

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

LEADER TECHNOLOGIES,) Trial Volume 5
INC.,)
)
Plaintiff,)
) C.A. No. 08-862-JJF-LPS
v.)
)
FACEBOOK, INC., a)
Delaware corporation,)
)
Defendant.)

Friday, July 23, 2010
9:00 a.m.

BEFORE: THE HONORABLE LEONARD P. STARK
United States District Court Magistrate

APPEARANCES:

POTTER, ANDERSON & CORROON, LLP
BY: PHILIP A. ROVNER, ESQ.

-and-

KING & SPALDING
BY: PAUL ANDRE, ESQ.
BY: LISA KOBIALKA, ESQ.
BY: JAMES HANNAH, ESQ.

Counsel for Plaintiff

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APPEARANCES CONTINUED:

BLANK ROME, LLP
BY: STEVEN L. CAPONI, ESQ.

-and-

COOLEY, GODWARD, KRONISH, LLP
BY: MICHAEL RHODES, ESQ.
BY: HEIDI L. KEEFE, ESQ.
BY: JEFFREY NORBERG, ESQ.
BY: MARK WEINSTEIN, ESQ.

Counsel for Defendant

1 THE CLERK: All rise. Court is
2 now in session. The Honorable Leonard P. Stark
3 presiding.

4 THE COURT: Good morning.
5 (Everyone said, Good morning, Your
6 Honor.)

7 THE COURT: You may be seated.
8 Is there anything we need to
9 discuss before we bring the jury in?

10 MR. RHODES: I have one, Your
11 Honor, that's really a product of my own
12 oversight. You recall the first two exhibits I
13 used yesterday were these interrogatory
14 responses.

15 My team tells me that there's a
16 whole bunch of other stuff in them like their
17 entire claim chart. They really shouldn't be in
18 evidence.

19 I had proposed with counsel that
20 we just submit through and I don't mean to
21 propose through Mr. Golden, but we could take
22 the document out and just leave the sentence in
23 that I was interested in.

24 I understand they have an

1 objection, so perhaps they should be heard.

2 THE COURT: Okay.

3 MR. ROVNER: Good morning, Your
4 Honor, Phil Rovner. This isn't just an
5 administrative type of thing. This was the
6 first exhibit that Mr. Rhodes introduced to the
7 jury. It's the first one they published to the
8 jury.

9 These are basically our
10 interrogatory responses which Mr. Rhodes made a
11 big deal about they were verified and under
12 oath -- under penalty of perjury. They give
13 them to the jury. If we pull them back, it
14 looks like we are seeking to hide something.

15 He knew full well what was in
16 there, and he put them in front of the jury.
17 And now you can't, you know, unring the bell.

18 THE COURT: Let me ask you: Do
19 you want to use them?

20 Is that the point? I mean, if
21 you're not going to be using them, we can change
22 out the jury binder without the jury necessarily
23 knowing.

24 MR. ROVNER: Well, they take them

1 with them. I've been noticing the jury takes
2 them every time they come in and out. They
3 carry them with them.

4 THE COURT: But if the concern is
5 prejudice about the jury's going to think, you
6 know, that you guys are trying to pull it back,
7 I can avoid that by saying, you know, I've made
8 an administrative mistake by admitting a large
9 document when I meant to admit two pages.

10 MR. ROVNER: With all due respect,
11 the jury may have been thumbing through this.
12 This is the first document they published to the
13 jury and they now have it.

14 And they could have leafed through
15 it. If all of a sudden they're gone, I think
16 they would think that we were hiding something.
17 And Mr. McKibben -- what Mr. Rhodes said, the
18 first question to Mr. McKibben, is I'm showing
19 to you one of the legal documents that the
20 parties exchanged before you come to trial.

21 He didn't say excerpts. He said
22 the whole thing.

23 So the whole thing was sent to the
24 jury. You know, and it was his mistake, but I

1 think now we're going to be the ones who are
2 prejudiced by his mistake.

3 THE COURT: So my question is:
4 Are you concerned about the prejudice or do you
5 want to use the document? If you're going to be
6 -- you know, if your point is they've admitted
7 now a whole big document and so it's fair game
8 for you to use it, that's one argument.

9 If you're not making that argument
10 and your concern just is it's going to look
11 funny to the jury and they're going to hold it
12 against you, but they're never going to hear
13 anything about it, then I may have a different
14 analysis.

15 MR. ROVNER: Well, I'm not
16 prepared at this point to say whether we will
17 use it or not, but we objected to the
18 interrogatories coming in as evidence. Mr.
19 Rhodes said they should.

20 Your Honor agreed. Now he wants
21 to pull it back. And we're the ones who are
22 going to suffer the prejudice, if anyone. I
23 don't think that's fair.

24 THE COURT: Okay. Mr. Rhodes.

1 MR. RHODES: I think that's an
2 absurd and shocking argument. The issue is
3 their claim chart in there. I missed it. It's
4 my error. I apologize.

5 So you're going to instruct the
6 jury on claim construction terms and how they
7 should use the law and the instructions. And I
8 just didn't realize that the claim -- it's --
9 their entire infringement chart is in there.

10 It would be 403 material to have
11 it in there before them. All I'm proposing is
12 we just give them a redacted version.

13 You can give whatever monitored
14 instruction you think would be appropriate.

15 THE COURT: How about I put the
16 blame on you?

17 MR. RHODES: Yes.

18 THE COURT: So I say Mr. Rhodes
19 realized this morning that he --

20 MR. RHODES: Absolutely.

21 THE COURT: -- included too much
22 stuff.

23 MR. RHODES: Absolutely, Your
24 Honor.

1 THE COURT: Okay. Mechanically
2 how will we do it, because the binders are with
3 the jury?

4 MR. RHODES: We should not have
5 any interaction with the jury materials. What I
6 would propose, I would give the Court -- we have
7 them -- redacted versions that have simply the
8 single line of fact that was relevant.

9 They're three-hole punched. We
10 could give them to the Court staff and suggest
11 that either at the end of the day or break,
12 whatever would be appropriate, for somebody on
13 the staff to do that.

14 We obviously should not have any
15 interaction with the material.

16 THE COURT: Right. All right.

17 Well, I'm going to give Mr. Rovner
18 one more chance before I rule on this, if he
19 wishes. But what I'm inclined to do is indicate
20 to the jury this morning that I've been informed
21 by Mr. Rhodes that he inadvertently by mistake
22 gave the wrong version of a document, whatever
23 one it is.

24 And so instead of it being however

1 many pages, it should just be two pages. And at
2 the break, my staff is going to switch out your
3 longer version for the now shorter version, and
4 make it very clear that it was Mr. Rhodes'
5 mistake.

6 MR. ROVNER: Well, Your Honor, Mr.
7 Rhodes is a little inconsistent, because he says
8 what he doesn't want the jury to see is the
9 claim construction chart.

10 I understand that. But he's
11 pulling out everything, but the one -- the two
12 answers that he read. Mr. Rhodes didn't even
13 read the questions to the jury.

14 But, you know, that's our position
15 and we do object for the record.

16 THE COURT: Okay. I understand
17 the objection. I'm going to overrule it and
18 we'll proceed in the manner that I indicated.

19 So I need to make sure that you
20 have sufficient copies to switch out to have my
21 staff switch out the version in the jury books,
22 which I will have them do at the first break.

23 MR. RHODES: Your Honor, may I
24 approach.

1 THE COURT: You may.

2 MR. RHODES: I believe I have ten
3 tabbed and three-hole punched versions of each
4 of the produced sets.

5 THE COURT: And tell me which ones
6 they are so I can point it out to the jury.

7 MR. RHODES: My apologies, Your
8 Honor. DTX 0969 and DTX 0963.

9 THE COURT: And they would be the
10 first two tabs in the book you gave them
11 yesterday?

12 MR. RHODES: Yes, I believe that's
13 correct.

14 THE COURT: And you may approach.

15 MR. RHODES: Thank you.

16 THE COURT: Anything else?

17 MR. RHODES: No, Your Honor.

18 THE COURT: Anything?

19 MS. KOBIALKA: I want to make sure
20 I don't know the -- functionally we switch them
21 out, will I be able to refer to the actual
22 exhibits on the cross? I do intend to use them.

23 THE COURT: Come forward to the
24 podium.

1 MR. KOBIALKA: Functionally I
2 wasn't sure when you were going to switch them
3 out. I was going to the refer to them just for
4 the question and the answer.

5 THE COURT: All right. I think
6 rather than delay them further, we'll switch
7 them at the break. I'm going tell them about it
8 first thing when they come in, and I take it you
9 don't plan to be referring them to any other
10 portion of those exhibits at this point.

11 MS. KOBIALKA: Right, unless for
12 some reason he raises something.

13 THE COURT: And I understand he's
14 not planning to do that.

15 MS. KOBIALKA: There may be other
16 subject matter that may be contained. I don't
17 know. I have to see what they do.

18 THE COURT: If you find yourself
19 thinking you're going to refer them to other
20 portions of the exhibit, let's have a sidebar
21 before you do that.

22 MS. KOBIALKA: Will do. Thank
23 you.

24 THE COURT: Anything else before I

1 bring the jury in? No? Okay.

2 (The jury entered the courtroom at
3 9:10 a.m.)

4 THE CLERK: All rise. You may be
5 seated.

6 THE COURT: Good morning, ladies
7 and gentlemen. Welcome back.

8 Before we begin with the
9 questioning this morning, one point. Mr. Rhodes
10 for Facebook shared with me this morning that
11 inadvertently yesterday, in the large binders
12 that you currently have that were passed out to
13 you in connection with the examination of
14 Mr. McKibben, the first two tabs, which are DTX
15 0963 and 0969, we've given you inadvertently
16 actually much longer documents than we intended.

17 And so at the break around 10:30,
18 10:45, one of my deputies is going to join you
19 in the jury room and just give you the
20 corrected, shorter version of those exhibits and
21 take back the longer versions.

22 And with that, Mr. Rhodes, you may
23 call your witness.

24 MR. RHODES: Thank you, and again

1 I apologize to the Court for my error.

2 We would recall Mr. McKibben to
3 the stand.

4 THE COURT: Good morning.

5 BY MR. RHODES:

6 Q. Good morning.

7 A. Good morning.

8 Q. Let's, if we could, ask
9 Mr. Katarski to put back on the screen DTX 179.
10 This is the -- you recall, Mr. McKibben, that we
11 were discussing this document yesterday toward
12 the end of your afternoon session.

13 A. Just trying to get there.

14 Q. 179. Are you with me?

15 A. Just refreshing my memory here.

16 Yes.

17 Q. And I apologize. I tend to make
18 mistakes. Did you say yesterday that you didn't
19 send this actually to the government?

20 A. Well, I believe what I said was
21 there were two copies of this in here, and there
22 was an earlier draft copy and then this copy
23 dated January 9th. I did send this one to a
24 website of DRBA.

1 Q. Was that website a security web
2 site? In other words, was it a secure upload of
3 the document?

4 A. It was a secure upload to the
5 Defense Department, yes.

6 Q. And this is a document that was
7 prepared by Leader for submission to the federal
8 government; correct?

9 A. It was a document prepared by
10 Leader at Wright-Patterson Air Force Base in the
11 University of Dayton Research Institute for
12 submission to DRBA.

13 Q. When it was submitted, you
14 understood that members of the federal
15 government would read and rely on it?

16 A. Yes.

17 Q. And you therefore understood the
18 importance of making sure everything in it was
19 absolutely correct; right?

20 A. Absolutely.

21 Q. May I ask that we turn to DTX 184,
22 please. Thank you, Ken.

23 The top of the document indicates
24 that this is an e-mail from Steve Hanna. Do you

1 see that?

2 A. I do.

3 Q. And if you just quickly turn to
4 the end of the second page of the document, at
5 the bottom there's a signature block for
6 Mr. Hanna. I want to blow it up.

7 Mr. Hanna at the time was the vice
8 president of the technology for Leader
9 Technologies; is that correct?

10 A. That is correct.

11 Q. So he was an officer and executive
12 with the company?

13 A. He wasn't exactly an officer, but
14 he was a senior manager.

15 Q. Vice president?

16 A. Of the subsidiary company, so yes.

17 Q. And he reported to you?

18 A. He reported to Jeff Lamb.

19 Q. Who reported to you?

20 A. Correct.

21 Q. Go back to the first page in the
22 section under general. There's a -- blow that
23 up, please.

24 It says "Mike and Jerry had

1 meetings and demos." Do you see that?

2 A. I do.

3 Q. Now, let's just take for a moment
4 the date of December 10, 2003, when the final
5 patent application was filed. Are you with me?

6 A. I'm listening.

7 Q. Before that time, you made many
8 presentations about Leader to Leader to many
9 people; right?

10 A. I made numerous presentations
11 about Leader to Leader, yes.

12 Q. And many of those were under
13 confidentiality agreements; correct?

14 A. All of them were under
15 confidentiality agreements.

16 Q. And indeed you had literally
17 hundreds of confidentiality agreements before
18 December 2003.

19 A. Probably more than that.

20 Q. Thousands?

21 A. Probably over a thousand.

22 Q. So over -- and they were all with
23 different people and entities?

24 A. Yes, usually.

1 Q. So before the patent application
2 was filed, you had over 1,000 different times
3 that you met with over 1,000 different folks to
4 talk about Leader to Leader; is that right?

5 A. Whenever we were speaking with
6 investors or potential suppliers or potential
7 customers, when we finished the product, prior
8 to those meetings, we would always get a
9 confidentiality agreement from them before we
10 disclosed any business trade secrets.

11 Q. Always?

12 A. Always.

13 Q. And always before the meeting?

14 A. That's correct.

15 Q. Never happened after the meeting?

16 A. Never.

17 Q. The purpose of these thousand
18 different meetings with 1,000 different parties
19 with 1,000 different contracts was to discuss
20 business opportunities for Leader to Leader;
21 right?

22 A. Well, you made some very broad
23 statements there. There weren't thousands of
24 contracts, and the way you characterize it is

1 probably incorrect, but we did have a lot of
2 presentations to potential investors, potential
3 suppliers or vendors, some developers that we
4 were talking to, and whenever we -- to build the
5 company, and whenever we did that, to protect
6 our trade secrets, we always had them enter a
7 confidentiality agreement so that we properly
8 protected our business trade secrets.

9 Q. Thank you. And many of those were
10 before December 1st of 2002, weren't they?

11 A. Yes.

12 Q. And many of those instances
13 involved discussions about someone buying or
14 licensing Leader2Leader; correct?

15 A. Well, those were prospective
16 discussions, and we couldn't have sold
17 Leader2Leader because it wasn't ready yet.

18 Q. Take a look at the -- if we go
19 down to the section that's says L2L. I think
20 it's two asterisks.

21 MR. RHODES: At the bottom, Ken.

22 BY MR. RHODES:

23 Q. Now, I take it where we see L2L,
24 that's a reference to the product Leader2Leader?

1 A. When our developers refer to the
2 body of code that we were developing around our
3 suite of technologies, that was their general
4 reference to the suite of technologies that we
5 were building.

6 MR. RHODES: Ken, do me a favor
7 and get rid of the Item 2. Just go through Item
8 1.

9 Thank you. There. That's fine.

10 BY MR. RHODES:

11 Q. The date of this document is
12 October 10, 2002, is it not?

13 A. Yes, it is.

14 Q. Okay. And the subject line of the
15 document is yesterday. Do you see that?

16 A. Yes, I do.

17 Q. That would be -- October 9, 2002
18 would be yesterday in this context?

19 A. I believe it would, yes.

20 Q. And then if we go down to where it
21 says **L2L, it says, we have verbally committed
22 to selling a system to Boston Scientific. Do
23 you see that?

24 A. I do.

1 Q. Now, that would be more than one
2 year before the final patent application was
3 filed; correct?

4 A. October 10th is, yes, before the
5 final patent was filed. Yes.

6 Q. And was Mr. Hanna lying in that
7 statement?

8 A. Mr. Hanna did not make a habit of
9 lying. No.

10 Q. We can look at that and believe
11 that that was a true statement as of October 10,
12 2002; right?

13 A. Well, I had not seen this before
14 this litigation, because it wasn't sent to me.
15 But in general I found Mr. Hanna always to be an
16 honest person.

17 Q. So as of October -- thank you.

18 I'm getting tired, so they're
19 trying to prod me up here.

20 October 10, 2002, Leader
21 Technologies had initially committed to selling
22 Leader2Leader to Boston Scientific; right?

23 A. Well, what Steve is referring
24 to --

1 Q. Correct?

2 A. There is a conversation that I had
3 with the security officer of Boston Scientific,
4 and that reference to L2L references a Smart
5 Camera discussion that I had with the security
6 officer at Boston Scientific.

7 So it included the Smart Camera
8 element of the Leader2Leader suite. It was a
9 plug in of the L2L reference there.

10 Q. Was LeaderPhone part of this
11 suite?

12 A. Not for what Steve is referring to
13 there, but we did also discuss LeaderPhone with
14 them.

15 Q. Is LeaderPhone part of the suite
16 that comprises Leader2Leader?

17 A. I think I just answered that.
18 We -- LeaderPhone was a plug in. Smart Camera
19 is a plug in.

20 Leader2Leader is a suite of
21 technologies, and we use that as the general
22 reference to the system that we were building.
23 But when we were talking with individuals, it
24 would be about the specific subject of that

1 discussion. And in that case, that was the
2 Smart Camera technology.

3 Q. Okay. But do you deny that as of
4 October 10, 2002, Leader Technologies committed
5 to selling a Leader2Leader system to Boston
6 Scientific?

7 A. What I just said was that we were
8 selling the Smart Camera technology aspect plug
9 in of Leader2Leader.

10 Q. Does it say Smart Camera in what
11 we're looking at up there?

12 A. It does not. No.

13 Q. Okay. Then let's go to the next
14 clause where it says, in general.

15 It says, the current level of
16 functionality is sufficient for the initial roll
17 out with Boston Scientific with some exceptions.
18 An then it says one being the implementation of
19 the Idea Registry.

20 Do you agree that as of October
21 10, 2002, the current level of functionality of
22 Leader2Leader was sufficient to be rolled out to
23 Boston Scientific?

24 A. For the Smart Camera section, yes.

1 Q. So there was real product and a
2 real customer and a real sale; right?

3 A. Well, it wasn't a sale because we
4 didn't have the product finished yet as Steve is
5 defining there.

6 Q. Okay. Let's take a look at the
7 next exhibit.

8 MR. RHODES: I would move into
9 evidence, Your Honor, DTX 184.

10 MS. KOBIALKA: No objection.

11 THE COURT: It's admitted.

12 BY MR. RHODES:

13 Q. Let's take a look at DTX 0776. Do
14 you see that, sir?

15 A. Yes, I do.

16 Q. This is another email from Mr.
17 Hanna who's a vice president of Leader
18 Technologies; correct?

19 A. Correct.

20 Q. And it's in October of 2002;
21 right?

22 A. Yes.

23 Q. More than one year before the date
24 that the final patent application was filed;

1 right?

2 A. That is correct.

3 Q. Okay. Take a look at --

4 MR. RHODES: Start. Stop, Ken.

5 BY MR. RHODES:

6 Q. The date is -- Monday, 11/25 is
7 the day before the day of the email, which is
8 November 26th. Do you see that?

9 A. Yes, I do.

10 Q. Okay. So he's writing it on the
11 Tuesday, but he's talking about what happened
12 the day before the Monday. Are you with me?

