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

EOLAS TECHNOLOGIES INCORPORATED,	§	Civil Action No. 6:09-CV-446-LED
	§	
PLAINTIFF,	§	
	§	JURY TRIAL DEMANDED
v.	§	
	§	
ADOBE SYSTEMS INC., et al.,	§	
	§	
DEFENDANTS.	§	
	§	

DEFENDANTS' REPLY IN SUPPORT OF THEIR MOTION TO EXCLUDE PORTIONS OF THE EXPERT TESTIMONY OF DAVID MARTIN AND ROY WEINSTEIN

Eolas' Opposition relies on the false premise that statements are ***not*** "opinions" if they are "based upon the substance of the documents of the party or the party's testimony." (D.I. 1007 at 2). That is precisely the definition of "opinion." For Eolas' experts' statements to be "based upon" the substance of documents, the statements necessarily must draw conclusions not ***specifically stated*** in the documents. And, because neither Dr. Martin nor Mr. Weinstein has established qualifications to draw such conclusions, they have not shown themselves to have any greater ability to do so than any member of the jury. Those statements, therefore, contain improper, unhelpful opinion testimony regarding knowledge, intent, or state of mind, and should be excluded.

Moreover, the case law string-cited by Eolas is irrelevant. None of them involves a technical or damages expert in a patent case attempting to testify regarding intent, knowledge, motivation, or state of mind. Instead, Eolas' cited law shows only that expert testimony on intent can be admissible where, unlike here, such testimony specifically draws on the specialized knowledge or experience of the expert.

I. NEITHER DR. MARTIN OR MR. WEINSTEIN HAVE ANY RELEVANT EXPERTISE AS TO KNOWLEDGE, INTENT, OR STATE OF MIND OF ANY ENTITY

A threshold question in whether to allow expert testimony is determining "whether the expert is proposing to testify to (1) scientific knowledge that (2) will assist the trier of fact to understand or determine a fact in issue." *Daubert v. Merrell Dow Pharms.*, 509 U.S. 579, 592 (U.S. 1993). The Supreme Court has also set forth the boundaries on the types of expert testimony that should be considered, finding that testimony based on "scientific, technical, or other specialized knowledge" can be admissible. *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 147 (U.S. 1999).

Without support, Eolas repeatedly asserts in its responsive brief that it is permissible for Dr. Martin and Mr. Weinstein to opine about the Defendants' and W3C's state of mind, such as, for example, Defendants' alleged intent to induce infringement, Defendants' alleged willful infringement, or the W3C alleged conspiracy. (D.I. 1007 at 1-9). But neither Dr. Martin nor Mr. Weinstein have any "scientific, technical, or other specialized knowledge" regarding a person's or party's intent, motivation, knowledge, or state of mind. Absent such specialized knowledge, this Court cannot possibly "ensure that [their] testimony … rests on a ***reliable foundation***," as the Federal Rules of Evidence Require. Fed. R. Evid. 702; *Kumho Tire*, 526 U.S. at 141; *see also Rodriguez v. Riddell Sports, Inc.*, 242 F.3d 567, 580 (5th Cir. 2001). Dr. Martin and Mr. Weinstein do not even ***claim*** to possess such expertise. Dr. Martin is a computer scientist who received his Ph.D. in the area of Internet security and privacy. (Martin Main Rep. at ¶ 7). Mr. Weinstein describes himself as an economist with particular experience in "the valuation of intellectual property and the calculation of patent infringement damages." (Weinstein Core Rep. at ¶ 1). Fed. R. Evid. 702 simply does not permit such "expert" testimony from witnesses testifying outside their area of expertise. And Dr. Martin and Mr. Weinstein, having no expertise in determining state of mind, are no better situated to do so than any member of a jury.

II. EXPERT TESTIMONY AS TO KNOWLEDGE, INTENT, OR STATE OF MIND IMPROPERLY USURPS THE FACTFINDING ROLE OF THE JURY

Dr. Martin's and Mr. Weinstein's testimony regarding the intent, knowledge, motivation, or state of mind of the Defendants improperly usurps the jury's role as factfinder and is not properly the subject of expert testimony under Rule 702. *See Tyco Healthcare Group, LP v. Applied Med. Res. Corp.*, No. 9:06-cv-151, 2009 U.S. Dist. LEXIS 125377 at *14 (E.D. Tex. Mar. 30, 2009).

Eolas' attempt to distinguish *Tyco* fails. The form of evidence relied on is irrelevant.

Allowing an expert witness to opine on actual knowledge of the patents in suit should not be permitted, since "[t]here is no 'scientific, technical, or other specialized knowledge'" required, and "the jury is perfectly able to make such a determination on its own"—regardless of whether the expert is "merely opining on underlying facts." *Id.* Regardless of the nature, volume, or public availability of underlying evidence, purported "opinions" on knowledge or intent are of no benefit to the jury, and instead only usurp the jury's role. It is the jury's place, not Dr. Martin's or Mr. Weinstein's, to evaluate that evidence.

III. EOLAS' CITED CASE LAW IS INAPPOSITE

Throughout its Opposition, Eolas relies on case law with little or no bearing on the facts of this case, resting on misstated holdings and misapplied comparisons.

For example, Eolas claims that the Federal Circuit, in *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. 2009), found that expert opinion on intent can support a finding of induced infringement. (D.I. 1007 at 7). But no such finding was made. In *Lucent*, the admissibility of expert testimony was not at issue. The *Lucent* Court therefore did not make ***any*** finding relevant to this Motion.[1] Eolas' reliance on *Spreadsheet Automation Corp. v. Microsoft Corp.*, 587 F. Supp. 2d 794 (E.D. Tex. 2007), (D.I. 1007 at 7), is equally unavailing. In *Spreadsheet*, expert testimony was permitted ***only*** because the Plaintiff represented that its expert ***would not*** testify as to the Defendant's intent. Thus, unlike here, the expert in *Spreadsheet* stopped short of opining on the state of mind of the Defendant.

