

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

I/P ENGINE, INC.

Plaintiff,

v.

AOL INC., *et al.*,

Defendants.

Civil Action No. 2:11-cv-512

**DEFENDANTS' OPPOSITION TO PLAINTIFF I/P ENGINE'S THIRD MOTION IN
LIMINE TO EXCLUDE PRIOR ART EVIDENCE**

I. INTRODUCTION

Plaintiff's Third Motion in Limine ("Motion"), which seeks to preclude any testimony from the inventors of three prior art patents that Defendants have asserted as invalidating references, is unwarranted and should be denied.

The lion's share of Plaintiff's Motion is devoted to attacking a straw man. Plaintiff asserts (without support) that these inventors will be providing expert testimony and then argues that Defendants have not satisfied the expert witness requirements of Fed. R. Civ. P. 26(a)(2) for these inventors. This argument is irrelevant, because these prior art inventors would not be offered as expert witnesses, but rather as fact witnesses who will testify about the patents that they invented. Such fact testimony from patent inventors is perfectly appropriate. As the Federal Circuit stated in *Voice Tech. Group, Inc. v. VMC Sys., Inc.*, 164 F.3d 605, 615 (Fed. Cir. 1999):

An inventor is a competent witness to explain the invention and what was intended to be conveyed by the specification and covered by the claims. The testimony of the inventor may also provide background information, including explanation of the problems that existed at the time the invention was made and the inventor's solution to these problems.

Indeed, the Federal Circuit has specifically allowed inventors of prior art patents to testify about the technology and disclosures in their patents for purposes of invalidity. *See, e.g., Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687, 689 (Fed. Cir. 1985) (holding that asserted patent was anticipated by a prior art patent, based in part on testimony of the prior art patent's inventor).

Notably, Plaintiff has stated that it will call at trial one of the inventors of the Asserted Patents, and may call another. If the inventors of the Asserted Patents may testify about their invention and technology in the Asserted Patents, then the inventors of the prior art patents may likewise testify about the invention and technology in their patents.

For all these reasons, Plaintiff's Motion to preclude the three prior art inventors from testifying should be denied.

II. BACKGROUND

Three of the prior art references that allegedly invalidate the Asserted Patents are U.S. Patent No. 6,185,558 to Bowman et al. ("Bowman"), U.S. Patent No. 6,006,222 to Culliss ("Culliss"), and U.S. Patent No. 6,202,058 to Rose et al. ("Rose"). Accordingly, Defendants' Rule 26(a) Initial Disclosures listed Ruben Ortega (named co-inventor of the Bowman patent), Gary Culliss (named inventor of the Culliss patent), and Daniel Rose (named co-inventor of the Rose patent) as persons having relevant knowledge about their respective patents. (Declaration of Margaret P. Kammerud in Support of Defendants' Opposition to Plaintiff's Motions in Limine

("Kammerud Dec."), Ex. D, 3, 8-9.) Defendants then listed Mssrs. Ortega, Culliss, and Rose in their Rule 26(a)(3) witness list as persons who will or may testify at trial. (*Id.*, Ex. F, 2.)¹

On August 31, 2012, Plaintiff issued deposition subpoenas for Mssrs. Ortega and Culliss. On September 13, the Court granted a Joint Motion to allow these depositions to occur after the normal discovery cut-off. (D.N. 246.) Mr. Ortega's deposition occurred on September 25, while Mr. Cullis's deposition will occur on September 27. At Mr. Ortega's deposition, Plaintiff questioned Mr. Ortega at length about the meaning and interpretation of various claims and passages from his patent. (Kammerud Dec., ¶ 15.)

III. ARGUMENT

A. The Prior Art Inventors Are Not Expert Witnesses, but May Provide Relevant Fact Testimony

The basic assumption of Plaintiff's main argument – namely, that Defendants are proffering the prior art inventors as expert witnesses – is false. Plaintiff simply states, without any support, that "Google clearly intends to elicit expert testimony from these witnesses." (D.N. 336, 1; *see also id.*, 3.) In reality, Mssrs. Ortega, Culliss, and Rose will be giving precisely the type of factual testimony that the Federal Circuit's *Voice Tech.* opinion authorizes patent inventors to give. Namely, they will "explain the[ir] invention and what was intended to be conveyed by the specification and covered by the claims." *Voice Tech.*, 164 F.3d at 615. As many courts have held, this type of testimony is perfectly appropriate.² *See In re Omeprazole*