13 A. I am.

14 Q. Okay. So, now let's go to the
15 body of the document and the first very part
16 under general. Just the first few lines.

17 MR. RHODES: Ken, thank you.

18 BY MR. RHODES:

19 Q. And it says, yesterday, so that
20 would be November 25th; right, the Monday?

21 A. That's right.

22 Q. Okay. So where we see yesterday,
23 we know that's Monday 11/25. Mike, that's you;
24 right?

1 A. Yes.

2 Q. You met with Boston Scientific;
3 right?

4 A. I remember that meeting. Yes.

5 Q. And he says you were demoing.
6 That means demonstrating; correct?

7 A. I believe that would mean
8 demonstrating, yes.

9 Q. And you were demonstrating the
10 Leader2Leader functionality for senior staff
11 members; correct?

12 A. Yes.

13 Q. And senior staff members refers to
14 the folks that are at Boston Scientific;
15 correct?

16 A. That meeting was with information
17 technology people within Boston Scientific.

18 Q. Okay. Now, let's take --

19 MR. RHODES: I'm sorry. Your
20 Honor, I'll move into evidence DTX 0776.

21 MS. KOBIALKA: No objection.

22 THE COURT: It's admitted.

23 BY MR. RHODES:

24 Q. Let's now take a look at DTX 0736.

1 MR. RHODES: Just blow up the
2 first paragraph -- or yeah, that's fine, Ken.

3 BY MR. RHODES:

4 Q. Have you had a chance to look at
5 that one?

6 A. Yes, I have.

7 Q. All right. So this is a document
8 that's entitled Boston Scientific Confidential
9 Disclosure Agreement. Do you see that?

10 A. I do.

11 Q. What's the effective date?

12 A. November 26, 2002.

13 Q. That's the day after November 25;
14 right?

15 A. Generally.

16 Q. Yeah. And November 25 is the day
17 you gave the demonstration?

18 A. Yes, that's right. It was on a
19 Monday.

20 Q. So this document wasn't in place
21 in the point in time that you made the
22 demonstration, was it?

23 A. Well, this was the second
24 confidentiality agreement we had with them.

1 Q. Did you sign one before?

2 A. We had a confidentiality agreement
3 sometime in September when I met them the first
4 time.

5 Q. Why would you sign another one the
6 day after the meeting if there was already one
7 in place?

8 A. Well, we often do that with large
9 companies, because we're dealing with different
10 sections of the company as we have conversations
11 that roll through the organization.

12 Q. All right. So let's get this
13 right. So we saw that with the Wright-Patterson
14 Air Force Base, within a few days of that
15 demonstration, you signed a confidentiality
16 agreement. Do you recall that from yesterday?

17 A. What I recall, we had a
18 confidentiality agreement when we had a first
19 meeting.

20 Q. I'm trying to understand the
21 pattern. You sign a confidentiality agreement,
22 and you have a meeting and sign another one?

23 A. We were protective of our
24 technology during that period because we knew we

1 had something special, and we were taking extra
2 efforts to protect it; therefore, when you're
3 dealing with a large organization, you're
4 dealing with different people, and just because
5 you get a general corporate NDA, you try to
6 emphasize to the person you're talking to that
7 may not have seen the corporate NDA that this is
8 a proprietary conversation.

9 So we would often have multiple
10 nondisclosure agreements with these
11 organizations in order to emphasize the fact
12 that we had trade secrets we wanted to protect.

13 MR. RHODES: I'll move into
14 evidence DTX 0736.

15 MS. KOBIALKA: No objection.

16 THE COURT: Admitted.

17 MR. RHODES: Two more or three
18 more. DTX 182, and, Ken, let's be a little
19 careful with this one. Only show the from/sent
20 material above the hard line there for a moment.

21 BY MR. RHODES:

22 Q. This is, I assume, the e-mail
23 correspondence between you and your wife.

24 A. Yes, that's what it appears to be.

1 Q. And it's from December 3, 2002?

2 A. Right, yes.

3 Q. So once again this is more than
4 one year before the filing of the final patent
5 application; correct?

6 A. That's correct.

7 Q. Let's see if I can direct your
8 attention to page two, the third paragraph that
9 deals with Boston Scientific.

10 So a week before December 3rd,
11 there's a reference that you met with Boston
12 Scientific. Do you see that?

13 A. I do.

14 Q. That's the same meeting we were
15 just talking about of November 25th?

16 A. Yes, that is.

17 Q. And you talk about what they want
18 to use Leader2Leader files for. You say we are
19 exchanging a mutual NDA. That means you guys
20 are going to enter into a confidentiality
21 agreement; right?

22 A. Again we were going to enter into
23 another one, yes.

24 Q. Another one. And you say in the

1 parenthetical at the end, "Stop the presses.

2 Their NDA just arrived for my signature."

3 Right?

4 A. Okay.

5 Q. And that would be just -- the
6 sequence of steps is that on November 25th you
7 have the demonstration to the people at Boston
8 Scientific of the Leader2Leader technology;
9 right?

10 A. Yes, 25th. Yes.

11 Q. The confidentiality agreement that
12 arrived for your signature says on its face that
13 it's effective the day after, on November 26th;
14 correct?

15 A. On its face, it does say that.
16 Yes.

17 Q. And here you're telling your wife
18 that very document has just arrived for your
19 signature on December 3rd; right?

20 A. Yes, that's what I'm saying.

21 MR. RHODES: Your Honor, I move
22 into evidence DTX 182.

23 MS. KOBIALKA: No objection.

24 THE COURT: Admitted.

1 BY MR. RHODES:

2 Q. Let's take a look at DTX 766,
3 please. And again, Ken, start with the invented
4 e-mail first. This one is dated Sunday
5 December 8, 2002, and I'm sorry. These are
6 pedantic questions, but I have to ask them.

7 You agree with me that's one year
8 before the final patent application was filed?

9 A. I do.

10 Q. And it's from you, of course?

11 A. This is an e-mail to one of my
12 shareholders and a supplier of some of our
13 hardware.

14 Q. From you?

15 A. From me to John.

16 Q. When we see, "Hi, John,"
17 everything after that is your words; correct?

18 A. Let me check here. That is
19 correct, except for the response from John.

20 Q. Right, and John was one of the
21 shareholders in your company?

22 A. He is a shareholder and a supplier
23 of hardware.

24 Q. You were writing to him

1 essentially a status report?

2 A. That's what this appears to be,
3 yes.

4 Q. May I ask that you look to the
5 paragraph that's entitled The Limited.

6 It says -- now, The Limited is the
7 company that has this man named Len
8 Schlessinger; is that right?

9 A. Len Schlessinger is former
10 associate dean at Harvard Business School,
11 became chief operating officer at The Limited in
12 Columbus, yes.

13 Q. That's the name that we see in the
14 -- you say The Limited. We have confirmation
15 now from both the CEO, Len Schlessinger. Do you
16 see that?

17 A. I do.

18 Q. You say confirmation. Now, that
19 means the present tense as of December 8, 2002?

20 A. Yeah, I'm following up a meeting
21 we had with Len Schlessinger and John Richter,
22 chief information officer at the executive
23 level, so they decided to move forward with us
24 to try to do something with our suite of

1 technologies.

2 Q. And it says in the next sentence
3 the contract -- it sounds like you're saying we
4 will acquire a contract in January for the
5 implementation of Leader2Leader; right?

6 A. That was one of the decisions that
7 came out of that meeting.

8 Q. You say that meeting. Which
9 meeting? The one before December 8th?

10 A. The one I just spoke about.

11 Q. Before December 8th?

12 A. Before this e-mail, yes.

13 Q. So before December 8th, you had
14 made an offer to sell Leader2Leader to The
15 Limited.

16 A. That would have been impossible.
17 We didn't have it done yet.

18 MR. RHODES: I move into evidence
19 DTX 0766.

20 MS. KOBIALKA: No objection.

21 THE COURT: Admitted.

22 MR. RHODES: Let's look at DTX
23 185. Please blow up the header.

24 THE WITNESS: What's the number of

1 this one?

2 MR. RHODES: DTX 185, I believe.

3 Look under Tab 186. I do this all the time. I
4 put the wrong thing with the wrong thing. I had
5 it in my binder as 186.

6 THE WITNESS: I don't see any of
7 the numbers.

8 MR. RHODES: Just look at the
9 screen.

10 BY MR. RHODES:

11 Q. This is an e-mail dated
12 November 21, 2002. Do you see that?

13 A. Could I possibly have a copy of
14 it?

15 Q. Yes.

16 MR. RHODES: May I approach, Your
17 Honor?

18 THE COURT: You may.

19 THE WITNESS: Thank you.

20 MR. RHODES: You're welcome.

21 BY MR. RHODES:

22 Q. Mr. McKibben, I apologize. I say
23 things that sometimes are wrong, and I get
24 things disorganized.

1 A. No problem.

2 Q. This is -- we were just looking at
3 your status report in early December to your
4 shareholder, and one of the things you were
5 reporting on to your shareholder was about The
6 Limited; is that right?

7 A. I need to look at that.

8 Q. Okay. That was DTX 0766, the one
9 we were just looking at.

10 A. Yes.

11 MS. KOBIALKA: Objection. That's
12 not the right document.

13 THE COURT: Are you trying to
14 direct him back to the document you were just
15 examining him about?

16 MR. RHODES: I thought we were
17 looking at DTX 0766, was the prior one.

18 MS. KOBIALKA: Well, it's not a
19 shareholder report.

20 THE COURT: I see. Restate the
21 question.

22 MR. RHODES: I'm not sure what the
23 objection is. I think I've lost everybody.

24 BY MR. RHODES:

1 Q. Do you have 0766 in front of you?

2 A. 0766. I do.

3 Q. That's the e-mail from you to a
4 guy named John Butler?

5 A. That's correct.

6 Q. And he's your shareholder?

7 A. He's a shareholder and a supplier.

8 Q. And you were talking about The
9 Limited, among other things?

10 A. Yes, on a Sunday. This is an
11 e-mail thread, so I'm going to look at the
12 December 8th. Is that what you're referring to?

13 Q. Michael McKibben, Sunday,
14 December 8th, to John Butler. Status report to
15 your shareholder as the CEO of the company,
16 about, among other things, The Limited; right?

17 A. I see that now.

18 Q. Agree with me on that?

19 A. I see this. I'm not sure what
20 you're asking me to agree to.

21 Q. That on Sunday, December 8, 2002,
22 you sent writing to your shareholder in which,
23 among other things, you discussed The Limited.

24 A. Yes.

1 Q. Now, let's go back to DTX 186.

2 A. And I don't have a tab, but is

3 that --

4 Q. 185. It's the one I handed you.

5 A. Okay. Good.

6 Q. Does that say 185 on it?

7 A. Down at the bottom right, yes.

8 Q. Good. So this document is about
9 two weeks earlier; right?

10 A. Yes, two weeks earlier.

11 Q. And there's a discussion about The
12 Limited; right?

13 A. It's an e-mail to Len
14 Schlessinger.

15 Q. He's at The Limited?

16 A. He is.

17 Q. He's one of the top guys; right?

18 A. Chief operating officer at that
19 time. I believe he later became CEO.

20 Q. On December 8th, when you were
21 sending a status report to your shareholder, you
22 were telling one of the members of the company
23 that you already had a commitment to sell
24 Leader2Leader; right?

1 A. What I said was we have
2 confirmation now that they will acquire a
3 significant contract in January.

4 Q. And that's because on November
5 21st of 2002, as that exhibit tells us, you had
6 made a sweetheart deal. You had offered a
7 sweetheart deal; isn't that right?

8 A. Well, I mean, there's some other
9 conversations that occurred in between this
10 time, and we had other meetings. But if you're
11 referring to the November 21st meeting, yes
12 that's what it does say.

13 Sweetheart deal, it does say that.

14 Q. And when it says I'd, that's a
15 contraction for I would; correct?

16 A. I believe it is.

17 Q. And I is you, Michael McKibben?

18 A. That is correct.

19 Q. So Michael McKibben made an offer
20 to a senior executive at The Limited in what you
21 characterize as a sweetheart deal; right?

22 A. That is what that says, yes.

23 Q. And that was done more than one
24 year before the final patent application was

1 filed; right?

2 A. What we were offering here was a
3 \$10 million financing for this.

4 Q. Well, take a look at the
5 Leader2Leader discussion right here. It says,
6 May I suggest -- this is the second sentence.

7 May I suggest that Limited
8 purchase the licenses for 2,000 Leader2Leader
9 user-seats for three years. Do you see that?

10 A. Yes, I do. That's what it says.

11 Q. So we have a term of years, three
12 years; right?

13 Right?

14 A. That is what it says.

15 Q. We have a number of units, 2,000
16 licenses; right?

17 A. Yes.

18 Q. And we have a product called
19 Leader2Leader?

20 A. Which is a suite of products. And
21 if you look down at the fourth, the fifth bullet
22 below that, you will see a description of a
23 number of the different elements of
24 Leader2Leader that we were offering as a part of

1 that Leader2Leader reference, like email, fax,
2 file exchange, bulletin boards news, ideas,
3 feedback, security, support for handhelds.

4 All of those things were in
5 discussion as a part of that reference to
6 \$20.83.

7 Q. And the word purchased means to
8 buy; right?

9 A. I believe that is the -- one of
10 the definitions of purchase. Yes.

11 Q. And then you have the word offer
12 right here; correct?

13 A. Mm-hmm.

14 Q. That's -- you need to answer
15 audibly, sir.

16 A. Pardon?

17 Q. You need to answer audibly. When
18 you say uh-huh --

19 A. Oh, yes.

20 Q. And then your characterization of
21 what followed, that's a colon right there;
22 right?

23 A. Yes, it is a colon.

24 Q. So that means that this language

1 is modifying what follows; right?

2 A. I'm getting confused.

3 Q. Whatever is -- whatever is after
4 that colon is what you call a sweetheart deal;
5 right?

6 A. One must read an entire
7 communication in context and that is halfway
8 down through the email.

9 MR. RHODES: I thank you for your
10 time. I appreciate it.

11 THE COURT: Thank you.

12 Cross-examination.

13 MS. KOBIALKA: Can I just have a
14 moment to get set up here?

15 THE COURT: Certainly.

16 MR. RHODES: Your Honor, I forgot
17 to move in DTX 179 and 185.

18 MS. KOBIALKA: No objection, Your
19 Honor.

20 THE COURT: Okay. They're
21 admitted.

22 MS. KOBIALKA: Wish me luck in
23 opening this properly.

24 MS. KEEFE: Paul, there's another

1 one behind you. Just take the pad off.

2 MS. KOBIALKA: Thank you.

3 MS. KEEFE: Sure.

4 MR. ANDRE: How many lawyers does
5 it take to set this up?

6 THE COURT: How many -- who hasn't
7 heard that one.

8 MR. RHODES: It's usually a light
9 bulb, though.

10 MR. ANDRE: Yeah, a bad joke.

11 THE COURT: More than two.

12 MS. KEEFE: Go sideways. It will
13 stay up.

14 MS. KOBIALKA: That will work.

15 MR. ANDRE: That will work.

16 MS. KOBIALKA: Can everyone see
17 that?

18 THE COURT: Okay.

19 CROSS-EXAMINATION

20 BY MS. KOBIALKA:

21 Q. Mr. McKibben, can you see that
22 okay as well?

23 A. I can.

24 Q. I apologize that it took a moment

1 to get set up.

2 Mr. McKibben, you've been asked a
3 lot of questions yesterday and today about
4 Leader2Leader. And there was one very important
5 question that hadn't been asked yet which is:
6 Is Leader2Leader exactly the same thing as the
7 technology of the '761 patent?

8 MR. RHODES: Objection, Your
9 Honor. Leading.

10 MS. KOBIALKA: This is
11 cross-examination.

12 THE COURT: Overruled.

13 THE WITNESS: No.

14 BY MS. KOBIALKA:

15 Q. Okay. So we probably need to
16 discuss a little bit about what, in fact,
17 Leader2Leader is and then how that plays with
18 respect to the technology in the '761 patent; is
19 that right?

20 A. That is correct.

21 Q. Okay. I believe you mentioned
22 that Leader2Leader is a suite of technologies
23 that falls under a brand; is that right?

24 A. That is correct.

1 Q. And I think it's helpful if we
2 take a look at what you mean by that. What do
3 you mean by a brand?

4 A. Well, in this case, Leader2Leader
5 was a brand name that we acquired from the
6 Patent & Trademark Office. And we use it in the
7 similar way you would use a name for any kind of
8 product line or suite of products.

9 And it's a name you apply to, in
10 this case, multiple technologies that we were
11 developing simultaneously.

12 Q. Okay. So let's say prior to when
13 you filed the provisional patent application,
14 and what date was that?

15 A. December 11th, 2002.

16 Q. Okay. So December 11th, 2002.

17 And prior to that date, what
18 technologies fell under this Leader2Leader
19 brand? And I'm going to go over here and see if
20 I can help demonstrate it.

21 A. Okay. Well, as I was pointing out
22 in Mr. Rhodes' question on Mr. Schlesinger's
23 email, we had many brand names under the
24 umbrella of Leader2Leader. For example,

1 LeaderPhone, LeaderMail.

2 MR. ANDRE: Your Honor, may I --

3 THE COURT: You may help.

4 MR. ANDRE: Sorry.

5 MS. KOBIALKA: My apologies.

6 Sorry. This thing is about as big as I am.

7 All right. Everyone can see that?

8 BY MS. KOBIALKA:

9 Q. So we had, all right,

10 Leader2Leader. You mentioned LeaderPhone?

11 A. Right, LeaderPhone.

12 Q. What else was there?

13 A. LeaderMail.

14 Q. Do you have another example?

15 A. Leader Smart Camera.

16 Q. Anything else?

17 A. Then there would be LeaderFile.

18 Q. Okay.

19 A. LeaderNews.

20 Q. All right.

21 A. Leader -- I can keep going.

22 Q. All right. But there was all

23 different technologies that included this Leader

24 name in it --

1 A. Yes.

2 Q. -- that fell under this brand. So
3 this is overarching brands; correct?

4 A. Correct.

5 Q. And so it could include
6 LeaderPhone?

7 A. Yes.

8 Q. It could include LeaderFile?

9 A. Yes.

10 Q. LeaderMail? Leader Smart Camera?

11 A. Yes.

12 Q. Could it include LeaderVoicemail?

13 A. Yes. It could.

14 Q. LeaderChat?

15 A. Yes.

16 Q. LeaderContact?

17 A. Yes.

18 Q. So there was a variety of things?

19 A. A variety of things.

20 Q. And so when you're talking about
21 the suite of technologies, LeaderPhone is just
22 an example of one of those technologies;
23 correct?

24 MR. RHODES: Objection. This is a

1 friendly witness.

2 THE COURT: It's
3 cross-examination. Overruled.

4 MS. KOBIALKA: Thank you, Your
5 Honor.

6 THE WITNESS: I'm sorry. Can you
7 repeat the question?

8 BY MS. KOBIALKA:

9 Q. When you're talking about the
10 suite of technologies, LeaderPhone is just one
11 of those technologies as an example?

12 A. That's correct.

13 Q. Okay.

14 A. You could put them together any
15 way you wanted to.

16 Q. Okay. Now, was LeaderPhone, could
17 that be sold just separately and apart from
18 Leader2Leader?

19 A. Yes, it could. And it is.

20 Q. Okay. At some point, you had the
21 technology of the '761 patent; correct?

22 A. On December 11th, 2002, we did.
23 Yes.

24 Q. Okay. And then you had a product

1 that embodied the technology of the '761 patent;
2 correct?

