the defendants who was attending a meeting.

10 That's the only other person.

11 Q. Okay. What did you understand the scope of

12 what you were asked to do?

13 A. Well, initially I was simply asked to try to

14 shed light on the field of the patent, which I did.

15 Eventually, more recently, this past fall, I

16 was contacted again by Quinn Emanuel and I was asked to

17 render an opinion about validity of the claims that are

18 at issue.

19 Q. And specifically you were asked to render an

20 opinion that the claims of the patent were invalid,

21 correct?

22 MS. PALLIOS ROBERTS: Objection. Form.

23 THE WITNESS: That's not correct. I was asked

24 for my honest opinion on validity.

25 MR. FENSTER: Q. And when did that -- when

19

1 were you asked to do this?

2 A. Oh, the first meetings were October or

3 thereabouts of 2009.

4 Q. And what were you asked to consider regarding

5 validity?

6 MS. PALLIOS ROBERTS: I'm going to object

7 again. This is not discoverable information under the

8 terms of the protective order.

9 MR. FENSTER: Are you instructing him not to

10 answer what he was asked -- the scope of what he was

11 asked to do?

12 MS. PALLIOS ROBERTS: I am instructing him not

13 to answer the content of communications with counsel,

14 which is specifically not discoverable --

15 MR. FENSTER: Okay. Are you --

16 MS. PALLIOS ROBERTS: -- under the protective

17 order unless it's information that he relied upon in

18 forming his opinions.

19 MR. FENSTER: Okay. Are you instructing him

20 not to answer this question?

21 MS. PALLIOS ROBERTS: I've just stated the

22 basis for the instruction.

23 MR. FENSTER: Are you instructing him not to

24 answer this question?

25 MS. PALLIOS ROBERTS: I just answered your

20

1 question.

2 MR. FENSTER: What you did is you stated a

3 basis. I'll ask the question again. You can either

4 instruct or not, I guess.

5 MR. CANNON: Brian, that is a different

6 question (inaudible) --

7 THE REPORTER: I can't hear you, sorry.

8 THE VIDEOGRAPHER: I'm sorry ...

9 MR. FENSTER: Q. What aspects of validity were

10 you asked to render opinions on?

11 MS. PALLIOS ROBERTS: Object again on the same

12 basis. You're asking him for what he was asked by

13 counsel.

14 MR. FENSTER: I don't care if you instruct or

15 not. But you've stated an objection; you haven't stated

16 an instruction. Are you instructing him not to answer?

17 MS. PALLIOS ROBERTS: I will instruct him not

18 to answer on that basis. If you can ask your question

19 in some other way, you're welcome to try.

20 MR. FENSTER: Thank you very much.

21 Q. And you'll follow your counsel's instruction?

22 A. Yes.

23 Q. What did you -- what aspects of validity did

24 you understand were within the purview of your task?

25 A. My understanding was that for the specific

21

1 claims that are at issue, any aspect of validity was

2 potentially rel -- at issue.

3 Q. Okay. And it's your testimony that you were

4 asked to give -- to render an honest opinion regarding

5 every aspect of validity regarding those asserted

6 claims; is that correct?

7 A. I --

8 MS. PALLIOS ROBERTS: Objection. Form. And

9 again, you're asking about what -- about the

10 communications with counsel.

11 THE WITNESS: Well, let me --

12 MS. PALLIOS ROBERTS: So I'll instruct him not

13 to answer on that basis.

14 THE WITNESS: Okay, well, if I'm instructed not

15 to answer, then I won't answer.

16 MR. FENSTER: Q. Is it your testimony that it

17 was your understanding that you were to -- that you were

18 tasked to render an honest opinion as to every aspect of

19 validity of the asserted claims?

20 A. Well, first of all, I absolutely took it as my

21 job to render an honest opinion on these claims.

22 And secondly, yes, there was never the

23 slightest suggestion from any of the attorneys that I've

24 been dealing with that I should do anything other than

25 that, if that's what you're trying to get at.

22

1 Q. My question is was it your understanding that  
 2 you were to render an opinion regarding every aspect of  
 3 validity that you could consider regarding the asserted  
 4 claims?  
 5 A. I thought your question was -- had to do with  
 6 the honesty of my opinion. I --  
 7 Q. It's both.  
 8 A. Well, I was asked to render an opinion -- an  
 9 honest opinion about any aspect of validity that I  
 10 thought was potentially relevant.  
 11 Q. Okay. And what aspects of validity did you  
 12 consider?  
 13 A. Well, I considered the ones I knew about.  
 14 Those would be anticipation. The claims construction  
 15 had already occurred, so those were defined. I thought  
 16 about obviousness. I thought about being -- having it  
 17 described carefully -- written description, I guess it's  
 18 called -- being described carefully enough that you  
 19 could actually follow it. And I thought about  
 20 usefulness, utility.  
 21 Q. Anything else?  
 22 A. Those are the ones that I can think of at the  
 23 moment.  
 24 Q. Did you consider enablement?  
 25 A. Yes, I see. Isn't written description an

23

1 aspect of enablement?  
 2 Q. Tell me your understanding.  
 3 A. Well, that was my understanding. If you want  
 4 to be able to practice a patent, it has to be  
 5 described -- you know, the invention has to be described  
 6 clearly enough to allow you to do that.  
 7 Q. Okay.  
 8 A. I'm not a lawyer, you understand, and so ...  
 9 but that's my understanding.  
 10 Q. And did you render any opinions -- strike that.  
 11 Did you reach any conclusions regarding the  
 12 anticipation -- the validity, based on anticipation, of  
 13 the asserted claims?  
 14 MS. PALLIOS ROBERTS: Objection. Form.  
 15 THE WITNESS: I -- did I reach any conclusions.  
 16 I certainly didn't report that I think it was  
 17 anticipated.  
 18 MR. FENSTER: Q. Is it fair to say that you  
 19 concluded that the patent was not invalid for  
 20 anticipation?  
 21 A. No, that wouldn't be fair to say. I mean, I  
 22 did not find another patent that encompassed all of the  
 23 claim -- the limitations on any -- the claims.  
 24 Q. Okay. You did not find any prior art reference  
 25 that would render any of the asserted claims invalid for

24

1 anticipation; is that correct?  
 2 A. I think that's right.  
 3 Q. Did you state that in your report?  
 4 A. No.  
 5 Q. Why not?  
 6 A. It wasn't relevant to my report.  
 7 Q. In your report you include a list of materials  
 8 that you reviewed; is that correct?  
 9 A. Yes.  
 10 Q. And in that list of materials, you -- actually,  
 11 let me back up.  
 12 I'll place before you what's been marked as  
 13 Peters Exhibit 1. Do you recognize that document?  
 14 A. It looks like my report -- or part of  
 15 thereof -- part of it.  
 16 (Plaintiff's Exhibit 1  
 17 marked for identification.)  
 18 MR. FENSTER: And I'll hand you Exhibit 2,  
 19 which was Exhibit B to your report.  
 20 (Plaintiff's Exhibit 2  
 21 marked for identification.)  
 22 MR. FENSTER: Q. Do you recognize that?  
 23 A. Yes, that's a list of materials that I did  
 24 review.  
 25 Q. Okay. And is this list of materials that we've

25

1 marked as Exhibit 2 -- is this a complete list of all  
 2 the materials that you reviewed in preparation of your  
 3 report?  
 4 MS. PALLIOS ROBERTS: Objection. Form.  
 5 THE WITNESS: It includes all the materials  
 6 that I used. I made thorough searches of the Internet  
 7 and looked at a lot of things.  
 8 MR. FENSTER: Q. Did you do your own search  
 9 for prior art?  
 10 A. I did.  
 11 Q. Can you describe that search.  
 12 A. Well, I used Internet search engines to search  
 13 for aspects of the patent -- aspects of the -- the  
 14 invention to see how they related to prior art.  
 15 I used tools to search for patents that were  
 16 potentially relevant in the same field.  
 17 I also read books that I had available on the  
 18 subject, so ... the usual means of scholarly search.  
 19 Q. Okay. Did you -- would you characterize your  
 20 search as thorough?  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: I did do quite a thorough search.  
 23 MR. FENSTER: Q. How much time did you spend  
 24 searching for prior art for the Geller patent?  
 25 A. Well, I -- I spent over a hundred hours



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1 preparing the report. I don't know how much of that  
 2 time was spent searching and how much was in preparing  
 3 the report and so on. But quite a lot of time.  
 4 Q. Did you find prior art references that were not  
 5 previously provided to you by the attorneys?  
 6 A. Yes, I did.  
 7 Q. Did you list those on your list of references  
 8 considered?  
 9 A. The ones that I felt it was useful to quote in  
 10 the report are all listed there.  
 11 Q. Do you know which of the references cited were  
 12 ones that you found that were not previously provided to  
 13 you by the attorneys?  
 14 MS. PALLIOS ROBERTS: Objection. Form.  
 15 THE WITNESS: Do I know? Yes.  
 16 MR. FENSTER: Q. Can you identify them for me,  
 17 please.  
 18 A. Well, there's a number of articles on here.  
 19 The Salton books, I had identified. Those, I think,  
 20 were also subsequently presented by attorneys, not  
 21 surprisingly, those being classics in the field. These  
 22 articles by McKeown, Menczer, Belkin, Church, Robertson,  
 23 a number of those are articles that I found on my own.  
 24 Q. Can you identify which of these references you  
 25 found that were not previously provided to you by the

27

1 attorneys?  
 2 A. Well, I --  
 3 MS. PALLIOS ROBERTS: Objection. Form.  
 4 THE WITNESS: -- thought I just gave you a  
 5 extensive list of them.  
 6 MR. FENSTER: Q. Okay. Is that an exhaustive  
 7 list?  
 8 A. Probably not. No. For example, this Myaeng  
 9 reference, I also found.  
 10 Q. Dr. Peters, let me be clear. I'm not asking  
 11 for isolated examples. I'm asking if you can identify  
 12 which of these references you found that were not  
 13 previously provided by the attorneys.  
 14 A. Well, no, I don't -- if you're asking me to say  
 15 exactly which ones I found and which ones I didn't find  
 16 on my own, I probably can't tell you exactly right here  
 17 on the spot.  
 18 Q. Okay. Fair enough. Are there any materials  
 19 that you considered that are not listed on Exhibit B?  
 20 MS. PALLIOS ROBERTS: Objection. Form.  
 21 THE WITNESS: Well, I don't know what you mean  
 22 by "considered." As I say, I looked around extensively.  
 23 In the course of doing so, you find all sorts of things  
 24 that search engines throw up which might be relevant and  
 25 turn out not to be. Did I consider those? I'm not sure

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1 what you mean.  
 2 MR. FENSTER: Q. Okay. Anything that you  
 3 considered and relied on is listed in this -- in this  
 4 Exhibit 2, correct?  
 5 A. What I --  
 6 MS. PALLIOS ROBERTS: Objection. Form.  
 7 THE WITNESS: What I based my report on is  
 8 listed in this exhibit.  
 9 MR. FENSTER: Q. Is there anything that you  
 10 relied on in forming your opinions that is not listed in  
 11 Exhibit B?  
 12 A. Well, I'm trying to answer your question, but I  
 13 guess I don't quite understand what you mean by "rely  
 14 on." Is it a legal term or ... you know, I'm -- I've  
 15 just answered it in a couple of different ways, and I'm  
 16 clearly not understanding something about it.  
 17 Q. What was your intention in compiling this list  
 18 of materials?  
 19 A. To disclose the things that form the basis of  
 20 my opinion as I presented it in my written report.  
 21 Q. Okay. So it was not -- Exhibit B was not  
 22 intended to include all the materials that you reviewed  
 23 in forming your opinion; is that correct?  
 24 MS. PALLIOS ROBERTS: Objection. Form.  
 25 THE WITNESS: Again, I don't know how to answer

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1 the question. It's -- I stand by my report and am  
 2 prepared to back it up based on the materials in Exhibit  
 3 B.  
 4 MR. FENSTER: Q. On page 1 of Exhibit B, the  
 5 third item listed is invalidity contentions dated  
 6 November 14, 2008. Do you see that?  
 7 A. Yes, I do.  
 8 Q. Okay. And did you review invalidity  
 9 contentions dated November 14, 2008?  
 10 A. So I think when I was -- you know, last fall,  
 11 2009, when I started this, I believe that was given to  
 12 me. I skimmed through that and found it most difficult  
 13 to understand. So if I reviewed it, it certainly didn't  
 14 have much of an impact on my subsequent thinking.  
 15 Q. Did you have an understanding that the  
 16 invalidity contentions dated November 14, 2008 were  
 17 drafted by attorneys for the defendants?  
 18 A. I didn't know who drafted them, but they sure  
 19 read like attorneys' documents.  
 20 Q. Did you understand, based on your review of  
 21 that document, that the attorneys for the defendants  
 22 were asserting that several references, prior art  
 23 references, rendered the asserted claims of the Geller  
 24 patent invalid for anticipation?  
 25 A. Oh, for anticipation. Well, I don't recall

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1 whether that -- it didn't make a big impression on me if  
2 I did actually realize that some of the references were  
3 being cited as anticipatory.  
4 Q. To the extent the attorneys for the defendants  
5 asserted that any prior art references did anticipate  
6 the asserted claims of the Geller patent, is it fair to  
7 say that you did not reach the same conclusion?  
8 MS. PALLIOS ROBERTS: Objection. Form.  
9 THE WITNESS: I don't know which ones they  
10 thought anticipated, off the top of my head. But as  
11 I -- as I answered earlier, I didn't find references  
12 that, in my view, anticipated. And that's why I didn't  
13 put in my report that I thought the patent -- that  
14 claims were anticipated.  
15 MR. FENSTER: Q. Were you given any other  
16 invalidity contentions, other than those dated  
17 November 14, in this case?  
18 A. Not as far as I remember. I only faintly  
19 remember those, to be honest.  
20 Q. Okay. You don't recall seeing any amended  
21 invalidity contentions in or around November of 2009?  
22 A. I don't remember seeing them. If I was given  
23 those -- well, I don't think I was given them. I  
24 certainly don't remember seeing them.  
25 I have to admit, you know, lawyerese really

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1 didn't help me in thinking about the questions I was  
2 trying to think about.  
3 Q. Referring to Exhibit 1, your report, how was --  
4 how did this come to be prepared?  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: How did it come to be prepared?  
7 Well, I studied the materials we've been talking about,  
8 including the patent and prior art, and I wrote down  
9 preliminary drafts of my views on things. I asked the  
10 attorneys about the law and -- you know, as -- for  
11 clarification of legal points -- and made a draft.  
12 MR. FENSTER: Q. Who actually wrote this  
13 report?  
14 A. Well, I wrote it.  
15 Q. Did you?  
16 A. Yes.  
17 Q. All aspects of it?  
18 A. All aspects of it. You mean did I type it?  
19 Q. Yes.  
20 A. I typed multiple drafts of it. Did somebody  
21 else type this draft? It was probably prepared by a  
22 stenographer.  
23 Q. Do you dictate?  
24 A. No, I write longhand and on computer.  
25 Q. Okay. There are a number of charts that were

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1 attached to your report.  
2 A. They're part of the report.  
3 Q. Okay. Who did the -- who prepared the charts?  
4 A. They were prepared at my direction. These were  
5 things that I had found, and I directed the -- the  
6 charts be prepared showing the art by limitations of  
7 those claims.  
8 Q. Okay. What do you mean they were prepared at  
9 your direction?  
10 A. I said which portions of the art pertain to  
11 which claim -- to which limitation.  
12 Q. Okay.  
13 A. And the -- as I say, I don't know -- presumably  
14 some stenographer actually produced the documents that  
15 we both have in our possession.  
16 Q. But it's your testimony that you identified  
17 each portion that appears in the right-hand column of  
18 the charts that are part of your report; is that  
19 correct?  
20 A. They are -- they all are part of my report,  
21 yes.  
22 Q. My question isn't whether they're part of your  
23 report. I understand that the charts are part of your  
24 report. My question is, is it your testimony that you  
25 personally identified each portion of each prior art

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1 reference that --  
2 A. There --  
3 Q. Excuse me. You need -- for us to get a clear  
4 record, we can't talk over each other. And so I need to  
5 wait for you to finish and you need to wait for me to  
6 finish.  
7 A. Very good.  
8 Q. Thank you. Is it your testimony, Dr. Peters,  
9 that you personally identified each portion of each  
10 prior art reference that appears in the right-hand  
11 columns of the charts that are part of your report?  
12 A. That's absolutely my belief. The charts are  
13 hundreds of pages long, but I identified all those  
14 things. I did my best to check that they are as I  
15 directed them to be.  
16 Q. And it's your testimony that it was your  
17 original work product, that you personally are the one  
18 that identified which portions to put in those charts;  
19 is that correct?  
20 A. I did --  
21 MS. PALLIOS ROBERTS: Objection. Form.  
22 MR. FENSTER: Q. Is that correct?  
23 A. I did identify them, yes.  
24 Q. Okay.  
25 A. Can I just -- I'm not quite sure the force of

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1 the objections here. So can I just get some  
 2 clarification about ...  
 3 MS. PALLIOS ROBERTS: Unless I instruct you not  
 4 to answer, you can answer the question.  
 5 THE WITNESS: Okay. Okay. Thank you.  
 6 MR. FENSTER: Q. Is your report a complete  
 7 statement of your opinions -- of the opinions that you  
 8 have reached in this case regarding the validity of the  
 9 Geller patent?  
 10 MS. PALLIOS ROBERTS: Objection. Form.  
 11 THE WITNESS: Yes. I mean, I did the work; I  
 12 came to opinions, and I wrote them in the report, and  
 13 it -- it states them.  
 14 MR. FENSTER: Q. Are there any opinions that  
 15 you reached that are not included in the report?  
 16 A. Well, the report reserves the right to add to  
 17 it under certain circumstances. Those circumstances  
 18 haven't arisen. I don't add to it at this -- I don't  
 19 wish to add to it at this point.  
 20 Q. Okay. So as you sit here today, this report is  
 21 a complete statement of the opinions you formed in this  
 22 case, correct?  
 23 A. I believe that's the case.  
 24 Q. Okay. And is it -- does it have a -- strike  
 25 that.

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1 Does it contain all the bases for those  
 2 opinions?  
 3 MS. PALLIOS ROBERTS: Objection. Form.  
 4 THE WITNESS: Again, I'm -- so the report tries  
 5 to present reasoning in support of conclusions and  
 6 opinions. And yes, it contains that reasoning.  
 7 MR. FENSTER: Q. And does it include all the  
 8 analysis that you have to offer, as you sit here today,  
 9 in support of your opinions?  
 10 A. Well, I guess we'll find out. I'll do my best  
 11 to provide analysis and we'll see whether it's exactly  
 12 as written. But it -- you're deposing me on the report.  
 13 I will -- I'll give you my analysis.  
 14 Q. My question is does your report contain all of  
 15 the analysis that you have done in support of your  
 16 opinions as you sit here today?  
 17 MS. PALLIOS ROBERTS: Objection. Form.  
 18 THE WITNESS: Again, I guess I'm just -- this  
 19 question sounds sort of formalistic. I wrote the  
 20 report. I printed my analysis. It's there. It's  
 21 complete as a report.  
 22 You're now asking me questions about it. I  
 23 will answer your questions. Are all the answers to the  
 24 questions in the report? If so, I don't know why -- why  
 25 you're here asking me questions. So that's what's

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1 puzzling me about your question.  
 2 MR. FENSTER: Q. Dr. Peters, can you answer my  
 3 question, please. I understand you have lots to say.  
 4 The purpose of a deposition, I get to ask questions and  
 5 you are to give -- to answer those questions as  
 6 precisely as you're able to.  
 7 A. Okay. Well, the only answer I can give you is  
 8 I don't know.  
 9 Q. Was it your intention to set forth in your  
 10 report all of the analysis that's necessary to support  
 11 your opinions?  
 12 A. That was my intention.  
 13 Q. And as you sit here today, are you aware of any  
 14 analysis that you forgot to include or did not include  
 15 in your report?  
 16 A. Not aware of it.  
 17 Q. Dr. Peters, there were two sets of exhibits to  
 18 your report. There were some ACC exhibits, which were  
 19 invalidity charts.  
 20 A. Yes.  
 21 Q. And I have 13 of those. Does that sound right?  
 22 A. That sounds right.  
 23 Q. Okay. And I also had some AR exhibits, and I  
 24 found 24 of those. Does that sound right?  
 25 A. That sounds right too.

