UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
NORFOLK DIVISION

I/P ENGINE, INC.,	)	
Plaintiff,	)	
v.	)	Civ. Action No. 2:11-cv-512
AOL, INC. et al.,	)	**REDACTED VERSION**
Defendants.	)	

PLAINTIFF I/P ENGINE, INC.'S OPPOSITION TO DEFENDANTS' MOTION TO PRECLUDE DR. FRIEDER FROM TESTIFYING REGARDING "UNTIMELY" OPINIONS

I. INTRODUCTION

Dr. Frieder is I/P Engine's expert on infringement. He is a Professor of Computer Science at Georgetown University, and is so well-regarded in the field that Defendants attempted to retain him as an expert in this litigation. Dr. Frieder submitted his expert report on July 25, 2012, describing in detail his opinions and conclusions, and citing voluminous evidence in support. *See* Ex. 1. Dr. Frieder was aware that fact discovery was ongoing, and was not scheduled to end until September 4, 2012. He expressly reserved the right to supplement his report with new evidence not available at the time of his report. *Id.* at ¶ 6.

After Dr. Frieder provided his report, but before the end of fact discovery, Google produced three additional witnesses for deposition. In addition, the Court issued an amended claim construction. None of this evidence was available to Dr. Frieder prior to the service of his report. With respect to the deposition testimony of the Google employees, Dr. Frieder already had described the technology referenced during those depositions, and had explained how it

infringed the patents in suit. Twelve days after the last of those depositions, and less than three weeks after the Court amended its claim construction, and before Dr. Frieder's deposition, I/P Engine served Dr. Frieder's Updated Expert Report. The updated report incorporated citations to the deposition testimony and related source code, and applied the Court's new claim construction.[1] Importantly, Dr. Frieder did not alter, expand, or otherwise change any aspect of his previously stated analysis, opinions, or conclusions. All Dr. Frieder did is cite the newly produced evidence in his report and exhibits. *See* Ex. 2 at Exhibit 2 (red-lined claim charts). With regard to the new claim construction, he explained that it did not alter his conclusion that all asserted claims are infringed because the evidence he previously relied upon satisfies the Court's construction. Ex. 2 at ¶¶ 3-4. Defendants examined Dr. Frieder on his Updated Report at his deposition. These facts show that there is no basis for Defendants' assertion that Dr. Frieder's Updated Report was "untimely" or "unjustified."

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II. DR. FRIDER APPROPRIATELY UPDATED HIS REPORT

[redacted]

[1] I/P Engine simultaneously served "clean" and a "redlined" versions of Dr. Frieder's Updated Expert Report, so Defendants could quickly identify what had changed. *See* Ex. 2 at ¶ 7 (noting the provision of red-lined claim charts as Exhibit 2).

[redacted]

During these depositions, the Google employees described their understanding of the operation of the Accused Systems, including the source code that was cited in Dr. Frieder's original report. Dr. Frieder noted that the last of these depositions, Mr. Holt's deposition on August 23, was particularly relevant to the topics he would opine on at trial because Mr. Holt prepared the templates demonstrating key functionality of Google's products. Ex. 3 at 215:9-18.

[redacted]

[redacted]

On September 6, 2012, Defendants conducted their deposition of Dr. Frieder. Defendants asked Dr. Frieder about both his original and updated expert reports, including the referenced to the testimony of Furrow, Cook, and Holt. See, e.g., Ex. 3 at 214:13-18. Defendants have not asserted that they were precluded from examining Dr. Frieder on any issues relating to his updated report.

III. THERE IS NO BASIS TO STRIKE DR. FRIEDER'S UPDATED REPORT

A. Dr. Frieder Timely Supplemented His Expert Report

Dr. Frieder's September 4 Updated Expert Report was not untimely. Under Rule 26(e) of the Federal Rules of Civil Procedure, I/P Engine had a duty to supplement Dr. Frieder's report "in a timely manner" or as otherwise set by the Court, and no later than the due date for Rule 26(a)(3) disclosures. Fed. R. Civ. P. 26(e)(1)-(2); *see Fisher v. Pelstring*, 817 F. Supp. 2d 791, 816 (D.S.C. 2011) (expert report supplementations "must be disclosed by the time the parties' pretrial disclosures under Rule 26(a)(3) are due"). This Court's Scheduling Order states that expert rebuttal disclosures "shall be made on September 4, 2012," and that Rule 26(a)(3) disclosures are due on or before September 19, 2012. D.I. 90. Defendants cite (Br. at 4) *Lindner v. Meadow Gold Dairies, Inc.*, 249 F.R.D. 625 (D. Haw. 2008), as supposedly showing that Dr. Frieder's supplementation of his report is, to use Defendants' term, "unsupportable." To the

contrary, the *Lindner* court found that a supplemental expert report that "does not drastically alter [the expert's] original disclosure" was a proper supplement, and denied a motion to strike the supplemental report. *Lindner*, 249 F.R.D. at 640. Indeed, the Federal Rules and this Court's Scheduling Order specifically provide for supplementation of expert reports, even with "the overall schedule in this case with short deadlines," as noted by the Defendants. (Br. at 7).