3 A. We could -- we could use that as a
4 plug in for any of those technologies.

5 Q. Okay. But you did get some sort
6 of other technology at some point; right?

7 A. Yes.

8 Q. Okay. So then that was a plug in,
9 so it would be another just -- just another part
10 of the --

11 A. Leader2Leader. Right. It could
12 be a plug in for Leader2Leader, for all of them,
13 or it could be a plug in for any one of them.

14 Q. So we can't equate Leader2Leader
15 with the technology of the '761 patent; right?

16 A. No, we can't.

17 Q. You've got to actually be specific
18 about what we're talking about when we're
19 talking about Leader2Leader; correct?

20 A. Exactly.

21 Q. Now, why did you just use
22 Leader2Leader as a name, then, in documents or
23 in talking to people?

24 A. Well, as we developed our

1 technology, we started realizing that this
2 technology had a lot of parts. And giving them
3 all individual names was good, but when you're
4 talking to people, like investors and potential
5 vendors and things like this, it became too
6 awkward to talk about all of those products and
7 give them a long litany of names every time.

8 So what we did is we put it under
9 the umbrella of Leader2Leader. And you see that
10 all the way through our documents, we just refer
11 to everything as Leader2Leader.

12 Q. But it meant whatever the suite of
13 technology was at that time when you referred to
14 Leader2Leader; correct?

15 A. It did. And it also meant
16 whatever we were talking with an individual
17 prospect about.

18 For example, with the first
19 conversation with Boston scientific about the
20 smart technology.

21 Q. We'll get to some of these
22 individuals.

23 Technologies like Leader phone.
24 Do they have separate patent applications?

1 A. They do.

2 Q. So you have --

3 THE COURT: There's an objection.

4 MR. RHODES: Objection. 403.

5 Beyond the scope of the 402.

6 MS. KOBIALKA: Your Honor, they've
7 introduced a number of documents that suggest
8 that the only patent that they had or technology
9 that they had under this whole suite --

10 THE COURT: I'm going to sustain
11 the objection.

12 BY MS. KOBIALKA:

13 Q. What was the first product in the
14 suite of technologies of Leader2Leader that you
15 first commercialized and began to sell?

16 A. That product would have been
17 Leader Phone.

18 Q. What is Leader Phone?

19 A. Leader Phone is a piece of this
20 Leader2Leader suite that specifically offers
21 audio conferencing technologies. Conference
22 calling.

23 Q. So I actually think we should do a
24 timeline. I might not have the camera on just

1 right.

2 So you founded the company
3 sometime in 1997; is that right?

4 A. Yes, that's correct.

5 Q. And when did the patent issue for
6 the -- we'll find it. It will be on there at
7 some point. There it is.

8 And when did the patent issue?
9 The 761 patent.

10 A. November 23rd, 2006.

11 Q. So November 2006. And when did
12 you file the provisional patent application?

13 A. On December 11, 2002.

14 Q. Okay. There was reference earlier
15 in questions about the final patent application.
16 The final application was in connection with the
17 filing that occurred after, I believe, it was
18 December 10, 2003.

19 Do you believe that the
20 December 11, 2002, wasn't the filing of the
21 patent application that led to the 761 patent?

22 A. We never thought of it that way.

23 Q. So prior December 11, 2002, when
24 you referred to Leader2Leader, did that include

1 the 761 technology that's a plug-in to
2 Leader2Leader?

3 A. No, it couldn't have because that
4 technology wasn't done until days before the
5 December 11, 2002, filing.

6 Q. How do you know that?

7 A. I vividly remember that because
8 this had been a long R and D cycle, and we had
9 been struggling during 2002 to get the code
10 ready, and we ran into some more difficulties,
11 so we were working into the fall.

12 And within days of actually
13 getting the code working, the technology
14 working, we actually pulled a section of that
15 code out of the working code and put it into the
16 provisional patent, and we went to the patent
17 office.

18 Q. That's all the pages of code we've
19 been seeing on that provisional patent
20 application?

21 A. Yes.

22 Q. You wanted to make sure you had
23 your code before you did the filing?

24 A. So that would tell a computer

1 science person how the system works.

2 Q. Now, the technologies that fell
3 under Leader2Leader change and develop over
4 time?

5 A. Certainly. That's the nature of
6 any software R and D project. You start small
7 and keep growing and solve problems and come
8 down blind alleys and come back. As we did
9 that, the technology grew, and as it grew, we
10 got more and more excited about our invention.

11 Q. Can you give me an analogy for a
12 brand that's changed over time.

13 A. Well, yeah, as an example, I
14 understand that this Leader2Leader brand
15 question is what were we talking about, so for
16 example, let's take the Corvette.

17 Corvette today is a great brand
18 name. It's been a brand name around for many
19 decades, and today it has blue tooth. But in
20 2002, I don't believe it had blue tooth phone
21 technology, so between that time, you've got the
22 same brand, but the technology is changed, and
23 that's the basis on which there's a difference
24 when you refer to Leader2Leader, as to what's

1 under the hood.

2 Q. Okay. So prior to December 11,
3 2002, was there any technology in Leader2Leader
4 that could permit someone to move from one work
5 space to another work space?

6 A. No, it wasn't done yet.

7 Q. Or move from board to board within
8 the system?

9 A. No, that technology was not done
10 until a few days before December 11, 2002.

11 Q. You couldn't track any movement
12 obviously since you didn't have that movement;
13 right?

14 A. It was not finished until right
15 before 2002. That is correct.

16 Q. At some point, you had a version
17 of the software; right? Is that correct?

18 A. Yeah, right around that time
19 December 11th.

20 Q. Okay. And you started to do some
21 beta testing of that software; right?

22 A. Yeah, what happens after that is
23 we had an experimental version then, so we
24 started doing experimental testing first inside

1 our company, and then as 2003 rolled around, we
2 started talking to a few companies about
3 participating in this experimental beta program
4 to continue to refine the invention.

5 Q. What do you mean by beta program?

6 A. Well, in software, first you build
7 it, and then you want to start testing it. And
8 so us in the computer science world, we break
9 that testing into two parts.

10 And the first part is when you
11 just do it internally and just test it among
12 your employees. That's called an alpha test,
13 alpha examination test.

14 And once you feel like you have
15 bugs worked out, you give it to a few third
16 parties who are usually friendly and will put up
17 with things not working right and crashing and
18 bugs, and you put it out for testing, and that's
19 what we started doing in early 2003.

20 Q. Around that same time in 2003, did
21 you also publish a white paper entitled "What
22 Convergence Was Meant To Be"?

23 A. I do recall publishing that paper,
24 yes.

1 MS. KOBIALKA: And, Your Honor,
2 may I approach?

3 THE COURT: The witness? Yes, you
4 may.

5 BY MS. KOBIALKA:

6 Q. Do you have that document in front
7 of you currently?

8 A. I do.

9 Q. We've marked that as PTX 1240, and
10 you authored this particular document?

11 A. Yes, I did.

12 MS. KOBIALKA: At this time, Your
13 Honor, I'd like to move this into evidence.

14 MR. RHODES: No objection.

15 THE COURT: Admitted.

16 BY MS. KOBIALKA:

17 Q. We had looked at some
18 interrogatory responses yesterday, so I'd like
19 to point to those. That was DTX 963 and DTX
20 969. Maybe we could pull up 963.

21 What I'm interested in looking at
22 was the question -- what the actual
23 interrogatory was. That would be for
24 interrogatory number nine.

1 A. I believe it was the first tab in
2 the big binder?

3 Q. That's correct.

4 So, Mr. McKibben, is it correct to
5 say you were asked, "For each claim of the 761
6 patent that LTI contends is practiced by
7 any products and/or services of LTI,
8 identify all such products and/or
9 services and provide a chart specifying
10 where each limitation of each claim is
11 found within the product."

12 Is that correct?

13 A. That's what I read.

14 Q. And what did you understand you
15 were being asked with respect to that
16 interrogatory?

17 MR. RHODES: Objection, Your
18 Honor. I'm going to object to that as a
19 conclusion, and I renew my objection of her
20 leading of 611(c).

21 THE COURT: I overrule the
22 leading.

23 Ms. Kobialka, calling for
24 conclusion?

1 MS. KOBIALKA: I asked his
2 understanding of what was being asked of him.

3 THE COURT: Overruled. You can
4 answer the question if you recall it.

5 THE WITNESS: I recall.

6 It's being asked what aspects of
7 our products and/or services today practice the
8 761 patent today.

9 BY MS. KOBIALKA:

10 Q. Today. So what do you mean by
11 today?

12 A. Well, I mean, the question had to
13 have occurred -- they're asking about the 761
14 patent, which did not issue until November 23,
15 2006. So this question had to refer to whatever
16 our products and services were after
17 November 23, 2006, and so that was the answer I
18 gave.

19 Q. If we go down to the response
20 where it says "Leader2Leader powered by Digital
21 Leaderboard engine is covered by the 761
22 patent." Do you see that?

23 A. I do.

24 Q. Was that an accurate statement

1 when you answered that response?

2 A. It is because we did do
3 Leader2Leader powered by Digital Leaderboard,
4 and we did use the technology after December 23,
5 2006.

6 Q. Is that a true statement today in
7 2010?

8 A. Yes, it is.

9 Q. And is that a true statement in
10 2008?

11 A. Yes, it was.

12 Q. And would it have been a true
13 statement in 2007?

14 A. Yes, I believe so.

15 Q. Would that have been a true
16 statement prior to December of 2002?

17 A. No, it could not have because that
18 technology of the 761 patent did not exist at
19 that time.

20 Q. Now, we heard a lot of questions
21 about demonstrations that you had done, and you
22 mentioned something about NDA. What are you
23 talking about when you say NDA?

24 A. It's a very common practice in the

1 software business where you're building
2 something that takes, sometimes, years to build,
3 and you're the trying to raise money to pay your
4 programmers and feed your staff, that you go out
5 and you talk to investors to get money to be
6 able to pay your bills.

7 And so the practice in our
8 business is to, if you're going to do that and
9 still protect your intellectual property, the
10 first thing you have to do before you present
11 any of your business information to that third
12 party is you get them to agree to a
13 confidentiality agreement.

14 The shorthand is NDA. It means
15 nondisclosure agreement. People refer to it as
16 NDA, but it's a confidentiality agreement where
17 that person is willing to agree to the trade
18 secret laws of the United States where you can
19 have confidential information.

20 Q. Did Leader have an NDA policy in
21 place?

22 A. We did.

23 Q. Starting from when?

24 A. From the inception of the company.

1 Q. And you were a bit paranoid about
2 protecting confidential and proprietary
3 information.

4 A. I have been accused of being
5 paranoid.

6 Q. And that you also required your
7 family members to sign NDAs as well?

8 A. I do.

9 Q. Did your daughter, who was an
10 intern at Leader, sign an NDA?

11 A. She did.

12 Q. How many NDAs do you think you
13 have currently?

14 A. The last count was about 2400.

15 Q. Was it your understanding this NDA
16 was intended to protect all of the different
17 technologies that were confidential and
18 proprietary to Leader?

19 A. Yes. It's my understanding of the
20 non-disclosure agreements that they protect all
21 business information in the company, whether
22 it's financials, whether it's technology,
23 whether it's sales plans, business strategy.
24 Whatever it is, it protects it.

1 Q. And on your presentation, did you
2 mark anything to indicate that the information
3 you would be providing was confidential or
4 proprietary?

5 A. I did on every presentation. I
6 marked it proprietary confidential.

7 Q. And that was your practice?

8 A. And that was my firm practice.

9 Q. And later did you also indicate it
10 might be trade secret information as well in the
11 legend of the presentation?

12 A. Well, it is my understanding that
13 proprietary means that you're presenting trade
14 secrets. But, yes, I would also emphasize that
15 by adding the trade secret words to it as well.

16 Q. Now, was there a lawyer that
17 represented Leader named Professor Chandler at
18 some point?

19 A. Yes. He started representing us
20 very early.

21 Q. Could you just give us a short
22 very brief background? Who was Professor
23 Chandler?

24 A. Professor Chandler is a professor

1 emeritus of law, intellectual property law at
2 George Washington University. He also taught at
3 Harvard and a number of academic institutions.

4 When I met him, he was on
5 President Clinton's National Infrastructure
6 Protection Council. And so he is an expert on
7 the area of trade secrets.

8 Q. Was he one of the authors of The
9 Trade Secrets Act?

10 A. He was.

11 Q. Did you believe Leader was in good
12 hands since Professor Chandler was Leader's
13 counsel working closely with Leader to protect
14 the patentable technology and trade secret
15 information?

16 A. That is why we went to Professor
17 Chandler, because I was looking for the best in
18 the business to protect our property.

19 Q. Did Professor Chandler ever attend
20 any of the meetings or presentations that you
21 had done?

22 A. He did on occasion.

23 Q. For example, did he attend any
24 meetings with Boston Scientific?

1 A. He attended my very first meeting
2 with Boston Scientific.

3 Q. Is it correct to say you would
4 never do a demonstration of any of the
5 proprietary technology of Leader unless there
6 was an NDA in place?

7 A. I never presented our technology
8 without a confidentiality agreement in place.

9 Q. And during any of the
10 demonstrations that you did prior to December
11 11, 2002, did you ever show anyone what was
12 under the hood, so to speak, of the
13 Leader2Leader technologies?

14 A. Well, prior to that time, it
15 didn't exist. So I couldn't have shown it.

16 Q. Well, I'm talking about just
17 Leader2Leader generally, I'm not referring to
18 the technology of the '761 patent. So let me
19 try that again.

20 A. Oh, okay.

21 Q. During any of your demonstrations
22 prior to December 11th, 2002, did you ever show
23 anyone what was under the hood of Leader2Leader?

24 A. We showed different aspects,

1 different parts of the suite. Yes.

2 Q. So you showed source code, for
3 example?

4 A. Oh, no. We never showed source
5 code.

6 Q. Okay. So maybe my under the hood
7 is not a very good way.

8 Did you ever show them the inner
9 workings of how the technology worked?

10 A. I didn't want to put people to
11 sleep.

12 Q. Okay. Well --

13 A. No. I never did that.

14 People weren't very interested in
15 seeing source code. They wanted to know how it
16 helped them.

17 That's why people want to see
18 demonstrations.

19 Q. So did anyone ever ask you, Can I
20 see the source code or the inner workings of the
21 technology of the '761 patent?

22 A. Certainly nobody ever asked for
23 source code because they knew I would never do
24 it.

1 Q. So was -- the only thing that you
2 ever showed for Leader2Leader, the suite of
3 technologies at any time, was just what the user
4 would see on a computer?

5 A. Yeah. Generally these meetings
6 would be only an hour to present everything
7 about our business, our strategy, our idea for
8 the company and what their investment
9 opportunity was.

10 So generally during that, we would
11 do a very short demonstration. People wanted to
12 see, okay, well, they're trying to get a handle
13 of what is it and how it might help them.

14 So I would usually show a couple
15 screens. It never usually got past a couple of
16 screens.

17 Q. And the screens don't actually
18 tell you what's going on in the back end; right?

19 A. No, just what the user sees.

20 Q. Did you ever do a demonstration of
21 the technology of the '761 that was a plug in
22 to Leader2Leader once you had it?

23 MR. RHODES: Objection, Your
24 Honor.

1 THE COURT: Hold on a second.

2 MR. RHODES: As a phrase,
3 technology of the '761, I thought we were
4 talking about the products, Leader2Leader.

5 THE COURT: Sustained. Let's
6 restate the question.

7 BY MS. KOBIALKA:

8 Q. At any time, did you ever
9 demonstrate the '761 technology that was plugged
10 in to Leader2Leader?

11 MR. RHODES: Objection. Same
12 objection.

13 THE COURT: Overruled. If you can
14 answer the question, answer it.

15 MS. KOBIALKA: Thank you.

16 THE WITNESS: Yes, we did. After
17 December 11, 2002, that technology was working.
18 And as I recall, the very first time we ever
19 showed the actual working technology was in the
20 advanced technology lab at The Limited to about
21 10 or 15 of their technology researchers.

22 BY MS. KOBIALKA:

23 Q. Let's talk about Wright Patterson.
24 So you had a meeting, I believe, with Wright

1 Patterson around April 2 of 2001; correct?

2 A. As I recall, that was our first
3 contact with Wright Patterson. Yes.

4 Q. Okay. And we had looked at one of
5 the NDAs that you had with Wright Patterson. It
6 was PTX 1058.

7 If you want to take a look at
8 that. You want to look on the screen?

9 That might --

10 A. Oh, okay. Okay.

11 Q. Yeah.

12 A. Yes.

13 Q. And you remember seeing this
14 particular NDA?

15 A. I do.

16 Q. The meeting that you had on April
17 2nd, 2001, was it with Mr. Fleser?

18 A. No. I had not met him yet.

19 Q. Okay. Who was at that meeting?

20 A. The person at that meeting was
21 invited by the senior people from University of
22 Dayton to attend. And he was the top civilian
23 at the Wright Patterson Air Force Base. His
24 name was Vincent Russo.

1 Q. Did you obtain an NDA for Mr.
2 Russo?

3 A. I did.

4 MR. KOBIALKA: Your Honor, I'd
5 like to approach and provide this to the
6 witness.

7 THE COURT: You may.

8 MS. KOBIALKA: It is part of DTX
9 725, which had numerous exhibits. So I'd be
10 happy to re-mark it as a PTX number so we don't
11 have to mark 2,000 of --

12 THE COURT: It's fine. Keep it as
13 it is.

14 MS. KOBIALKA: So this is DTX 725,
15 and it starts with Bates number LTI 153001
16 through 3003.

17 BY MS. KOBIALKA:

18 Q. Is this the NDA that you had with
19 Mr. Russo?

20 A. Yes. Not that one.

21 Q. It's in the middle of the
22 document.

23 MS. KOBIALKA: At this time, Your
24 Honor, I'd like to move in, I guess, the entire

1 Exhibit 725 into evidence.

2 MR. RHODES: No objection.

3 THE COURT: It's admitted. We're
4 still trying to get the correct page on the
5 screen; is that correct?

6 MS. KOBIALKA: That's correct.

7 BY MS. KOBIALKA:

8 Q. While we're getting the correct
9 page up on the screen, that meeting on April
10 2nd, 2001, did you disclose any of the
11 technology of the '761 patent?

12 A. No, it was impossible. It didn't
13 exist then.

14 Q. Did you demonstrate it?

15 A. It didn't exist. I did a demo.

16 Q. What did you demonstrate to them?

17 A. Some of the elements of
18 Leader2Leader.

19 Q. Now, you had talked about a White
20 paper and there was a Quad paper in connection
21 with DARPA.

22 A. Right.

23 Q. What is DARPA?

24 A. It's a -- it's the primary funder

1 of advanced technology research run by the
2 Department of Defense.

3 Q. And can we take a look at DTX 179?
4 And that is in the jury binders.

5 Do you have it in front of you?

6 A. Yes, I do.

7 Q. Okay. I'd like to take a look at
8 the page that has the Bates number on the bottom
9 48199. If you could take a look at the second
10 paragraph from the bottom where it says WPAFB,
11 which is I believe Wright Patterson Air Force
12 Base will use the LeaderPhone services within
13 its fire walls. WPAFB will become a classical
14 beta customer for the full Leader2Leader
15 platform and will receive commensurate licenses
16 to do so.