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1 Q. Okay. What are the AR exhibits?  
 2 A. Well, those are prior art. Those are the --  
 3 those are patents and articles.  
 4 Q. Okay. What caused you to attach these 24 out  
 5 of the list of references that you considered in Exhibit  
 6 B?  
 7 A. Well, at the time I wrote the report, it seemed  
 8 to me that those were, taken together, sufficient, along  
 9 with the analysis, to justify the opinions that I  
 10 offered in the ...  
 11 Q. Is it fair to say that the 24 references that  
 12 you attached as exhibits to your report as the AR  
 13 exhibits are the references that you intend to rely on  
 14 in support of your opinions?  
 15 MS. PALLIOS ROBERTS: Objection. Form.  
 16 THE WITNESS: Well, they're certainly the ones  
 17 that I did rely on in the written report, yes.  
 18 MR. FENSTER: Q. So to the extent that there  
 19 were prior art references listed in Exhibit B to your  
 20 report that are not included in the AR exhibits, is it  
 21 fair to say that you did not intend to rely on them or  
 22 that you did not rely on them to support your opinions  
 23 in your report?  
 24 A. In the written report, I did not find those  
 25 other references were required as a part of the

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1 analysis.  
2 Q. Dr. Peters, the ACC exhibits that you attached  
3 to your report, can you give me an overview of what the  
4 13 exhibits are.  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: Well, each of those charts is  
7 directed to one of the claims, claim 1 or claim 45,  
8 showing on a limitation-by-limitation basis prior art  
9 that is relevant to the -- that particular limitation.  
10 So the different charts are different  
11 combinations -- you know, call out there as -- as two  
12 principal sources, different combinations of prior art.  
13 And then in the right-hand column, they contain  
14 additional citations from other prior art.  
15 MR. FENSTER: Q. So I'm trying to understand  
16 the combinations that are being asserted. So, for  
17 example, chart 1, ACC1, is entitled "Invalidity Chart,  
18 Salton '89 In View Of Culliss And Additional Prior Art  
19 References." You're familiar with that chart?  
20 A. Yes.  
21 Q. Okay. And you have what you've described as  
22 two primary references, Salton '89 and Culliss,  
23 described in the charts, correct?  
24 A. Yes.  
25 Q. Okay. And in the right-hand column, you have

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1 additional prior art references, correct?  
2 A. That's correct.  
3 Q. Okay. So -- and those include a relatively  
4 long list of references, Salton '68, Braden, Herz, Ahn,  
5 A-H-N, Brookes, Dasan, Dedrick, Krishnan, Kupiec?  
6 A. Yes. Other patents that are in that other  
7 volume that you were just showing me.  
8 Q. Okay. So what is the significance of the prior  
9 art references in the right-hand column? Are those part  
10 of the combinations or not?  
11 A. They supplement. They would strengthen the  
12 combination in the first two columns. So --  
13 Q. So, for example, with the Braden reference, is  
14 it -- are you meaning to assert that claim 1 is invalid  
15 in light of the combination of Salton '89 in view of  
16 Culliss and Braden?  
17 MS. PALLIOS ROBERTS: Objection. Form.  
18 Do you have a copy of the charts for the  
19 witness?  
20 MR. FENSTER: Go ahead.  
21 THE WITNESS: Well, it would help to see a copy  
22 of the charts. But what I mean to assert is that the  
23 first two columns following the limitation that's quoted  
24 themselves prefigure that limitation. And then they are  
25 buttressed or even further reinforced by the citations

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1 in the right-hand column.  
2 MR. FENSTER: Okay.  
3 THE WITNESS: And you'll notice that many of  
4 the citations that occur in the right-hand column also  
5 occur as members of other combinations; that is,  
6 there'll be another chart that uses those things in  
7 combination with some other element as the two principal  
8 items anticipating.  
9 MR. FENSTER: Q. Right. So are you intending  
10 that the prior art references in the right-hand column,  
11 the additional prior art references that you include --  
12 are those part of the combinations or not?  
13 A. If you like, they're two combinations signaled  
14 by every chart. There's the combination of simply the  
15 two principal ones and then there's a combination of  
16 those plus the right-hand column.  
17 Q. So is it your intention [sic] that ACC1 sets  
18 forth a combination -- sets forth two combinations to  
19 invalidate claim 1? The first combination is Salton '89  
20 plus Culliss -- in view of Culliss by themselves; is  
21 that correct?  
22 A. Yes.  
23 Q. Okay. And it's your further opinion that claim  
24 1 is invalid in light of the combination of Salton in  
25 view of Culliss and all of the additional prior art

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1 references?  
2 A. Listed for that, yes, that's correct.  
3 Q. Okay. Is it your opinion that the combination  
4 of Salton plus Culliss plus each individual reference by  
5 itself invalidates claim 1?  
6 A. I suppose it would be. I mean, I don't think  
7 the references in the right-hand column take away  
8 anything from Salton plus Culliss. So if -- so each of  
9 them individually adds, and all of them taken together  
10 add still more. That's -- that's my view.  
11 Q. So should I understand from your report that  
12 you're intending to assert that claim 1 is invalid under  
13 the combination of Salton '89 plus Culliss plus Salton  
14 '68 --  
15 MS. PALLIOS ROBERTS: Objection. Form.  
16 MR. FENSTER: Q. -- as one combination?  
17 A. Well, yes, I -- I think that those -- that  
18 combination makes claim 1 -- claim 1 obvious.  
19 Q. Okay. And it's further -- and you further  
20 intend to -- strike that.  
21 And it's also your opinion that the combination  
22 of Salton '89 plus Culliss plus Braden renders claim 1  
23 invalid, correct?  
24 A. Yes.  
25 Q. And does your -- so am I to understand that

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1 each possible combination of the prior art references in  
 2 each chart render that claim invalid?  
 3 MS. PALLIOS ROBERTS: Objection. Form.  
 4 THE WITNESS: Well, as I say, there are two  
 5 principal ones. So those -- those are meant, as far as  
 6 these charts go, always to be included in the  
 7 combination. And then the addition of zero or one or  
 8 more of the additional references listed in the  
 9 right-hand column is also sufficient.  
 10 MR. FENSTER: Q. Does your report say anywhere  
 11 that claim 1 is invalid in view of Salton '89 in view of  
 12 Culliss by themselves and without any additional prior  
 13 art references?  
 14 A. Well, I think that's -- that's the meaning of  
 15 my report.  
 16 Q. Can you point to anywhere in your report where  
 17 you say that claim 1 is invalid in light of the  
 18 combination of Salton '89 in view of Culliss by  
 19 themselves?  
 20 A. Well, let's take a look at the report.  
 21 MS. PALLIOS ROBERTS: I think when you provided  
 22 him with Peters Exhibit 1, you noted that it was a  
 23 portion of the report. Do you have the rest of the  
 24 report for him?  
 25 You're not going to answer?

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1 MR. FENSTER: Well, I didn't bring extra  
 2 copies. So I can give the witness this copy of the  
 3 report if he needs to look at it.  
 4 THE WITNESS: So in -- so let me just describe,  
 5 in answer to your question, how the report is organized,  
 6 if that -- if I may do that.  
 7 MR. FENSTER: Q. Can you answer my question  
 8 first?  
 9 A. Is there -- can I point you to a sentence that  
 10 says that combination of two patents renders claim 1  
 11 invalid for obviousness?  
 12 Q. Yes.  
 13 A. Probably not. I certainly don't remember well  
 14 enough to find that sentence right now. But I can tell  
 15 you how I think it says that, how the report says that.  
 16 Q. So it's your opinion -- it was your intention  
 17 to disclose all of the possible combinations of Salton  
 18 plus Culliss in combination with zero, one or more of  
 19 all of the prior art references listed in the right-hand  
 20 column for each chart; is that correct?  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: I don't know. What my intention  
 23 was, let me tell you and we'll see whether it's what you  
 24 just said, was -- I believe that claim 1 and claim 45  
 25 are both rendered obvious in virtue of many combinations

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1 of prior art.  
 2 It was my intention in the report to point out  
 3 how that is the case. The report includes both the  
 4 discursive prose section and those charts that identify  
 5 prior art by claim limitation for those two claims.  
 6 So as I say, I think there are many  
 7 combinations of prior art that are sufficient. And what  
 8 I intended to do in the report is to give you a number  
 9 of such examples -- not necessarily an exhaustive list  
 10 of the examples, but a number of such examples -- of  
 11 combinations of prior art that suffice.  
 12 MR. FENSTER: Q. And what are the examples of  
 13 the combinations that you intended to disclose in your  
 14 report?  
 15 MS. PALLIOS ROBERTS: Objection. Form.  
 16 THE WITNESS: Well, again, I didn't have an  
 17 intention to make an exhaustive list, but among them are  
 18 Salton and Culliss, the one you -- the one that you were  
 19 just talking about.  
 20 MR. FENSTER: Q. I'm handing you, Dr. Peters,  
 21 my copy of ACC1, which is the first chart, okay.  
 22 A. Yes.  
 23 Q. Can you tell me all the combinations that you  
 24 intended to disclose as invalidating claim 1 by that  
 25 chart.

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1 A. All right. So Salton '89 and Culliss is one  
 2 such combination. As you say, Salton '89 and Culliss  
 3 and Salton '68 would be another. Salton '89, Culliss  
 4 and Braden. Salton '89, Culliss and Herz, and so forth.  
 5 What I'm doing, as you did, is simply going  
 6 down the --  
 7 Q. I'd like you to go through and list all the  
 8 combinations that are disclosed there. I don't want  
 9 "and so on." Please go ahead and list them.  
 10 A. All right. Well, so also Salton '89, Culliss,  
 11 Salton '68 and Braden. Salton '89, Culliss, Braden and  
 12 Herz. Salton '89, Culliss, Salton and Herz.  
 13 And now we need to move on. Salton '89,  
 14 Culliss, and Ahn. Salton '89, Culliss, Salton '68 and  
 15 Ahn. Salton '89, Culliss, Braden and Ahn. Salton '89,  
 16 Culliss, Salton -- sorry -- Herz and Ahn. Salton '89,  
 17 Culliss and Brookes. Salton '89, Culliss, Salton '68  
 18 and Brookes. Salton '89, Culliss, Braden and Brookes.  
 19 Salton '89, Culliss, Herz and Brookes. Salton '89,  
 20 Culliss, Ahn and Brookes. Salton '89, Culliss and  
 21 Dasan. Salton '89, Culliss, Salton '68 and Dasan.  
 22 Salton '89, Culliss, Braden and Dasan. Salton '89,  
 23 Culliss, Herz and Dasan. Salton '89, Ahn and Dasan.  
 24 Did I omit Culliss there inadvertently? I  
 25 meant to say Salton '89, Culliss, Ahn and Dasan. Salton

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1 '89, Culliss, Brookes and Dasan. Salton '89, Culliss  
 2 and Dedrick. Salton '89, Culliss, Salton '68 and  
 3 Dedrick. Salton '89, Culliss, Braden and Dedrick.  
 4 Salton '89, Culliss, Herz and Dedrick. Salton '89,  
 5 Culliss, Ahn and Dedrick. Salton '89, Brookes and  
 6 Dedrick. Salton '89, Dasan and Dedrick. Salton '89,  
 7 Culliss and Krishnan. Salton '89, Culliss, Salton '68  
 8 and Krishnan. Salton '89, Culliss, Braden and Krishnan.  
 9 Salton '89, Culliss, Herz and Krishnan.  
 10 I mean, we --  
 11 Q. Keep going.  
 12 A. We could spend most of the day doing this  
 13 because this is an exponential number of combinations.  
 14 I'm happy to keep going as long as you like, but ...  
 15 Q. Okay. Let me --  
 16 A. Is Herz involved in that one?  
 17 Q. Let me -- would you mind handing that back.  
 18 A. Here you are.  
 19 MS. PALLIOS ROBERTS: Counsel, we've been going  
 20 for a little over an hour. Can we take a break?  
 21 MR. FENSTER: We can, but we're going to  
 22 keep -- request that we keep breaks short since we  
 23 started late at your request.  
 24 THE VIDEOGRAPHER: We are now off the record at  
 25 11:14.

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1 (Recess taken.)  
 2 (Mr. Cannon left the deposition.)  
 3 THE VIDEOGRAPHER: We are now on the record at  
 4 11:27.  
 5 MR. FENSTER: Q. Dr. Peters, during the break  
 6 did you talk with anybody about your testimony?  
 7 A. Yes, I talked with the attorneys. I was in the  
 8 room here, just said "How am I doing?"  
 9 Q. What did they say?  
 10 MS. PALLIOS ROBERTS: Objection. Protective  
 11 order makes communications with counsel not  
 12 discoverable.  
 13 MR. FENSTER: I disagree.  
 14 MS. PALLIOS ROBERTS: I'll instruct you not to  
 15 answer.  
 16 MR. FENSTER: You're going to instruct him not  
 17 to answer about communications regarding his testimony  
 18 in the middle of a deposition?  
 19 MS. PALLIOS ROBERTS: I believe the protective  
 20 order says unless communications are used to form the  
 21 basis of his opinions, they're not discoverable.  
 22 MR. FENSTER: Okay. We'll reserve the right to  
 23 go to court on that.  
 24 Q. Dr. Peters, did you find that claim 1 was  
 25 invalid for obviousness based on any reference by

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1 itself, any single reference by itself?  
 2 MS. PALLIOS ROBERTS: Objection. Form.  
 3 THE WITNESS: Well, in my report I assert that  
 4 it's invalid for obviousness on the basis of  
 5 combinations of references, not on the basis of a single  
 6 reference.  
 7 MR. FENSTER: Q. Okay. So it's fair to say  
 8 that in your report, you didn't state any conclusion  
 9 that claim 1 was invalid based on any single reference  
 10 either for anticipation or obviousness, correct?  
 11 A. That's true.  
 12 MS. PALLIOS ROBERTS: Objection. Form.  
 13 MR. FENSTER: Q. And the same is true with  
 14 respect to every other claim, correct?  
 15 MS. PALLIOS ROBERTS: Objection. Form.  
 16 THE WITNESS: The ones at issue, yes.  
 17 MR. FENSTER: Q. Okay. The only way you were  
 18 able to find obviousness was by combining -- by  
 19 combining references?  
 20 A. That's correct.  
 21 Q. So is it -- let me -- let me hand you back  
 22 ACC1.  
 23 A. All right.  
 24 Q. So is it fair to say that Salton '89 by itself  
 25 fails to disclose one or more elements of claim 1?

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1 A. My feeling was that -- and my -- my analysis, I  
 2 wanted -- I believe that the combination of elements in  
 3 claim 1 is obvious, but I did not feel I could get a  
 4 clear enough statement for every single one of those  
 5 limitations from Salton '89 alone to make me comfortable  
 6 asserting that.  
 7 Q. So is it fair to say that Salton '89 by itself  
 8 fails to disclose one or more elements of claim 1?  
 9 A. Well, I guess -- no, it's not fair to say that.  
 10 I mean, that's -- I'm not -- I'm not contending that it  
 11 does disclose all of them. But I think that's an  
 12 arguable point, you know. Another person -- another  
 13 expert in the field might wish to actually claim that it  
 14 does.  
 15 Q. Okay. You didn't find --  
 16 A. I didn't. I'm not claiming that.  
 17 Q. So you felt -- you reached the opinion that  
 18 Salton '89 by itself was insufficient in describing at  
 19 least one or more elements of claim 1 to render that  
 20 claim invalid by itself; is that fair?  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: Salton '89 by itself did not  
 23 meet -- did not rise to my standards for clarity as  
 24 antecedent -- you know, as prefiguring all of the  
 25 limitations so that I was -- I felt comfortable saying

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1 on the basis of Salton '89 alone that the claim was  
 2 obvious.  
 3 MR. FENSTER: Q. Okay. And that's true of all  
 4 of the prior art references cited in your report,  
 5 correct?  
 6 MS. PALLIOS ROBERTS: Objection. Form.  
 7 THE WITNESS: That is true for each -- yes,  
 8 each single one of the references.  
 9 MR. FENSTER: Q. Now, in ACC1, you assert  
 10 various combinations that we started to go through, one  
 11 of which is the combination of Salton '89 with Culliss,  
 12 correct?  
 13 A. Yes. In fact, that's the principal one.  
 14 Q. Okay. And do you anywhere in your report  
 15 disclose any particular motivation to combine Salton '89  
 16 with Culliss?  
 17 A. Yes.  
 18 Q. Okay. Where is that?  
 19 A. Well, there's a discussion in the --  
 20 Q. I'm sorry. I'll let you get there. Pardon --  
 21 pardon me.  
 22 Is there any disclosure in the chart ACC1 of  
 23 the motivation to combine Salton '89 with Culliss?  
 24 A. ACC1, the chart itself, does not contain the  
 25 analysis that would motivate someone to do that.

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1 Q. Okay. And is that true of all the charts, that  
 2 none of the charts contain any analysis or disclosure  
 3 regarding the motivation to combine the various  
 4 references disclosed in those charts?  
 5 A. The charts do not contain that. They were not  
 6 intended to. They are -- they present information that  
 7 is both so detailed and so voluminous that it would have  
 8 interfered with intelligibility of the report if they'd  
 9 been contained in the prose section, and that's why they  
 10 were attached as separate charts.  
 11 Q. Okay. So I'm sorry I interrupted you before,  
 12 but I would like you to point out where in your report  
 13 you believe you disclosed the motivation to combine  
 14 Salton '89 with Culliss.  
 15 A. All right. Yeah. So -- and it's not  
 16 particular to Salton '89 and Culliss. It applies to  
 17 numerous of these combinations.  
 18 So the report itself includes background on the  
 19 state of the field -- yes, by all means, take that  
 20 back -- on the state of the field at the time when this  
 21 patent was filed. And then it includes a discussion of  
 22 the elements that are found in the claims that are at  
 23 issue in the patent. And then it points to prior art  
 24 for those patents -- for those claims.  
 25 And it's the combination -- and then it's

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1 backed up by these detailed charts that cite prior art  
 2 by limitation in the independent claims. And it's the  
 3 combination of these things that actually explains the  
 4 motivation. So as --  
 5 Q. I'm sorry, when you say "the combination" --  
 6 "it is the combination of these things that explains the  
 7 motivation," to combine Salton '89 with Culliss?  
 8 A. Yes.  
 9 Q. And what --  
 10 A. The background -- these things are the  
 11 background -- the analysis of the principal ideas in the  
 12 patent, and the detailed references cited in the claim  
 13 chart.  
 14 Q. Okay. And that is as specific as you can be  
 15 regarding pointing -- in terms of pointing me to  
 16 disclosure of particular motivation to combine Salton  
 17 '89 with Culliss; is that right?  
 18 A. No. No, I think that the report, for example,  
 19 in the background section talks quite clearly about how  
 20 the rise of the World Wide Web led to a completely  
 21 different kind of information search than had earlier  
 22 been the case in information retrieval and produced the  
 23 need for personalized information search.  
 24 And the report also talks about the activity in  
 25 the field that was bringing in techniques such as

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1 natural language processing for information retrieval  
 2 and indeed for personalization.  
 3 And so the motivation comes from a combination  
 4 of the need and the strands of research that were going  
 5 on in a very lively way at that time.  
 6 Q. Okay. Is there -- does your report contain any  
 7 specific motivation to combine Salton '89 specifically  
 8 with Culliss --  
 9 A. Well, in the --  
 10 Q. -- to achieve the claimed invention?  
 11 A. So in the section where -- the section starting  
 12 on page 24 with paragraph 91, the claims of the '067  
 13 patent existed in the prior art. My report calls out  
 14 how -- what the precursors are in prior art for each of  
 15 the motivating strands, each of the things that was  
 16 trying to be achieved by this new patent, brought  
 17 together to achieve the goal of this new patent.  
 18 And it does then cite specific examples. It  
 19 cites examples from Salton '89, from Culliss, from  
 20 Kurtzman, from numerous other precursors, any -- any  
 21 subset of which provides sufficient prior art for  
 22 combining. The motivation was that the ideas were  
 23 there.  
 24 Q. Okay. Is it fair to say that your report  
 25 discusses motivation to combine in general but doesn't

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1 do a separate analysis of the motivation to combine any  
2 particular combination of references?  
3 MS. PALLIOS ROBERTS: Objection. Form.  
4 THE WITNESS: Well, for -- for -- take, for  
5 example, the particular combination Salton '89 and  
6 Culliss. The report shows that there was this general  
7 motivation to combine and shows that that particular  
8 combination was sufficient.  
9 So I believe it does actually provide  
10 motivation for that specific combination.  
11 MR. FENSTER: Q. Where in your report does it  
12 disclose -- and so -- my question is the same for each  
13 of these combinations, okay. So, for example, in ACC2,  
14 the principal references are Braden in view of Herz.  
15 A. Mm-hm.  
16 Q. Do you have -- does your report disclose a  
17 particular motivation to combine Braden and Herz  
18 specifically?  
19 A. So as I say, the report starts off by saying in  
20 each section what the problem was. So then -- it  
21 discusses several different sources of art for solving  
22 that problem and then it says, as explained in detail in  
23 the attached charts, these claims are not novel by  
24 virtue of whatever specific feature they're talking  
25 about because the prior art, as called out in these

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1 attached claim charts, suffices to -- as -- to make that  
2 obvious.  
3 Q. Where does your report say -- disclose the  
4 motivation to combine Braden with Herz?  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 MR. FENSTER: Q. Or does it?  
7 A. Well, it does. And as I say, the motivation is  
8 that --  
9 Q. No, I'm not asking for what the motivation is;  
10 I'm asking for what your report discloses, okay.  
11 A. Yes.  
12 Q. So show me page and line where in your report  
13 you say "The motivation to combine Braden and Herz is  
14 X."  
15 MR. WHITE: Marc, I'd appreciate it if you'd  
16 let him finish his answers and not interrupt, please.  
17 THE WITNESS: Okay, so you're asking me to  
18 point you to a sentence that says "Here is the  
19 motivation for combining Braden and Herz"?  
20 MR. FENSTER: Yes.  
21 THE WITNESS: Okay. To the best of my  
22 recollection, there isn't a sentence in the report that  
23 says that.  
24 MR. FENSTER: Q. Okay. Do you disclose the  
25 particular motivation to combine Salton '89 and Culliss

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1 anywhere in your report?  
2 MS. PALLIOS ROBERTS: Objection. Form.  
3 THE WITNESS: I believe I do, as I've  
4 explained.  
5 MR. FENSTER: Q. Can you point me to where  
6 that is.  
7 MS. PALLIOS ROBERTS: Objection. Form.  
8 THE WITNESS: I've pointed you to the  
9 combination of elements that do that.  
10 MR. FENSTER: Q. Okay. Is it your -- strike  
11 that.  
12 Does your report disclose any particular  
13 motivation to combine Braden in view of Culliss?  
14 MS. PALLIOS ROBERTS: Objection. Form.  
15 THE WITNESS: Well -- so I understand you to be  
16 asking me the same question about a different  
17 combination.  
18 MR. FENSTER: That's correct.  
19 THE WITNESS: The answer is the same. I  
20 believe -- so I don't -- I don't recall there being a  
21 specific sentence for each of these combinations, no.  
22 What there is in here is a discussion of the  
23 fact that there were numerous combinations that would  
24 suffice, and that if anything, this simply adds to the  
25 obviousness.