¹ Specifically, Mssrs. Ortega and Culliss were listed as "will testify" witnesses while Mr. Rose was listed as a "may testify" witness. (*Id.*)

² Plaintiff argues that Mssrs. Bowman, Culliss, and Rose should be precluded from testifying because they might "testify about purported embodiments of their patents." (Motion at 3.) While it is true that the Bowman, Culliss, and Rose patents are the prior art at issue in this case, the Federal Circuit's *Voice Tech.* opinion held that "[t]he testimony of the inventor may also provide background information, including explanation of the problems that existed at the time

Patent Litig., 2002 WL 287785, *6 fn. 7 (S.D.N.Y. Feb. 27, 2002) ("fact witnesses who are skilled in the art, including the named inventors of the '505 and '230 patents, are competent to testify concerning prior art documents."); *Sitrick v. Dreamworks, LLC*, 2006 WL 6116641, *22 (C. D. Cal. July 20, 2006) ("Bloom's testimony regarding [the] WordFit [prior art system], which he invented, can properly be considered factual testimony and is admissible on that basis without Bloom being a designated expert: Bloom obviously has sufficient first-hand, personal knowledge to state facts regarding WordFit.")

Furthermore, Plaintiff has represented that it will call Andrew Lang and may call Donald Kosak, co-inventors of the Asserted Patents. In Plaintiff's Initial Disclosures, Plaintiff describes these inventors as having knowledge of the "[c]onception and reduction to practice of the patents-in-suit" as well as the "the technology underlying the patents-in-suit." (Kammerud Dec., Ex. L, 2; *id.*, Ex. I, 1-2.) If Mssrs. Lang and Kosak can testify about the invention and technology in the Asserted Patents, then Mssrs. Ortega, Culliss, and Rose can testify about the inventions and technology in their patents.³

B. Plaintiff's Cited Cases are Inapposite

Plaintiff relies heavily on the Federal Circuit's *Innogenetics v. Abbott Labs.* case. (*See* D.N. 336, 2, 5, 7-8, 10 (citing *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363 (Fed. Cir. 2008)). In *Innogenetics*, the Federal Circuit affirmed the district court's preclusion of testimony from a prior art inventor, but it did so largely because the defendant had proffered the inventor as an expert yet refused to provide an expert report. *See Innogenetics*, 512 F.3d at 1375. By

the invention was made and the inventor's solution to these problems." *Voice Tech.*, 164 F.3d at 615.

³ At their depositions, Mssrs. Lang and Kosak recalled very little information about the invention and technology in the Asserted Patents, and Defendants reserve all rights to preclude them from providing any information at trial that they were unwilling or unable to provide in response to deposition questions.

contrast, Defendants do not proffer Mssrs. Ortega, Culliss, and Rose as experts, so this *Innogenetics* holding is simply irrelevant.

The *Innogenetics* court also affirmed preclusion of the inventor's testimony because the defendant did not "discuss how [the inventor's] testimony would inform the jury of how the ordinary artisan would understand the disclosures of the [prior art]." *Id.* By contrast, the testimony of Mssrs. Ortega, Culliss, and Rose could provide important information about the meaning of specific, disputed elements from the prior art patents. For example, the parties in this case dispute the meaning of the following passage from the Bowman patent: "adjusting the ranking value produced for each item in the query result to reflect the number of terms specified by the query that are matched by the item;" Defendants contend that this method requires counting the number of query terms that appear in the item, while Plaintiff contends that it does not. (*Compare* Kammerud Dec., Ex. C, ¶ 105 *with* D.N. 240-19, ¶¶ 85 and 84 fn. 3). Should the Court send this dispute to the jury,⁴ it is perfectly appropriate for Mr. Ortega (the co-inventor of the Bowman patent) to testify about what this disputed language means and what method it discloses. Similarly, the parties dispute whether the Bowman, Culliss, and Rose patents disclose the concept of searching for information, and these prior art witnesses could provide testimony relevant to that dispute. (*Compare* Kammerud Dec., Ex. C, ¶¶ 111, 138, 207 *with* D.N. 240-19, ¶¶ 80, 104, 48).

⁴ Consistent with the Opening Brief and forthcoming Reply Brief to their Motion for Summary Judgment, Defendants respectfully argue that their interpretations of the disputed language in these references are the ones that makes logical or linguistic sense, and that Plaintiff cannot raise a genuine issue of material fact as to it.

Accordingly, *Innogenetics* does not support the preclusion of these inventors' testimony under the facts of this case.⁵ Rather, as the Federal Circuit has stated in a related context, "testimonial evidence is frequently critical to invalidity defenses." *A.C. Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.2d 1020, 1035 (Fed. Cir. 1992) (en banc).