17 Do you see that?

18 A. Yes, I do.

19 Q. What specific technology were you
20 talking about in this document?

21 A. I was talking about various
22 elements of the Leader2Leader platform as you
23 illustrated up on the easel that we were showing
24 to them and they were expressing interest in.

1 Q. How do you know it didn't include
2 the technology of the '761 patent?

3 A. Because that technology didn't
4 exist yet, so it couldn't have.

5 Q. So was this a joint -- I heard --
6 I believe you testified yesterday this was some
7 sort of a joint development project?

8 A. Right.

9 Q. Okay. What were you guys
10 discussing about what you were going to jointly
11 develop together?

12 A. Well, at that time, this was right
13 after the September 11th terrorist attack. And
14 they were interested in talking to us about
15 using some of our technologies in conjunction
16 with some of their other research to help the
17 problem that was identified by the 9/11 disaster
18 in getting different intelligence agency data to
19 speak -- to talk together basically.

20 Q. And let's flip towards the end.
21 It's Page 9 of this document, which is entitled
22 Project Plan Management Milestones and
23 Deliverables.

24 Okay. Do you see that?

1 A. I do.

2 Q. And just below that, it says, This
3 BA A is a one-year contract with a five-year
4 tail. All of the heavy development work will
5 occur in the first 12 months. The ensuing five
6 years of the tail will entail some hardware
7 upgrading as well as ongoing Leader2Leader
8 licensing and a support contract.

9 Why did you put that in the
10 document?

11 A. We were the -- DARPA has very
12 stringent presentation parameters that you have
13 to follow when you submit one of these
14 proposals. And these were some of the areas
15 that we had to address in the requirements,
16 especially as it related to any of our
17 technology that we would be contributing to the
18 joint venture.

19 Q. And can we take a look at the full
20 page there? There's a chart.

21 It looks like maybe some
22 projections. What is this?

23 Let's just look at the whole
24 document. What is this chart below what we just

1 read?

2 A. This is the BAA funding
3 requirement for showing how the funds would be
4 used if they were provided by DRPA to fund this
5 project, and it needed to include all the key
6 elements of what is called the use of proceeds.

7 Q. So when we see Leader2Leader
8 licenses 8.4 million, what is that referring to?
9 Is that actual price for the product?

10 A. No, that is a budget number
11 applied to whatever would be decided to be the
12 elements of the Leader2Leader suite that Wright
13 Patterson would want to have included in the
14 final product, and that puts a number on that
15 just so DRPA can get an idea of the scale of the
16 project.

17 Q. Now, I see where it says Table 2,
18 BAA funding request. Do you see that?

19 A. Yes, I do.

20 Q. What is BAA funding request
21 referring to?

22 A. BAA is the way DRPA solicits
23 proposals. DRPA funds very cutting-edge,
24 sometimes people say bleeding-edge,

1 technologies. They don't fund things that are
2 ready to go.

3 What they do is, they look way out
4 in the future, and they say we need to get
5 better technologies to defend this country. And
6 what they do is, they say -- we put out these
7 broad agency announcements. That that's what
8 BAA stands for.

9 They say, if you've got an
10 innovative idea, come to us with it. The United
11 States needs your ideas, and therefore, they've
12 created this mechanism for presenting these kind
13 of proposals to DRPA.

14 Q. BAA stands for broad agency
15 announcement?

16 A. Yes.

17 Q. When you submit one of these
18 requests, is it a multistep process you have to
19 undergo?

20 A. Yes, this is the very first step.

21 Q. So the very first step. Does that
22 include a technical proposal that sets forth the
23 objective and you're also required to provide
24 the author's statement of work, and you're also

1 required to provide a cost proposal?

2 A. Yes.

3 Q. Do you recall the next step after
4 that?

5 A. They come back to you with their
6 assessment of what you've presented and tell you
7 whether they're interested or not.

8 Q. Do you recall what the next step
9 is after that?

10 A. There are a lot of steps in the
11 proposals.

12 Q. I'd like to show the witness PTX
13 1234. Maybe that will help refresh your memory.

14 MS. KOBIALKA: May I approach?

15 THE COURT: You may.

16 BY MS. KOBIALKA:

17 Q. What do you have in front of you
18 there?

19 A. It says broad agency announcement
20 and program research and development industry
21 guide.

22 THE COURT: Mr. Rhodes.

23 MR. RHODES: I object to the
24 document because it lacks foundation. It's not

1 his.

2 THE COURT: Has it been admitted.

3 MR. RHODES: It was on the list.

4 THE COURT: It was on the exhibit
5 list. Objection has been overruled.

6 MS. KOBIALKA: So --

7 THE COURT: You may use the
8 document.

9 MS. KOBIALKA: Thank you, Your
10 Honor.

11 BY MS. KOBIALKA:

12 Q. So if we could turn to page -- I
13 believe it is fourteen of the exhibit, entitled
14 technical and cost negotiations.

15 And does this help you remember
16 now what is the next step in this whole process
17 to get a funding request?

18 A. I generally remember now that the
19 next step would be a whole group of negotiations
20 around the initial proposal to see what would be
21 in, what would be out, what Wright-Patterson
22 would be interested in, what they wouldn't be
23 interested.

24 Q. So that initial white paper and

1 request for funding that you provide to the
2 government. Is that something that they could
3 just accept right there?

4 A. No.

5 Q. And to be clear, it did not
6 include any of the technology of the 761 patent;
7 correct?

8 A. That is correct.

9 Q. Okay. And I think we can now just
10 see very quickly the portion of Exhibit 725
11 which is the NDA of Mr. Russi. Do you see that?

12 A. I do.

13 MS. KOBIALKA: Your Honor, at this
14 time I'd like to move exhibit PTX 1234 into
15 evidence.

16 THE COURT: That was the one --
17 that's not the one we're looking at now?

18 MS. KOBIALKA: Correct.

19 THE COURT: Earlier one.

20 Objection?

21 MR. RHODES: I did object.

22 THE COURT: Overruled. It's
23 admitted.

24 MS. KOBIALKA: And we will prepare

1 jury binders so we can provide hard copies we
2 moved in because we didn't know what we would be
3 able to have.

4 THE COURT: Fine.

5 BY MS. KOBIALKA:

6 Q. Now, you had mentioned that part
7 of the DRPA proposal included discussions with
8 the University of Dayton; correct?

9 A. That is correct.

10 Q. And there were meetings with
11 University of Dayton in 2001; is that right?

12 A. There were.

13 Q. Did you obtain any nondisclosure
14 agreements from individuals at the University of
15 Dayton?

16 A. Anybody we talked to at the
17 university of Dayton had an NDA before we talked
18 to them.

19 Q. Would that include a nondisclosure
20 agreement with John Leland?

21 MR. RHODES: With respect to the
22 University of Dayton, I thought that was
23 Saturday's ruling; therefore, beyond the scope.

24 THE COURT: Sidebar.

1 (A discussion ensued at sidebar.)

2 MR. RHODES: My objection --

3 THE COURT: What he was talking
4 about Dayton?

5 MR. RHODES: Yesterday she
6 objected, and I said you were giving me loss of
7 -- I didn't put anything --

8 MS. KOBIALKA: First of all, the
9 DRPA project was a joint project with the
10 University of Dayton and Wright-Patterson, and
11 the suggestion has been that he did
12 demonstrations in connection with this whole day
13 without an NDA.

14 In fact it was on his
15 demonstrative opening statement that University
16 of Dayton received demonstration and disclosure
17 of information prior to having an NDA. I can
18 show you his opening demonstrative, but he's
19 raised this issue, that we didn't get NDA and
20 did all these demonstrations to imply that we
21 had publicly disclosed this information, so we
22 need the opportunity to rebut this.

23 THE COURT: I did notice you and
24 Carol try to avoid talking about the University

1 of Dayton separately.

2 MR. RHODES: I understood
3 Saturday's ruling to limit me.

4 Your Honor, the issue I put in
5 with regard to public demonstration is that
6 April 2002 presentation, and sounds like they
7 impeached us on that. That's all I put in. I
8 was studious to put in --

9 THE COURT: Is there anything more
10 that you would do with the University of Dayton?

11 MR. RHODES: No.

12 MS. KOBIALKA: I'm fine with not
13 addressing it. I understood that was being
14 implied here. I don't want this to come back
15 later and bite us, to suggest that did not have
16 a NDA with the University of Dayton.

17 MR. RHODES: I'll make that
18 statement.

19 THE COURT: You're not arguing
20 that demonstration to the University of Dayton
21 predates everything we heard evidence on about
22 Wright-Patterson that invalidates the
23 demonstration?

24 MR. RHODES: I won't go over it.

1 BY MS. KOBIALKA:

2 Q. Let's talk about The Limited.

3 When did you first meet with The Limited
4 regarding Leader2Leader?

5 A. I think it was in the 2000 time
6 frame.

7 Q. And did you receive NDAs from the
8 individuals at The Limited?

9 A. We received more NDAs from the
10 limited.

11 Q. Did those NDAs include an NDA from
12 someone named Mr. Jerry Strikes?

13 A. Yes.

14 Q. How about Peter Gartman?

15 A. Yes.

16 Q. Nick LaHowchic?

17 A. Yes.

18 Q. Len Schlessinger?

19 A. Yes.

20 Q. And Ed Gaydos?

21 A. Yes.

22 MR. RHODES: I don't think I put
23 this at issue, the public demonstration.

24 THE COURT: And so you're

1 objecting to the question with respect to?

2 MS. KOBIALKA: Your Honor, it was
3 brought in.

4 THE COURT: I'm overruling it.
5 You can explore this area.

6 MS. KOBIALKA: I'd like to mark
7 these NDAs together to make it easier. They
8 would be PTX 1175, PTX 1049, PTX 1173, PTX 1174,
9 PTX 1172.

10 And one day, Mr. Andre will keep
11 up with me.

12 May I approach?

13 THE COURT: You may.

14 BY MS. KOBIALKA:

15 Q. Mr. McKibben, are these the NDAs
16 for the individuals I just identified?

17 A. Yes, they are.

18 Q. And why did you obtain so many
19 NDAs from a single entity?

20 A. Well, with larger companies, you
21 find as a small company, an entrepreneur, that
22 people forget they signed NDAs. If it's a
23 corporate NDA, you want to make a point.

24 When you're talking to someone

1 individually, you have them do it too to make
2 the point they're covered under their company's
3 confidentiality requirements.

4 Q. We heard a lot about the e-mail
5 you sent to Mr. Schlessinger on November 21st
6 and reference to the sweetheart deal, and that's
7 exhibit DTX 185. So can you just briefly
8 describe what the context of this particular
9 e-mail was.

10 A. Yeah, it was an e-mail to a person
11 who was friendly to the company who for a number
12 of years had been, kind of, morally supporting
13 our effort, and as we got closer to the -- as we
14 proceeded in our development, I kept him
15 informed just on a casual basis.

16 And when we got where I could show
17 him some of the early elements of Leader2Leader,
18 we started talking again, and Len is an -- I
19 call him an entrepreneur-friendly CEO, probably
20 the most entrepreneur-friendly CEO I met.

21 He knows as you continually
22 develop your systems as a small company, it
23 costs money, and when I came to him with this
24 e-mail, we had an opportunity to bring in about

1 \$10 million in one form or another, and I was
2 asking for his help to get this \$10 million
3 funding round.

4 Q. So at the time you were talking
5 about Leader2Leader, what specific technologies
6 under the suite of technologies were you talking
7 about?

8 A. As I recall at that time, we were
9 largely talking about Leader Phone, Leader File,
10 and Leader Message.

11 Q. If we could take a look at some of
12 the e-mails that were shown previously, let's
13 start with 776.

14 Now, this is an e-mail from
15 Mr. Hanna to CWCal at computer wizards. Do you
16 know what that e-mail is?

17 A. I do. That was a broadcast list
18 to our developers.

19 Q. Leader's developers?

20 A. Yes.

21 Q. If we scroll down, we go to LP.
22 It says, "Right now we are focusing primarily on
23 those issues that affect LP. Some work is
24 proceeding on more general L2L issues."

1 What does LP refer to?

2 A. That's the developer shorthand for
3 Leader Phone.

4 Q. Around this time, this is what you
5 were discussing with The Limited; correct?

6 A. That is correct.

7 Q. Okay. So now I'd like to turn to
8 exhibit 766. This is DTX 766, and this is an
9 e-mail between you and Mr. Butler.

10 And look at The Limited here, and
11 you were asked a number of questions about that.
12 Were you referring to your discussions you had
13 previously in November with Mr. Schlessinger in
14 connection with this description to Mr. Butler
15 about your negotiations with The Limited?

16 A. Yes, I was, and we were generally
17 very excited that this major company was getting
18 ready to endorse what we were doing, and we were
19 talking with -- about Leader Phone and elements
20 of the Leader2Leader suite that existed at the
21 time, and the reference there to a contract was
22 in relation to an experimental beta program.

23 Q. And so you had further discussions
24 with The Limited about eventually doing a beta

1 program?

2 A. Yes, we did.

3 Q. After you sent the e-mail to
4 Mr. Schlessinger on November 21, what was their
5 response?

6 A. Well, that e-mail that we're
7 referring to was an attention-getter e-mail. It
8 got his attention, and he said, "Let's start out
9 something. Let's test this and see how we may
10 want to use it in your various divisions."

11 And that's what those five bullets
12 in that e-mail before are referring to. They
13 were referring to the potential fits within the
14 organization.

15 Q. The five bullets you're referring
16 to are the ones in the November 21st, 2003
17 email, which is Exhibit 185.

18 We have just blown it up. On
19 Exhibit 185, are those the five bullets point
20 you're referring to?

21 A. That is correct.

22 Q. Okay. At some point, did you
23 draft a beta testing agreement with The Limited?

24 A. Yes. Within months of this

1 agreement at Mr. Schlesinger's direction, their
2 advanced technology group engaged us in
3 discussions. And in fact, this email talks
4 about two of those gentlemen.

5 And we organized an experimental
6 beta program within The Limited, and we got it
7 down to an actual contract statement.

8 Q. So at some point after you sent
9 the November 21st, 2002 email, did Leader obtain
10 the technology of the '761 patent?

11 A. Yes. A few days with -- around
12 December 11th, 2002.

13 Q. And so at some point after you
14 filed your patent application, did you discuss
15 with The Limited about including the technology
16 of the '761 patent into the Leader2Leader suite
17 of technologies that you were discussing with
18 them?

19 A. We were so excited to show
20 somebody, that they opened up their lab to us
21 and we showed it the first opportunity we had
22 within their testing lab.

23 Q. Okay. Can you describe what that
24 demonstration was that you provided to The

1 Limited?

2 A. Yeah. And to do a demonstration
3 of the '761 technology, you need at least two
4 internet connections. You need two computers.

5 And it requires some set up. So
6 you get multiple people logging in, and then
7 going into the boards and then moving from one
8 board to another.

9 And so that's not something I ever
10 did in presentations. But because they had a
11 computer lab where that was already set up, they
12 had computers all around the lab, and we
13 probably had 15, 10 or 15 people using the
14 system. That was the first time it had ever
15 been shown.

16 Q. You said it was difficult to do
17 that type of demonstration. This was in the
18 2002 time frame.

19 Can you explain why?

20 A. Well, back then, it was -- dial-up
21 modems is what we all had. And so consequently
22 when I would do demonstrations, sometimes I'd
23 have to carry a phone cord and run it 50 or a
24 hundred feet to somebody's telephone line in

1 order just to get one connection.

2 So to have two connections in a
3 conference room where the person's only got an
4 hour and to have two computers, it was just too
5 cumbersome. And we never did it.

6 Q. All right. I'd like to show you a
7 draft of The Limited brand beta agreement marked
8 as PTX 773.

9 MS. KOBIALKA: May I approach?

10 THE COURT: You may.

11 BY MS. KOBIALKA:

12 Q. Do you recognize this document,
13 Mr. McKibben?

14 A. Yes, I do.

15 Q. And what is the document?

16 A. This was the result of our
17 discussions during the first few months of 2003
18 to finalize an initial experimental test with
19 them. We called it the Beta Agreement.

20 Q. Okay. Let's talk about Boston
21 Scientific.

22 In some of your first meetings
23 with Boston Scientific, did Professor Chandler
24 attend with you?

1 A. Actually Professor Chandler
2 introduced us to Boston Scientific and he
3 attended the first meeting.

4 Q. And you had an NDA at that first
5 meeting; correct?

6 A. We had a confidentiality agreement
7 at the very first meeting.

8 Q. I think we have enough NDAs in the
9 record, so I'll just ask some questions. What
10 was that meeting about that you were discussing
11 back in September of 2002?

12 A. That was a meeting with the chief
13 security officer for Boston Scientific and the
14 professor and him had been a colleague for many
15 years, years in the National Intellectual Law
16 Institute.

17 That meeting was primarily
18 introductory and it was to generally discuss our
19 products. I recall showing him LeaderPhone and
20 discussing the possibilities with that.

21 And the other aspect of our
22 technology that he was primarily interested in
23 was the Leader Smart Camera, because he was in
24 charge of all of the security systems for Boston

1 Scientific worldwide.

2 Q. What is Leader Smart Camera, just
3 generally and very quickly?

4 A. Okay. Leader Smart Camera is a
5 technology that was invented at Lawrence
6 Livermore National Laboratories.

7 And we had acquired rights to
8 include in our Leader2Leader framework
9 technologies. And basically what it was
10 invented to do was provide perimeter security
11 for nuclear securities of the United States
12 government.

13 Q. At some point, did you begin to
14 have discussions with Boston Scientific about
15 implementing the technology of the '761 patent
16 and doing a beta test with Boston Scientific?

17 A. Yes, we did in 2003.

18 Q. I'd like to mark DTX I believe
19 it's 769, which is a service provider agreement.

20 MR. ANDRE: 679.

21 MS. KOBIALKA: 679. My apologies.

22 May I approach?

23 THE COURT: You may.

24 BY MS. KOBIALKA:

1 Q. Mr. McKibben, what is this
2 document you have in front of you?

3 A. This is the service provider
4 agreement that we developed with Boston
5 Scientific for the experimental beta program
6 with them in the -- starting late summer of
7 2003.

8 Was this the first beta program
9 for the technology that included the technology
10 of the '761 patent for Leader2Leader?

11 A. Yes, it was.

12 MS. KOBIALKA: Your Honor, I'd
13 like to move in Exhibit DTX 679 into evidence.

14 THE COURT: Admitted.

15 BY MS. KOBIALKA:

16 Q. And can you turn to Exhibit A?

17 A. Okay.

18 Q. And in Exhibit A under monthly
19 user license, how many licenses were granted in
20 this document?

21 A. Ten user licenses.

22 Q. So that the ten user licenses
23 indicates to you that this was just intended to
24 be a small beta test; is that correct?

1 A. That is correct.

2 Q. When you originally started
3 talking to Boston Scientific, you were talking
4 about one set of technologies involved in the
5 Leader2Leader product; correct?

6 And did that change over time to
7 include the '761 patent?

8 A. Yeah. As I stated earlier, the
9 first meetings discussed primarily LeaderPhone
10 and Leader Smart Camera.

11 And then the gentleman named Lynn
12 Mattice suggested that he -- he heard a little
13 bit about Leader2Leader and suggested that he
14 wasn't the right person to hear about our
15 technologies. And so he suggested I come back
16 and do a presentation for information technology
17 people that would more appreciate what we were
18 doing.

19 Q. And eventually then you began to
20 have discussions with them once you had the
21 technology of the '761 patent to be included in
22 the Leader2Leader product offering that you were
23 discussing with Boston Scientific; correct?