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1 MR. FENSTER: Q. Okay. Is it fair to say that  
2 you don't disclose anywhere in your report any express  
3 teaching from Salton '89 that would -- that would  
4 suggest a combination with Culliss or the other  
5 references that you disclose?  
6 MS. PALLIOS ROBERTS: Objection. Form.  
7 THE WITNESS: No, I didn't say -- well, Salton  
8 '89 was -- preceded Culliss, so -- but I didn't say  
9 that, no, Salton '89 teaches that you should combine  
10 some part of that with Culliss.  
11 MR. FENSTER: Q. Okay. And you didn't  
12 disclose in your report any express teaching in any of  
13 the references that would suggest combination with any  
14 of the others, correct?  
15 MS. PALLIOS ROBERTS: Objection. Form.  
16 THE WITNESS: No, I didn't.  
17 MR. FENSTER: Q. Can you turn to paragraph 85  
18 of your report.  
19 A. Okay. Yes.  
20 Q. You state at paragraph 85 that in determining  
21 whether a claimed invention is obvious, you have been  
22 informed that one should consider the scope and content  
23 of the prior art, the level of ordinary skill in the  
24 relevant art, the differences between the claimed  
25 invention and the prior art, and whether the claimed



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1 invention would have been obvious to one skilled in the  
2 art in light of those differences, correct?  
3 A. That's correct.  
4 Q. Okay. So one of the things that you needed to  
5 evaluate was the differences between the claimed  
6 invention and the prior art; is that fair?  
7 A. That is correct.  
8 Q. Okay. Does your report set forth the  
9 differences between any of the asserted claims and the  
10 prior art?  
11 A. Well, there are very few differences, to be  
12 honest. The only one that I found that -- was the use  
13 of part-of-speech tagging in linguistically profiling  
14 users and stored data files and queries for these  
15 purposes, for the purposes of personalized information  
16 retrieval. And the report does actually specifically  
17 address that difference.  
18 Q. Where do you identify the differences between  
19 the claimed inventions and the prior art?  
20 A. Oh, you mean is -- again, you're asking me is  
21 there a sentence that says "For each of these claims,  
22 these are the differences"?  
23 Q. Yes.  
24 A. I don't -- I don't call out the differences  
25 explicitly except in the case of this one affirmative

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1 difference that -- where I do talk about it being  
2 obvious to use that particular form of natural language  
3 processing and personalization.  
4 Q. So you didn't endeavor to explicitly list the  
5 differences between the prior art in each of these  
6 asserted claims in your report; is that correct?  
7 A. In the report --  
8 MS. PALLIOS ROBERTS: Objection. Form.  
9 THE WITNESS: So I -- I examined them all  
10 carefully. I was looking to see what they were.  
11 MR. FENSTER: Q. Can you answer my question?  
12 A. But did I list them in the report? I did not.  
13 Q. Okay.  
14 A. Not all of them exhaustively.  
15 Q. Did you anywhere explicitly list any of the  
16 differences between the asserted claims and the prior  
17 art?  
18 MS. PALLIOS ROBERTS: Objection. Form.  
19 THE WITNESS: You mean did I say "This piece of  
20 prior art doesn't use part-of-speech tagging, but the  
21 patent does," that sort of thing?  
22 MR. FENSTER: Q. I'm asking, yes, did you  
23 compare the individual reference -- did you compare the  
24 prior art references to the asserted claims and say  
25 "These are the differences"?

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1 MS. PALLIOS ROBERTS: Objection. Form.  
2 THE WITNESS: I did compare them. I did not  
3 write in the report exactly what the differences were  
4 for every -- every piece of prior art.  
5 MR. FENSTER: I see.  
6 Q. Now, at paragraph 86, you state -- you  
7 reference a statement from the Supreme Court that,  
8 quote,  
9 "When there is a design need or market  
10 pressure to solve a problem and there are a  
11 finite number of identified predictable  
12 solutions," comma, "a person of ordinary  
13 skill has good reason to pursue the known  
14 options within his or her technical grasp,"  
15 and the quote goes on.  
16 Do you see that?  
17 A. Yes, I do.  
18 Q. Okay. And you considered -- you relied on this  
19 statement from the Supreme Court to -- in reaching your  
20 conclusion that the claims were obvious?  
21 MS. PALLIOS ROBERTS: Objection. Form.  
22 THE WITNESS: Well, so I -- I was guided by  
23 this, yes. I mean, I do believe this is a case in  
24 point, that they -- that the patent at issue is a case  
25 in point of what's described in that sentence.

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1 MR. FENSTER: Q. Okay. In other words, you  
2 found that this -- the patent was addressing a problem  
3 for which there were a finite number of identified  
4 predictable solutions; is that correct?  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: Yes.  
7 MR. FENSTER: Q. Okay. Do you anywhere in  
8 your report identify what those -- what that finite  
9 number of identified predictable solutions are?  
10 MS. PALLIOS ROBERTS: Objection. Form.  
11 THE WITNESS: Do I list them all out? No.  
12 MR. FENSTER: Q. Do you ever state -- do you  
13 ever state that -- how many there are?  
14 MS. PALLIOS ROBERTS: Objection. Form.  
15 THE WITNESS: No, I don't think I stated how  
16 many there are. I mean, the one particular one that  
17 Geller adopted is the one that I spend the most time  
18 discussing.  
19 MR. FENSTER: Q. Okay. Did you mention any  
20 other identified predictable solutions to the same  
21 problem in your report?  
22 MS. PALLIOS ROBERTS: Objection. Form.  
23 THE WITNESS: I didn't mention them as that.  
24 So some of the prior art presents other approaches. For  
25 example, having users construct their own profile is

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1 something -- is another -- one of the finite possible --  
 2 set of possible solutions. And some of the prior art  
 3 actually uses that.  
 4 MR. FENSTER: Q. Okay. Can --  
 5 A. But I didn't enumerate that as another --  
 6 explicitly as another possible solution.  
 7 Q. Okay. So in your report, you didn't try to  
 8 list or identify the finite number of predictable  
 9 solutions that you think exists; is that right?  
 10 MS. PALLIOS ROBERTS: Objection. Form.  
 11 THE WITNESS: Well, I -- insofar as I think  
 12 you're just repeating what I said, I agree.  
 13 MR. FENSTER: Q. Okay. As you sit here today,  
 14 now, what is -- is it your opinion that there are a  
 15 finite number of identified predictable solutions to the  
 16 problems addressed by the Geller patent?  
 17 A. That there are, or there were in 1990?  
 18 Q. Excellent clarification. That there were as of  
 19 the date of the invention.  
 20 A. As of the date of the invention, I believe  
 21 that's the case, yes.  
 22 Q. Okay. And what were the finite number of  
 23 identified predictable solutions as of the date of the  
 24 invention?  
 25 A. Well, there were two basic approaches to user

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1 profiling. One had to -- one was to employ the user's  
 2 history and do some automatic computation on that to  
 3 calculate a profile which could then be used in  
 4 personalizing retrieval results.  
 5 And the other is -- approach is to have the  
 6 user construct the profile himself, usually with the aid  
 7 of some software that's provided. Some kind of a  
 8 graphical user interface would often be provided, and  
 9 the user would make selections under that.  
 10 So those are the two general approaches to  
 11 solutions. And within each approach, there was just a  
 12 finite number of different variants as to what things  
 13 would go into the profile.  
 14 So some of the ones where the user constructed  
 15 his own profile would simply ask the user to mark items  
 16 that they had encountered as things they liked or things  
 17 they weren't interested in. Others would ask them to  
 18 explicitly list out their interest areas.  
 19 Within the approaches that -- the family of  
 20 approaches that did automatic computation on some amount  
 21 of -- you know, some collection of documents or some  
 22 amount of user history, some of those approaches used  
 23 natural language processing of documents that were  
 24 obtained, for example, from the user himself or  
 25 documents that the user had visited; others used

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1 statistical means, which you can think of as a form of  
 2 natural language processing, but it's a bit different  
 3 from the kind that Geller employed.  
 4 So that basically is the space of  
 5 possibilities. And what Geller did fell into one of  
 6 those.  
 7 Q. Okay. So it's your testimony that there were  
 8 only two possible identified solutions, one being  
 9 natural language processing and the other being  
 10 statistical for the automatic computation family; is  
 11 that right?  
 12 MS. PALLIOS ROBERTS: Objection. Form.  
 13 THE WITNESS: Those were the two I just named  
 14 right now. I think they principally cover the  
 15 possibilities.  
 16 MR. FENSTER: Q. Is it your testimony that  
 17 natural language processing -- that there's one way to  
 18 do natural language processing, that it wouldn't have  
 19 multiple variants?  
 20 A. No. No, that's not what I'm saying.  
 21 Q. How many variants are there if one of ordinary  
 22 skill in the art sat down to do natural language  
 23 processing in 1999?  
 24 A. Well, natural language processing is the  
 25 computational analysis of language to extract structure

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1 and, through that, information from text usually; I mean  
 2 as opposed to speech. And that structure exists at  
 3 numerous levels.  
 4 There's the morphological structure of words.  
 5 This word is the plural of that, or this is -- this  
 6 adjective is formed from that noun by adding a suffix,  
 7 or so forth.  
 8 One very low level of processing involves  
 9 finding these -- doing stemming, finding these -- these  
 10 roots.  
 11 Other levels of processing find structure at  
 12 higher levels, finding, for example, the so-called  
 13 part-of-speech, the grammatical category of -- that  
 14 distinguishes noun from verbs and adjectives from  
 15 prepositions that determine what combinations of these  
 16 words can occur in well-formed sentences of the  
 17 language.  
 18 Still higher levels of structural processing  
 19 would include taking a string of text words and finding  
 20 that syntactic structure, which implies finding the  
 21 parts of speech, finding the basic categories, finding  
 22 the -- not only that, but the phrases and combinations.  
 23 Still deeper levels of processing include  
 24 finding aspects of the meaning of the sentence, because  
 25 different words can mean the same thing; different

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1 orders of the same words can mean the same thing;  
2 different combinations of words can mean the same thing.  
3 So getting at the meaning is also a part of natural  
4 language processing.  
5 And so some -- different ones of the prior art  
6 that are cited here actually go to different levels of  
7 depth, as it were, in the kind of processing -- natural  
8 language processing. And they do employ different  
9 methods for discovering, for example, syntactic  
10 structure as well.  
11 Q. Isn't it true that there's lots of different  
12 methods and lots of different levels and ways to conduct  
13 computational analysis within the broad confines of  
14 natural language processing?  
15 MS. PALLIOS ROBERTS: Objection --  
16 THE WITNESS: Well, there's --  
17 MS. PALLIOS ROBERTS: -- form.  
18 THE WITNESS: There are lots of them today,  
19 including numerous ones that were not widely available  
20 in the '90s. But even then, there were -- there were a  
21 number of ways, that's true.  
22 And there were many good textbooks on the  
23 subject. I mean, it was an area that someone with --  
24 who wanted to make use of natural language processing  
25 had good resources for finding out about.

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1 MR. FENSTER: Q. A lot of options?  
2 MS. PALLIOS ROBERTS: Objection. Form.  
3 MR. FENSTER: Q. One of skill in the art would  
4 have lots of options, lots of -- based on the resources  
5 available to him or her in 1999 about how to go about  
6 doing natural language processing; is that true?  
7 MS. PALLIOS ROBERTS: Objection. Form.  
8 THE WITNESS: Yeah. So, for example, if they  
9 were -- if the person wanted to do part-of-speech  
10 tagging, there were several different part-of-speech  
11 tagging algorithms available which the person could  
12 choose among.  
13 MR. FENSTER: Q. Can you turn to paragraph 160  
14 of your report.  
15 A. Yes.  
16 Q. So in the middle of paragraph 160, you state,  
17 "Numerous pieces of prior art can be  
18 combined in order to demonstrate the  
19 obviousness of the invention. For example,"  
20 and then you call out four of the charts.  
21 A. Oh, yes, so I did.  
22 Q. Do you see that?  
23 A. Yes.  
24 Q. Okay. My question is why these four and why  
25 didn't you reference any of the other charts in your

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1 report?  
2 MS. PALLIOS ROBERTS: Objection. Form.  
3 THE WITNESS: Well, these four are not any  
4 better than any of the other ones. The example -- or  
5 the sentence says, for example,  
6 "Claim 1 is obvious in light of Salton  
7 '89 in combination with Culliss."  
8 So the purpose was simply to bolster the  
9 general statement that numerous pieces of prior art can  
10 be combined. The 13 charts actually give you specific  
11 combinations.  
12 MR. FENSTER: Q. If you can turn to page 17 of  
13 your report.  
14 A. Mm-hm.  
15 Q. So at 17 you have a series of paragraphs,  
16 starting with 67, that describe the various prior art  
17 references.  
18 A. Yes.  
19 Q. Okay. Do you anywhere in your report analyze  
20 the differences between Braden-Harder and the asserted  
21 claims?  
22 MS. PALLIOS ROBERTS: Objection. Form.  
23 THE WITNESS: Does the report lay out  
24 explicitly in text those differences? Not that I -- I  
25 don't recall doing that, no. I certainly didn't do it

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1 systematically.  
2 MR. FENSTER: Q. Does your report disclose the  
3 differences or analyze the differences between Brookes  
4 prior art reference and the asserted claims?  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: No, it does not.  
7 MR. FENSTER: Q. Does the report disclose  
8 or -- any analysis regarding the differences between  
9 Chislenko and any of the asserted claims?  
10 A. No.  
11 MS. PALLIOS ROBERTS: Objection. Form.  
12 MR. FENSTER: Q. Does your report disclose any  
13 analysis regarding the differences between Culliss and  
14 any of the asserted claims?  
15 MS. PALLIOS ROBERTS: Objection. Form.  
16 THE WITNESS: Not -- no, not systematically.  
17 MR. FENSTER: Q. And does it disclose any  
18 analysis regarding the differences between any of the  
19 prior art references and any of the asserted claims?  
20 MS. PALLIOS ROBERTS: Objection. Form.  
21 THE WITNESS: Again, not systematically.  
22 MR. FENSTER: Q. If you can turn to paragraph  
23 91 on page 24.  
24 A. Yes.  
25 Q. So you state at paragraph 91, "I

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1 believe that claim 1 of the '067 patent  
2 consists of six different general concepts,  
3 while claim 45 consists of three additional  
4 general concepts," each of which you discuss  
5 in that section; is that right?  
6 A. Yes.  
7 Q. And your analysis of obviousness was based on  
8 finding disclosures of those general concepts in the  
9 prior art; is that how you went about it?  
10 MS. PALLIOS ROBERTS: Objection. Form.  
11 THE WITNESS: No. The analysis was based on  
12 finding prior art for the elements in each of the  
13 limitations. The concepts are here for purposes of  
14 explanation and analysis.  
15 For example, there are certain elements -- if  
16 you will, concepts -- that cut across multiple  
17 limitations in a single patent -- claim. And it seemed  
18 informative and useful to discuss them together in one  
19 place -- discuss that element in one place, even though  
20 it appears in multiple claims, rather than just to  
21 repeat the discussion many times.  
22 MR. FENSTER: Q. In the body of the report,  
23 isn't it true that you compared the general concepts or  
24 you showed disclosure of the general concepts in the  
25 prior art references as opposed to going through,

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1 element by element, using the actual claim language?  
2 MS. PALLIOS ROBERTS: Objection. Form.  
3 THE WITNESS: No, not -- not in general.  
4 That's not true. So for -- for claim 1 and claim 45,  
5 which have many, many elements, many limitations, I  
6 appended the claim charts which did show element by  
7 element in the claims what their antecedents were, as I  
8 said earlier, to avoid putting that huge volume of  
9 material in the report and making it completely  
10 unintelligible.  
11 So it's incorporated by reference as part of  
12 the report, but it doesn't consist of the flow -- part  
13 of the flow of prose here.  
14 MR. FENSTER: Okay.  
15 THE WITNESS: On the other hand, for the  
16 dependent claims, which are -- each add one single  
17 discrete bit to the independent claims on which they  
18 depend, you do find analysis right here in this section  
19 of the prior art.  
20 MR. FENSTER: Q. Okay. Excluding the ACC  
21 charts -- I want to distinguish between what's in the  
22 ACC charts and what's in the body of the report. I  
23 understand that they're incorporated by reference, but I  
24 just need a way to talk about the body of the -- of your  
25 report separate from the charts.

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1 Okay. So if I talk about the body of the  
2 report, excluding the charts, will you understand that  
3 I'm talking about the 57 pages that constitute the body  
4 of your report?  
5 A. Well, I don't -- I don't think of that as the  
6 body of my report. I think of the claim charts as an  
7 inherent part of it. But I do understand what you mean  
8 by 57 pages. So let's talk about pages 1 through 57.  
9 That's just as good.  
10 Q. All right. Is it fair to say that in the prose  
11 section of your report on pages 1 through 57, you don't  
12 analyze the prior art with reference to individual  
13 elements, but instead you analyze it with respect to the  
14 general concepts that you describe in paragraphs 91, et  
15 cetera?  
16 A. I think it would be --  
17 MS. PALLIOS ROBERTS: Objection. Form.  
18 THE WITNESS: I think it would be more -- more  
19 accurate to say I analyze it -- I don't analyze it in  
20 each case with respect to individual claim limitations,  
21 that I do analyze it with respect to elements of those  
22 claim limitations. That's what the concepts are;  
23 they're elements that cut, in some cases, across  
24 multiple limitations.  
25 So the analysis is -- and the discussion is

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1 there. And when you read it in light of the claim  
2 charts, it's also very clear on a  
3 limitation-by-limitation basis what the prior art is.  
4 MR. FENSTER: Q. Did anyone tell you that  
5 analyzing claims in terms of breaking them down into  
6 general concepts as a means of analyzing the validity of  
7 the claims was a valid approach to validity analysis?  
8 MS. PALLIOS ROBERTS: I'm going to object, to  
9 the extent this calls for communications with counsel,  
10 and instruct you not to answer on --  
11 THE WITNESS: Okay.  
12 MS. PALLIOS ROBERTS: -- that basis.  
13 MR. FENSTER: Q. How did you conclude that  
14 breaking claims down into general concepts was the  
15 proper test for validity?  
16 MS. PALLIOS ROBERTS: Objection. Form.  
17 THE WITNESS: I -- I didn't think it was the  
18 proper test for validity. I thought it was a way of  
19 explaining the analysis about -- of clearly explaining  
20 the analysis of what made each of the claims obvious.  
21 You could either go through a long and  
22 unilluminating recitation for each limitation of the  
23 prior art and then the discussion of the obviousness of  
24 combining those and so forth, or you could give a  
25 general overarching discussion that drew out

<p style="text-align: right;">74</p> <p>1 similarities across cases and give the explanation that 2 way. 3 And it was my feeling that the latter was more 4 illuminating. 5 MR. FENSTER: All right. I think we're going 6 to have to go off the record to change the tape. 7 THE WITNESS: Oh, okay. 8 THE VIDEOGRAPHER: This is the end of video 9 number 1. We are now off the record at 12:14. 10 (Discussion off the record.) 11 (Lunch recess from 12:19 to 1:05.) 12 13 14 15 16 17 18 19 20 21 22 23 24 25</p>	<p style="text-align: right;">76</p> <p>1 talked about earlier; and the other one is ranking 2 documents based on personalized interests. So that 3 latter concept belongs more particularly to information 4 retrieval. 5 And documents can be ranked for personalized 6 interest in a variety of ways. But one of those ways is 7 by using the product of natural language processing. 8 MR. FENSTER: Q. Earlier you described several 9 different methodologies or hierarchies of analysis that 10 all fell within the broad category of natural language 11 processing. Do you recall that? 12 MS. PALLIOS ROBERTS: Objection. Form. 13 THE WITNESS: I did describe several different 14 levels of structure that natural language processing can 15 produce, yes. I did. That's correct. 16 MR. FENSTER: Q. And you agree that there are 17 different ways to conduct natural -- strike that. 18 You agree that there were different ways to 19 conduct natural language processing as of 1999, correct? 20 MS. PALLIOS ROBERTS: Objection. Form. 21 THE WITNESS: Yes. There were. 22 MR. FENSTER: Q. Did all forms of natural 23 language processing that were available in 1999 extract 24 linguistic patterns, as that term has been defined by 25 the court in this case?</p>
<p style="text-align: right;">75</p> <p>1 AFTERNOON SESSION 1:02 P.M. 2 THE VIDEOGRAPHER: We are now on the record at 3 1:02. This is the beginning of video number 2. 4 EXAMINATION RESUMED BY 5 MR. FENSTER: Q. Dr. Peters, if you could turn 6 to page 24 of your report, paragraph 92. 7 A. 24, 92. Yes. 8 Q. So here you identify one general concept as the 9 use of natural language processing to rank for 10 personalized interest. And you identify that as 11 corresponding to elements 1(a), 1(b), 1(d) and 1(i); is 12 that correct? 13 MS. PALLIOS ROBERTS: Objection. Form. 14 THE WITNESS: I do identify natural language 15 processing for ranking documents. And it is used for 16 that and those elements that you named. 17 MR. FENSTER: Q. Okay. And what do you mean 18 by "natural language processing"? What do you mean by 19 the con -- what are you using as the general concept of 20 the use of natural language processing to rank for 21 personalized interest here? 22 MS. PALLIOS ROBERTS: Objection. Form. 23 THE WITNESS: Well, there -- there are two 24 concepts: natural language processing, which is using 25 computers to process natural language in the ways we</p>	<p style="text-align: right;">77</p> <p>1 MS. PALLIOS ROBERTS: Objection. Form. 2 THE WITNESS: So the court defined linguistic 3 pattern as -- well, I don't have the construction in 4 front of me, but it's basically a combination of parts 5 of speech, is the operative part of it, as I recall it. 6 And not all types of natural language 7 processing do extract parts of speech. Some, as I 8 mentioned earlier, for example, simply stem words. They 9 remove suffixes to try to find the root of a word, 10 without necessarily identifying the part of speech. In 11 fact, they may reduce different words of different parts 12 of speech to the same stems. 13 MR. FENSTER: Q. Okay. So would you agree 14 that the specific steps set forth in claim 1 in the 15 elements 1(a), 1(b), 1(d) and 1(i) reflect a particular 16 method or a particular aspect of natural language 17 processing? 18 MS. PALLIOS ROBERTS: Objection. Form. 19 MR. FENSTER: Q. Natural language processing. 20 A. So employing a part-of-speech tagger and a 21 dictionary, as this patent does, to identify linguistic 22 patterns is a -- is a particular form of natural 23 language processing. Is that -- did that answer your 24 question? 25 Q. I believe so. It's correct that not all forms</p>