Eolas provides a laundry list of cases (D.I. 1007 at 9-12), but ***none*** of them deals with a situation where, as here, a ***technical*** or ***damages*** expert in a ***patent case*** attempts to testify

[1] Moreover, while the Court states that expert testimony was among the testimony presented related to indirect infringement, it characterized the entire body of evidence as "not strong", finding not that Lucent had proved indirect infringement, but rather that Defendant Microsoft's JMOL motion for non-infringement was properly denied.

regarding intent, knowledge, motivation, or state of mind. Instead, where expert testimony regarding knowledge or intent was permitted, such testimony was directly related to the specialized knowledge of the expert:

- *U.S. v. Moore*, 997 F.2d 55 (5th Cir. 1993): tax evasion case in which an expert in ***tax matters and criminal investigation of tax violations*** was permitted to testify only ***within*** his area of expertise;[2]
- *U.S. v. Dotson*, 817 F.2d 1127 (5th Cir. 1987): tax evasion case in which an expert in ***tax matters and criminal investigation of tax violations*** was permitted to testify only ***within*** his area of expertise; expert was not permitted to "directly embrace the ultimate question of [intent]." 817 F.2d at 1132;
- *Bauman v. Centex Corp*., 611 F.2d 1115 (5th Cir. 1980): contract case in which a ***corporate finance expert*** was allowed to testify in a case involving "issues of corporate management of sufficient complexity to call for expert clarification." 611 F.2d at 1121;
- *Dunn v. HOVIC*, 1 F.3d 1368 (3d Cir. 1993): a products liability case in which a ***medical expert*** who assists companies in determining whether substances are harmful was permitted to testify regarding a company's knowledge of risks associated with asbestos exposure;
- *Bouyges Telecom, S.A. v. Tekelec*, 472 F. Supp. 2d 722 (E.D.N.C. 2007): tort case in which ***telecommunications expert*** was permitted to testify regarding the level of "common knowledge within the telecommunications field." 472 F. Supp. 2d at 726;
- *Hartzler v. Wiley*, 277 F. Supp. 2d 1114 (D. Kan. 2003): a contract case in which a ***construction and engineering expert*** was permitted to testify regarding the meaning of a contract "in light of construction industry custom and practice." 277 F. Supp. 2d at 1118;
- *Top of Iowa Coop v. Schewe*, 149 F. Supp. 2d 709 (N.D. Iowa 2001): contract case in which expert was permitted to testify regarding natural result of Defendants "superior knowledge about and experience in the grain industry." 149 F. Supp. 714;
- *Media Sport & Arts v. Kinney Show Corp.*, No. 95 Civ. 3901, 1999 U.S. Dist. LEXIS 16035 (S.D.N.Y. Oct. 18, 1999): a contract case in which a ***sports marketing and licensing expert*** was permitted to testify only with regard to "industry customs and practices." 1999 U.S. Dist LEXIS 16035 at *12;
- *Steinhilber v. McCarthy*, 26 F. Supp. 2d 265 (D. Mass. 1998): medical negligence case in which ***medical expert*** was permitted to testify regarding customs and practices of reasonable medical professionals and specialists;

[2] In *Moore*, the expert "never testified explicitly as to the defendants' intent or state of mind. Instead, he testified to facts that were either well within his area of expertise or were personally experienced by him." 997 F.2d at 59. *Moore*, therefore, shows only that testimony on intent or state of mind, if outside the special expertise of the expert, would be ***impermissible***.

- *Hopson v. Cheltenham Township*, 1990 U.S. Dist. LEXIS 8905 (E.D. Pa. July 17, 1990): Fourteenth Amendment case in which expert was permitted to testify with regard to customary knowledge and awareness to be attributed to a police officer.

Eolas further attempts to relate the above cases to this case on the basis that this case involves complex technical issues, the comprehension of which require the assistive testimony of a qualified expert. (D.I. 1007 at 11-12). But unlike several of the cases described above, the intent, knowledge, motivation, and state of mind of the various actors in this case is ***not*** a technically complex issue, nor do they have anything to do with computer science (Dr. Martin's expertise) or economics (Mr. Weinstein's expertise). Therefore, unlike the experts in the above cases whose testimony on issues ***related to their expertise*** was permitted, Dr. Martin and Mr. Weinstein have ***no specialized knowledge*** on which to base the testimony Defendants now seek to exclude, nor will that testimony assist the jury.

IV. EOLAS AGREES THAT DR. MARTIN WILL NOT ATTEMPT TO PROVIDE OPINIONS ABOUT THE DOCTRINE OF EQUIVALENTS

Eolas confirms, in its Opposition, that Dr. Martin will not attempt to offer any opinions regarding Defendants' alleged infringement under the doctrine of equivalents. (D.I. 1007 at 1). This representation should be enforced without qualification. Defendants have no intention of mischaracterizing, or limiting the Court's claim construction, nor should Eolas be permitted to expand it.

V. CONCLUSION

For the above reasons, Defendants respectfully request that their Motion be granted, and that improper opinions or testimony from Dr. Martin or Mr. Weinstein regarding the knowledge, intent, motivation, or state of mind be excluded. Defendants further request that this Court grant the relief requested concerning Dr. Martin's proffered testimony on the doctrine of equivalents, barring such testimony in light of Eolas' concessions.

Dated: October 17, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on October 17, 2011.

/s/ Michael E. Jones