24 A. Right.

1 MS. KOBIALKA: Just one minute.

2 All right.

3 I have no further questions.

4 Thank you.

5 THE COURT: All right. Then we'll
6 take our morning break.

7 THE CLERK: All rise.

8 (Jury leaving the courtroom at
9 10:42 a.m.)

10 THE COURT: We'll see you in 15
11 minutes.

12 (Proceedings reconvened at 11:59
13 a.m.)

14 THE CLERK: All rise.

15 MS. KOBIALKA: Your Honor, very
16 quickly, I forgot to move Exhibit 773 in, and
17 counsel stipulated that those exhibits are in.
18 I just want to make a record.

19 THE COURT: It's admitted. It's
20 fine, and I believe we did the switch-out of the
21 exhibits during the break.

22 You can bring the jury in.

23 (The jury entered the courtroom at
24 11:00 a.m.)

1 THE CLERK: Be seated.

2 THE COURT: Welcome back. Let's
3 continue.

4 MR. RHODES: May we recall our
5 witness, Your Honor?

6 THE COURT: Yes.

7 BY MR. RHODES:

8 Q. Mr. McKibben, you recall that
9 before the case was in trial, we took your
10 deposition?

11 A. I do.

12 Q. And I put a copy of it before you
13 and handed up a copy to the Court. I'd like to
14 play page fifty-one, lines sixteen through
15 twenty-three, please.

16 MS. KOBIALKA: Objection, Your
17 Honor. There's no basis to start showing
18 depositions.

19 MR. RHODES: 32(a), Your Honor.

20 THE COURT: I'm sorry.

21 MR. RHODES: 32(a). Any purpose.
22 FRCP 32(a).

23 MS. KOBIALKA: He's already
24 designated --

1 THE COURT: Hold on a second.

2 Let's come to sidebar.

3 (A discussion ensued at sidebar.)

4 THE COURT: What you're showing is
5 his deposition?

6 MR. RHODES: A couple snippets I'm
7 allowed to use in trial.

8 THE COURT: Are they already in
9 evidence?

10 MR. RHODES: No, they are not.

11 She opened the door to certain matters. She
12 just testified -- I can make a proffer.

13 He just testified what technology
14 of Leader implements the patent, and what he
15 said at his deposition was, "As far as I'm
16 concerned, this is what Leader2Leader is doing."

17 Then he says -- we asked him they
18 just put in what iteration of it practicing the
19 patent, and he just got done testifying
20 everything after what time, and he says, "That
21 was a long time ago. I can't point to a
22 specific point."

23 THE COURT: So is this impeachment
24 or substantive evidence?

1 MR. RHODES: It's both, but it is
2 impeachment. I'm allowed. They opened the door
3 to this. I could read it to him, but I have it
4 on video.

5 MS. KOBIALKA: First of all, if
6 they wanted to designate this, they should have
7 already. I disagree this is coming up for the
8 first time now. They had the opportunity to get
9 all this in, but I'm going to object.

10 If he's trying to use it for
11 impeachment, he's got to lay foundation that
12 there's something to impeach. He's attempting
13 to play random clips of testimony without
14 establishing what we're talking about.

15 THE COURT: What about 32(a)?

16 MR. RHODES: It says, "At a
17 hearing or trial, all or part of a deposition
18 may be used against a party with these
19 conditions."

20 Condition A, B, and C are met.
21 They were present as used, would otherwise be
22 admissible, and use is allowed by 32(a) through
23 (h).

24 Deposition of a first party may be

1 used for any purpose, the deposition party, or
2 anyone who was deposed or was the party's
3 officer, director, or managing agent. That's
4 him.

5 THE COURT: I think it's subject
6 to rules of evidence, so you have to lay the
7 impeachment foundation first.

8 MR. RHODES: He just testified
9 when the iteration embodied the patent.

10 THE COURT: You have to ask him
11 the question again, and if you get the answer
12 that Ms. Kobialka got, you can.

13 MR. RHODES: Fair enough.

14 (The discussion at sidebar ended.)

15 MR. RHODES: May I proceed, Your
16 Honor.

17 THE COURT: You may.

18 BY MR. RHODES:

19 Q. Mr. McKibben, I think I heard you
20 just say that it wasn't until after the
21 provisional application was filed on December
22 11, 2002 that you had a operational version of
23 Leader2Leader platform; is that right?

24 A. No. That's not what I said. I

1 said that we had an operational version of the
2 '761 technology.

3 Q. Okay. And that didn't happen
4 until after December 11, 2002; right?

5 A. That's correct.

6 Q. And isn't it a fact that you can't
7 remember any iteration of the Leader2Leader
8 product that did not implement what's claimed in
9 the '761 patent?

10 A. What is your question?

11 Q. Isn't it true that you are not
12 able to identify any iteration of the
13 Leader2Leader product that, in your opinion, did
14 not implement what's claimed in the '761 patent?

15 A. I don't understand that question.
16 Can you rephrase it?

17 THE COURT: I think there's a lot
18 of negatives. Try one more time.

19 THE WITNESS: Yeah.

20 THE COURT: Because it is
21 confusing.

22 BY MR. RHODES:

23 Q. I'm trying to read this.

24 THE COURT: I understand.

1 BY MR. RHODES:

2 Q. Are you able to identify any
3 iteration of the Leader2Leader product that, in
4 your opinion, did not implement what's claimed
5 in the '761 patent?

6 A. So may I ask a question? Am I
7 able to identify any element at any time that
8 didn't implement?

9 Q. Leader -- I'll try to clear this
10 up.

11 Leader2Leader, as you said,
12 evolved over time; right?

13 A. Correct.

14 Q. And now -- and there were many
15 iterations of it; correct?

16 A. Correct.

17 Q. Now, I'm asking you: Were
18 there -- was there ever an iteration of the
19 Leader2Leader platform that did not embody the
20 '761 patent?

21 A. Any time before December 11, 2002,
22 it couldn't have because, it didn't exist.

23 MR. RHODES: Okay. May I play the
24 record, Your Honor?

1 MS. KOBIALKA: I'd like to see --

2 THE COURT: Page, say that again.

3 MR. RHODES: Page 135. Well, I'll
4 set it up.

5 Page 51, Lines 16 through 23.

6 Page 135 --

7 MS. KOBIALKA: I'm sorry.

8 THE COURT: Say that again, Mr.
9 Rhodes.

10 MR. RHODES: Page 135, Lines 15 to
11 21.

12 MR. ANDRE: What was the first
13 page?

14 MR. RHODES: I just misspoke
15 afterwards. I'm tired, Paul.

16 Page 135, lines 15 to 21.

17 THE COURT: That's the only page?

18 MR. RHODES: Yes.

19 THE COURT: Hold on. Ms. Kobialka.

20 MS. KOBIALKA: Yes.

21 THE COURT: Hold on a second from
22 playing that.

23 MS. KOBIALKA: I'm going to object
24 to it. It's incomplete.

1 If they provide the question
2 before it and I think the answer, it will be
3 okay.

4 THE COURT: I believe this is a
5 different page than we looked at previously. So
6 I need a second. Page 135.

7 MR. RHODES: 135.

8 THE WITNESS: So what are we
9 looking at, 135?

10 THE COURT: We're not -- we're not
11 there yet, I apologize. I know this is
12 confusing. Just bear with us a minute, please.

13 THE WITNESS: Okay. I will.

14 MR. RHODES: Lines 15 to 21.

15 THE COURT: You propose to play 15
16 to 21?

17 MR. RHODES: Correct, Your Honor.

18 THE COURT: And Ms. Kobialka, you
19 want the prior question?

20 MS. KOBIALKA: Correct. It should
21 start at least from nine on that same page. It
22 actually should possibly start from one, but I'd
23 be okay to start from there.

24 THE COURT: Yeah. I think for

1 completeness, start at Line 9. And where did
2 you want to end it, Mr. Rhodes?

3 MR. RHODES: Line 21.

4 THE COURT: Okay. You can go
5 ahead and play that. Nine through 21, please.

6 (Beginning of videotape deposition
7 excerpt of Mr. McKibben.)

8 Q. Did you have any technique for
9 identifying differences between various
10 iterations of Leader2Leader product?

11 A. As I'm speaking here today, I
12 believe that our developers kept track of that.
13 But the name they gave to it, I don't remember.

14 Q. Can you identify any iteration of
15 the Leader2Leader product that, in your opinion,
16 did not implement what's claimed in the '761
17 patent?

18 A. That was a long time ago. I -- I
19 can't point back to a specific point.

20 (Conclusion of videotape
21 deposition excerpt of Mr. McKibben.)

22 BY MR. RHODES:

23 Q. Now, Mr. McKibben, at some point
24 in time, you had the Leader2Leader product

1 implemented; correct?

2 A. As I've tried to explain,
3 Leader2Leader is a suite of applications. It's
4 a brand name.

5 There is no such thing as
6 completion of a brand name. There's a lot of
7 technologies within the suite of applications.

8 Some were more developed than
9 others at different times.

10 Q. The Leader2Leader platform, at
11 some point in time, you had that implemented;
12 correct?

13 A. I'm trying to help you here, but
14 Leader2Leader is not a technology. It is a
15 brand name for a suite of technologies. So the
16 answer is various pieces of the product were
17 done at different times.

18 Q. Let's go to DTX 179 and let's go
19 to the page that has Item 4 on it.

20 Is that in the binder?

21 A. Yes.

22 Q. Let's highlight that last
23 paragraph where it says "Leader is already".

24 MR. RHODES: Can you pull that up,

1 Ken?

2 THE WITNESS: 134? What's the
3 number?

4 BY MR. RHODES:

5 Q. We can go over one, three, four --

6 A. What's the number?

7 Q. This is DTX 139. This is the
8 January submission to the government. Let's set
9 the stage for this. This is --

10 A. What page was this?

11 Q. This is the page that has item
12 four on it. This is a few months after 9/11;
13 right?

14 A. What was the date on this?
15 That's correct.

16 Q. And this is a paper that you wrote
17 because the first page says copyright Michael
18 McKibben; right?

19 A. Did I copyright this? I don't
20 think so.

21 Q. What does the circle say?

22 A. Leader Technologies. Yes.

23 Q. That's what it says. Copyright;
24 right?

1 A. I was the author, but Leader is
2 the owner.

3 Q. That was ten or eleven months
4 before the provisional?

5 A. I'm confused. What are you
6 pointing to?

7 Q. You see it says January 9, 2002.
8 The provisional was filed later that year in
9 December.

10 A. You're referring to the bottom of
11 the page, to the footer where the
12 confidentiality notice is?

13 Q. It's highlighted on the screen.

14 A. I know. I'm trying to look at the
15 actual document if you don't mind.

16 I got it.

17 Q. Just set the stage: Four months
18 after 9/11, and ten months before you filed the
19 provisional. Are you with me?

20 A. I hope so.

21 Q. This was a document that was
22 submitted to the government?

23 A. That is correct.

24 Q. You wrote it?

1 A. I helped write it.

2 Q. And it says up here Leader is
3 already commercializing, and then it
4 distinguishes Leader Phone and Leader2Leader.
5 Do you see that?

6 A. I do.

7 Q. So when you submitted this
8 statement to the government, that was a true
9 statement; right?

10 A. It was.

11 Q. So commercializing means to do
12 something for a profit, doesn't it?

13 A. I guess that's one definition.

14 Q. But you testified that
15 Leader2Leader wasn't operational until after the
16 provisional.

17 A. I did not testify to that. I said
18 Leader2Leader was being developed. Over time,
19 there were different parts of the technology
20 that were coming online, and the 761 technology
21 had not been developed until the end of 2002.

22 I wasn't referring to
23 Leader2Leader, to the 761 technology, here. It
24 didn't exist.

1 Q. I thought you conceived them in
2 1999; right?

3 A. Is the question did Jeff and I
4 conceive of 761 sometime in 1999? The answer is
5 yes.

6 Q. And whatever Leader2Leader was at
7 the time, you were proposing to install and
8 implement that within the first quarter of 2002
9 in this document; correct?

10 A. As I've explained, Leader2Leader
11 discussions vary depending on who it is that we
12 are discussing it with, and at that time the
13 specific components of Leader2Leader that we
14 were discussing with Wright-Patterson Air Force
15 Base weren't working and weren't included in
16 that reference.

17 Q. Weren't working?

18 A. They were working and were
19 included in that reference, but it couldn't have
20 been the 761 technology because it didn't exist
21 until a few days before November 11, 2002.
22 December 11, 2002.

23 Q. Did Leader Technologies ever
24 create marketing materials before 2002 in which

1 it claimed that Leader2Leader was a
2 browser-based, fully scaleable collaboration
3 platform for communicating and banking
4 intellectual property powered by Digital
5 Leaderboard technology, patent pending?

6 MS. KOBIALKA: Objection. Outside
7 the scope of the cross.

8 THE COURT: Overruled.

9 THE WITNESS: Can you repeat the
10 question.

11 BY MR. RHODES:

12 Q. Yes.

13 Did your company in 2001 create
14 marketing materials referring to Leader2Leader
15 as subject to a pending patent?

16 A. If we ever created materials to
17 present what we were doing, it would have only
18 been under a nondisclosure agreement to
19 potential investors. We never presented such a
20 statement outside confidentiality agreements.

21 Q. My question is in marketing
22 something called Leader2Leader in 2001, did your
23 company use marketing materials for
24 Leader2Leader that said patent pending?

1 MS. KOBIALKA: Objection.

2 THE WITNESS: I believe I just
3 answered that.

4 MS. KOBIALKA: Objection. Your
5 Honor, I wasn't allowed to get into their other
6 patent pending. This was an area --

7 MR. RHODES: It goes to his
8 statements regarding what was and wasn't covered
9 by the 761, Your Honor.

10 THE COURT: Are you -- is your
11 proffer that the patent referred to is 761, or
12 is that in dispute?

13 MR. RHODES: That's a good point.
14 I don't know is the honest answer.

15 I'll move on.

16 THE COURT: I'll sustain the
17 objection, and let's move on.

18 BY MR. RHODES:

19 Q. Now, let's take a look -- we were
20 talking about Boston Scientific. Did you enter
21 into a sale with them ultimately?

22 A. We did in 2003.

23 Q. And you invoiced them?

24 A. We did.

1 Q. Did they pay?

2 A. No, they didn't.

3 MS. KOBIALKA: Objection, Your
4 Honor. This goes to issues that were
5 bifurcated.

6 MR. RHODES: Secondary
7 consideration of nonobviousness.

8 THE COURT: I'm going to overrule
9 the objection, but do you plan to explore this
10 area further?

11 MR. RHODES: A little bit.

12 THE COURT: Let's hear what the
13 next question is.

14 BY MR. RHODES:

15 Q. Did you -- up until the time that
16 the patent application was filed, did you sell
17 Leader2Leader to anyone else?

18 A. I need you to clarify date because
19 we have two dates related to filings.

20 Q. Fair enough. Before the final
21 application was filed in December 2003, other
22 than Boston Scientific, was there any other
23 invoice sent to anyone for Leader2Leader?

24 A. I don't believe so. We were still

1 in the experimental beta phase at that point.

2 Q. And let's look at DTX 185 finally
3 and pull up the middle part of the document.

4 I was confused by your testimony,
5 and I get confused easily so blame me, not you.
6 Did you say that Leader Phone and Leader2Leader
7 are the same thing?

8 A. No.

9 Q. They go hand in glove?

10 A. I don't understand your question.

11 Q. Isn't Leader Phone something you
12 plug into the Leader2Leader platform?

13 A. That is one of the ways you can
14 use it.

15 Q. And in this proposal if you look
16 at the Leader2Leader section, I notice that
17 there's a sentence where it says that -- we can
18 include that sentence right there.

19 It says "we can include a clause
20 which would permit any unused license fees to be
21 applied for future Leader Phone charges at your
22 discretion." Do you see that?

23 A. I do.

24 Q. I mean, these separate things --

1 are the platform and the phone are actually
2 separate things?

3 A. No, that statement was going to
4 issues of finances and had nothing to do with
5 the technologies that was out. They would be
6 charged out and counted out within The Limited.

7 Q. Have you ever heard the phrase
8 vaporware?

9 A. Yes.

10 Q. What is it?

11 MS. KOBIALKA: Objection, Your
12 Honor. This is beyond the scope of the cross.

13 THE COURT: I don't know where
14 this is going.

15 MR. RHODES: Thank you.

16 THE COURT: Okay.

17 MR. RHODES: It's time to move on.

18 THE COURT: We'll move on.

19 MR. RHODES: I thank you for your
20 indulgence.

21 THE COURT: Okay.

22 Mr. McKibben you can, step down.

23 THE WITNESS: Do I take this?

24 THE COURT: You can leave it for

1 counsel to remove.

2 MS. KEEFE: Your Honor, we also
3 have more paper for the jury members, and we've
4 discussed it with opposing counsel, and I don't
5 think there's any objections; is that right?

6 MR. ANDRE: There's no objections.

7 THE COURT: So you want the
8 distribute the binders?

9 MS. KEEFE: May I, please?

10 THE COURT: Let's do that now.

11 MS. KEEFE: I tried to decide if
12 it was afternoon or morning.

13 THE COURT: Still morning.

14 MS. KEEFE: Good morning, Your
15 Honor. At this time, Facebook would like to
16 call Dr. Saul Greenberg to the stand.

17 THE COURT: You may do so.

18 THE CLERK: Please state and spell
19 your name for the record.

20 THE WITNESS: Saul Greenberg.

21 S-A-U-L G-R-E-E-N-B-E-R-G.

22 THE CLERK: Do you swear the
23 testimony you will give to the Court and the
24 jury in the case now pending before it will be

1 the truth, the whole truth and nothing but the
2 truth so help you God?

3 THE WITNESS: Yes, I do.

4 THE CLERK: Please be seated.

5 THE COURT: Good morning.

6 THE WITNESS: Good morning.

7 DIRECT EXAMINATION

8 BY MS. KEEFFE:

9 Q. Good morning, Dr. Greenberg.
10 Could you please briefly run through your
11 education and your degrees for us?

12 A. So I received my bachelor of
13 science from the Gill University in 1976. I
14 think it was quite a long time ago.

15 Sorry, 1980.

16 Q. What was that degree in? You said
17 bachelor of science?

18 A. Bachelor of science.

19 Q. And was there a specialization?

20 A. That was in microbiology and
21 immunology. I then received a diploma of
22 education, that training for teaching.

23 It was '78 my initial one. And
24 in -- I received my master of computer science

1 in 1984 and my Ph.D. in computer science in
2 1988.

3 Q. And could you briefly run through
4 your work history for us?

5 A. Sure. After I finished my Ph.D.,
6 I worked for the Alberta Research Counsel at the
7 post-doctoral research where I was asked to
8 explore the area of computer support and
9 cooperative work.

10 And shortly after --

11 Q. Sorry. Just real quick, when you
12 use the terms computer operative work; is that
13 what I heard?

14 What is this?

15 A. Computer supported cooperative
16 work. That's essentially how people and teams
17 can work together using computing technology.

18 Q. Sorry. Please keep going.

19 A. Okay. Then shortly after that, I
20 was hired on at the University of Calgary as an
21 assistant professor.

22 And I was pretty fairly rapidly
23 promoted through the rank to associate professor
24 and then full professor. In fact, that's my

1 position today.