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1 of natural language processing involve the particular  
2 steps outlined in claim 1, correct?  
3 MS. PALLIOS ROBERTS: Objection. Form.  
4 THE WITNESS: Well, could can we take a look at  
5 claim 1?  
6 MR. FENSTER: Certainly. It's set forth in  
7 your report, but --  
8 THE WITNESS: Yes. I don't have it in front of  
9 me. That's why I was --  
10 MR. FENSTER: It is in -- it is in your report,  
11 but I'll hand you the patent marked as Exhibit 3.  
12 (Plaintiff's Exhibit 3  
13 marked for identification.)  
14 THE WITNESS: Thank you. Right. I mean, as  
15 you -- as you know, I have only a part of my report in  
16 front of me.  
17 So let's see. Claim 1.  
18 MS. PALLIOS ROBERTS: Is there a question  
19 pending?  
20 MR. FENSTER: Yes. Question is, is it correct  
21 that not all forms of natural language processing  
22 involve the particular steps outlined in claim 1?  
23 MS. PALLIOS ROBERTS: Objection. Form.  
24 THE WITNESS: Well, that's very definitely  
25 correct because the steps outlined in claim 1, of which

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1 there are nine, I guess, A through I, include many  
2 things, of which a certain form of natural language  
3 processing is only one.  
4 MR. FENSTER: Q. So you agree that natural  
5 language processing is broader than -- it's more  
6 encompassing than the particular form of language  
7 processing that's specified in the elements of claim 1,  
8 correct?  
9 MS. PALLIOS ROBERTS: Objection. Form.  
10 THE WITNESS: Well, I think -- I'm trying to  
11 think how to answer your question because as you've --  
12 as you've posed it, it doesn't make technical sense to  
13 me, but ... let me try --  
14 MR. FENSTER: Let me -- let me see if I can  
15 clarify the question.  
16 THE WITNESS: All right.  
17 MR. FENSTER: Q. Would you agree that natural  
18 language processing, as you've used the term in your  
19 report, refers to a class of methodologies of which only  
20 one is used in the actual claim 1, that the particular  
21 methodology of claim 1 is one methodology that belongs  
22 to the class of methodologies that you describe as  
23 natural language processing?  
24 A. So the class I included -- I -- so yes, I  
25 outlined the class of methods for extracting structure

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1 at several levels. And I do believe that claim 1 makes  
2 reference to a particular subset of those methods.  
3 Q. Okay. So what I'm a little bit -- what I'm  
4 trying to get at, and I'm a little confused by, is the  
5 way I understand your report to be structured, you seem  
6 to be using these general concepts, of which the first  
7 is the use of natural language processing to rank for  
8 personalized interest -- you seem to be using those  
9 concepts as a way to explain how the prior art teaches  
10 the claims -- or the elements of the claims, correct?  
11 A. That --  
12 MS. PALLIOS ROBERTS: Objection. Form.  
13 THE WITNESS: I did introduce it to try to  
14 explain that, yes.  
15 MR. FENSTER: Q. And instead of using the  
16 particular method of natural language processing that's  
17 actually called out in the claims, you used the general  
18 concept that includes the whole class of natural  
19 language processing, correct?  
20 MS. PALLIOS ROBERTS: Objection. Form.  
21 THE WITNESS: So I did -- I made reference to  
22 the whole class and I did talk some about the more  
23 specific species within it, yes. I mean, I did do that.  
24 MR. FENSTER: Q. And so when you go through  
25 and you did your analysis finding that this first

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1 general concept that corresponds, according to you, to  
2 elements 1(a), (b), (d) and (i), as described in the  
3 prior art, you base that conclusion on disclosures  
4 relating to the general class of natural language  
5 processing; is that correct?  
6 MS. PALLIOS ROBERTS: Objection. Form.  
7 THE WITNESS: So there are -- in that section,  
8 there are a number of different pieces of prior art  
9 cited that made use of natural language processing. And  
10 different ones made, in some cases, slightly different  
11 use of natural language processing -- of -- inside the  
12 general class. That's -- that is true.  
13 Some of those prior art -- for example, in  
14 paragraph 91 it points out here -- sorry, I beg your  
15 pardon -- paragraph 95, it points out that  
16 Braden-Harder, the Braden patent, uses natural language  
17 processing that involved a multiplicity of steps, one of  
18 which was assigning parts of speech.  
19 MR. FENSTER: Okay.  
20 THE WITNESS: And similarly in 96, paragraph  
21 96, it points out that Kupiec teaches the analysis --  
22 language -- natural language processing, including  
23 assigning parts of speech.  
24 MR. FENSTER: Q. So in paragraphs 92 through  
25 97, do you describe how the prior art discloses

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1 extracting the user profile from the linguistic data  
 2 previously provided by the user?  
 3 A. No. Paragraphs 92 to 97 are about the use of  
 4 natural language processing for ranking according to a  
 5 user profile. It's other paragraphs that describe what  
 6 you're asking about.  
 7 Q. Okay. In paragraphs 92 through 97, do you  
 8 describe how the prior art discloses constructing a  
 9 plurality of data item profiles, as required by claim  
 10 1(b)?  
 11 A. No, I don't.  
 12 MS. PALLIOS ROBERTS: Objection. Form.  
 13 MR. FENSTER: Q. In paragraphs 92 through 97,  
 14 did you describe how the prior art discloses extracting  
 15 a search request profile, as required by 1(d)?  
 16 A. No, that's not the organization of my  
 17 explanation.  
 18 Q. And in paragraphs 92 through 97 do you explain  
 19 how the prior art discloses retrieving data that has  
 20 linguistic characteristics that substantially correspond  
 21 to linguistic characteristics of the linguistic data  
 22 generated by the user, as required by 1(i)?  
 23 A. Retrieving data that has -- well, the data that  
 24 are ranked are being ranked according to the linguistic  
 25 characteristics of the user profile.

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1 So the method described in paragraphs 92  
 2 through 97 are -- the approaches described there are  
 3 talking about how those retrieved data are ranked, yes.  
 4 Q. Okay. So where do you disclose that the prior  
 5 art discloses the elements specifically of claim 1(i)?  
 6 MS. PALLIOS ROBERTS: Objection. Form.  
 7 THE WITNESS: All right. So claim -- if you  
 8 look at -- so that's not in that section of the  
 9 paragraph -- of the report.  
 10 Claim 1(i) by itself is simply retrieving a  
 11 data item that you've already selected by some other  
 12 method and presenting it to the user.  
 13 And then there's just the bald assertion that  
 14 the method described in the patent actually does make it  
 15 correspond to the user's social, cultural and economic  
 16 background and psychological profile.  
 17 MR. FENSTER: Q. Do you anywhere in paragraphs  
 18 92 through 134 explain how the prior art discloses the  
 19 particular elements of claim 1(i)?  
 20 A. Of claim 1(i).  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: Through paragraphs -- I'm sorry,  
 23 what was the final one again?  
 24 MR. FENSTER: 134.  
 25 THE WITNESS: 134. Well, so claim 1(i) is

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1 simply the step of retrieving a document that was  
 2 selected by claim 1(h) and presenting it to the user.  
 3 And to the extent that the document presented --  
 4 retrieved and presented is the one that's selected by  
 5 claim 1(h), it is actually paragraphs 92 through 97 that  
 6 are relevant. That is, claim 1(h) is all about ranking  
 7 documents according to a personalized interest profile.  
 8 There's nothing novel about claim 1(h).  
 9 Retrieving the documents and presenting it is well-known  
 10 art. And the citations in the claim charts actually  
 11 demonstrate this.  
 12 MR. FENSTER: Q. Dr. Peters, I really want to  
 13 ask you to constrain your comments to response to my  
 14 questions. My question is, where in your report do you  
 15 disclose how the prior art discloses the particular  
 16 elements of claim 1(i)?  
 17 MS. PALLIOS ROBERTS: Objection. Form.  
 18 THE WITNESS: In the claim charts.  
 19 MR. FENSTER: Q. Okay. And there's nothing in  
 20 the body of your report; is that right?  
 21 MS. PALLIOS ROBERTS: Objection --  
 22 MR. FENSTER: Q. Meaning pages 1 through 57.  
 23 A. So --  
 24 MS. PALLIOS ROBERTS: Objection. Form.  
 25 THE WITNESS: Paragraph 97.

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1 MR. FENSTER: Q. Okay. Anything else?  
 2 A. Which refers you to the claim --  
 3 MS. PALLIOS ROBERTS: Objection. Form.  
 4 THE WITNESS: -- charts.  
 5 Not as far as I can recall right now.  
 6 MR. FENSTER: Q. Now, in the claim charts, as  
 7 far as I could tell, on -- the structure of the charts  
 8 has the claim language on the left, and then you have  
 9 three columns from the prior art references, correct?  
 10 A. Yes.  
 11 Q. And as far as I could tell, the evidence in the  
 12 three columns relating to the prior art references were  
 13 either excerpts from the prior art references or  
 14 citations to the prior art references. Is that right?  
 15 A. For the most part, that is what's there.  
 16 Q. It doesn't include any analysis on your part in  
 17 terms of showing how, for example, the portions cited  
 18 correspond to or relate to the language of the claim; is  
 19 that right?  
 20 MS. PALLIOS ROBERTS: Objection. Form.  
 21 THE WITNESS: That analysis is implied by the  
 22 discussion in the section that we've just been talking  
 23 about.  
 24 MR. FENSTER: Q. Okay. But the chart itself  
 25 does not contain any analysis by you showing how the

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1 cited portions of the prior art correspond or relate to  
 2 the language of the claims, correct?  
 3 MS. PALLIOS ROBERTS: Objection. Form.  
 4 THE WITNESS: Not above and beyond what's in  
 5 the rest of the report. So, for example, it's pretty --  
 6 well, yes. Let's leave it there.  
 7 MR. FENSTER: Q. The chart itself -- the  
 8 charts themselves do not contain any analysis by you  
 9 showing how any of the cited portions of the prior art  
 10 correspond to or disclose any of the claim elements,  
 11 correct?  
 12 MS. PALLIOS ROBERTS: Objection. Form.  
 13 THE WITNESS: That's not where that analysis  
 14 is. It's not in the claim charts.  
 15 MR. FENSTER: Q. And is that true for all 13  
 16 of the claim charts?  
 17 MS. PALLIOS ROBERTS: Objection. Form.  
 18 THE WITNESS: Probably. The claim charts don't  
 19 stand by themselves. The claim charts are a part of a  
 20 report. The report is a whole entity.  
 21 MR. FENSTER: Q. Okay. But the claim charts  
 22 themselves don't contain any analysis by you showing how  
 23 the cited portions of the prior art references disclose  
 24 the particular elements of the claims, correct?  
 25 MS. PALLIOS ROBERTS: Objection. Form.

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1 THE WITNESS: Well, these things disclose  
 2 that -- that particular claim limitation. Do I say it's  
 3 these specific words in this part that correspond to  
 4 those specific words? That's not in the claim chart.  
 5 MR. FENSTER: Q. Is there any analysis, any  
 6 original work product by you, other than the mere  
 7 citation of the portions of the prior art references  
 8 themselves, showing how those prior art references  
 9 correspond to or disclose the particular claim elements  
 10 in the charts?  
 11 A. It's included --  
 12 MS. PALLIOS ROBERTS: Objection. Form.  
 13 THE WITNESS: -- in the discourse that we've  
 14 just been discussing.  
 15 MR. FENSTER: Q. Is there any analysis by you  
 16 in the charts, ACC1 through ACC13, showing how any  
 17 portion of the prior art corresponds and discloses the  
 18 actual claim elements?  
 19 MS. PALLIOS ROBERTS: Objection. Form.  
 20 THE WITNESS: Well, I don't have all the charts  
 21 in front of me. But to the best of my recollection,  
 22 that's not in the charts. I can look through all of  
 23 them here if you like, but ...  
 24 MR. FENSTER: If you need to to answer the  
 25 question. You're the one who prepared the charts.

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1 THE WITNESS: Yep, yep. They are voluminous.  
 2 That's why I'm saying I don't remember them all. But  
 3 as -- you know, there -- there are -- there may be  
 4 specific bits of explanation, for example, where there  
 5 are terminological difference between one of -- of the  
 6 citations of prior art and the terminology that's used  
 7 in the claim elements.  
 8 There are, as I recall, some explanations like  
 9 that that are in the chart itself that show what the  
 10 correspondence is.  
 11 But the principal work of explaining how the  
 12 elements of the claims relate to what's called out in  
 13 the -- what's cited in the claim charts is done in the  
 14 explanatory sections, not in the charts.  
 15 MR. FENSTER: Q. And the charts themselves  
 16 don't reflect any analysis by you -- don't -- strike  
 17 that.  
 18 The charts themselves don't include any  
 19 analysis by you showing how the prior art references  
 20 disclose the claims as construed by the court, correct?  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: Well, it's the claims as  
 23 construed by the court that I was looking for prior art  
 24 for. So that's -- the citations are there because they  
 25 relate to the claim as construed by the court, the claim

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1 language as construed by the court.  
 2 That language is not recited in the chart. If  
 3 you're asking me is it recited in the chart, it's not.  
 4 MR. FENSTER: Q. Dr. Peters, for example,  
 5 with -- let's -- let's just look at 1(a) for example,  
 6 which is at page 5 of -- starts at page 5 of ACC1.  
 7 And on the left-hand column, you've got the  
 8 claim language from claim 1(a), correct?  
 9 A. Yes.  
 10 Q. And then in the next column you have some  
 11 excerpts from Salton '89, correct?  
 12 A. Yes.  
 13 Q. And you have Salton '89, and you cite a page,  
 14 and then you have quotes -- quoted language there,  
 15 correct?  
 16 A. That's correct. And there's several of those,  
 17 as you say.  
 18 Q. Right. And that's true for all of the prior  
 19 art references; you just have quoted portions from the  
 20 text and citations set forth in these columns, correct?  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: That is what's there, yes.  
 23 MR. FENSTER: Q. Okay. And in the chart, do  
 24 you provide any explanation as to how the quoted portion  
 25 matches up with or discloses the claim language in the



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1 left column?  
 2 A. No. The chart does not say, you know, "These  
 3 words in column 2 map to those words in column 1."  
 4 Q. It's left as an exercise for the reader?  
 5 MS. PALLIOS ROBERTS: Objection. Form.  
 6 THE WITNESS: It was explained earlier in  
 7 the -- the correspondence was explained in the section  
 8 we were discussing earlier.  
 9 MR. FENSTER: I see.  
 10 THE WITNESS: Would you like this back?  
 11 MR. FENSTER: Sure. Thanks.  
 12 Q. So if you could turn to page 36 of your report.  
 13 A. Yes.  
 14 Q. Okay. Now, you cite three general concepts for  
 15 claim 45; is that correct?  
 16 MS. PALLIOS ROBERTS: Objection. Form.  
 17 THE WITNESS: Yes. In connection with claim  
 18 45, I lump together the elements that appear across its  
 19 limitations in three major groups, yes.  
 20 MR. FENSTER: Q. Okay. And the first major  
 21 group, as you call it, is creation of user profile from  
 22 text items, correct?  
 23 A. That's correct.  
 24 Q. And it's your opinion that that major category  
 25 corresponds to six of the elements from claim 45; is

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1 that right?  
 2 MS. PALLIOS ROBERTS: Objection. Form.  
 3 THE WITNESS: Yes. And if I may consult the  
 4 patent here for a second and look at claim 45.  
 5 It's my opinion that six of those limitations  
 6 are involved in creating a user profile from text items  
 7 in one way or another.  
 8 MR. FENSTER: Q. Is it your opinion that if a  
 9 reference discloses creating a user profile from text  
 10 items, that that reference will necessarily disclose  
 11 each of the six elements you've identified as  
 12 corresponding?  
 13 MS. PALLIOS ROBERTS: Objection. Form.  
 14 THE WITNESS: No, not -- it's not. As I -- as  
 15 I've said, there are -- well, let's see. In claim 45  
 16 here, we have even more. Eight, nine, ten, 11 -- 11  
 17 steps, 11 limitations called out in the claim. So I  
 18 believe that -- my understanding is that for the patent  
 19 to be obvious, each of those steps has to have an  
 20 antecedent.  
 21 MR. FENSTER: That's not my question.  
 22 THE WITNESS: Okay.  
 23 MR. FENSTER: Q. Okay. At page 36 of your  
 24 report, you, in paragraph -- well, it's listed as  
 25 indented 1. The first major category you have listed is

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1 creation of a user profile from text items. Do you see  
 2 that?  
 3 A. Yes.  
 4 Q. And in parentheses you have claims 45(a), (b),  
 5 (c), (d), (e), (f), (g) and (k), along with two  
 6 dependent claims. Do you see that?  
 7 A. That's correct.  
 8 Q. Okay. And what did you mean by putting those  
 9 claim elements in parentheses after reciting that major  
 10 category?  
 11 A. I mean that those are the steps in claim 45.  
 12 Those are the elements in claim 45 that are involved in  
 13 creating the user profile from text items in the way  
 14 that claim 45 claims.  
 15 Q. Okay. Is it your opinion that any prior art  
 16 reference which creates a user profile from text items  
 17 will necessarily disclose each of claim elements 45(a),  
 18 (b), (c), (f), (g) and (k)?  
 19 A. No, it is not.  
 20 Q. Do you, in paragraphs 135 through 139, show how  
 21 Salton discloses the particular elements of claim 45(a)?  
 22 MS. PALLIOS ROBERTS: Objection. Form.  
 23 THE WITNESS: Not in those paragraphs taken by  
 24 themselves. It's in the combination of those paragraphs  
 25 and the claim charts that support these.

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1 MR. FENSTER: Q. Okay. So there isn't  
 2 anything in the disclosure of paragraphs 135 through 139  
 3 by themselves that would show a mapping of the  
 4 disclosure from Salton '68 to the particular claim  
 5 elements of claim 1(a); is that right?  
 6 MS. PALLIOS ROBERTS: Objection. Form.  
 7 THE WITNESS: No, it doesn't say, you know,  
 8 "This part of Salton 1968 is about retrieving user  
 9 linguistic data comprising at least one text item," et  
 10 cetera.  
 11 MR. FENSTER: Q. Is there anything in  
 12 paragraphs 135 through 139 showing how Culliss teaches  
 13 the particular elements of claim 1(a)?  
 14 MS. PALLIOS ROBERTS: Objection. Form.  
 15 THE WITNESS: No, in the same way; it's not  
 16 there alone.  
 17 MR. FENSTER: Q. Is there anything in  
 18 paragraphs 135 through 139 showing how Culliss teaches  
 19 any of the particular -- of the particular six elements  
 20 that you identified as corresponding to this general  
 21 category of creating a user profile from text items?  
 22 MS. PALLIOS ROBERTS: Objection. Form.  
 23 THE WITNESS: In that part of the report alone,  
 24 no. It's the combination of that part, plus the claim  
 25 charts, that show -- that provide that.

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1 MR. FENSTER: Q. Is there anything in  
 2 paragraphs 135 through 139 that discloses how Herz  
 3 teaches each of the six elements that you identify as  
 4 corresponding to this general category?  
 5 MS. PALLIOS ROBERTS: Objection. Form.  
 6 THE WITNESS: Well, so it's not about  
 7 retrieving. Herz does talk about using copies of the  
 8 target objects that the user indicates are  
 9 representative of his or her interest, so ... you could  
 10 say that even in this particular prose, there's some  
 11 indication there.  
 12 MR. FENSTER: Q. Tell me which of these  
 13 elements -- which of the six elements of 45(a), (b),  
 14 (c), (f), (g) and (k) you think are specifically  
 15 disclosed by Herz, as disclosed in paragraphs 135  
 16 through 139 of your report.  
 17 MS. PALLIOS ROBERTS: Objection. Form.  
 18 THE WITNESS: Okay. So Herz talks about -- the  
 19 citation from Herz here is about initially  
 20 determining -- it's about determining a user profile  
 21 using copies of the profiles of target objects that the  
 22 user represents -- indicates are representative of his  
 23 or her interest. That's related to retrieving user  
 24 linguistic data provided by the user.  
 25 MR. FENSTER: Q. Does your report say that?