B. The Mere Twelve Day Delay Between Completion of The Technical Depositions and Service of Dr. Frieder's Updated Expert Report Was Substantially Justified and Harmless

Even if Dr. Frieder's Updated Expert Report could be considered untimely (and it is not), the Federal Rules state that even an untimely supplementation should not be excluded if the late disclosure is either "substantial[ly] justify[ed]" or "harmless." Fed. R. Civ. P. 37(c)(1). The Fourth Circuit has held that, in exercising its broad discretion to determine whether a nondisclosure of evidence is substantially justified or harmless for purposes of a Rule 37(c)(1) exclusion analysis, a district court should consider:

> (1) the surprise to the party against whom the evidence would be offered;
>
> (2) the ability of that party to cure the surprise;
>
> (3) the extent to which allowing the evidence would disrupt the trial;
>
> (4) the importance of the evidence; and
>
> (5) the nondisclosing party's explanation for its failure to disclose the evidence.

Southern States Rack And Fixture, Inc. v. Sherwin-Williams Co., 318 F.3d 592, 597 (4th Cir. 2003). All of these factors favor admitting Dr. Frieder's Updated Expert Report.

1. Defendants Cannot Feign Surprise At Dr. Frieder's Updated Expert Report

The Updated Expert Report could not have come as a surprise to Defendants. Defendants' counsel were present at the Furrow, Holt, and Cook technical depositions, and, as

they noted in their own brief (Br. at 6), they observed that Dr. Frieder was present at the Furrow deposition. Defendants acknowledge (Br. at 6) that the subject matter of Furrow, Holt, and Cook's depositions was of interest to Dr. Frieder, and Dr. Frieder had already discussed the subject matter of those depositions in his expert report.

Defendants also knew, after they persuaded the Court to partially reconsider its claim construction, that Dr. Frieder would supplement his expert report to reflect the updated claim construction. Given Defendants' stated anticipation that these events would cause Dr. Frieder to update his original expert report, Defendants cannot now feign surprise. *See, e.g., Davis v. U.S.*, Case No. 5:10-cv-00384, 2011 WL 7053630, *1 (S.D.W.Va. Oct. 14, 2011) (refusing to exclude testimony from supplemental expert reports because "such testimony, given the overall nature of the allegations, would not come as a surprise to Defendant, and that Defendant is not prejudiced thereby").

2. Defendants Had the Opportunity To, And Did, Cure Any "Prejudice" By Deposing Dr. Frieder About His Updated Expert Report

Defendants' claim of prejudice rings hollow. They knew of the depositions scheduled after the date of Dr. Frieder's original report and they knew of the new claim construction. Dr. Frieder did not change his opinions or conclusions, and Defendants fully examined Dr. Frieder on his updated report. Defendants assert (Br. at 8) two examples of supposed "prejudice" that resulted from the Updated Expert Report: (1) that its counsel "did not have enough time to perform an in depth investigation" into Dr. Frieder's "new citations" in his Updated Expert Report prior to his deposition; and (2) that Dr. Ungar's rebuttal report "was not able to address these new infringement contentions." Neither stands up to scrutiny, and Defendants had a full opportunity to cure this supposed "prejudice."

Defendants apparently ask this Court to believe its counsel did not have an opportunity to conduct an "in depth investigation" of the deposition testimony of its own employees. This assertion contradicts the premise of the motion: if defendants did not have enough time to look into the testimony of its own employees, how could Dr. Frieder have time to do so? Defendants of course participated in each of these depositions, and they have admitted (Br. at 6) that they expected Dr. Frieder to supplement his expert report based on this testimony. In fact, Dr. Frieder performed an admirable job of quickly reviewing the new deposition testimony and preparing an updated report, while simultaneously preparing for the start of a new school year.

To the extent Defendants are referring to the limited testimony from these witnesses that Dr. Frieder cited in his updated report, Defendants' counsel would have this Court believe that they could not review the citations to the Furrow, Holt, and Cook deposition transcripts that Dr. Frieder added to his claim charts in redline. In fact, Defendants did ask Dr. Frieder multiple questions about the new citations at his deposition, eliminating any supposed prejudice. *See, e.g.*, Ex. 3 at 212:12-220:12. When a defendant had an opportunity to question an expert about a supplementation, the defendant is not prejudiced. *See, e.g., Fisher v. Pelstring*, 817 F. Supp. 2d at 816.