2 I'm a full professor with computer
3 science at the University of Calgary.

4 Q. And what do you do as a full
5 professor?

6 A. Oh, lots of stuff. Primarily I do
7 teaching, research and service.

8 So teaching is, of course,
9 teaching undergraduate computer scientists about
10 the basic concepts in the field. But it also
11 involves supervising and mentoring graduate
12 students. So these are students who will become
13 highly skilled professionals researching in
14 their own right and perhaps professors in
15 academics as well.

16 For research, I work with my
17 students. We investigate usually quite novel
18 areas of technology.

19 We try to -- to -- essentially to
20 envision the future to try to make the future a
21 better place with technology and to explore the
22 possibilities of those.

23 And with service, usually that
24 involves helping the community as a whole. In

1 this case, the academic community comes to some
2 consensus about the quality of work that is
3 worthy of acceptance and distribution to the
4 rest of the community.

5 So we do a lot of judging of
6 things like papers, whether they're worthy for
7 publications. I spend a lot of my time doing
8 that.

9 I do things such as judging other
10 professors to see whether they should be
11 promoted or not. So I'm often given --

12 Q. Sorry. Is there a special area of
13 computer science that you focus on?

14 A. Yes, the area I work in is called
15 human computer interaction, which is essentially
16 designing and computing technology for human use
17 for everyday people.

18 And within that, I work in a
19 subdiscipline called computer supported
20 cooperative work. And we often call that CSU.

21 So there is a bit of jargon for
22 you. Or it's also more colloquially known as
23 groupware.

24 Q. Why did you get into that field?

1 A. Well, around -- so I first got
2 into this around 1980, '81. And at that time,
3 technology was really designed for programmers
4 or for people who spent a lot of time trying to
5 figure out computing technology.

6 And I was introduced to this
7 concept of human computer cooperative
8 interaction by one of my professors where it
9 tried to really envision how we can create
10 technology that's really for everyday people for
11 everyday people performing their everyday work.

12 And that's -- kind of sounds
13 updated now, but because here we are in 2010 but
14 back in 1980, that wasn't the case. Technology
15 was really only available to highly skilled
16 people or for people who spent a lot of time
17 training themselves to understand the colloquial
18 language of technology.

19 Q. As a researcher, do you also write
20 code?

21 A. Oh, absolutely. So what -- the
22 kinds of things that I tend to do in my job has
23 a lot to do with designing new ways to think
24 about technology.

1 And often the new ways that we
2 want to do things don't really fit on a
3 computing platform as they now exist. So we
4 spent a lot of time -- and by we, I meant
5 myself, my students, my post-docs, research
6 assistants, essentially working at the low-level
7 plumbing of system design where we spent a lot
8 of time building systems, building the
9 underlying architectures that will let us
10 actually create a new way of envisioning
11 computers.

12 So, yes.

13 Q. Have you been recognized with any
14 awards in your field?

15 A. Yes. I have several awards from
16 some organizations. Starting with the most
17 local, I have a university professorship from my
18 own university, University of Calgary. And
19 that's different from being a professor.

20 It's essentially -- it's an award
21 of distinction. It's recognized as my
22 contributions to the field. And I'm still
23 currently holding that.

24 It's a five-year special

1 recognition. It comes with funding and other
2 things.

3 Within Canada, I have an award
4 from the computer -- I have to remember the
5 acronym. It' CHCCS Society, which essentially
6 has recognized my research achievements in the
7 field. And that was, I think, in about 2005,
8 2006.

9 But probably the one I'm the most
10 proud of is I'm what's -- I was elected as a
11 member of the ACM Chi Academy for essentially my
12 overall research contributions to the field.
13 And I should explain that ACM is the association
14 of computing machinery.

15 It's -- essentially it's an
16 academic association that really takes care of a
17 lot of the academic stuff that happens, and not
18 only in North America, but internationally.

19 And the Chi is the discipline that
20 I work with in computer human interaction. So
21 the ACM Chi Academy is essentially a peer
22 recognition by the group that there's certain
23 members in the discipline, thousands of
24 researchers in the discipline that should be

1 recognized for their contributions in the area.

2 And I received that in '95 -- in
3 2005. As I said, I'm very proud of that.

4 Q. And you mentioned that groupware
5 was one of the words that can be used to
6 describe your particular special field of
7 computer science; is that right?

8 A. That's correct.

9 Q. And what is groupware?

10 A. Well, groupware is the underlying
11 technology that -- it's essentially computing
12 systems that lets groups of people, teams
13 actually do their work, pursue their tasks
14 together.

15 So the field of computer support
16 of cooperative work is really a much broader
17 thing. It looks at the design. It looks at the
18 implementation.

19 But it also looks to see what
20 people do today. We actually go out in the
21 field. We watch what people do.

22 And we try to use that and
23 influence our design. Groupware is the actual
24 technology. It's the system and all the time

1 that we build.

2 Q. Can you give us an example of
3 something that would be a groupware, a product
4 in the market today?

5 A. Sure. There's -- in fact, I
6 suspect many members of the Court and jury has
7 already experienced this of these computers.

8 So the small kind of things that
9 you use, like Instant Messenger or Skype, maybe
10 even email at one extreme is a type of
11 groupware. It lets you interact with other
12 people through the technology.

13 But more broadly, there's more
14 enterprise-level systems that are really there
15 to try to support teams to pursue some task
16 where the -- you know, in an organizational
17 setting, there could be a team that's working
18 toward a goal.

19 And they have, for example, a
20 whole bunch of documents that they're producing.
21 Maybe people are working across distributed
22 sites, so the technology will help them
23 communicate with each other. It will also help
24 them coordinate their activities, and as well it

1 will help them share and store all their
2 artifacts, their documents, those kind of
3 things, in a way that goes beyond what we can
4 currently do with our traditional computers that
5 are designed for one person to use them.

6 Q. Have you ever created a groupware
7 product?

8 A. Yes.

9 Q. What was it called?

10 A. We actually created a lot of
11 groupware products, and the typical way we work
12 in our lab is that we build our systems and we
13 write papers about them and then we almost
14 always try to place our systems online to give
15 them to others. We make them freely available
16 so other researchers can build upon our
17 platforms or try them out to see if what which
18 say is true.

19 One of the systems we build is
20 team rooms. To give you a flavor of it, we did
21 that, I guess, in the early 2000s. Team rooms
22 was a system that essentially lets groups of
23 people create virtual rooms where you can create
24 a room around a topic of interest.

1 One or more people can go in the
2 room, bring applications to the room, bring work
3 and documents and their own data. It's a real,
4 physical room that you work with a team. You
5 can leave stuff in there, and stuff stays where
6 it is.

7 People can come and go in it, and
8 everything they have in the room is available to
9 them. In a way it sets a context or environment
10 for them to do their work together over time.

11 Q. Just one last background question.
12 Have you ever been mentioned in connection with
13 any rankings in the computer industry in terms
14 of your papers or groupware?

15 A. Sure. One -- well, the way
16 academics are normally ranked is by the
17 publication. That's the corner of realm. It's
18 how we spread our ideas around.

19 There's two external sites that I
20 know that have ranked me. There's one site
21 called the HCR, human computer interaction
22 video. I don't go there. They collect the
23 papers of everything in my area. I'm listed as
24 I believe -- as think I'm the third from the top

1 author on their top authors list, and this is of
2 thousands.

3 And more recently I just came back
4 from Microsoft, and they have a service there
5 called Microsoft academic search they just
6 released over the last recent period of time,
7 and if you go into their site and look up
8 human-computer interaction over the last ten
9 years, I believe I'm the third most ranked at
10 that one, and I'm the fifth one at HCR, and
11 these are done by external organizations I have
12 nothing to the with.

13 Q. Thank you, Dr. Greenberg.

14 MS. KEEFE: At this time, Facebook
15 would like to proffer Dr. Greenberg as an expert
16 in the field of computer science.

17 MR. ANDRE: No objection.

18 THE COURT: So recognized.

19 MS. KEEFE: Thank you, Your Honor.

20 BY MS. KEEFE:

21 Q. Dr. Greenberg, have you been
22 retained as an expert in this case?

23 A. Yes, I have.

24 Q. And are you being compensated for

1 the time you're working with us in this case?

2 A. Yes.

3 Q. And how much are you being paid?

4 A. \$450 an hour.

5 Q. Were you asked to perform any
6 tasks in this case?

7 A. Yes, I was.

8 Q. And what were you asked to do?

9 A. I was essentially asked to do two
10 different things.

11 The first was to look -- to
12 essentially compare the provisional application
13 filed by Leader with the actual 761 patent.
14 Everybody knows what I mean about the 761
15 patent?

16 Q. I think we heard about it a lot.

17 A. To the 761 patent. I was
18 essentially asked to compare the two to see if
19 the provisional application discloses each and
20 every element in the asserted claims of the 761
21 patent and to render an opinion as to whether it
22 does. And if it didn't disclose them, I believe
23 that Leader was not entitled to the filing date
24 of the provisional application.

1 Q. Were you asked to perform another
2 task?

3 A. Yes.

4 Q. What was that?

5 A. The second task was to take the
6 761 and essentially to judge its novelty. That
7 is, to compare each and every asserted element
8 in the asserted claims of the 761 patent against
9 several references. That is, several
10 publications or systems that appeared before the
11 filing of the -- either the provisional and 761
12 patent.

13 And if in fact the ideas in the
14 761 patent appeared earlier, then it's not
15 novel, so that in the words, it means that the
16 patent would be invalid.

17 Q. Did you prepare a slide to show
18 the two things that you were asked to do?

19 A. Yes, I did.

20 Q. I believe you already testified
21 the first task. That's what's under the first
22 number there; is that right?

23 A. That's right. So my first opinion
24 is the provisional patent application did not

1 disclose every element of the asserted claims of
2 the 761 patent.

3 Q. And did you come to an opinion
4 regarding your second task, whether or not the
5 patent was valid?

6 A. Yes, I did.

7 Q. What was that?

8 A. As you can see here, I compared
9 each asserted claim of the 761 patent to a
10 variety of references, and for the first three
11 there, we see U.S. patent 6236994. I'll call
12 this Swartz from now on. Swartz is the inventor
13 assigned to.

14 Everything in the asserted claims
15 was in Swartz, and the iManage 6.0 reference
16 manual, and I again found all the ideas in the
17 asserted claims in each and every element of the
18 asserted claims in the iManage system.

19 And I also looked at the European
20 patent application, EP 10873067 AT, which I'll
21 call Hubert, and I found each and every element
22 of the asserted claims in the Hubert patent were
23 in the 761 patent -- I should correct myself.
24 For Swartz and Hubert. That's each and every

1 asserted claim except for sixteen.

2 If you look at these patents in
3 combination with another patent called Ausems,
4 then claim sixteen, the idea is also there.

5 Q. If I understand you correctly,
6 you're saying that all of the claims would be
7 invalidated by -- every claim except sixteen
8 would be invalidated by Swartz or iManage or
9 Hubert by themselves; is that correct?

10 A. It's almost correct, except for
11 sixteen by Swartz or Hubert alone. iManage does
12 disclose claim sixteen.

13 Q. And then for claim sixteen, would
14 claim sixteen be invalid as well?

15 A. Well, I believe claim sixteen, if
16 you look at what's in the claim, it would really
17 be obvious to one skilled in the art to a
18 practitioner of the day.

19 Aside from that, it would be
20 obvious in you combine the Ausems patent with
21 any one of the other patents.

22 Q. We'll go into those with detail.

23 Before we do that, I'd like to
24 learn about how you went about your analysis.

1 So what materials you used and what documents
2 you relied on in coming up with your opinion.

3 A. Sure. Should I start with the
4 provisional?

5 Q. Let's start with the provisional.
6 What documents did you use in order to come to
7 your opinion that the provisional did not
8 disclose all of the elements of the final
9 patent?

10 A. For the provisional, I looked only
11 at the provisional, and I compared all the
12 material, and I compared that extensively with
13 what was in the asserted claims of the 7612
14 patent. I would look at, for example, claim
15 one, each one of the elements, and I would
16 search through the provisional application to
17 see if that idea was there.

18 Q. And in order to understand what
19 the claims of the issued patent covered, how did
20 you do that? Did you have any documents that
21 educated you as to what the language of the
22 claims meant?

23 A. Yes, the Court construed certain
24 terms that was in the 761 patent, so I followed

1 that definition when they were there.

2 If the Court did not construe or
3 define any terms, I went to the patent itself to
4 see if they provided a definition.

5 If they did not provide a
6 definition, I used the definition that would be
7 known to one skilled in the art.

8 These slides are bit of evidence
9 back up.

10 Q. I think you were saying if there
11 wasn't a definition provided by the Court, you
12 used the patent itself to find the definition or
13 you used what one of ordinary skill in the art
14 would use.

15 A. That's correct.

16 Q. What is one of ordinary skill in
17 the art in computer science in this case?

18 A. One of ordinary skill in the art,
19 as I believe, is somebody with a bachelor of
20 science in computing science or computer
21 engineering or equivalent and a couple years of
22 experience.

23 I kind of know what students can
24 do as soon as they graduate, and you need a

1 couple years experience to mature and understand
2 what you do and how to build products within
3 that.

4 Because of the nature of the 761
5 patent, they would have to have background in
6 networking, in distributed systems, in
7 weapon-based platforms, and a little groupware.
8 Doesn't have to be extensive.

9 Q. When you were doing your analysis
10 regarding the other pieces of prior art Swartz
11 and iManage and Hubert, did you use a different
12 definition or different process for the claim
13 terms?

14 A. No, I used exactly what was
15 construed by the Court then what the patent said
16 and then failing that, what one of ordinary
17 skill in the art would understand those words to
18 mean.

19 Q. So right now, Dr. Greenberg, I'd
20 like to step us through your first opinion, the
21 one regarding the provisional application, and
22 whether or not the provisional application
23 contains a disclosure of each and every element
24 of the issued claims.

1 A. Yes.

2 Q. I think you have an exhibit in
3 your binder, PTX 3. Can you turn to that.

4 A. I see it.

5 Q. What is that?

6 A. This is the provisional
7 application.

8 Q. And again just for clarity, when
9 you were doing your analysis comparing the
10 claims of the issued patent to the provisional
11 application, did you confine yourself to just
12 those two pieces of paper?

13 A. Yes, I did.

14 Q. Why did you do that?

15 A. My understanding of patent law is
16 that for a patent to be entitled to the date of
17 provisional application, the provisional
18 application by itself has to disclose each and
19 every element of the claim, and if it doesn't,
20 the patent is not allowed to use the filing date
21 of provisional application.

22 Q. And so why didn't you look to
23 anything else that was in existence at the same
24 time?

1 A. Well, as I mentioned, the law
2 states that I have to confine myself to the
3 provisional application. I am, of course,
4 allowed to apply my understanding as one skilled
5 in the art or as I would interpret one skilled
6 in the art at the time of the filing, how they
7 would understand the terms in the provisional
8 application. As a matter of law, that's how it
9 is.

10 Q. What conclusion did you make when
11 you started this analysis?

12 A. The provisional application -- I
13 have a graphic on this.

14 The provisional application
15 defines a whole variety of -- defines ideas in
16 it. There is some stuff in it. When I compared
17 it to the 761 patent, the 761 patent has
18 substantially more material in it, and it's not
19 just more words, but it has substantially new
20 ideas, new parts of invention, that just don't
21 appear in the provisional anywhere.

22 Q. Doctor, before we move on, I
23 notice you have claim numbers up there. Why did
24 you choose those claims?

1 A. Yes, because when you look at the
2 ideas that are in the claims, those ideas are
3 covered by the material added to the 761 patent,
4 and they're not in the provisional application.
5 The provisional application does overlap with
6 what's in the patent, but not in the ideas that
7 are in the claims. That's all the new stuff
8 that was added.

9 Q. And why did you pick these
10 particular claims?

11 A. Well, my understanding is that
12 these are the claims being asserted in the case,
13 and that's where I focused my attention. Other
14 claims may talk about what's in the provisional
15 application, but that's not what's at issue
16 here.

17 Q. Did you analyze each and every one
18 of these claims and compare it to what was
19 disclosed in the provisional application?

20 A. Yes, I did.

21 Q. And what did you -- you said that
22 there was some things in these claims that was
23 not in the provisional application. What do you
24 mean by that?

1 A. Well, what I did was, I looked for
2 the ideas, what's in each one of the elements.
3 Can I find a match of the provisional
4 application?

5 So for example, at one level, are
6 the words there? At another level, if the words
7 aren't there, is the idea there?

8 There's some code included in the
9 provisional application. I looked at the code,
10 and I asked, does the code actually have any of
11 these words or ideas within it?

12 So that's how I did my comparison.

13 Q. Can you pull up a slide of claim
14 one, please. Just go to the patent itself and
15 show claim one.

16 So for example, this is claim one;
17 is that right?

18 A. Right.

19 Q. Now, are there -- what elements in
20 claim one are you talking about when you say
21 that there are ideas that are in the claim that
22 are not in the provisional application?

23 A. We see two major elements. We see
24 two paragraphs.

1 In the first, we see a
2 "computer-implemented context component for
3 capturing context information associated with
4 user defined data." One of the things I looked
5 for a was a context component in the provisional
6 that captures context information. Is there
7 something there that's associated with user
8 defined data?

9 The second paragraph says there's
10 a computer-implemented tracking component for
11 tracking of change of the users from the first
12 context to the second context. I looked at the
13 provisional to see is there anything there that
14 tracks a user moving from one context to
15 another.

16 And the third thing, dynamically
17 updating the stored metadata based on the
18 change. I looked to see, first, is there any
19 notion of metadata and any notion of dynamically
20 updating the metadata on change.

21 Q. Is there anything in the patent
22 that talks about these things you're mentioning?

23 A. Absolutely. I believe the figure
24 on the face of the patent, that is Figure 1,

1 which is a little figure we see clearly.

2 So this is obviously important.

3 It's on the very front of the patent, and
4 there's -- on the left side we see this thing
5 called a context component and this thing called
6 a tracking component. This is part of the 761
7 patent.

8 Q. Are those figures in the
9 provisional patent?

10 A. This figure is not in the
11 provisional patent. There's no figures at all
12 in the provisional patent.

13 Q. Are there more figures in the
14 issued patent?

15 A. There's twenty or twenty-one.
16 However you count in the issued patent, there's
17 quite a lot more.

18 Q. Are there other differences
19 between, just facial differences between the
20 provisional patent application and the final
21 patent?

22 A. Well, the provisional application
23 is a lot shorter, for one thing. And I
24 actually --

1 Q. Did you prepare a slide?

2 A. Yes. So here's a good
3 side-by-side comparison.

4 The provisional application, as I
5 mentioned, is quite a bit shorter. We see
6 there's nine and a half pages of text, plus
7 eight and a half pages of code.

8 And it's in quotes because I don't
9 actually know if it's working code or just
10 something that was written that never actually
11 ran. There's nothing in the application that
12 says that.

13 Whereas the final patent
14 application has 39 pages of text. You know, so
15 this is substantially more stuff in it.

16 The provisional has no figures to
17 illustrate a concept whereas the final patent
18 application has 22 figures.

19 I mention words like tracking,
20 context, context data, metadata. There's
21 absolutely no mention of the word tracking in
22 the provisional application. And in the final
23 patent application, tracking is an element of
24 every single asserted claim, and it's also

1 described thoroughly in the specification.

2 In the provisional application,
3 there's no mention of context data or this idea
4 of metadata. Well, there is of storing
5 metadata.

6 There is one mention of metadata
7 that I'll talk about shortly. But there's no
8 mention of these terms of context data at all.