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1 A. No.  
 2 MS. PALLIOS ROBERTS: Objection. Form.  
 3 THE WITNESS: I take that to be something that  
 4 you could easily figure out.  
 5 MR. FENSTER: Q. You're referring to paragraph  
 6 138 of your report; is that correct?  
 7 A. That's correct.  
 8 Q. Okay. And 138 says "Herz teaches" and then has  
 9 a quote from Herz, correct?  
 10 A. That's correct.  
 11 Q. The sum total of your analysis regarding Herz  
 12 in those paragraphs is "Herz teaches," correct?  
 13 MS. PALLIOS ROBERTS: Objection. Form.  
 14 THE WITNESS: No. No, that's not the sum  
 15 total. Again, the paragraphs -- this paragraph is one  
 16 of a series of paragraphs that culminates by bringing in  
 17 the attached claim chart --  
 18 MR. FENSTER: Okay.  
 19 THE WITNESS: -- where Herz is one of the  
 20 examples.  
 21 MR. FENSTER: Q. I'm having trouble finding  
 22 your analysis in the -- in your report. You keep  
 23 telling me that it's here in the report, it's not in the  
 24 charts, and that it's the sum total.  
 25 Let's go through -- let's just take Herz as an

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1 example.  
 2 A. Okay.  
 3 Q. Okay. And Herz is disclosed in ACC2, for  
 4 example.  
 5 A. Well, that one's about claim 1. If we want to  
 6 talk about claim 45, we should --  
 7 Q. You're right. So let's go to ACC11. Okay.  
 8 Now -- so what I want is your analysis -- what  
 9 I want you to point out is where in your report do you  
 10 show your own analysis and explanation as to how Herz  
 11 discloses each of the elements of claim 45, okay.  
 12 So let's start -- let's start with 45(a) and go  
 13 all the way through (k). And for each one, I want you  
 14 to go through and point out everywhere in your report  
 15 where you think you provide your own analysis and  
 16 explanation as to how Herz teaches each element.  
 17 A. Okay. But remember, I -- I -- what this --  
 18 what I've asserted here is that Salton plus Herz teach  
 19 each element of claim 45, not that Herz alone teaches  
 20 every element of claim 45.  
 21 Q. Okay.  
 22 A. So we'll go through the ones which I think Herz  
 23 does teach.  
 24 All right. So let's see. For claim 45(a),  
 25 which is retrieving user linguistic data comprising at

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1 least one text item, and so on -- so Herz in -- let's  
 2 see. I got mixed up here about pages here.  
 3 In column 56, 20 through 28 says,  
 4 "As in any application involving search  
 5 profiles" -- I'll show it to you here --  
 6 "they can be initially determined" --  
 7 Q. Okay.  
 8 A. -- "or explicitly altered by a number  
 9 of procedures, including the following  
 10 preferred methods."  
 11 And one of those methods is using copies of the  
 12 profiles of target objects or target clusters the user  
 13 indicates are representative --  
 14 Q. Dr. Peters, let me interrupt.  
 15 MS. PALLIOS ROBERTS: Don't interrupt his  
 16 answer.  
 17 MR. FENSTER: Q. -- 'cause you're not actually  
 18 answering my question. What you were reading from was a  
 19 quoted portion from Herz that you have at page 3 of  
 20 ACC11, correct?  
 21 A. Mm-hm.  
 22 Q. Okay. What I'm asking you for is not what --  
 23 I'm not asking for your analysis now, okay. I'm not  
 24 asking you to now provide an analysis and explanation as  
 25 to how Herz -- how the quoted portions of Herz disclose

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1 45(a).  
 2 A. Mm-hm.  
 3 Q. What I want you to do is point to the -- any  
 4 explanation that you already provided in your report, if  
 5 there is any.  
 6 A. Mm-hm. Okay. Well, the explanation is the  
 7 combination of that citation and the discussion in these  
 8 paragraphs 135 through 139 as it applies to claim 45(a)  
 9 specifically -- not as it applies to the other claims of  
 10 45, 'cause this discussion is intended to summarize  
 11 across claims -- but as it applies to claim 45(a), this  
 12 discussion, together with the citations from Herz here.  
 13 Q. Okay. So what you've identified for me is  
 14 paragraphs 135 through 139 in your report and the quoted  
 15 portions from Herz in the chart, correct?  
 16 A. Mm-hm.  
 17 MS. PALLIOS ROBERTS: Objection. Form.  
 18 MR. FENSTER: Q. Okay. And is it correct that  
 19 the chart doesn't include any explanation by you; it's  
 20 just quoted portions regarding Herz?  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: That's correct in this case, yes.  
 23 MR. FENSTER: Q. Okay. Now, does 135 -- does  
 24 paragraph 135 of your report provide any explanation by  
 25 you as to how Herz discloses element 45(a)?

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1 A. Well, I believe it does, yes.  
 2 Q. Okay. Show me where.  
 3 A. Well, in paragraph 138 in particular.  
 4 Q. I was asking about 135.  
 5 A. Oh, I'm sorry. 130 -- does 135? 135 speaks  
 6 about Salton.  
 7 Q. It doesn't include any explanation by you about  
 8 how Herz discloses paragraph 45(a), correct?  
 9 A. No.  
 10 Q. Okay. And paragraph 136 of your report  
 11 likewise does not include any explanation by you as to  
 12 how Herz discloses 45(a), correct?  
 13 A. Not by itself. What each of these paragraphs  
 14 does is to talk about how elements of other patents or  
 15 textbooks map onto elements of claim 45(a).  
 16 So the only one that specifically is about Herz  
 17 is 138. It needs to be --  
 18 Q. Okay.  
 19 A. -- interpreted in the context of the whole  
 20 section.  
 21 Q. Okay. And so paragraph 138 is the only  
 22 paragraph in your entire report that contains any  
 23 explanation by you as to how Herz discloses element  
 24 45(a), correct?  
 25 A. That's not what I said.

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1 MS. PALLIOS ROBERTS: Objection. Form.  
 2 THE WITNESS: I said it had to be read in the  
 3 context of the rest of the explanation.  
 4 (Brief interruption.)  
 5 MR. FENSTER: Q. The only words that are yours  
 6 in paragraph 148 -- 138 are "Herz teaches," correct?  
 7 A. In 138, that is -- "Herz teaches," and then  
 8 there's a quotation.  
 9 Q. And you can't point to any other portion of  
 10 your report where you provide explanation as to how Herz  
 11 teaches element 1(a), correct?  
 12 MS. PALLIOS ROBERTS: Objection. Form.  
 13 THE WITNESS: The rest of this section plus the  
 14 charts that involve Herz.  
 15 MR. FENSTER: Q. Okay. Let's do the same  
 16 exercise for 45(b).  
 17 A. All right.  
 18 Q. You contend that Herz discloses element 45(b),  
 19 correct?  
 20 A. That's right. Generating, in this case, an  
 21 empty user data profile. That's the first step in  
 22 entering -- in generating data profiles generally.  
 23 Q. Do you provide any explanation in your  
 24 report -- any explanation by you -- as to how Herz  
 25 teaches element 45(b)?

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1 A. Yes. The answer is the same as before. It's  
 2 the combination of these paragraphs 135 through 139,  
 3 which make -- which include particular mention of Herz,  
 4 plus the quoted portions of Herz here in the claim  
 5 chart.  
 6 Q. Okay. And the only words in all of that that  
 7 you've quoted regarding Herz that are yours are "Herz  
 8 teaches," correct --  
 9 MS. PALLIOS ROBERTS: Objection --  
 10 MR. FENSTER: Q. -- in paragraph 138?  
 11 MS. PALLIOS ROBERTS: Objection. Form.  
 12 THE WITNESS: No. The -- that's the only  
 13 mention of Herz in my words. The section as a whole is  
 14 intended to show how prior art, including Herz's art,  
 15 maps onto a collection of steps -- anticipates, if you  
 16 like -- that's not the right technical term because I'm  
 17 not saying it anticipates the claim -- but it's prior  
 18 art for these steps in those limitations of claim 45.  
 19 MR. FENSTER: Q. I'm eager for your words. If  
 20 you can point me to any words -- you're a teacher. You  
 21 explain. If you can point me to any words of yours in  
 22 your report where you explain how -- tell me how Herz  
 23 discloses element 45(b), please do so.  
 24 MS. PALLIOS ROBERTS: Objection. Form.  
 25 THE WITNESS: Well, the report explains the

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1 context in which this patent occurred; it explains what  
2 combination of elements occur there; it talks about  
3 where each of the parts that goes into the combination  
4 can be found.  
5 MR. FENSTER: Q. Can you --  
6 MS. PALLIOS ROBERTS: Let him finish.  
7 MR. FENSTER: Q. Can you answer my specific  
8 question. Can you point me to any words of yours where  
9 you explain how Herz in particular discloses element  
10 45(b) in particular?  
11 MS. PALLIOS ROBERTS: Objection. Form.  
12 THE WITNESS: I guess I don't know what you're  
13 looking for if I -- what I've given you isn't an answer  
14 to the question.  
15 MR. FENSTER: Q. I'm asking where you discuss  
16 Herz in particular, if you do, in your report and where  
17 you explain in your own words and provide your analysis  
18 as to how Herz in particular discloses the particular  
19 element of 45(b).  
20 MS. PALLIOS ROBERTS: Objection. Form.  
21 THE WITNESS: So my -- the report is not a  
22 report about Herz; it's a report about the Geller  
23 patent, what is -- what combination of elements it  
24 involves, how other people were looking at those  
25 elements, and even for a similar combination at the

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1 time, and a discussion of who those people were and what  
2 they actually presented.  
3 MR. FENSTER: Q. If it's not there, that's a  
4 fine answer. If it is there, I want you to show me  
5 where it is. That's all.  
6 So if you contend that you did explain where  
7 Herz discloses 45(b) and how, then show me. And if you  
8 didn't explain it, just say so.  
9 A. I am --  
10 MS. PALLIOS ROBERTS: Objection. Form.  
11 THE WITNESS: -- going to say again that the  
12 report is not about Herz. I don't give a section on  
13 what Herz teaches about this particular patent in, you  
14 know, minute detail.  
15 MR. FENSTER: Q. Okay. So is it fair to say  
16 that your report wasn't intended to and doesn't explain  
17 how Herz teaches the particular elements of claim 45?  
18 MS. PALLIOS ROBERTS: Objection. Form.  
19 THE WITNESS: No, I don't think that's fair.  
20 MR. FENSTER: Q. Okay. So let me ask it this  
21 way: Does your report explain how Herz discloses claim  
22 45(b)?  
23 MS. PALLIOS ROBERTS: Objection. Form.  
24 THE WITNESS: In my opinion, it does.  
25 MR. FENSTER: Q. And can you point me to any

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1 sentences in your report where that explanation is  
2 provided?  
3 MS. PALLIOS ROBERTS: Objection. Form.  
4 THE WITNESS: The sentences of the section  
5 we're discussing about paragraphs 135 through 139, plus  
6 the portion of the claim chart that we're looking at  
7 here.  
8 MR. FENSTER: Q. Okay. Can you point me to --  
9 does your report explain in your words how Herz  
10 discloses claim element 45(c)?  
11 A. Let's look at 45(c), retrieving a text item  
12 from user linguistic data. So Herz actually -- yes,  
13 Herz does teach that the -- in creating a profile, you  
14 can take text and you can break it into segments here  
15 that correspond to these text items.  
16 Q. Dr. Peters, please focus on my question. Does  
17 your report explain in your own words how Herz discloses  
18 claim element 45(c)?  
19 MS. PALLIOS ROBERTS: Objection --  
20 MR. FENSTER: Q. Yes or no?  
21 MS. PALLIOS ROBERTS: Objection. Form.  
22 THE WITNESS: I guess you're saying that you  
23 find it hard to make the connection between those two  
24 things. I do not explain so -- apparently so that you  
25 could see the connection, what that connection was.

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1 MR. FENSTER: No, I --  
2 THE WITNESS: You don't seem to be seeing the  
3 connection.  
4 MR. FENSTER: Q. I'm slow, so, you know --  
5 I -- I'm not asking -- can you answer my question yes or  
6 no; does your report explain in your own words how Herz  
7 discloses element 45(b)?  
8 MS. PALLIOS ROBERTS: Objection. Form.  
9 THE WITNESS: I've answered yes.  
10 MR. FENSTER: Q. Can you point me to where?  
11 A. It --  
12 MS. PALLIOS ROBERTS: Objection. Form.  
13 THE WITNESS: It is the section that discusses  
14 claims here, including 45(b), these paragraphs 135  
15 through 139, and the portion of the claim charts that  
16 appear -- that corresponds to -- that matches Herz up  
17 with claim 45(b).  
18 MR. FENSTER: Q. Does your report explain in  
19 your own words how Herz teaches claim 45(c)?  
20 MS. PALLIOS ROBERTS: Objection. Form.  
21 MR. FENSTER: Q. Yes or no?  
22 A. Yes, it does.  
23 Q. Okay. Where?  
24 MS. PALLIOS ROBERTS: Objection. Form.  
25 THE WITNESS: Same portion of these pages 36

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1 and 37 and the part of the claim chart that maps Herz --  
 2 quotations from Herz to claim 45(c).  
 3 MR. FENSTER: Q. Does your report explain in  
 4 your own words how Herz discloses claim element 45(f)?  
 5 MS. PALLIOS ROBERTS: Objection. Form.  
 6 THE WITNESS: Yes, it does.  
 7 MR. FENSTER: Q. Where?  
 8 A. Paragraphs 135 --  
 9 MS. PALLIOS ROBERTS: Objection. Form.  
 10 THE WITNESS: -- to 139 and the portion of the  
 11 claim chart that maps citations from Herz to claim  
 12 45(f).  
 13 MR. FENSTER: Q. Okay. Does your report  
 14 explain in your own words how Herz teaches claim 45(g)?  
 15 MS. PALLIOS ROBERTS: Objection. Form.  
 16 THE WITNESS: Yes, it does.  
 17 MR. FENSTER: Q. Where?  
 18 A. Paragraphs 135 through 139 and the portion of  
 19 the claim chart that map Herz to claim 45(g).  
 20 Q. Okay. Does your report explain in your own  
 21 words how Herz teaches or discloses the element 45(k)?  
 22 MS. PALLIOS ROBERTS: Objection. Form.  
 23 THE WITNESS: Yes.  
 24 MR. FENSTER: Q. Where?  
 25 A. Yes, it does.

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1 MS. PALLIOS ROBERTS: Objection. Form.  
 2 THE WITNESS: Paragraphs 135 through 139 and  
 3 the portion of the claim chart that maps, in this case,  
 4 multiple citations from Herz to claim 45(k).  
 5 MR. FENSTER: Q. And do you agree with me that  
 6 the only words of your own that you provide in  
 7 paragraphs 135 through 139 and the chart ACC11 regarding  
 8 Herz are the introductory phrase "Herz teaches"?  
 9 MS. PALLIOS ROBERTS: Objection. Form.  
 10 THE WITNESS: No, I don't agree with that at  
 11 all. The section is about a collection of concepts  
 12 explained in light of a background which I expanded on  
 13 in considerable detail. And the citations from the  
 14 patents as well as the Geller patent are things which I  
 15 believe are understandable in light of that explanation.  
 16 And I think that it's a clear -- taken  
 17 together, it amounts to a clear explanation of how Herz  
 18 maps onto it.  
 19 And so the words "Herz teaches" are not the sum  
 20 total of what I have to say about what it is that Herz  
 21 teaches.  
 22 MR. FENSTER: Q. Do you say --  
 23 A. You have to read it in the context of all that  
 24 surrounds it.  
 25 Q. Okay. Are there any other paragraphs where you

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1 discuss Herz in particular?  
 2 MS. PALLIOS ROBERTS: Objection. Form.  
 3 THE WITNESS: Well, there may well be. I don't  
 4 recall offhand. It did come up other times, so surely  
 5 there are. In claim -- discussed in claim 1, for  
 6 example.  
 7 MR. FENSTER: Q. Is paragraph 138 the only  
 8 place where you discuss Herz in connection with claims  
 9 45(a), (b), (c), (d), (e), (f), (g) and (k)?  
 10 MS. PALLIOS ROBERTS: Objection. Form.  
 11 THE WITNESS: No. It's paragraphs 135 through  
 12 139, taken with the claim charts.  
 13 MR. FENSTER: Q. Do you mention Herz in  
 14 paragraph 135?  
 15 A. No.  
 16 Q. Do you mention Herz in paragraph 136?  
 17 A. I don't mention him, no. I'm talking --  
 18 Q. Do you mention -- do you mention Herz in  
 19 paragraph 137?  
 20 A. No.  
 21 Q. And do you mention Herz in paragraph 139?  
 22 A. No. These are a series of connected paragraphs  
 23 of which the paragraph about Herz is one. And it  
 24 relates, in the context, to all the other discussion.  
 25 Q. Does your report contain any explanation by you

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1 as to how Salton '68 teaches element 45(a)?  
 2 MS. PALLIOS ROBERTS: Objection. Form.  
 3 THE WITNESS: Yes, it does.  
 4 MR. FENSTER: Q. Where?  
 5 A. It's in paragraph 135 through 139 and the  
 6 charts about Salton '68, which this -- this is the chart  
 7 which combines Salton with Herz.  
 8 Q. And you're referring to ACC11, correct?  
 9 A. I am, yes.  
 10 Q. Does your report disclose any explanation by  
 11 you in your own words as to how Salton '68 teaches  
 12 element 45(b)?  
 13 MS. PALLIOS ROBERTS: Objection. Form.  
 14 THE WITNESS: The same paragraphs, 135 through  
 15 139, and the part of this chart that lines up Salton  
 16 specifically here are reference to the figure and  
 17 paragraph -- limitation (b) of claim 45.  
 18 MR. FENSTER: Q. Does your report contain any  
 19 explanation by you as to how Salton '68 teaches element  
 20 45(c)?  
 21 MS. PALLIOS ROBERTS: Objection. Form.  
 22 THE WITNESS: Paragraphs 135 through 139 --  
 23 MR. FENSTER: Q. Can you answer my question  
 24 yes or no?  
 25 A. Oh, I'm sorry.

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1 MS. PALLIOS ROBERTS: Let him finish his  
 2 answer.  
 3 THE WITNESS: Well, yes. I'll start with yes.  
 4 Same paragraphs and the part of the claim chart that  
 5 lines up Salton with 45(c).  
 6 MR. FENSTER: Q. Does your report contain any  
 7 analysis or explanation by you as to how Salton '68  
 8 teaches element 45(f)?  
 9 MS. PALLIOS ROBERTS: Objection. Form.  
 10 THE WITNESS: Yes.  
 11 MR. FENSTER: Q. And where is that found?  
 12 THE WITNESS: It's in the paragraph about  
 13 Salton, 135, plus the remainder of that section, 139,  
 14 and the portion of the claim chart that line up Salton  
 15 '68 with claim 45(f).  
 16 MR. FENSTER: Q. Okay. Does the chart ACC11  
 17 include any explanation by you or just quotations or  
 18 citations to Salton '68?  
 19 A. In the chart, there are citations and  
 20 quotations.  
 21 Q. The chart itself doesn't -- does the chart  
 22 itself include any explanation by you regarding Salton  
 23 '68?  
 24 A. The chart taken alone does not seem to include  
 25 any explanation about Salton. It's the combination that

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1 does.  
 2 Q. And does your report contain any explanation by  
 3 you as to how Salton '68 discloses claim element 45(f)?  
 4 MS. PALLIOS ROBERTS: Objection. Form.  
 5 THE WITNESS: Yes.  
 6 MR. FENSTER: Q. And where is that found?  
 7 A. Okay, I -- it's right here in front of me. So  
 8 I thought that might be the one I just answered, but  
 9 maybe I turned to it in looking through the chart.  
 10 It's in paragraphs 135 through 139 plus the  
 11 section of the chart that has some citations of Salton  
 12 lined up with claim 45(f).  
 13 Q. Okay. And does your report contain any  
 14 explanation or analysis by you as to how Salton '68  
 15 teaches element 45(g)?  
 16 MS. PALLIOS ROBERTS: Objection. Form.  
 17 THE WITNESS: Yes, it's paragraphs 135 through  
 18 139 and the portion of the chart that aligns citations  
 19 of Salton with claim limitation 45(g).  
 20 MR. FENSTER: Q. And is your answer the same  
 21 with respect to Salton -- your analysis of -- or your  
 22 explanation of how Salton '68 teaches 45(k)?  
 23 MS. PALLIOS ROBERTS: Objection. Form.  
 24 THE WITNESS: It -- yes, it is. Those  
 25 paragraphs plus the part that lines up citations of

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1 Salton with claim 45(k).  
 2 MS. PALLIOS ROBERTS: Counsel, we've been going  
 3 for about an hour. If this is a natural stopping point,  
 4 could we take a break.  
 5 MR. FENSTER: Sure.  
 6 THE VIDEOGRAPHER: We are now off the record at  
 7 2:07.  
 8 (Recess taken.)  
 9 THE VIDEOGRAPHER: We are now on the record at  
 10 2:24.  
 11 MR. FENSTER: Q. Dr. Peters, you assert in  
 12 ACC12 that chart -- that claim 45 is invalid in light of  
 13 several references, the principal ones of which are  
 14 Braden and Kurtzman; is that correct?  
 15 A. I believe that's correct. If I could just see  
 16 it for one second.  
 17 Yes, that -- that is correct.  
 18 Q. Does your report disclose anywhere any analysis  
 19 or explanation in your own words -- strike that.  
 20 Does your report contain any explanation in  
 21 your own words as to how Braden teaches element 45(a)?  
 22 MS. PALLIOS ROBERTS: Objection. Form.  
 23 THE WITNESS: Well, yes, it does. I discuss  
 24 Braden in -- when it's introduced as prior art; I  
 25 discuss it in some other places; and I discuss it in

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1 particular in paragraphs -- the ones we were just  
 2 talking about -- and I have to find them again here --  
 3 paragraphs 135 through 139 with -- together with that  
 4 portion of the claim chart that you just mentioned,  
 5 ACC12, that pertains to claim 45(a).  
 6 MR. FENSTER: Q. It's your testimony that your  
 7 report contains an explanation in your own words  
 8 regarding how Braden -- explaining how Braden discloses  
 9 claim 45(a) in paragraphs 135 through 139 together with  
 10 the chart; is that correct?  
 11 MS. PALLIOS ROBERTS: Objection. Form.  
 12 THE WITNESS: I -- I do think that it does.  
 13 What I said was that it's discussed in the places where  
 14 Braden itself is introduced and those paragraphs and the  
 15 chart.  
 16 Let's see. Paragraph 67, for example, Braden  
 17 is discussed, along with being relevant to the -- those  
 18 paragraphs 135 through 139. And, of course, it's also  
 19 in that chart.  
 20 MR. FENSTER: Q. Okay. So you're telling me  
 21 that the places where I can find -- that your report  
 22 explains in your own words how Braden teaches 45(a) in  
 23 particular at paragraph 67 of your report, paragraphs  
 24 135 through 139 of your report, together with the chart;  
 25 is that correct?