3. Permitting Dr. Frieder To Address The Testimony Of Google's Witnesses Would Not Disrupt Trial

Mr. Furrow, Mr. Cook, and Mr. Holt, have already been deposed, and Defendants have already deposed Dr. Frieder based on his Updated Expert Report. Accordingly, the Updated Expert Report does not present any disruption to the upcoming trial. Indeed, in the pretrial disclosures submitted last week, Google identifies Mr. Furrow, Mr. Cook, and Mr. Holt as witnesses Google intends to call at trial. Ex. 4 at Exhibit A. Accordingly, Google cannot

seriously object that the updated portions of Dr. Frieder's expert report that address their testimony would disrupt trial in this case.

4. The Updated Expert Report Addresses Google's Own Characterization of How Its Products Operate, And Is Important To This Case

Dr. Frieder is I/P Engine's infringement expert witness in this case. The Updated Expert Report presents Dr. Frieder's best analysis of the subject matter that was disclosed after the initial submission of his report. This evidence comes from the witnesses that Google identified as having the best understanding of the technology in question. Google intends to call these witnesses at trial. The Updated Expert Report also addresses this Court's revised claim construction, and testimony based on the Updated Expert Report is necessary for that reason alone.

5. The Mere Twelve Day Delay Between The Completion of Technical Depositions and Service of Dr. Frieder's Updated Expert Report Is Substantially Justified

In an attempt to paint the Updated Expert Report as untimely, Defendants characterize Dr. Frieder's timeline as starting on the date that Dr. Frieder reviewed Google's source code, on July 13, 2012. Defendants ignore the three technical depositions where the features were first identified by Google's witnesses and the revised claim construction order that this Court issued at Defendants' request. Google's own expert witness noted that he needed to have phone calls with one of these witnesses, Bartholomew Furrow, to fully understand the Google source code. Ex. 5 at 156:5-19.

[redacted]

C. Dr. Frieder Did Not Disavow Infringement Based On Click-Through Rate

In their motion for summary judgment (D.I. 237), their motion to exclude their own harmful documents (D.I. 303), and now this motion, [redacted]

[redacted]

Dr. Frieder's testimony does not constitute the "express disavowal" that Defendants allege. By way of contrast, in *Devito v. Smithkline Beecham Corp.*, No. 02-cv-00745 (NPM), 2004 WL 3691343 (N.D.N.Y. Nov. 29, 2004), which Defendants cite as supporting their argument, the plaintiff's expert witness provided "unequivocal deposition testimony disavowing that he made the opinions which plaintiff claims he did." *Id*. at *4. There, the plaintiff provided an expert disclosure stating what it understood Dr. George would testify to at trial. *Id.* In his deposition, however, "Dr. George was asked point blank whether he had formed any of the three opinions quoted above, and whether he was prepared to testify to same. Each time he answered no." *Id*.

[redacted]

Dr. Frieder, on the other hand, made no such "unequivocal deposition testimony disavowing" his opinions here and repeatedly reaffirmed that he stood by his positions. Defendants' attempts to construe the facts otherwise only reflect poorly on their credibility.

D. Dr. Frieder's Trial Testimony Will Be Fully Supported by and Consistent with His Expert Report

[redacted]

Defendants cite *Sharpe v. U.S.*, 230 F.R.D. 452 (E.D. Va. 2005), and *Wright v. Commonwealth Primary Care, Inc.*, 3:10-cv-0034, 2010 WL 4623998 (E.D. Va. Nov. 2, 2010), as supposedly demonstrating that "the Federal Rules are designed to prevent situations like this . . . ." Br. at 10. They are not. The Federal Rules are designed to prevent situations like in *Sharpe*, where an expert provides only a "sketchy and vague" report where it is "completely unclear . . . what the reasons are for [the] opinion," 230 F.R.D. at 458, or like in *Wright*, where

the expert does not provide a report at all, 2010 WL 4623998 at *3. That Dr. Frieder defended the opinions in his expert report in his deposition by further explaining Defendants' own documents to Defendants' counsel does not substantiate Google's accusation of "hiding-the-ball." Br. at 10.

IV. CONCLUSION

For the reasons discussed above, Defendants' Motion To Preclude Dr. Ophir Frieder from Testifying Regarding "Untimely" Opinions That Were Not Disclosed In His Original Expert Report and Opinions That He Now Concedes Are Incorrect should be DENIED.

Dated: September 27, 2012

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CERTIFICATE OF SERVICE

I hereby certify that on this 27th day of September, 2012, the foregoing **PLAINTIFF I/P ENGINE, INC.'S OPPOSITION TO DEFENDANTS' MOTION TO PRECLUDE DR. FRIEDER FROM TESTIFYING REGARDING "UNTIMELY" OPINIONS,** was served via the Court's CM/ECF system and via Hand Delivery, on the following:

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