9 Whereas in the final patent, their
10 context data and metadata are in -- are elements
11 of each and every one of the independent claims.
12 And it's also claimed in the -- described in the
13 specification.

14 Q. And you mentioned that the
15 metadata is used once in the provisional, but
16 it's not used as -- the same way in the final?

17 A. And again, metadata is in each and
18 every one of the elements of the asserted -- of
19 the independent claims that are asserted in this
20 case.

21 Q. Can you describe for us some of
22 the examples of the description of context
23 components and context data that you found in
24 the patent itself? And I think you had some

1 slides for that as well.

2 A. Sure.

3 Q. Column 6.

4 A. Well --

5 Q. Oh, go ahead. Did you want to
6 talk about this?

7 A. Sure. Maybe we can just bring
8 them both up at the same time. Okay.

9 This just elaborates a little bit
10 more about what I said before. Tracking appears
11 zero times. Track appears zero times.

12 Metadata appears once. And as I
13 mentioned, not in the way it's used, access
14 appears twice. And whereas these terms are
15 really heavily used in the final patent.

16 They appear 64 times. So that was
17 back to the question of, you know, on the face
18 level, you know, are there stark differences.
19 And the answer is yes.

20 Q. Okay. So you mentioned that these
21 terms appear numerous times in the final
22 application?

23 A. That's correct.

24 Q. Before we dive into the

1 provisional, I'd like you to walk us through a
2 little bit of how those elements are described
3 in the final patent application.

4 A. Sure.

5 Q. So I think you actually had some
6 slides that showed some portions of the patent
7 that describe these elements; is that right?

8 A. There is columns from the patent,
9 yes.

10 MS. KEEFE: Can you bring up
11 Columns 6 and 7?

12 BY MS. KEEFE:

13 Q. Does this look familiar?

14 A. Yeah. Yeah, it does.

15 Q. What is this?

16 A. So this is from Column 6 of the
17 patent. So here -- here we see it clearly says,
18 The system 100 also includes a context component
19 in association with the figures context to
20 monitor and generate context data associated
21 with data operations of the user in the first
22 context.

23 Essentially what this means is
24 that there, context component is monitoring what

1 people are doing with their data and it's
2 generated context data captioning that
3 information.

4 Q. And is the same true with respect
5 to the tracking component you were mentioning in
6 the claims?

7 A. Yes, it is.

8 Q. Can we look at Column 7?

9 A. Yeah. So here's another excerpt.

10 And here at the bottom we see --
11 let's see. So such user activities and data
12 operations in the one or more context of the
13 system 100 and movement of the user between
14 context are tracked using a tracking component.

15 So what this is talking about here
16 is that we have a tracking component in a bit of
17 the software that's actually watching what's
18 going on, that's watching how the user moves
19 from one context to another. And it's
20 captioning that as information.

21 Q. And is it your opinion that either
22 of these concepts, which are in all of the
23 claims, do they appear anywhere in the
24 provisional application?

1 A. No. They don't appear whatsoever.
2 And again, I have to stress, and I think this is
3 really important, it's not just that the words
4 don't appear, but the concept itself just isn't
5 there in the provisional.

6 Q. Is the process of moving between
7 contexts, so moving from one context to another,
8 discussed in the later -- in the later patent
9 application, just that idea of movement, not
10 just tracking?

11 A. It's discussed in the patent.
12 Yes.

13 Q. Could you show Figure 2 again,
14 please? How does Figure 2 show that?

15 A. Well, there's also some associated
16 text with this. I don't know if you can bring
17 this side by side.

18 Q. Column 7.

19 A. That may be a bit -- can everybody
20 see that?

21 So here this -- this essentially
22 describes the basic process that's handled by
23 pretty well all of the asserted independent
24 claims of the patent.

1 We have at the beginning here, you
2 know, it starts user is associated with a first
3 context. They do some stuff. You know, user
4 sends application. They may perform data
5 operations.

6 That is the notion of context
7 component. You know, watching what's going on
8 and actually looking at this.

9 But then we see the step 206,
10 where it says the user changes context, and
11 there's a text that describes it. It says at
12 206, the user changes context from the first
13 context to a second context. So there's the
14 movement there.

15 And then at 208, it says the data
16 and applications are then automatically
17 associated with the second context. So there's
18 a consequence there.

19 But we see this idea of user
20 changing context is part of the general flow
21 that's described in the '761 patent. And this
22 is pretty well what happened with all of the
23 independent claims being asserted.

24 Q. And does a description like

1 this -- actually the first question: Does this
2 language appear in the provisional application,
3 the language that you were just describing?

4 A. No, it does not.

5 Q. And does Figure 2 appear in the
6 provisional application that you've been
7 describing?

8 A. They're -- not only does Figure 2
9 not appear, there's nothing in the provisional
10 application that even textually describes what's
11 in Figure 2.

12 Q. Aside from the exact language, is
13 there any description using any language of the
14 concepts that are disclosed in the paragraph
15 that you've been talking about here?

16 A. No, it's not. It's not in the
17 description.

18 It's not in the examples given,
19 nor is it in the code that was provided.

20 Q. So I think you've actually
21 mentioned three things, if I remember right.
22 You mentioned that the provisional application
23 did not have any concept of metadata storage or
24 updating; is that right?

1 A. That's correct.

2 Q. In fact, can I get a --

3 MS. KEEFE: Your Honor, may I
4 approach behind to write on a white board? To
5 put a white board up and write on it?

6 THE COURT: You may.

7 MS. KEEFE: So I apologize already
8 for speaking from here. I'll be very loud
9 before I go back over there.

10 BY MS. KEEFE:

11 Q. So I believe that you actually
12 said that the first thing that you couldn't
13 find -- and by the way, I'm only doing this
14 because Dr. Greenberg says his handwriting is
15 very bad.

16 A. It's really bad.

17 Q. I think you said the first concept
18 that's all throughout all of the claims as well
19 as the specification of the patent was the idea
20 of metadata storage and updating; is that right?

21 A. That's correct.

22 Q. And then if I remember right --

23 MR. ANDRE: Your Honor, objection.

24 Counsel is leading. He can tell her what to

1 write.

2 THE COURT: Sure. Sustained.

3 BY MR. RHODES:

4 Q. What were the other two concepts
5 that you did not find from the claims of the
6 patent in the provisional application?

7 A. Okay. So the other -- I am just
8 going to bring the patent, just use the right
9 language in front of me. So this is '761 here.

10 So essentially the context
11 component for captioning context. For caption
12 context information.

13 Q. Okay. And another?

14 A. And the third one is tracking
15 component for tracking a change of the user from
16 the first context to a second context.

17 Q. Does that look right?

18 A. That's correct.

19 Q. Okay. So I'd like to go through
20 these with you one by one.

21 A. Sure.

22 Q. So why don't we take the first one
23 first.

24 Why do you think that there is no

1 description of metadata storage or update in the
2 provisional application?

3 A. Well, it's just not there. In
4 fact, they -- the term metadata is used only
5 once, and it's used as a description of what was
6 available previously.

7 And the way it's used is in a
8 different way from the way it's described in the
9 '761 patent.

10 In fact, I have some -- I've
11 highlighted some materials about that.

12 Q. Actually, no, before we bring that
13 up --

14 A. That's not --

15 Q. No. No, before we bring that up,
16 so with metadata, I just want to back up and
17 make sure this concept is very clear.

18 Where does metadata storage and
19 update -- in fact, let's bring up Claim 1 again.

20 Where does metadata and storage
21 appear in Claim 1?

22 A. Okay. So it appears in -- let's
23 take a look at this.

24 So if we look at the first

1 paragraph right at the middle, we see the word
2 metadata. If we can highlight that.

3 There it is. So we see the
4 context component dynamically storing the
5 context information in metadata associated with
6 the user-defined data. So that is the first
7 place it appears.

8 Essentially the context component
9 is taking this information and it's storing
10 it. And metadata, by the way, is just data
11 about data. That's the Court's construction.
12 That's the everyday use of the Court's
13 construction, I believe.

14 The second paragraph says metadata
15 based on the change. So what this is talking
16 about is that the tracking component is watching
17 the person moving from one context to another.
18 And as part of that, it takes that metadata, the
19 stuff that was stored in the first context and
20 is updating it again. Essentially is adding
21 new.

22 It's either changing the
23 information or adding things associated with
24 that information.

1 Q. Is this an important context in
2 the claim?

3 A. Well, absolutely. It appears in
4 every -- as I mentioned, it appears in every one
5 of the asserted independent claims.

6 And it's talked about extensively
7 throughout the patent. Essentially it says in
8 computer science terms, it says, this is a
9 method by which we will take this information
10 and we'll structure it and store it for later
11 access and use.

12 Q. Can you show us where the concept
13 of metadata is in Claim 9, please?

14 A. Sure. Let's move to Claim 9.

15 It's -- we'll see that there's --
16 it's all very similar, although the wording
17 around it is somewhat different. So, again, in
18 the middle, we see dynamically -- well,
19 beginning of the second paragraph, we see
20 dynamically associating metadata with the data.
21 So it appears there again.

22 And then it says the data and
23 metadata stored on a storage component. We see
24 even later on, the metadata -- what the metadata

1 consists of, what it includes. So information
2 related to the user, the data, the application
3 and the user environment.

4 In the last paragraph, we see
5 dynamically updating the stored metadata. And
6 again, it gives a bit of a description of what
7 it's doing. So there it is in Claim 9.

8 Q. And is the concept in Claim 21?

9 A. Let's look at Claim 21, and we see
10 something very similar. We see in the second
11 paragraph, again dynamically associating
12 metadata with the data. And again, the data,
13 metadata stored, in this case, on a web-based
14 computing platform.

15 There we see the metadata includes
16 information and it says what's in it.

17 We see in the one, two, three,
18 fourth paragraph dynamically associating the
19 data and the application with the second user
20 workspace in the metadata.

21 And then final paragraph, we see
22 starting near the bottom that we see a plurality
23 of different users can access the data via the
24 metadata from a corresponding plurality of

1 different user workspaces.

2 So, again, we see it's littered
3 throughout this claim.

4 Q. And finally, is it also -- the
5 concept of metadata also in Claim 23?

6 A. Yes, it is. So, again, something
7 very similar. Let me just search for this.

8 Here -- it's somewhere in the
9 middle of the first paragraph. It says for
10 dynamically -- just a little bit below, for
11 dynamically storing the context data as metadata
12 on a storage component.

13 And a little bit right after that,
14 it says which metadata. It says that's
15 dynamically associated with data.

16 And then in the second paragraph,
17 we have again near the bottom, it says
18 dynamically storing the change information on
19 the storage component as part of the metadata.
20 So again, it's throughout these claims. It's a
21 fundamental component of many of the elements of
22 these claims.

23 Q. And what's the basis for your
24 opinion that these elements are not disclosed in

1 the provisional application?

2 A. Well, as I mentioned, the word
3 metadata appears only once and it appears in a
4 completely different context. In fact, as part
5 of the background of the invention.

6 And there's -- there's nothing
7 else in the -- in the provisional that actually
8 has any concept of metadata, nor is there
9 anything in the code, nor is there anything in
10 the examples. I didn't see it.

11 Q. Can you please pull up the
12 background of the provisional.

13 So is this the paragraph that
14 describes metadata?

15 A. Yes. So let me just see where it
16 is, if it's this particular part.

17 Maybe it's the next paragraph.
18 I'm not sure.

19 Q. How about Paragraph 11?

20 A. Yeah, keep going.

21 There we go. In fact, if you
22 include Paragraph 12 as well, that would be
23 good.

24 So this is in the background of

1 the invention in the provisional. And so what
2 they're talking about here is what existed at
3 the time of the filing of this provisional
4 application.

5 And here we see, the second line,
6 it says Current processes. So this is what
7 exists. Then designed to add context to files
8 such as the metadata tagging approach, involve
9 having a knowledge officer view files after they
10 have been stored and create metadata tags.

11 So here they're saying that at the
12 time of this filing, the one approach was to use
13 metadata where some person would manually assign
14 essentially this information to the file so they
15 can later search for it.

16 And then immediately following it,
17 it says -- it actually says, Well, this isn't
18 good enough. It says, Notwithstanding the
19 usefulness of the above-described methods, a
20 need still exists for a communications tool that
21 associates files generated by applications with
22 individual groups and topical context.

23 So really here they're talking
24 about metadata as here's what existed before.

1 They're talking about it as, Oh, it was done
2 manually and we can do better than that.

3 But that's it. That's the only
4 use of the word metadata in this entire
5 provisional is to say, Here's what's been done
6 before.

7 And it's wrong or it's not wrong,
8 but it's not enough.

9 Q. If the provisional doesn't
10 describe metadata storage and updating, what
11 does it describe?

12 A. So I prepared a series of slides
13 on power point to try to illustrate this. If we
14 could bring that up. There we go.

15 So the provisional application
16 describes this idea -- describes here a lot of
17 the ideas in it. So there is stuff in there.
18 It's just not the stuff that's in the asserted
19 claims.

20 So the first thing it does, it
21 describes these things called boards. And
22 boards are essentially a collection of data and
23 application functions.

24 So these are things like, Well,

1 you know, we have Microsoft Word and we have a
2 document prepared with it. And it's all the
3 stuff that -- essentially all the data and later
4 applications, stuff that can happen on the
5 board. So it's just a collection.

6 It knows that there could be a
7 word file, for example, with the document
8 associated with it.

9 The next thing it does, if you go
10 to the next slide, is that -- and this is a
11 quote from the provisional -- it says "the
12 present invention automates workflow processes."

13 The workflow is a sequence of
14 steps. It's usually designed -- workflow is
15 usually for office automation where it tries to
16 automate some kind of procedure that documents
17 will follow or that people have to follow.

18 So for example, like, if you
19 wanted to buy something, you filled out a form,
20 and that form would go to this place first and
21 that place next and that place next. It's a
22 sequence of steps.

23 Q. Dr. Greenberg, when you have your
24 quotes up there, I wanted to help. If anyone

1 wanted to follow, what is the paragraph number?
2 What does that mean?

3 A. That means this is an excerpt from
4 paragraph twenty-two in the provisional
5 application.

6 The provisional application says
7 we can relate these boards together in a
8 sequence of steps, and the next thing the
9 provisional says -- this is a quote from page
10 six, paragraph three. The numbering is a little
11 different because the provisional looks like two
12 different documents stuck together. The way the
13 provisional numbers their paragraphs isn't
14 consistent.

15 It says the workflow process may
16 be readily reorganized by making a change to one
17 or more of the webs and boards. Imagine that.
18 Somehow we've created a sequence, maybe
19 manually, that there's a sequence or process
20 that goes from board A to board B to board C and
21 then D.

22 We can shuffle around that
23 sequence. The invention says we can change that
24 sequence and reorganize those boards, so we can

1 go from board B to board D to board A. All that
2 stuff will be on those boards.

3 Q. Why would someone want to do that?

4 A. Workflow processes essentially, as
5 I said, describe a sequence of steps, and these
6 steps could change over time.

7 One of the problems around -- I
8 shouldn't say major problem. One of the issues
9 that we wanted workflow systems to be, for
10 example, so a site administrator could say,
11 let's change the sequence of steps we're going
12 to do things in without having to do a massive
13 amount of rewrite of code.

14 Essentially what this invention
15 says, we can change the sequence of steps. I
16 think we have a few more animations to show
17 that.

18 We could do this, and this is
19 captured by this quote, and this is what's meant
20 in the provisional. The user changes the
21 context, the files, and applications
22 automatically follow dynamically capturing those
23 shifts in context, so this is automated.

24 When they go from one board to the

1 next, these things will be in the right place.
2 This is not about tracking movements, capturing
3 contexts. It is about, here's the boards,
4 here's the relationships, and we keep juggling
5 those relationships and boards around to define
6 different sequences of steps and different
7 relationships.

8 Q. Say as a user changes their
9 context. Why doesn't that mean when a user goes
10 from board D to board C?

11 A. Here they are going from board D
12 to board C. This is an after-the-fact thing.

13 What the invention describes is we
14 can take the boards and change the
15 relationships. Here we're talk about a person
16 can go from one board to the next, and the stuff
17 will be there. There is no capturing of the
18 context of what the person is doing as they do
19 that, nor is there any tracking of the movements
20 nor updating of metadata. That is not in there.

21 Q. You mentioned there's two
22 documents pushed together to make up this
23 provisional application; is that right?

24 A. That's correct.

1 Q. What are those two documents?

2 A. If I look at the provisional, so
3 there's one that looks like an -- essentially a
4 description, and it's -- they have paragraphs
5 numbers one through twenty-five and then there's
6 an attachment. It's labeled attachment two.

7 So I'm not sure. There's no
8 attachment one. I could see it just seems
9 something gathered from someplace else which
10 contained another description, and there's code
11 associated with it.

12 Q. Did you study that portion of
13 application as well?

14 A. Yes, I did.

15 Q. Does the code included in that
16 portion of the application change your opinion
17 regarding what's disclosed in that provisional
18 application?

19 A. No, if anything, it reenforces
20 what I found in the description.

21 The code is all about here's a
22 board and here's a relationship between boards,
23 and one is simply form filling essentially
24 manually what the relationships between the

1 boards are.

2 Q. Can you pull up the code,
3 Dr. Greenberg. Do you see the import statements
4 here?

5 A. Yes, I do.

6 Q. Are these in the provisional?

7 A. Yes, they are at the beginning of
8 the code section.

9 Q. What's the purpose of an import
10 statement?

11 A. So an import statement is, as the
12 name suggests, is a way for the computer program
13 to import code that's somewhere else, so
14 essentially it says it's a way for us to manage
15 code. It says that there's code somewhere else,
16 and I want to bring it into the program so the
17 program can actually use it.

18 Q. If we take the -- one of the first
19 ones, for example, the import com.leader.util.
20 What would that mean?

21 A. Not much because one thing that is
22 not in the provisional is what's in these
23 external files. All this tells me is that --
24 and I'm just guessing now, so this is an

1 educated guess -- that because it starts with
2 com.leader, this is some code that Leader may
3 have or may not have written yet or may plan to
4 write that does some stuff.

5 Essentially it just says that
6 whatever is there is intrinsic to Leader, so I
7 would be guessing. It's like, we have this box,
8 and we have stuff in it, and the company
9 holds the box, but I won't tell you what's in
10 it.

11 Q. Can you determine in any way from
12 the import statements what the code looks like?

13 A. First, I have to say I don't know
14 if the code exists. I can't tell if this code
15 is working code. Is it actually code that they've
16 actually compiled to run? I don't know. I
17 can't tell from this because that's not
18 complete.

19 The second thing I can tell is
20 this code or pseudocode is stuff intended to run
21 compiled by systems to be run eventually, or
22 it's more of a sketch. And looking at it, it
23 looks more like code. Again I don't know.

24 The third thing I can't tell is

1 whether these files com.leader.util or debug,
2 whether they exist or not. I have no idea
3 whether these are just place holders or if they
4 have stuff there. It's not in the provisional.

5 If I look at any particular one of
6 them, I can make a guess. Com.leader.util,
7 maybe that means there's a utility program in
8 it, but there's another one called
9 asp.facebook.util, so I don't know what's in it.
10 I just make a wild guess.

11 Q. These are part of what's been
12 described as the code for this program?

13 A. Well, it's part of the code that
14 was produced in the provisional, but it's the
15 actual stuff in these things designated by the
16 import isn't there. They did not deliver that.