114	1 MS. PALLIOS ROBERTS: Objection. Form. 2 THE WITNESS: Let's say -- I can look through 3 the report and see if there are any other places that 4 are pertinent. 45(a) we're talking about? 5 MR. FENSTER: Yep. 6 THE WITNESS: Well, that's part of the creation 7 of a user profile and so ... there's also relevant 8 discussion of creating user profiles in paragraphs 98 9 through 111. And indeed in the section under Graham 10 factors on the scope and content of the prior art, 11 there's again reference to Braden. 12 MR. FENSTER: Q. What paragraph are you at? 13 A. In paragraph 171 and paragraphs 178, 175. 14 So they've -- you know, it's not that the 15 contribution of Braden to understanding how to create 16 user profiles is not discussed in the report; I believe 17 it is. 18 Q. What did you understand my last question to be? 19 MS. PALLIOS ROBERTS: Objection. Form. 20 THE WITNESS: Well, I think -- 21 MS. PALLIOS ROBERTS: Counsel, he answered your 22 question. Can you move on. 23 MR. FENSTER: No. 24 Q. What did you understand my last question to be? 25 A. Well, your very last question was did I agree	116	1 discussion of Braden in connection with user profiling 2 in paragraphs 98 through 111, and the discussion of 3 claim -- creation of a user profile from text items, 4 paragraphs 135 through 139, and the citations in the 5 claim charts for claim 45(b). 6 Q. Does paragraph 67 mention element 45(b) at all? 7 A. Let me look. 8 No, paragraph 67 does not mention claim 45(b). 9 Q. Does claim [sic] 98 mention either Braden or 10 element 45(b)? 11 MS. PALLIOS ROBERTS: Objection. Form. 12 THE WITNESS: Does paragraph 98 ... 13 MR. FENSTER: Q. Mention either Braden or 14 paragraph 45(b) -- element 45(b). 15 A. Paragraph 98. 16 No, it does not mention either one. 17 Q. Does paragraph 99 mention either Braden or 18 element 45(b)? 19 A. No, it does not. 20 Q. How about paragraph 100? 21 A. No. 22 Q. How about 101? 23 MS. PALLIOS ROBERTS: Objection. Form. 24 THE WITNESS: Paragraph 101 doesn't mention 25 either Braden or 45(b).
115	1 that only -- you named -- I forget exactly which 2 paragraphs, but a specific set of paragraphs plus the 3 claim charts were the analysis of how Braden teaches 4 this. 5 And I was saying no, no, what I had answered 6 the previous question as saying was that those 7 paragraphs, the claim charts and other discussion in 8 these 53 pages, or whatever the number is -- 57 pages -- 9 were all a part of the account of how Braden teaches the 10 construction of things relevant to the construction of 11 user profiles. 12 MR. FENSTER: Q. Do you believe that your 13 report sets forth an explanation in your own words as to 14 how specifically Braden specifically discloses element 15 45(b)? 16 MS. PALLIOS ROBERTS: Objection. Form. 17 THE WITNESS: Yes, I do believe that. 18 MR. FENSTER: Q. Okay. Can you show me where 19 in your report you explain in your own words 20 specifically how Braden specifically discloses the 21 elements of 45(b). 22 MS. PALLIOS ROBERTS: Objection. Form. 23 THE WITNESS: Yes. You put the words -- put 24 together the words about Braden in the sections that 25 I've cited earlier, the prior art paragraph 67, the	117	1 MR. FENSTER: Q. Does 102 mention either 2 Braden or paragraph [sic] 45(b)? 3 A. Paragraph 102 does not mention either Braden or 4 paragraph 45 -- or claim limitation 45(b). 5 Q. Do any of the paragraphs 98 through 111 mention 6 either Braden or paragraph 45(b)? 7 MS. PALLIOS ROBERTS: Objection. Form. 8 THE WITNESS: No, they don't mention it. 9 MR. FENSTER: Q. Do any of paragraphs 135 10 through 139 mention Braden? 11 MS. PALLIOS ROBERTS: Objection. Form. 12 THE WITNESS: No, they do not mention Braden. 13 MR. FENSTER: Q. So I don't understand, Dr. 14 Peters, how if paragraphs 98 through 111 don't mention 15 either Braden or claim 45(b) you could answer a question 16 that asks specifically for your explanation of your 17 words explaining how Braden teaches 45(b) -- you would 18 respond citing, in part, paragraphs 98 through 111. 19 MS. PALLIOS ROBERTS: Is there a question? 20 MR. FENSTER: Q. Please explain that to me. 21 A. When -- I'm trying to think of an analogy here 22 that might be helpful to you. 23 So when someone explains that a group of 24 writings by various people are precursors to some other 25 particular point -- you know, let's say a group of

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1 historical writings talk about some element of American  
 2 Revolution or something like that -- and they explain  
 3 that in detail, giving examples but not exhaustive  
 4 lists, and then they give in detail a list of authors,  
 5 maybe including some that weren't mentioned, called out  
 6 explicitly as examples in that earlier -- the earlier  
 7 general discussion, and show, you know, the  
 8 correspondence between their words and whatever aspect  
 9 of, say, the American Revolution it was they were [sic]  
 10 about, it seems to me reasonable to say "Look, they  
 11 explained the connection between that writing and that  
 12 element of the revolution."  
 13 They talked about it in general terms. They  
 14 gave some specific examples. They called out this  
 15 particular case separately.  
 16 Q. Okay.  
 17 A. They didn't repeat their words about that case.  
 18 They didn't mention it as an example.  
 19 Q. Okay. But my question to you is, using your  
 20 analogy, show me where, if anywhere, you discuss a  
 21 particular author in connection with disclosing a  
 22 particular thing.  
 23 I'm not asking you the general question why do  
 24 you think the patent's obvious, okay. I understand your  
 25 whole report lays that out. What I'm asking you is for

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1 a very specific disclosure, if it's there.  
 2 It's not there, and yet you won't tell me.  
 3 MS. PALLIOS ROBERTS: Counsel, are you going to  
 4 get to a question?  
 5 MR. FENSTER: You know --  
 6 MS. PALLIOS ROBERTS: I mean, I appreciate that  
 7 you're arguing with him.  
 8 MR. FENSTER: -- you can object to form, and  
 9 that's all you can do.  
 10 MS. PALLIOS ROBERTS: Well, you need to -- you  
 11 need to ask a question.  
 12 MR. FENSTER: Q. Dr. Peters, I'm asking you  
 13 whether your report specifically discusses a specific  
 14 reference in connection with element 45(b), for example.  
 15 And I'm asking you very specific questions. I'm asking  
 16 discrete questions. And I'd appreciate an answer to  
 17 those discrete questions. Will you try to do that for  
 18 me?  
 19 A. I am trying to do that for you. I'm trying to  
 20 answer questions accurately here. So --  
 21 Q. Does your report contain any explanation where  
 22 you discuss Braden specifically, and only Braden, and  
 23 how it discloses element 45(b)?  
 24 MS. PALLIOS ROBERTS: Objection. Form.  
 25 THE WITNESS: That's the function of the claim

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1 chart. Yes, it does; that's the function of the claim  
 2 chart.  
 3 MR. FENSTER: Q. Is that the only place where  
 4 you provide any explanation discussing Braden  
 5 specifically, and only Braden, and how it discloses  
 6 element 45(b)?  
 7 MS. PALLIOS ROBERTS: Objection. Form.  
 8 THE WITNESS: The discussion in the prose part,  
 9 the pages 1 through 57, is not unique to Braden. It  
 10 doesn't -- it does not mention Braden and claim 45(b) in  
 11 the same sentence, as far as I recall.  
 12 So if you're asking me did I mention the two in  
 13 the same sentence somewhere else, I did not.  
 14 MR. FENSTER: Q. Okay. Did you mention -- did  
 15 you provide any explanation regarding Braden  
 16 specifically and any particular element of claim 45?  
 17 A. Yes, I believe I --  
 18 MS. PALLIOS ROBERTS: Objection. Form.  
 19 THE WITNESS: I did. I believe that is exactly  
 20 what these -- this section -- these paragraphs, combined  
 21 with the claims chart, do.  
 22 MR. FENSTER: Q. All right. Let's keep going  
 23 one by one, then.  
 24 Do you provide any explanation discussing  
 25 Braden in particular in connection with element 45(c)?

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1 MS. PALLIOS ROBERTS: Objection. Form.  
 2 THE WITNESS: Let's see. 45(c) ... it would be  
 3 in the claims chart, including, for example, ACC12,  
 4 where -- in the portion where claim 45(c) is paired up  
 5 with citations to Braden.  
 6 MR. FENSTER: Q. Okay. And do you include any  
 7 analysis other than citations to Braden in the ACC12?  
 8 MS. PALLIOS ROBERTS: Objection. Form.  
 9 THE WITNESS: Yes. It's in the paragraphs that  
 10 should be read in understanding the force of these --  
 11 this claim chart, paragraphs 135 through 139.  
 12 MR. FENSTER: Q. Let me ask a more specific  
 13 question. Other than citations and quotations from  
 14 Braden that you include in your chart, do you include  
 15 any explanation or analysis that specifically addresses  
 16 Braden in connection with element 45(c)?  
 17 MS. PALLIOS ROBERTS: Objection. Form.  
 18 THE WITNESS: Well, specifically addresses  
 19 Braden, I don't know what you mean. As I've explained,  
 20 I think it clearly encompasses Braden. You say it's not  
 21 specific. I think it clearly encompasses Braden. I say  
 22 yes.  
 23 MR. FENSTER: Q. Even though Braden's not  
 24 mentioned anywhere in the paragraphs that you cited in  
 25 connection with --



122	1 A. No, that's right. 2 Q. -- 45(c)? 3 MS. PALLIOS ROBERTS: Objection. Form. 4 THE WITNESS: The claim charts are referenced 5 for incorporation. That's exactly the purpose of 6 saying -- you know, paragraph 139 says "as explained in 7 detail." 8 MR. FENSTER: Q. And that detailed explanation 9 you think is in the charts? 10 MS. PALLIOS ROBERTS: Objection. Form. 11 THE WITNESS: The details are in the charts. 12 The general explanation is relevant for interpreting the 13 charts. And yes, I think together there's a 14 sufficiently detailed explanation. 15 MR. FENSTER: Q. Can you point to anywhere in 16 your report where you explain in your own words how 17 Braden specifically discloses the elements of claim 18 45(f). 19 MS. PALLIOS ROBERTS: Objection. Form. 20 THE WITNESS: So the -- once again, the 21 paragraphs 135 through 139, which make reference to the 22 attached charts, refer -- apply in interpreting the 23 references in ACC12 where reference to Braden is 24 connected to claim 45(f). 25 MR. FENSTER: Q. Okay. But you acknowledge	124	1 profile are relevant. As far as I can see here, they do 2 not explicitly reference Kurtzman. 3 Again, the paragraphs 135 through 139 are 4 particularly relevant. And I don't see specific 5 reference to Kurtzman in them. 6 There is a reference -- there are references in 7 paragraphs 171 and 179 to Kurtzman. 8 So those are explicit reference. And then, of 9 course, in a claim chart such as ACC12, there's a good 10 deal of detailed information about Kurtzman in relation 11 to claim limitations of claim 45, including -- and I'm 12 sorry, I've now forgotten which limitation you were 13 asking about. 14 Q. 45(c). 15 A. (C). Yes, so here, for example, are citations 16 to Kurtzman in connection with 45(c). 17 Q. It was actually all of the elements, 45(a), 18 (b), (c), (f), (g) or (k). 19 A. Oh, all right. Well, I can check and see. 20 Yes, there are Kurtzman reference for (a), for 21 (b), (c), (f) and (j) [sic]. 22 Q. And in the chart ACC12 where you say that there 23 was a good bit of detailed information, did any of that 24 include any analysis by you other than mere quotes from 25 Kurtzman?
123	1 that Braden's not mentioned anywhere in paragraphs 135 2 through 139, correct? 3 MS. PALLIOS ROBERTS: Objection. Form. 4 THE WITNESS: There's not a -- there's not an 5 explicit mention of Braden in those paragraphs. 6 MR. FENSTER: Let me have that back. 7 THE WITNESS: Sure. 8 MR. FENSTER: Q. Can you show me where in the 9 body of your report, separate from the chart -- do you 10 have any -- strike that. 11 Do you have any discussion in the body of your 12 report that is specific to Kurtzman, II? 13 A. To Kurtzman, II? 14 Q. Yes. 15 MS. PALLIOS ROBERTS: Objection. Form. 16 MR. FENSTER: In connection with elements 17 45(a), (b), (c), (f), (g) or (k). 18 MS. PALLIOS ROBERTS: Objection. Form. 19 THE WITNESS: So again, the Kurtzman patent is 20 introduced in the prior art section in paragraph 77, 21 which talks about disclosing the use of natural language 22 processing to select advertisements related to a user 23 based on the user's profile. 24 And then the section I referred you to earlier, 25 paragraphs 98 through 111, about creation of a user	125	1 MS. PALLIOS ROBERTS: Objection. Form. 2 THE WITNESS: Well, let me see what -- what's 3 said here in those sections on Kurtzman. 4 Right. So those sections on Kurtzman in this 5 chart do consist of quotes. The analysis is simply the 6 combination of especially paragraphs 135 through 139 7 with the chart. It's not found in the chart itself 8 by -- taken by itself. 9 MR. FENSTER: Q. Okay. Does your report 10 contain any explanation in your own words addressing 11 Culliss specifically in connection with elements 45(a), 12 (b), (c), (f), (g) or (k)? 13 MS. PALLIOS ROBERTS: Objection. Form. 14 THE WITNESS: Well, so Culliss is referenced in 15 paragraph 137, among those 135 through 139 that I 16 referred you to earlier for a discussion of the 17 interpretation of these particular claim charts. 18 I don't have all of the claim charts in front 19 of me. But looking through this chart, for example, 20 there are -- against 45(a) -- there are citations to 21 Culliss. Same for 45(b), (c), (f), (g) and (k). 22 MR. FENSTER: Q. Is it true that the 23 information in the chart consists only of quotations 24 from Culliss, with respect to those elements, and none 25 of your own analysis?

126	1 MS. PALLIOS ROBERTS: Objection. Form. 2 THE WITNESS: The -- in the chart, against 3 those -- those claim limitations, there are quotations 4 from Culliss. The analysis is -- results from the full 5 report, including the discussion in the prose, 6 combination of the charts. 7 MR. FENSTER: Q. Referring to ACC11, you opine 8 that claim 45 is invalid in view of principal references 9 Salton '68 and Herz, in addition to other prior art 10 references, correct? 11 MS. PALLIOS ROBERTS: Objection. Form. 12 THE WITNESS: Well, my report as a whole, yes, 13 contains that opinion. And this chart ACC11 is support 14 for that. 15 MR. FENSTER: Q. What elements of claim 45 are 16 missing from claim Salton -- from the reference Salton 17 '68 that you relied on Herz for? 18 A. Well, at a glance through the chart, I seem to 19 have a reference to Salton connected with each element 20 of the claim. 21 And so my reliance on Herz really is to 22 strengthen the case that -- you know, in some cases, the 23 references are not a point citation in Salton, but 24 they're -- for example, say Salton teaches receiving -- 25 sorry -- retrieving, locating, multiple text items, and	128	1 MR. FENSTER: Q. What aspects of Herz are you 2 relying on to combine with Salton to achieve the claimed 3 invention in claim 45? 4 A. Well, especially elements that have to do with 5 how user profiles are created from a collection of text. 6 Q. And what does your report say about the 7 specific motivation to combine the Herz teaching 8 regarding the user profiles created from texts with 9 Salton '68? 10 MS. PALLIOS ROBERTS: Objection. Form. 11 THE WITNESS: Well, what it says in paragraphs 12 159 and 160 is that the creation of the Internet led to 13 this need for personalized search engines -- that's 14 something that didn't exist, by the way, at the time 15 of -- neither the Internet nor highly individualized 16 search existed at the time of Salton 1968 -- and that 17 this design need, this market pressure to improve the 18 performance and accuracy, which incidentally the Geller 19 patent cites as a motivation, produced a pressure to 20 solve that problem. 21 And among the numerous pieces of prior art that 22 could be combined, Salton '68 and the Herz patent are an 23 example. 24 MR. FENSTER: Q. You don't point to anything 25 specific in terms of a motivation to combine Herz
127	1 there's a reference to a section of his 1968 book, which 2 I thought really would be more convincing if backed up 3 by a more specific detail that -- for which I cited Herz 4 and other -- and the -- you know, the right-hand column 5 additional -- 6 Q. So let me understand. 7 A. -- items. 8 Q. You've got a citation to Salton '68 for every 9 element, correct? 10 A. Yes, I have. 11 Q. Okay. 12 A. So it appears. 13 Q. And yet you don't find that Salton '68 14 anticipates claim 45; is that correct? 15 MS. PALLIOS ROBERTS: Objection. Form. 16 THE WITNESS: No, I haven't -- you know, I 17 haven't asserted that it anticipates it. 18 MR. FENSTER: Q. So there are some 19 references -- some citations that you have there that 20 are not sufficient to find the element fully disclosed 21 sufficient for anticipation; is that fair? 22 MS. PALLIOS ROBERTS: Objection. Form. 23 THE WITNESS: Yes. I wouldn't -- I would not 24 try to make the case that the Salton 1968 book 25 anticipates the claim 45 in this case.	129	1 specifically with Salton '68, correct? 2 MS. PALLIOS ROBERTS: Objection. Form. 3 THE WITNESS: Well, I mean, there's -- as I 4 say, there's nothing special about Herz. There are a 5 number of combinations that are possible. Herz, and 6 Braden-Harder is another one that's actually called out 7 here. But that's for claim 1. So ... 8 I didn't say and I wouldn't say that, you know, 9 Salton published a paper that said "Please combine me 10 with Herz." 11 MR. FENSTER: Q. Claim 45(h) requires 12 generating at least one user segment group by grouping 13 together identical segments. Do you see that? 14 A. Yes. 15 Q. Does your report address that specific element, 16 and if so, where? 17 MS. PALLIOS ROBERTS: Objection. Form. 18 THE WITNESS: Let me just read that, if I may, 19 in the context here of the sequence of steps so that I 20 can figure out where I did talk about that. 21 So I have a hard time finding it here without 22 looking through the entire thing in detail. The user 23 segment groups are sequences of parts of speech, 24 according to the claims construction, if I remember 25 correctly.