IV. CONCLUSION

For the foregoing reasons, Defendants respectfully request that the Court deny Plaintiff's Third Motion in Limine to preclude Defendants from calling Msrs. Ortega, Culliss, and Rose as trial witnesses.

⁵ The district court cases cited by Plaintiff also do not support its position. In *WNS Holdings, LLC v. UPS, Inc.*, 2009 WL 2136961 (W.D. Wisc. July 14, 2009), the court allowed a fact witness to testify about his first-hand experience but barred him from offering testimony that "could have been offered by *any* individual with specialized knowledge of the [relevant topic]," on the grounds that such testimony would be prohibited expert testimony. *Id.* at *2-3 (emphasis and brackets in original). In this case, the prior art inventors will testify about their first-hand experience creating the prior art patents and conceiving the disclosed inventions. Because this testimony is not the type that "could have been offered by *any* individual with specialized knowledge," it is not impermissible expert testimony under *WNS Holdings*. *Eugene Baratto and Textures, LLC v. Brushstrokes Fine Art, Inc.*, 701 F. Supp. 2d 1068 (W.D. Wisc. 2010) drew the same distinction between expert and factual testimony as *WNS Holdings*, so the inventor testimony here is permissible for the same reason. *See id.* at 1074. And in *BorgWarner, Inc. v. Honeywell Intern., Inc.*, 750 F. Supp. 2d 596, 604 (W.D.N.C. 2010), the court found that a witness would be giving expert testimony by answering hypothetical questions, since hypothetical situations are the province of experts. *See id.* at 604. By contrast, no hypothetical questions would be proffered to the prior art inventors in this case.

DATED: September 27, 2012

/s/ Stephen E. Noona

Stephen E. Noona
Virginia State Bar No. 25367
KAUFMAN & CANOLES, P.C.
150 West Main Street, Suite 2100
Norfolk, VA 23510
Telephone: (757) 624.3000
Facsimile: (757) 624.3169
senoona@kaufcan.com

David Bilsker
David A. Perlson
QUINN EMANUEL URQUHART &
SULLIVAN, LLP
50 California Street, 22nd Floor
San Francisco, California 94111
Telephone: (415) 875-6600
Facsimile: (415) 875-6700
davidbilsker@quinnemanuel.com
davidperlson@quinnemanuel.com

*Counsel for Google Inc., Target Corporation,
IAC Search & Media, Inc., and Gannett Co., Inc.*

/s/ Stephen E. Noona

Stephen E. Noona
Virginia State Bar No. 25367
KAUFMAN & CANOLES, P.C.
150 W. Main Street, Suite 2100
Norfolk, VA 23510
Telephone: (757) 624-3000
Facsimile: (757) 624-3169
senoona@kaufcan.com

Robert L. Burns
FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER, LLP
Two Freedom Square
11955 Freedom Drive
Reston, VA 20190
Telephone: (571) 203-2700
Facsimile: (202) 408-4400

Cortney S. Alexander
FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER, LLP
3500 SunTrust Plaza
303 Peachtree Street, NE
Atlanta, GA 94111
Telephone: (404) 653-6400
Facsimile: (415) 653-6444
Counsel for Defendant AOL Inc.

CERTIFICATE OF SERVICE

I hereby certify that on September 27, 2012, I will electronically file the foregoing with the Clerk of Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

Jeffrey K. Sherwood
Kenneth W. Brothers
DICKSTEIN SHAPIRO LLP
1825 Eye Street NW
Washington, DC 20006
Telephone: (202) 420-2200
Facsimile: (202) 420-2201
sherwoodj@dicksteinshapiro.com
brothersk@dicksteinshapiro.com

Donald C. Schultz
W. Ryan Snow
Steven Stancliff
CRENSHAW, WARE & MARTIN, P.L.C.
150 West Main Street, Suite 1500
Norfolk, VA 23510
Telephone: (757) 623-3000
Facsimile: (757) 623-5735
dschultz@cwm-law.com
wrsnow@cwm-law.com
sstancliff@cwm-law.com

Counsel for Plaintiff, I/P Engine, Inc.

/s/ Stephen E. Noona
Stephen E. Noona
Virginia State Bar No. 25367
KAUFMAN & CANOLES, P.C.
150 West Main Street, Suite 2100
Norfolk, VA 23510
Telephone: (757) 624.3000
Facsimile: (757) 624.3169
senoona@kaufcan.com