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1 Perhaps, actually, if you could let me see a  
2 copy of the claims construction order, that would help  
3 me to be more precise.  
4 (Plaintiff's Exhibit 4  
5 marked for identification.)  
6 MR. FENSTER: Q. Hand you what's been marked  
7 as Exhibit 4, which was Exhibit D to your expert report.  
8 It's a copy of the claims construction order.  
9 A. Thank you. Segment, page 22.  
10 Right, so the court construed segment to mean  
11 one or more parts of speech arranged in an order.  
12 That's more or less the way I was recalling it.  
13 Q. So my question is does your report specifically  
14 discuss where the prior art discloses that specific  
15 element in 45(h), and if so, where?  
16 MS. PALLIOS ROBERTS: Objection. Form.  
17 THE WITNESS: Well, I know I considered it. I  
18 think I put it in my report. Let me just look through  
19 here and see if I can figure out where.  
20 So the segments are the elements -- if you  
21 like, the numbers -- of the profiles. And in the user  
22 document profiles, they're combined with frequency  
23 counts.  
24 And so I'm not finding it right offhand where I  
25 talk about segments in connection -- you know, as a part

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1 of profile. But that's what they are.  
2 MR. FENSTER: Q. You can't point to anyplace  
3 in your report where you specifically address element  
4 45(h); is that correct?  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: I can read the whole thing as we  
7 sit here and try, but I can't find it off the top of my  
8 head. The point is that elements -- as constituents of  
9 profiles, the counterpart of -- counterparts of segment  
10 and prior art are the corresponding elements of profiles  
11 that other inventors, other scientists, use.  
12 MR. FENSTER: Q. Let's talk a little bit about  
13 your definition of a person with ordinary skill in the  
14 art.  
15 A. All right.  
16 Q. How did you -- what's your understanding of the  
17 level of a person of ordinary skill in the art?  
18 A. This would be an ordinary person who is  
19 sufficiently skilled to practice the art to which the  
20 invention belongs, or the nearest neighboring art, in  
21 this case -- in this case, there is an art of  
22 information retrieval, Web search, including  
23 personalized search.  
24 So it would be a person who had sufficient  
25 skill to practice that art.

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1 Q. I don't understand your answer. What do you  
2 mean sufficient skill to practice?  
3 A. Well, so what I suggested constituted ordinary  
4 skill in the art was a bachelor's degree in computing,  
5 because computing is the mechanism by which this  
6 happens, together with either some advanced study or  
7 work experience, at least couple years of that, in  
8 natural language processing and personalization as being  
9 the other ingredients here.  
10 I think I called out information retrieval as  
11 also being relevant. Let me look and see exactly what I  
12 did say. Trying to find the paragraph here.  
13 Well, I've already gotten to the overview of  
14 the patent, so I must have skipped over it.  
15 Q. Are you looking for paragraph 64?  
16 A. I'm sure I defined it earlier than that, but  
17 you're right, I probably reiterated it. Oh, no. Thank  
18 you. 64. Right. Right.  
19 So what I did say here was an undergraduate  
20 degree in computer science or its equivalent and either  
21 additional graduate education or one to two years of  
22 work experience in natural language processing, use of  
23 computers to process human language for some useful  
24 purpose, and information retrieval.  
25 Okay. So NLP, information retrieval and

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1 computer science were the three ingredients.  
2 Q. Okay. Would you consider yourself a person of  
3 skill -- of ordinary skill in the art in 1999?  
4 A. In 1999, no, I would not have been.  
5 Q. Why not?  
6 A. Well, I was doing research in information  
7 retrieval at that time, and I think my skill was greater  
8 than ordinary skill.  
9 Q. So you had an extraordinary level of skill in  
10 the art at the time --  
11 A. Well --  
12 Q. -- in 1999?  
13 A. -- I'm --  
14 MS. PALLIOS ROBERTS: Objection. Form.  
15 THE WITNESS: -- too modest to say so, but I'll  
16 accept your characterization.  
17 MR. FENSTER: Q. Okay. And were you working  
18 in the field of personalized search at the time?  
19 A. I do have a paper in personalized search at  
20 about that time, yes.  
21 Q. Is that your paper in 1998?  
22 A. Yes, the one in SIGIR, mm-hm.  
23 Q. And did your paper describe the inventions  
24 claimed in the Geller patent?  
25 A. No, it didn't.

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1 Q. Have you found -- are you -- have you found any  
 2 references after 1999 that describe all the elements of  
 3 claim 1 of the Geller patent?  
 4 MS. PALLIOS ROBERTS: Objection. Form.  
 5 THE WITNESS: Have I found references after '99  
 6 that describe all the elements of claim 1. I don't  
 7 think I have, no.  
 8 MR. FENSTER: Q. Have you found any references  
 9 after 1999 that describe all the elements of claim 45 of  
 10 the Geller patent?  
 11 MS. PALLIOS ROBERTS: Objection. Form.  
 12 THE WITNESS: I don't think I have found any  
 13 reference since then.  
 14 MR. FENSTER: Q. Have you found any references  
 15 since '99 that describe all of the elements of any of  
 16 the asserted claims of the Geller patent?  
 17 MS. PALLIOS ROBERTS: Objection. Form.  
 18 THE WITNESS: Well, let's see. The others are  
 19 dependent claims. So that would include the elements of  
 20 1 and 45, as well as the additions. No.  
 21 MR. FENSTER: Okay. We have to go off the  
 22 record to change the tape.  
 23 THE WITNESS: Okay.  
 24 THE VIDEOGRAPHER: This is the end of video  
 25 number 2. We are now off the record at 3:17.

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1 (Recess taken.)  
 2 THE VIDEOGRAPHER: We are now on the record at  
 3 3:32. This is the beginning of video number 3.  
 4 MR. FENSTER: Q. Dr. Peters, in addition to  
 5 invalidity, were you asked to render an opinion  
 6 regarding materiality of several prior -- several  
 7 references?  
 8 MS. PALLIOS ROBERTS: Objection. Form.  
 9 THE WITNESS: Yes, I was asked to render an  
 10 opinion on materiality.  
 11 MR. FENSTER: Q. Do you have an understanding  
 12 as to what materiality relates to, why were you asked  
 13 to -- or why you were asked to render such an opinion?  
 14 MS. PALLIOS ROBERTS: Objection. Form.  
 15 THE WITNESS: Yes.  
 16 MR. FENSTER: Go ahead.  
 17 MS. PALLIOS ROBERTS: Is there a question?  
 18 MR. FENSTER: Q. Why were you asked -- what  
 19 does materiality relate to?  
 20 A. Well, materiality relates to the question of  
 21 whether a patent examiner would wish to see a particular  
 22 reference -- a particular piece of prior art at the time  
 23 he's examining a patent application.  
 24 Q. What is your understanding as to the -- as the  
 25 standard for materiality?

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1 MS. PALLIOS ROBERTS: Objection. Form.  
 2 THE WITNESS: Well, I mean, my understanding  
 3 pretty much what's -- I wrote in the report here. So  
 4 let me try to refresh myself and you on that.  
 5 So the standard is the reasonable examiner  
 6 would consider the piece of art important in deciding  
 7 whether to allow the application to issue as a patent.  
 8 MR. FENSTER: Q. That's the full statement of  
 9 your understanding as to materiality?  
 10 A. Well, that's what it is -- that's what  
 11 materiality is. So there's a -- you know, a reference  
 12 is not material if it's merely cumulative to or is less  
 13 relevant than information that has already been  
 14 considered by the examiner.  
 15 Q. Okay. And is this the standard that you  
 16 applied in reaching your conclusions as to whether  
 17 several references were material?  
 18 A. Yes, it is.  
 19 Q. Okay. And you were asked specifically to  
 20 determine whether three patents, Ahn, Dasan and ...  
 21 "Syfert"?  
 22 A. Yes, I'm not sure of the pronunciation either.  
 23 I called it "Seefert."  
 24 Q. Okay. You were asked to determine whether  
 25 those three patents are material art; is that correct?

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1 A. Yes, I was.  
 2 Q. Okay. And did you reach any conclusions with  
 3 respect to those three references?  
 4 A. Yes. I looked at those in light of the art  
 5 that the examiner hadn't listed on the face of the  
 6 Geller patent, and I came to the conclusion that both  
 7 the Dasan and -- "Seefert" is what I've been saying --  
 8 patents were material.  
 9 Q. Okay. And what about the Ahn reference?  
 10 MS. PALLIOS ROBERTS: Objection. Form.  
 11 MR. FENSTER: Q. Did you reach any conclusions  
 12 regarding the materiality of Ahn?  
 13 A. I did not conclude that it was material.  
 14 Q. Why not?  
 15 A. Well, I thought that in the case of Ahn, it was  
 16 merely cumulative.  
 17 Q. Now, did you find that the Dasan reference  
 18 anticipates any of the asserted claims?  
 19 A. No, I didn't find that the Dasan reference  
 20 anticipates claims.  
 21 Q. Did you find that the Siefert reference  
 22 anticipates any of the asserted claims?  
 23 A. No, I didn't find a Siefert reference to that  
 24 either.  
 25 Q. Did you conclude that Dasan, in combination

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1 with other references, would render any of the asserted  
2 claims invalid?  
3 A. I thought that Dasan was a reference that  
4 the -- a reasonable examiner would have wanted to have  
5 in front of him in considering whether the claims of the  
6 Geller patent met the standard of being new, useful and  
7 not obvious.  
8 Q. Did you reach a conclusion that Dasan, in  
9 combination with any other patents or prior art,  
10 rendered any of the asserted claims invalid for  
11 obviousness?  
12 A. Oh, I feel that it does, yes, of course.  
13 Q. Okay. What combinations did you find in your  
14 report, that include Dasan, render any of the asserted  
15 claims invalid for obviousness?  
16 MS. PALLIOS ROBERTS: Objection. Form.  
17 THE WITNESS: Well, in each case where Dasan is  
18 cited in one of these claim charts, I felt that Dasan,  
19 in combination with the other patents -- the other art  
20 that was cited for that -- for that claim limitation,  
21 made it -- you know, predated it. It was prior art and  
22 would therefore be part of the combination that would  
23 render the claim, the entire collection of limitations,  
24 invalid for obviousness.  
25 MR. FENSTER: Q. Do you anywhere set forth any

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1 combinations that include Dasan for any of the asserted  
2 claims?  
3 MS. PALLIOS ROBERTS: Objection. Form.  
4 THE WITNESS: Well, let's look. I certainly  
5 included Dasan at certain places in the charts, so that  
6 it does figure in combination with other art in that  
7 way.  
8 MR. FENSTER: Q. Do you rely on Dasan as any  
9 of the principal references in any of the 13 charts?  
10 MS. PALLIOS ROBERTS: Objection. Form.  
11 THE WITNESS: I don't -- could I -- could I see  
12 the -- let's look at the charts. I don't think that I  
13 did, but let's look at the charts and just make sure  
14 that I'm going to be able to -- I'm going to give you  
15 the correct answer here.  
16 Thank you.  
17 So the first one, the principal ones are Salton  
18 and Culliss -- Salton '89 and Culliss, Braden and Herz,  
19 Braden and Culliss, Culliss and Herz, Salton '68 and  
20 Braden, Salton '68 and Herz, Salton '89 and Salton '68,  
21 Salton '89 and Braden, Salton '68 and Herz, Braden and  
22 Kurtzman, II, Salton '68 and Culliss.  
23 So the answer is no, not as the principal.  
24 MR. FENSTER: Q. Okay. If you could refer to  
25 paragraph 198 of your report.

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1 A. Yes.  
2 Q. There you make the assertion, "The  
3 prior art patents cited by the '067 patent  
4 in combination with the Dasan and Siefert  
5 patents render the '067 patent obvious."  
6 Do you see that?  
7 A. Yes.  
8 Q. Okay. Do you state anywhere in your report  
9 what combinations of Dasan and Siefert and the cited  
10 prior art references would render any claim obvious?  
11 MS. PALLIOS ROBERTS: Objection. Form.  
12 THE WITNESS: I don't know where that would be  
13 in the reports. Not in the claim charts. Those are not  
14 the art that was cited by the '067 patent. And I  
15 certainly don't here in this paragraph 198, so I think  
16 that's probably -- you know, so it's not called out --  
17 if you're saying here do I call out -- again, as we've  
18 been talking about limitation by limitation for a given  
19 claim for each of the claims in issue -- each of the  
20 claims that's in issue, do I have a place in the report  
21 where I call that out, I do not seem to do that.  
22 MR. FENSTER: Q. Okay. And you don't in your  
23 report anywhere identify any particular combinations of  
24 any of the cited prior art of either Dasan and/or  
25 Siefert that would render any of the asserted claims

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1 obvious; is that correct?  
2 MS. PALLIOS ROBERTS: Objection. Form.  
3 THE WITNESS: So the reason that I felt that  
4 Dasan and Siefert were not cumulative is that they each  
5 disclose elements that were not disclosed in the cited  
6 art, this art in the patent application, or -- neither  
7 the application, nor that was, you know, listed by the  
8 examiner.  
9 And so I do call out in paragraph 196 that the  
10 Dasan patent discloses utilization of user profiles and  
11 the Siefert patent, I call out in 197, discloses display  
12 of documents through a user profile and a learning  
13 profile.  
14 And my belief was that if the examiner had had  
15 these bits of art in front of him, along with the art  
16 that he did consider, that he might well have come to a  
17 different conclusion.  
18 So that's his -- that's as close as I come in  
19 the report to giving combinations that would make the  
20 claims obvious.  
21 MR. FENSTER: Q. Do you identify any  
22 particular combinations of any of the cited prior art  
23 with either Dasan and/or Siefert that would render any  
24 of the asserted claims obvious in your report?  
25 MS. PALLIOS ROBERTS: Objection. Form.

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1 THE WITNESS: I think I've just answered the  
2 question.  
3 MR. FENSTER: Q. The answer's no, isn't it?  
4 MS. PALLIOS ROBERTS: Objection. Form.  
5 THE WITNESS: The answer is I explained what  
6 was in Dasan and Siefert that wasn't in the other art  
7 that could have rendered it obvious.  
8 MR. FENSTER: Q. Do you identify any  
9 particular combinations that include Dasan and Siefert  
10 with the cited prior art that would render any of the  
11 asserted claims invalid for obviousness?  
12 MS. PALLIOS ROBERTS: Objection. Form.  
13 THE WITNESS: All of the prior art that was  
14 considered -- that was listed by the examiner at the  
15 time it was considered can be combined with either of  
16 these two. And I do believe that if they were combined,  
17 there's a good chance the examiner could have found the  
18 invention was obvious.  
19 I can -- I suppose that's identification.  
20 You're asking -- if you're asking do I have a sentence  
21 that says "The claims 1 and 45 are obvious when you  
22 combine Dasan with," and then I give a list of all of  
23 the art that was considered by the examiner, there is no  
24 such sentence there.  
25 MR. FENSTER: Q. Okay. Do you identify any

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1 particular combinations --  
2 A. There is --  
3 MS. PALLIOS ROBERTS: Objection. Form.  
4 MR. FENSTER: Let me finish the question.  
5 Q. Do you identify in your report any particular  
6 combinations that include Dasan and/or Siefert and the  
7 cited prior art that would render any asserted claim  
8 invalid?  
9 MS. PALLIOS ROBERTS: Objection. Form.  
10 THE WITNESS: To the extent that I've just been  
11 explaining, yes. Do I have a sentence that names any  
12 subsets of the cited prior art along with Dasan and/or  
13 Siefert? There is no such sentence.  
14 MR. FENSTER: Q. Okay. Then tell me which  
15 particular combinations you think you disclose in your  
16 report that would render any of the asserted claims  
17 invalid for obviousness that include Dasan and/or  
18 Siefert.  
19 A. Well, I think the combination --  
20 MS. PALLIOS ROBERTS: Objection. Form.  
21 THE WITNESS: -- of all prior art with Dasan or  
22 with Siefert could well have led the examiner to the  
23 conclusion that the invention was obvious.  
24 MR. FENSTER: Q. Okay. And just so I  
25 understand your question -- or your answer, on the front

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1 page of the Geller patent and continuing on to the  
2 second page, there is a list of references cited. Do  
3 you see that?  
4 A. Yes.  
5 Q. Okay. And that includes the prior art cited,  
6 correct?  
7 A. That's correct. So we're looking at three  
8 patents and three other publications on the front page  
9 and then an additional seven patents on the second page.  
10 Q. Okay. So we've got a total of ten patents,  
11 correct?  
12 A. Correct.  
13 Q. Okay. And three articles?  
14 A. Yes.  
15 Q. Okay. And is it your opinion that the asserted  
16 claims are invalid in light of all 13 references  
17 together plus Dasan or any one of the 13 references plus  
18 Dasan?  
19 MS. PALLIOS ROBERTS: Objection. Form.  
20 THE WITNESS: So I haven't asserted that all of  
21 them together plus Dasan make the invention obvious. I  
22 asserted that Dasan was material, that it was not  
23 cumulative. I think Dasan in combination with some  
24 other prior art does make the claims obvious.  
25 And the other prior art is not the cited art;

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1 it's the art that I put in my report.  
2 MR. FENSTER: Q. Okay. So you have not  
3 concluded -- strike that.  
4 Your report doesn't set forth any affirmative  
5 opinion that any of the asserted claims are invalid for  
6 obviousness in light of Dasan in combination with any of  
7 the cited prior art; is that correct?  
8 MS. PALLIOS ROBERTS: Objection. Form.  
9 THE WITNESS: That's correct.  
10 MR. FENSTER: Okay.  
11 THE WITNESS: It doesn't set forth any such  
12 opinion.  
13 MR. FENSTER: Got it.  
14 Q. Now, if I could ask you to take a look at  
15 paragraph 194 of your report.  
16 A. Okay.  
17 Q. In paragraph 194 you state, quote,  
18 "In my opinion, the Dasan and Siefert  
19 patents each disclose elements of the '067  
20 patent that were not disclosed by the prior  
21 art that was submitted to the United States  
22 Patent & Trademark Office for the '067  
23 patent," comma, "and are therefore  
24 material."  
25 Do you see that?

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1 A. Yes.  
2 Q. Okay. Is that an accurate statement of your  
3 opinion?  
4 MS. PALLIOS ROBERTS: Objection. Form.  
5 THE WITNESS: It is my opinion, yes.  
6 MR. FENSTER: Q. Okay. You -- is it a  
7 necessary inference that something is material -- that  
8 Dasan and Siefert are material because they each  
9 disclose elements of the patents that were not disclosed  
10 by the prior art that was submitted to the Patent  
11 Office?  
12 MS. PALLIOS ROBERTS: Objection. Form.  
13 THE WITNESS: I see; so you're focusing on the  
14 word "therefore." So as I -- as we've discussed, to be  
15 material I think it needs to be something the examine --  
16 the examiner would want to consider -- that he would  
17 consider important and that isn't cumulative.  
18 And so they do disclose elements that were not  
19 disclosed by the prior art that I believe the examiner  
20 would have wanted to consider. And so I think they are  
21 therefore material.  
22 But you're correct, I think -- you know, my  
23 opinion's based on both of those.  
24 MR. FENSTER: I see.  
25 Q. In paragraph 194, the same paragraph --

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1 A. Mm-hm.  
2 Q. -- you state that Dasan and Siefert disclose  
3 elements that were not disclosed by the prior art that  
4 was submitted to the United States Patent Office.  
5 Are you aware that examiners can do their own  
6 searches and that examiners may be aware of other prior  
7 art that wasn't submitted to them?  
8 A. I am, yes.  
9 Q. Okay. And did you mean to make that  
10 distinction in this sentence?  
11 A. I do not, actually. In fact, you know, I see,  
12 now that we're discussing it, that this sentence is not  
13 all that well worded because I really meant to say the  
14 prior art that was considered by the Patent Office, not  
15 that was submitted to.  
16 Q. Got it. Do either Dasan or Siefert disclose  
17 retrieving search results that reflect a user's social,  
18 cultural, educational and economic background or  
19 psychological profile?  
20 A. To be honest with you, I'd have to look back at  
21 the patents in order to -- to tell you. I know that  
22 both of them relate to personal relevance. You know,  
23 whether that relevance has to do with those specific  
24 items, I would have to take another look at the  
25 patents --

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1 Q. Does your report --  
2 A. -- to tell you.  
3 Q. -- disclose any analysis as to whether Dasan or  
4 Siefert disclosed that limitation?  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: No, it doesn't. Sorry. I'm  
7 sorry. The Siefert -- it does disclose that the Siefert  
8 patent contemplates finding documents that correspond to  
9 a user's learning history or educational background. It  
10 does disclose that.  
11 MR. FENSTER: Q. I'm sorry, where are you  
12 reading?  
13 A. Paragraph 197.  
14 Q. Okay.  
15 A. The second sentence.  
16 Q. Can you tell me -- actually, did you draft this  
17 section on materiality?  
18 A. Yes, I got -- so I don't know the law. I asked  
19 the lawyers to explain the law to me. The draft of this  
20 section about what the law states was created by them,  
21 and then I put -- you know, put it in my words.  
22 But the analysis of what's in the patents and  
23 the conclusions that I came to were drafted entirely by  
24 me.  
25 Q. Okay. Regarding obviousness, what is your

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1 understanding of the standard for obviousness?  
2 MS. PALLIOS ROBERTS: Objection. Form.  
3 THE WITNESS: Well, it's as I set it out here,  
4 that a person of ordinary skill in the art would have  
5 been able to make the combination of prior art that is a  
6 claim to the claim.  
7 Let's see here. We were looking at that  
8 paragraph earlier. I think you may be getting tired. I  
9 know I am. But -- oh, here we are.  
10 We have to consider the scope and content of  
11 the prior art, level of ordinary skill in the relevant  
12 art, differences between the claimed invention and the  
13 prior art, whether the claimed invention would have been  
14 obvious to one of ordinary skill in the art in light of  
15 those differences.  
16 So that's basically it. Someone of ordinary  
17 skill in the art would have been able to bridge the  
18 difference between the prior art and the claimed art by  
19 gaining these elements of prior art.  
20 MR. FENSTER: Q. Is it your understanding that  
21 the test is as applied -- that the test for obviousness  
22 is applied element by element or to the invention as a  
23 whole?  
24 MS. PALLIOS ROBERTS: Objection. Form.  
25 THE WITNESS: Well, my understanding is that

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1 what's obvious is a claim, if that's what you're asking,  
2 as opposed to an entire patent.  
3 MR. FENSTER: Q. Okay. And now I'm asking  
4 actually --  
5 A. About a claim. Okay.  
6 Q. -- within the claim, is it your understanding  
7 that the test for obviousness is applied on an  
8 element-by-element basis within the claim or to the  
9 claim as a whole?  
10 A. No, my understanding is it's applied to the  
11 claim as a whole.  
12 Q. So, for example, you go through and talk about  
13 the various elements in paragraph 92 through 97. For  
14 example, at paragraph 97 you concluded that elements  
15 1(a), 1(b), 1(d) and 1(i) are not novel.  
16 Do you see that?  
17 A. Yes.  
18 Q. And then paragraph 111, you find that paragraph  
19 1(a) doesn't contain anything that's not obvious from  
20 the prior art.  
21 A. Yes.  
22 Q. So what's the relevance of that statement with  
23 respect to an individual element?  
24 A. Well --  
25 MS. PALLIOS ROBERTS: Objection. Form.

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1 THE WITNESS: The -- for the claim to be  
2 nonobvious -- well, sorry. Let me put it differently.  
3 The claim is obvious if one of ordinary skill  
4 in the art could have combined the elements from prior  
5 art, all the elements that make up the claim, in the  
6 manner that the claim itself does combine them, bridging  
7 whatever differences there might have been from, you  
8 know, their appearance in other related art to the form  
9 they take in this combination.  
10 So this analysis is part of the analysis that  
11 says "Well, look, all of those elements were there.  
12 They're in the ethos of Web search in the 1990s. They  
13 were available for any inventor, anyone of ordinary or  
14 extraordinary skill in the art, to combine. And so  
15 their combination could be obvious."  
16 MR. FENSTER: Q. Do you -- so we've discussed  
17 the parts of your report where you've provided a general  
18 discussion of the motivation to combine.  
19 Is there any general reference that you point  
20 to that provides a road map of how to combine all these  
21 various elements that were out there in the ethos -- is  
22 there a reference that you look to that provides a road  
23 map of how to combine these various elements to get to  
24 this combination that was claimed in the '067 patent?  
25 MS. PALLIOS ROBERTS: Objection. Form.

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1 THE WITNESS: I didn't find any such road map.  
2 I found lots of examples of combining various things  
3 that were models, if you like, but I didn't find a road  
4 map.  
5 MR. FENSTER: Q. Can you show me where in your  
6 report you have analysis that claim 1 as a whole --  
7 strike that.  
8 You told me that your understanding is that the  
9 test for obviousness is applied to the claim as a whole,  
10 correct?  
11 A. That's correct.  
12 Q. Okay. Can you show me where in your report you  
13 discuss claim 1 being obvious as a whole -- that claim 1  
14 as a whole would have been obvious to one of skill in  
15 the art in 1999.  
16 A. Do you mean --  
17 MS. PALLIOS ROBERTS: Objection. Form.  
18 THE WITNESS: So following on this discussion  
19 of the elements were out there in the ethos, can I point  
20 you to a place where I say, okay, so claim 1 itself is  
21 obvious?  
22 MR. FENSTER: Q. Yeah, so you've got an  
23 individual -- a discussion of the various individual  
24 elements and you discuss how you believe they're not --  
25 the individual elements are novel or obvious.

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1 But can you show me where the discussion is  
2 regarding the claim as a whole not being obvious -- or  
3 being obvious, rather.  
4 A. Yeah, being obvious.  
5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: Well, again, that's basically the  
7 analysis where I talk about why one skilled in the art  
8 would have been motivated to pursue the combination, how  
9 the combinations themselves are predictable, don't yield  
10 unpredictable results, and that when you analyze these  
11 claims in terms of the Graham factors, the scope and  
12 content of the prior art, the differences between prior  
13 art and claims and the level of skill in the art, they  
14 all point to the conclusion that claim 1 and claim 45,  
15 and so forth, are obvious.  
16 MR. FENSTER: Q. So let's talk a little bit  
17 about your understanding -- or your opinions regarding  
18 section 112, which start at page 53 of your report.  
19 A. Okay.  
20 Q. So as I understand it, you have reached  
21 conclusions regarding both written -- invalidity for  
22 failure to meet the written description requirement, and  
23 separately, invalidity for failure to meet the  
24 enablement requirement. Is that correct?  
25 A. Yes, I guess that's correct.



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1 Q. What is your understanding of the standard for  
2 validity under section -- under the written description  
3 requirement of section 112?  
4 MS. PALLIOS ROBERTS: Objection. Form.  
5 THE WITNESS: Well, the written -- roughly, I  
6 think the requirement is that a person of ordinary skill  
7 must be able, by reading the patent, to make and use the  
8 invention for the purpose that's claimed, or, I guess,  
9 you know, in the technical sense, that the -- it's that  
10 the invention really was in possession of the inventor.  
11 MR. FENSTER: Q. Do you have -- what is your  
12 understanding as to the relationship between the written  
13 description requirement and the enablement requirement  
14 under section 112?  
15 MS. PALLIOS ROBERTS: Objection. Form.  
16 THE WITNESS: Well, I think that both  
17 conditions have to be met, both written description and  
18 enablement, for the patent to be -- to issue.  
19 MR. FENSTER: Q. What is your understanding as  
20 to the standard for validity under written description?  
21 MS. PALLIOS ROBERTS: Objection. Form.  
22 THE WITNESS: Well, I mean, I think I said it.  
23 It says -- let me just read in what it says here.  
24 "The description written in the patent  
25 itself has to be sufficiently clear, concise

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1 and exact, that any person skilled in the  
2 art to which it pertains or with which it's  
3 most nearly connected could make and use the  
4 same," the invention.  
5 And it also has to set forth this preferred  
6 embodiment, the best mode contemplated by the invention.  
7 MR. FENSTER: Q. Okay. Are you reading from  
8 paragraph 199?  
9 A. Yes, I am.  
10 Q. And what is your understanding as to the  
11 standard for validity -- or the standard to meet the  
12 enablement requirement of section 112?  
13 MS. PALLIOS ROBERTS: Objection. Form.  
14 THE WITNESS: Well, the part that I've focused  
15 on is that the person of ordinary skill should be able  
16 to follow the description as it's described in the  
17 patent. They have to be able to make it and use it  
18 without undue experimentation.  
19 MR. FENSTER: Q. And can you state your  
20 opinion regarding the validity of each of the -- strike  
21 that.  
22 And did you reach any conclusions regarding the  
23 validity of any of the asserted claims in connection  
24 with the enablement standard?  
25 MS. PALLIOS ROBERTS: Objection. Form.

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1 THE WITNESS: The enablement. Yes.  
2 MR. FENSTER: Q. Can you state those  
3 conclusions.  
4 A. Well, yes. I think that the -- that it's --  
5 does not -- does not meet the enablement standard. I  
6 think it would require undue experimentation, at the  
7 very least.  
8 Q. Okay. And does that conclusion apply to all  
9 asserted claims?  
10 MS. PALLIOS ROBERTS: Objection. Form.  
11 THE WITNESS: Well, the purpose of the  
12 invention is to provide the user of the method or system  
13 with documents that are relevant to their queries and  
14 match their background and psychological profile.  
15 I think to -- at the very least, enormous  
16 quantities of experimentation, certainly undue  
17 experimentation, would be required by anyone following  
18 the descriptions given in the patent itself --  
19 MR. FENSTER: Q. Why?  
20 A. -- to accomplish that.  
21 Q. Why?  
22 A. Well, there are a number of reasons for that.  
23 So, I mean, one is that the patent just doesn't  
24 even really give any working examples of how to follow  
25 the prescription that it lays out for the invention so

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1 that the results will match the user's background.  
2 It asserts that they will, but it doesn't --  
3 when you -- when you actually look through the working  
4 examples, those are -- those don't actually show how it  
5 would.  
6 A second is that it's actually well known in  
7 information retrieval that when you start following the  
8 kinds of procedures that the patent itself describes,  
9 such as counting the number of occurrences of identified  
10 segments in text and so forth, that the raw counts of  
11 these don't even provide very good results, just for  
12 simple relevance to queries, for a host of reasons.  
13 For example, larger documents tend to have  
14 higher counts of the segment -- of given segments in  
15 them than smaller ones do. But they may not be, by any  
16 means, the most relevant to a query.  
17 So in information retrieval, what one does is  
18 to normalize counts by length of documents, to apply  
19 other techniques, such as TFIDF, to distinguish between  
20 frequent terms that are not very good discriminators  
21 between documents and terms that are pretty frequent and  
22 are good discriminators between documents and therefore  
23 helpful in determining the relevance of a document to a  
24 query.  
25 There is -- there is lots of kinds of

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1 operations of this kind that are needed in order to make  
2 information retrieval systems work well, none of which  
3 are described in the patent. So I think that a person  
4 of ordinary skill reading the patent would be obliged to  
5 do an enormous amount of experimentation to try to make  
6 the thing work at all, let alone for its intended  
7 purpose.  
8 Q. Did you apply the same standard for a person of  
9 ordinary skill in the art when you did your obviousness  
10 analysis as when you did your written description and  
11 enablement analysis?  
12 MS. PALLIOS ROBERTS: Objection. Form.  
13 THE WITNESS: I did.  
14 MR. FENSTER: Q. So it's the same person of  
15 skill in the art that we're talking about that would  
16 find it impossible to make and use the claimed invention  
17 without undue experimentation that would also find the  
18 same invention obvious in light of the prior art; is  
19 that correct?  
20 A. Yes, that's -- that's right. Someone with a --  
21 you know, the bachelor's degree we talked about and a  
22 couple of years of graduate study or experience.  
23 Q. And you taught lots of these -- lots of  
24 students that you think qualify as people of ordinary  
25 skill in the art back in 1999, correct?

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1 MS. PALLIOS ROBERTS: Objection. Form.  
2 THE WITNESS: I was teaching students like that  
3 then, yes, that's right.  
4 MR. FENSTER: Q. Okay. And so you had -- so  
5 one of your students who was a person of ordinary skill  
6 in the art would have been able to make and use the  
7 claimed invention from the prior art -- it would have  
8 been obvious for him or her to do so; is that your  
9 opinion?  
10 MS. PALLIOS ROBERTS: Objection. Form.  
11 THE WITNESS: No, it's my -- it's my opinion  
12 that that person would have found it obvious -- given  
13 the motivation, given the aim -- would have found it  
14 obvious to try combining those elements.  
15 It would have been obvious, looking around at  
16 the field, to try combining the various elements that we  
17 identified into a single whole to create an invention of  
18 this kind.  
19 And maybe it would have worked; maybe it would  
20 not have worked; but it would have been obvious to try  
21 that combination.  
22 MR. FENSTER: Q. I see. So in reaching your  
23 conclusion regarding obviousness, you -- do you have any  
24 opinion as to whether one of skill in the art would have  
25 actually been able to successfully make the

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1 combination -- the claimed invention based on the prior  
2 art?  
3 A. Well, I explained in another section of my  
4 report my concerns about the usefulness. But -- and --  
5 so I do have -- I do have doubts about whether they  
6 could have succeeded. But I certainly don't think that  
7 it would have been anything but obvious if they had the  
8 goal that this inventor had to try combining those  
9 things -- those elements.  
10 And if they had succeeded in actually doing  
11 this, what they would have needed to disclose, in my  
12 opinion, about their invention would be a great deal  
13 more information through worked-out examples and  
14 explicit guidance for these kinds of tuning that I've  
15 been describing of how to do that in order to lead to  
16 success.  
17 Q. So --  
18 A. In the absence of that, I don't think, you  
19 know, they would have deserved a patent for their  
20 invention.  
21 Q. Okay. Your conclusion on obviousness is that  
22 one of skill in the art, someone like one of your former  
23 students, it would have been obvious to such a person to  
24 make this invention based on the prior art that existed  
25 as of 1999, correct?

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1 MS. PALLIOS ROBERTS: Objection. Form.  
2 THE WITNESS: It would have been obvious for  
3 them, that's right, to try and combine those elements to  
4 create an invention for this purpose.  
5 MR. FENSTER: Q. Okay. And do you have any  
6 opinion as to whether such a person, a person of  
7 ordinary skill in the art, would have actually been able  
8 to make, successfully, the claimed invention based on  
9 the prior art?  
10 A. Successfully make it. That would be really  
11 pure speculation on my part. I find it surprising, but  
12 that would be pure speculation.  
13 Q. Okay. So you have not reached any affirmative  
14 opinion that one of skill in the art in 1999 would have  
15 been able to successfully make any of the claimed -- any  
16 of the inventions claimed in the asserted claims based  
17 on the prior art available in 1999?  
18 MS. PALLIOS ROBERTS: Objection. Form.  
19 MR. FENSTER: Q. Is that right?  
20 A. Well, let's be careful here. What I'm -- what  
21 is it that's supposed to not be obvious? Is it --  
22 Q. Can you answer my question?  
23 A. I'm trying to. You know, I'm trying to be  
24 careful about exactly what the question is.  
25 Q. Okay.

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1 A. So can you rephrase it.  
2 Q. Do you believe that a person of skill in the  
3 art would have been able to successfully make the  
4 inventions claimed in the '067 patent based on the prior  
5 art available as of 1999?  
6 A. So by "successfully make the inventions  
7 claimed," you mean not only to assemble the component  
8 parts as described, but that they would actually have  
9 returned search results that did match the user's  
10 background and psychological profile.  
11 Q. Yes.  
12 A. So as I say, I don't -- I -- it would be  
13 speculation on my part. I would find it very surprising  
14 if one of ordinary skill could do that.  
15 Q. As of the date of the invention, correct?  
16 A. That's correct, yes.  
17 Q. If you could turn to paragraph 207.  
18 A. Okay.  
19 Q. You state first that "The '067 patent,  
20 however, does not teach how to use the parts  
21 of speech that comprise the linguistic  
22 patterns in order to return search results  
23 that correspond to a user's social  
24 background."  
25 Do you see that?

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1 A. Yes.  
2 Q. You continue, "The match factor, as  
3 described by the '067 patent, would merely  
4 return results that had similar combinations  
5 of nouns, verbs and adjectives."  
6 Do you see that?  
7 A. Yes.  
8 Q. So if I'm understanding you right, you're  
9 saying that the patent wouldn't succeed at delivering  
10 documents that match the user's background; it would  
11 only succeed in returning results that had linguistic  
12 patterns that matched the user's background. Is that  
13 right?  
14 MS. PALLIOS ROBERTS: Objection. Form.  
15 THE WITNESS: So -- yes. I'm saying -- I'm  
16 saying that it would succeed -- and let's say it will  
17 succeed. I think it's clear enough that you could -- a  
18 person of ordinary skill could make it succeed in  
19 matching patterns that were the same patterns that were  
20 extracted, for example, from the user's linguistic data.  
21 But, now, depending on what those patterns  
22 are -- remember, all that the patent says about the  
23 choice of patterns is, "Well, this is a matter of design  
24 choice." And it doesn't give any guidance on how to  
25 make these design choices.

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1 And it goes on to say that then the preferred  
2 embodiment, there's really just one very simple form of  
3 pattern. Now -- so the question is, would matching  
4 patterns in the documents that are retrieved to the  
5 patterns that were in the user's linguistic data --  
6 well, first of all, would that even return relevant  
7 documents?  
8 The patterns might be so crude that the  
9 documents that were returned were not even relevant to  
10 the query. But then if you -- you know, so there is  
11 actually a literature on how to -- how to adjust the  
12 parameters, you know, how to do things like  
13 normalization by document length and text frequency by  
14 inverse document frequency. And you can do similar  
15 things with patterns.  
16 So there's a literature on how to deal with at  
17 least the relevance question. But there's the further  
18 personalization issue here, which is what the patent's  
19 really about.  
20 And so to make the retrieved documents actually  
21 be the ones that are relevant to the user would require  
22 additional tuning, about which there's not much relevant  
23 literature, and there's certainly none in the patent.  
24 MR. FENSTER: Q. So you think that there is  
25 enough of a blueprint for the -- for one of skill in the

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1 art to make a system that retrieved documents that  
2 matched the linguistic patterns of the user profile, but  
3 that that wouldn't necessarily correspond -- that  
4 wouldn't necessarily result in results correlating to  
5 the user's background and profile; is that right?  
6 MS. PALLIOS ROBERTS: Objection. Form.  
7 THE WITNESS: Yes, I'm prepared to stipulate to  
8 the first part, and I -- and I believe it would not  
9 necessarily correlate. In fact, I know it wouldn't. It  
10 would depend heavily on what the patterns were that you  
11 chose to look for.  
12 MR. FENSTER: Got it.  
13 Q. And skipping ahead to the utility -- your  
14 utility opinion, I think -- building off what I just  
15 understood, is it fair to say that you find that it  
16 wouldn't -- that it's invalid for lack of utility  
17 because it wouldn't work, because just finding a  
18 document that has matching linguistic characteristics  
19 may not necessarily give you a document that matches the  
20 user's background and profile?  
21 MS. PALLIOS ROBERTS: Objection. Form.  
22 THE WITNESS: Yes, that's a -- that's a  
23 critical part of this. There really are two parts as  
24 regards utilities. One is that, as you say, it's not  
25 just enough for the particular patterns that happen to

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1 be -- happen to have been selected in a particular  
2 instantiation of this to match, but that has to result  
3 in people of similar backgrounds getting similar  
4 documents, but furthermore -- I mean, that must happen  
5 not just by accident; it has to happen systematically,  
6 right. In other words, people of different backgrounds  
7 need to get documents that are appropriate to their  
8 different backgrounds, so they'll need to get different  
9 documents.

10 MR. FENSTER: Q. Does the claim require that  
11 last bit? I noticed that you said that in -- for  
12 example, in paragraph 207 that it has to be adequate to  
13 discriminate between people of varying backgrounds. Is  
14 that a requirement of the claim, in your view?

15 A. Well, just think about it. The dashes the --  
16 as the patents itself explains -- let's say you have a  
17 12-year-old child and a physician, who are both  
18 searching for something. Let's say, for example,  
19 they're both searching for, I don't know, Hodgkin's  
20 lymphoma or something like this.

21 So one of the problems with a lot of the  
22 current search is the 12-year-old child is going to get  
23 things way above the child's reading level, completely  
24 inappropriate, not match that child's background for  
25 that query.

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1 And conversely, the physician is going to get  
2 lots of stuff that is for laypeople; it's not technical,  
3 not what he was looking for, given his extensive medical  
4 background.

5 So if the system can't, for the same query,  
6 produce different documents for people that have  
7 different backgrounds in the cases where different  
8 documents are suitable, it's not doing what it's claimed  
9 to do. It's not providing the utility that it says that  
10 it will provide.

11 You know, if it only -- it always provides  
12 professor-like documents and so, you know, I get good  
13 documents when I use it. It's working fine for me. But  
14 it's not an invention of the kind that it claims to be,  
15 because when an elementary school student or when  
16 somebody who is very highly educated but doesn't know  
17 about my particular field makes the same kind of search,  
18 they get the same documents I do.

19 Q. And is it your understanding that in order to  
20 meet the utility requirement of section 101 of the  
21 patent code, that an invention -- that this invention  
22 would have to meet that requirement of giving different  
23 results for different people?

24 A. So -- yes. I mean, the invention was found by  
25 the examiner, and so that's presumed to be new and

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1 useful and nonobvious, right. All of those things.  
2 So why would -- why is it useful? Well, the  
3 invention states what it's for. It's to provide, to a  
4 variety of different users, documents that are  
5 appropriate to their background and psychological  
6 profile. And so to really be useful, it should do  
7 exactly that. That's my understanding.

8 Q. How well does an invention have to work for its  
9 stated purpose in order to be valid under section 101,  
10 in your view?

11 MS. PALLIOS ROBERTS: Objection. Form.  
12 THE WITNESS: I don't know, you know, what the  
13 cutoff is.

14 MR. FENSTER: Q. Does it have to work most of  
15 the time?

16 MS. PALLIOS ROBERTS: Objection. Form.  
17 MR. FENSTER: Q. Some of the time?

18 A. I would think it would at least have to work  
19 some of the time, yes. I would think it has to work  
20 some of the time.

21 Q. Do you have any -- seriously, do you have any  
22 understanding as to what degree an invention should work  
23 for its stated purpose in order to meet the utility  
24 requirement of section 101?

25 A. No, I -- I don't know exactly what standard the

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1 examiner applies.

2 Q. Do you have any understanding as to -- as to  
3 what degree the claimed invention works for its stated  
4 purpose?

5 MS. PALLIOS ROBERTS: Objection. Form.  
6 THE WITNESS: I haven't seen it tested  
7 anywhere.

8 MR. FENSTER: Q. So you don't know?  
9 A. So I don't know how well it actually works.

10 MS. PALLIOS ROBERTS: Counsel, if we're at a  
11 natural breaking point, can we take a break.

12 MR. FENSTER: Sure.  
13 THE VIDEOGRAPHER: We are now off the record at  
14 4:35.  
15 (Recess taken.)  
16 THE VIDEOGRAPHER: We are now on the record at  
17 4:52.

18 MR. FENSTER: Q. Dr. Peters, can I ask you to  
19 turn to pages 14 and 15 of your report.  
20 A. All right. Yes.  
21 Q. Okay. So in the middle of page 14, you have  
22 the characteristics of the system claimed by the '067  
23 patent, and you state, "I will discuss the steps,"  
24 slash, "elements of the claims below."  
25 Do you see that?