17 I've read other patent
18 applications, other things, before and sometimes
19 they come with a floppy or CD that says, here's
20 our stuff.

21 For one, this is all I have to
22 work with. I would be guessing.

23 Q. Can I direct your attention to a
24 particular part of the code attached here, the

1 sixteenth page of the provisional. There should
2 be something called tool code. Tool code equals
3 get contact?

4 A. I think you want to see more than
5 that. The bottom one. Keep going right to the
6 bottom, to where it says return form.

7 Two more lines.

8 Q. And in here in particular, I'd
9 like to point your attention to the middle of
10 the page where it says action.addactionlistener.
11 Do you see that code?

12 A. I do.

13 Q. What does that code do?

14 A. So remember before I said that
15 what the provisional allows it to reset the
16 relationship between these boards. I believe in
17 looking at this and using my knowledge of
18 programming that what this essentially does is
19 really the user interface part for somebody to
20 manually set the relationship of one board to
21 another.

22 If I could highlight, it says the
23 fourth, fifth line down, add new relationship
24 subform. So it's using the word "form," and we

1 have sub equal new concrete sub form create
2 relationship sub form. So that would probably
3 be the title of the window you would see as the
4 user and creator.

5 New relationship would be
6 instruction, and the rest of the code -- go a
7 little below it -- says sub.addboarddropdown.
8 It says sub.addboarddropdown, and following
9 that, it talks about the board drop down.

10 I think this is a drop down form
11 or guideline, something that you've probably
12 seen before on computer systems, but it brings
13 up this form that lets you set the relationship
14 of one board to another, and this is a manual
15 thing.

16 Q. Does anything in this disclose
17 tracking a user's movement from one board to
18 another board?

19 A. Neither is it in this code and
20 nowhere else in the code.

21 Q. Does anything in this code
22 disclose tracking a user's movement from one
23 context to a separate context?

24 A. No.

1 Q. There was a deposition taken in
2 this case of Mr. Lamb. Are you aware of that?

3 A. Yes, I am.

4 Q. Did you read Mr. Lamb's
5 deposition?

6 A. I did.

7 Q. Did you base your opinion on
8 Mr. Lamb's testimony in his deposition?

9 A. No, I did not.

10 Q. When you reviewed Mr. Lamb's
11 testimony about what he thought was in the
12 provisional application, did it change your
13 opinion as to whether or not the provisional
14 disclosed each and every element of the claim?

15 A. It enforced my position. He said
16 several times that no tracking was done in the
17 provisional application.

18 MR. ANDRE: I'm going to object to
19 the characterization of the witness's testimony,
20 and he testified to that.

21 THE COURT: Overruled. He's
22 testifying to his interpretation of that.

23 BY MS. KEEFFE:

24 Q. Dr. Greenberg, one of the terms we

1 hear a lot of in patent law is enabling. Do you
2 know what that means?

3 A. Yes, I do.

4 Q. What does it mean to be enabled or
5 enabling technology?

6 A. It mean that is -- this
7 description has to be enough that somebody of
8 ordinary skill in the art could go and build it.
9 It doesn't have to say everything, but it should
10 be rich enough that you can say, here's what it
11 says, and you can do something about it.

12 Q. And in your opinion, was the text
13 and code in the back of the provisional
14 application enabling technology?

15 A. It was enabling in the sense that
16 I understood enough to determine it's about
17 creating boards and setting the relationships
18 between those boards. In that sense, it's
19 enabling.

20 But it's not a full specification.
21 There's a lot of stuff missing, such as in those
22 import files. I could tell from the code in the
23 description that it matches the description I
24 told you, but in terms of enabling what's in the

1 761 patent, I would say it's not.

2 Q. So the -- in your -- in your
3 opinion, did the disclosure from the provisional
4 application, including the code at the back,
5 enable one of skill in the art to build or
6 understand what was in the claims of the 761?

7 A. No.

8 Q. In your opinion, does the
9 provisional patent application disclose each and
10 every element fully of the asserted claims of
11 the 761 patent?

12 A. No, they do not.

13 MS. KEEFE: This is a good place
14 for a break, Your Honor, or we can go to the
15 next topic.

16 THE COURT: I know the next topic
17 will take more than six minutes.

18 MS. KEEFE: I promise it will.

19 THE COURT: Based on that promise,
20 we'll start our lunch a little early today and
21 have the jurors back in time to start again at
22 1:30.

23 THE CLERK: All rise.

24 (The jury exited the courtroom at

1 12:22 p.m.)

2 THE COURT: You can step down, and
3 the rest of you can sit.

4 Just talk briefly about where we
5 are.

6 You're free to go.

7 THE WITNESS: What time?

8 THE COURT: Talk to your attorneys
9 about that.

10 I've been advised that a new
11 declaration of the special verdict form has been
12 filed as I directed, so I'll start taking a look
13 at this, and I figure we would have our prayer
14 conference after we finish testimony today,
15 which I'm guessing will be 4:30, but if it were
16 all wrapped up before then, we would go to the
17 prayer conference.

18 Any questions or needs to be
19 addressed?

20 MR. ANDRE: No, thank you, Your
21 Honor.

22 THE COURT: Mr. Rhodes?

23 MR. RHODES: No, thank you, Your
24 Honor.

1 THE COURT: We'll see you back at
2 1:30 then.

3 THE CLERK: All rise.

4 (A recess was taken at 12:23 p.m.)

5 THE CLERK: All rise. Court's now
6 in session.

7 THE COURT: Let's bring the jury
8 in.

9 MS. KEEFE: I have the special
10 verdict form, just to hand up physical copies.

11 THE COURT: Okay. That's fine.
12 You can do that as we're bringing
13 the jury in. Thank you.

14 THE CLERK: All rise.

15 (Jury entering the courtroom at
16 1:50 p.m.)

17 THE CLERK: Please be seated.

18 THE COURT: Good afternoon, ladies
19 and gentlemen. Welcome back.

20 And let me apologize. I had some
21 other matters come up. I wish this was the only
22 case I was dealing with, but I actually have a
23 few others.

24 And there was some other urgent

1 things I had to take care of and I apologize for
2 keeping you waiting. And welcome back and let
3 me keep you waiting no longer.

4 Ms. Keefe.

5 MS. KEEFE: Dr. Greenberg.

6 Go ahead and put up the summary
7 slide.

8 BY MS. KEEFE:

9 Q. Good afternoon, Dr. Greenberg.

10 A. Hi.

11 Q. So before lunch, I think we were
12 talking about your first opinion; is that
13 correct?

14 A. That's correct.

15 Q. And what was your first opinion,
16 again?

17 A. So just to summarize, the
18 provisional patent application does not disclose
19 every element of each asserted claim of the '761
20 patent.

21 Q. Thank you.

22 I'd like for us now to move on to
23 your second opinion. Now, before we dive into
24 that, I think one of the terms that we keep

1 hearing is prior art.

2 What is prior art?

3 A. Well, prior art is essentially
4 stuff that's been -- that's been created before
5 the critical date. So it could be publications.
6 It could be systems or other things like that.

7 Essentially anything that
8 discloses ideas and inventions.

9 Q. And what are the names of the four
10 things that you have here next to the bullets?

11 A. Do I have to recite the numbers
12 or?

13 Q. No, just the names is fine.

14 A. So Swartz was the inventor of the
15 first patent. And the iManage is actually a
16 system, and it's a reference manual that I've
17 been using to base my opinion on.

18 Hubert is an invention of a
19 European patent. And Ausem is the inventor of
20 the U.S. patent.

21 Q. Can you please turn in your binder
22 to PTX 0919.

23 A. I see it.

24 Q. You see it? And what is that?

1 A. That's the Swartz patent that I've
2 used.

3 MS. KEEFE: Your Honor, at this
4 time, I'd like to move the Swartz patent into
5 evidence.

6 MR. ANDRE: No objection.

7 THE COURT: It's admitted.

8 BY MS. KEEFE:

9 Q. Dr. Greenberg, you've stated that
10 you have an opinion on the Swartz patent and
11 how -- as to how it relates to the asserted
12 claims of the patent in this case.

13 What is that opinion?

14 A. So my opinion is that Swartz
15 essentially discloses all of the ideas or
16 inventions in the -- in each one of the elements
17 of the asserted claims of the '761 patent.

18 Q. Now, I noticed you essentially
19 disclose everything, every single one. I'm
20 sorry.

21 A. Yes. It discloses every single
22 one.

23 Q. Can you explain what are the dates
24 that we're seeing here on the screen?

1 A. So the bottom date is the date
2 that this patent was filed, which we see is June
3 29th, 1998, which is quite a long time before
4 the '761 patent. And in fact, the patent was
5 actually granted by the Patent Office and
6 obviously very publicly available on May 2nd,
7 2001, which is also well before the date of both
8 the provisional and the '761 application
9 filings.

10 Q. Have you read and studied the
11 Swartz patent?

12 A. Oh, yes.

13 Q. And what is the Swartz patent
14 about?

15 A. So I actually have a -- maybe
16 there's a graphic that I could use to just kind
17 of give a high-level view of it. It's power
18 point.

19 Q. Do you have the --

20 A. No.

21 Q. You mean the animation that you
22 worked on?

23 A. No. It's -- oh, sorry. I believe
24 it's Figure 1.

1 Q. Figure 1. Okay.

2 A. Yeah.

3 Q. Can we find Figure 1 of the Swartz
4 patent?

5 A. Yeah. So this is kind of an
6 abstract figure, but essentially Swartz was
7 really interested in or really concerned about
8 what happened when people would be using a
9 variety of systems in a fairly serious process.

10 So he was looking, for example,
11 and this is his example of what are all the
12 things that people do when they're developing a
13 drug, and eventually they're going to file it to
14 a regulatory agency for approval.

15 And the problems of the time was
16 that people would be using a variety of systems
17 to do all the work. So these systems are
18 essentially the context and environments where
19 they do their work.

20 So, for example, those bottom
21 three bubbles are EDMS. That would be
22 enterprise document management system.

23 They may use that. Then they may
24 use an imaging management system to manage all

1 the images they produce and an enterprise
2 workflow system.

3 And the problem that existed was
4 that as people would be doing their work through
5 this, essentially their information would be
6 fragmented and not captured.

7 So what he -- what his invention
8 essentially --

9 Q. Could you give us an example of
10 that? You said people using these systems, our
11 work could be fragmented.

12 A. Sure. So, for example, if
13 somebody is developing a drug, there's lots of
14 documentation and other things that happen with
15 that, so if they're doing a little bit on one
16 system and moving over to another system or
17 another different environment or context, then
18 essentially that all this stuff they do is
19 separate.

20 And as part of a -- when you're in
21 the business of doing things like drug
22 regulatory approval, you need to be able to
23 track all the stuff that happens along the way:
24 When your ideas were created, the documents, and

1 so on.

2 So his concept was to trying to
3 integrate the systems by this thing called
4 knowledge integration, which would monitor what
5 people could do within a particular context or
6 system, track as they move between them,
7 essentially, to use Swartz's term, to create a
8 knowledge path of all the things they did across
9 the systems.

10 That's the big picture view of
11 what Swartz was looking at.

12 Q. What words in the patent itself
13 led you to the this?

14 A. There are words very similar in
15 the 761 patent talks about context tracking,
16 metadata. I think that will come up -- I
17 prepared other slides to look at later.

18 Q. What are we looking at here?

19 A. So this is an example from the
20 Swartz patent, and we can see some -- in fact,
21 we can see some of the words he uses here.

22 He says, "Such a system also
23 preferably captures metadata associated
24 with the information shared, stored, and

1 accessed by the users of the data so as
2 to characterize the context in which the
3 information is being used."

4 The context is the things they're
5 doing within the system and also going between
6 systems.

7 Q. Now, can this system be used to
8 change the data itself, like the document about
9 the drug?

10 A. Of course. This is all an
11 evolutionary thing. As people are doing the
12 work, they're creating things, changing things,
13 adding to things, and all the usual stuff I
14 would expect.

15 Q. Are there other portions of the
16 specification that led you to believe that
17 Swartz has invented this idea first?

18 A. Oh, yes. I believe I've
19 identified some other places. Maybe we could
20 bring that up.

21 This is kind of a high-level view
22 of the concept that I stated previously. So on
23 the left and right here, we are actually seeing
24 two different systems that he was talking about.

1 Doesn't really matter what they are.

2 For this example, we see a
3 customer-data analysis application that somebody
4 could be working in that context, then they
5 could be moving to customer document application
6 in the middle, that data docket software.

7 That's what Swartz calls the
8 knowledge integration part. This is what's
9 monitoring what people are doing in the left and
10 right context, tracking as they move between
11 them, and storing that as metadata, which is
12 what we saw in the previous excerpt.

13 Q. How does the text of the patent
14 describe this data docket software?

15 A. Very similarly. In fact, this is
16 something I identified within the patent, so
17 here's the data docket phase. We see that up on
18 top, and that's the thing in the middle. That's
19 watching what's going on.

20 We see words in it like point
21 number C generation of an audit trail to
22 represent the flow of data an audit trail is all
23 these things that happened with that data as
24 people use it over time.

1 Q. What's another way of thinking
2 about an audit trail in terms of the language in
3 the patent?

4 A. It's tracking context information
5 across everything that happens. We see
6 burgeoning after analysis data. We're capturing
7 data as well and all the data as it changes over
8 time.

9 We see number eight -- we see
10 using stored context information to provide
11 access to the historical information about how a
12 report was created. This is like, if you think
13 about capturing context, we're talking about how
14 a person would create a report, who actually did
15 the work, when it was completed, as well as
16 other things.

17 So he talks about this as
18 historical information. So when Swartz is
19 talking about capturing the stuff, he's not
20 talking about capturing a little bit about what
21 they're doing. He's talking about a flow of
22 events that captures what happens over a course
23 of time, all the decisions made, and that's
24 referred to later as a knowledge pattern.

1 Q. Is there a figure in the patent
2 that describes more detail about the information
3 that's being gathered?

4 A. Yes, and I've identified that, so
5 this is, kind of, a portion of the figure -- I
6 don't remember the figure number.

7 Q. Five?

8 A. Sounds about right.

9 -- where we see -- and again it's
10 kind of abstract. We see at the top this thing
11 called the knowledge repository, and this is the
12 stuff that the system is keeping track of.

13 If we look at the left, we see the
14 top three things, and maybe we can highlight
15 those where it says record of transactions. It
16 keeps a record of the transactions. It keeps a
17 record of the context information from users and
18 their applications, and it has this information,
19 metadata catalog, so we see the metadata is
20 there as well.

21 More importantly than that, if you
22 look at the bottom of the picture, there's a
23 bubble that says "knowledge integration," and
24 below that, vertical text called "knowledge

1 path." And this is the aspect of the system
2 that says, let's capture this as a sequence of
3 events that occurs as people do their work over
4 time.

5 We're not just talking about
6 within a system, here's what people are doing,
7 but also as they flow from system to system to
8 system, and this is the essence of tracking
9 movement.

10 Q. And did you find other quotations
11 in the patent that also describe this figure?

12 A. Yes, I've identified some. Let's
13 take a look at this quote.

14 Q. Where are we here?

15 A. We're in either column five or
16 six. It's hidden away.

17 Q. Is it fair to say column six, line
18 seventeen?

19 A. Sounds right.

20 This is in the Swartz patent.
21 Let's look at what we says here, and as used
22 herein, the term knowledge integration
23 middleware represents -- and that's that thing
24 at the bottom.

1 If you remember, that has -- the
2 knowledge path represents any software used to
3 assist in the integration of disparate
4 information sources and the corresponding
5 applications for the purpose of recording
6 distributing and activating knowledge, knowledge
7 application, knowledge services.

8 And I think the next line is
9 really a good one to match to the 761 patent
10 because he says "more specifically, knowledge
11 integration middleware is preferably employed to
12 identify and hereby identified --" he says,
13 including tracking monitoring as well as
14 analyzing.

15 Here we're monitoring what people
16 do in the system. We're tracking what they do
17 in between the systems in the context, and he
18 uses that word, the context, in which
19 information is employed so as to enable the user
20 of such context in the management knowledge.

21 We're seeing wording that's
22 similar to the 761 patent.

23 Q. Are there other paragraphs in the
24 Swartz patent that also --

1 A. Sure, there are numerous examples.

2 Here is another one. So this is
3 again from the Swartz patent from column seven,
4 where Swartz says he's describing why this is a
5 good thing.

6 So he says some key advantages of
7 the present invention are the saving of context.
8 Again we see context comes in. That's
9 important.

10 And having the ability to
11 visualize and explore past, present, and
12 potential decisions. There's two contexts,
13 first, to visualize. We're accessing all this
14 stuff, not collecting and sticking it on a
15 computer, but it's for the people to access all
16 this information, context information, and the
17 stuff they do to explore past, present, and
18 potential decisions.

19 There we have again the concept of
20 the knowledge path. There's a flow of events
21 that happen over time as people do these things
22 both between and within the context. So that's
23 really the major thing that I wanted to point
24 out in this passage.

1 Q. Did you prepare some graphics to
2 show how the Swartz patent could operate?

3 A. Yes. So this is -- what I've done
4 is I've taken Figure 2 and which shows the data
5 docket software and in this case two different
6 contexts or two different systems on the left and
7 right. And I've added the bottom part of Figure
8 5, which is essentially the knowledge.

9 Sorry. This is the top part of
10 Figure 5. It's essentially the knowledge
11 repository.

12 Now, if we abstract a little and
13 the data docket software, that's doing the
14 context monitoring. And the tracking is shown
15 in the middle of Figure 2A.

16 So if we abstract this a little
17 bit, we have our two contexts in this case, the
18 customer data analysis software and enterprise
19 document management system.

20 And at the bottom, if we abstract
21 that, we have our knowledge repository. This is
22 where stuff gets stored.

23 So what Swartz does, if we
24 continue on from here, is essentially we're --

1 well, this quote kind of captures it. We're
2 watching what people do as they do their work in
3 a particular system.

4 And here he says such a system
5 also preferably captures metadata associated
6 with the information shared, stored and accessed
7 by the users of the data. And again, so as to
8 characterize the context in which the
9 information is being used.

10 So this is all -- you know,
11 clearly this is what's happened. You are
12 capturing the context. There's software that
13 captures the context information and that's
14 being stored in this knowledge repository.

15 Now, if we keep on going, so this
16 is also -- now, we get to the tracking. So
17 here's another quote, which you've actually seen
18 before where it says knowledge integration
19 middleware is preferably employed to identify --
20 and here we see the including tracking,
21 monitoring and analyzing the context in which
22 information is employed.

23 So here we have a person moving
24 across context and that's also tracking and

1 captured and put in the knowledge repository.

2 If we go on. And, in fact, even
3 in the claims of Swartz, Swartz actually says
4 that his system generates this audit trail to
5 represent the flow of data. So, again, we have
6 this notion of tracking in one of the claims.

7 And in Claim 5, he actually says
8 that all this is dy -- that the system
9 dynamically stores information about these
10 transactions. So this is all happening as
11 people are doing their work.

12 Q. Now, how do these features that
13 you've just described compare to the claims of
14 the '761 patent?

15 A. Well, they pretty well -- well,
16 not pretty well. They describe using Claim 1 as
17 an example. This describes what Claim 1 is
18 doing.

19 Q. Can we go through the animation
20 again and have you use the language of Claim 1?

21 A. Okay. I just want to get the
22 language of Claim 1 in front of me to see.

23 Q. Why don't you put it up on the
24 white board to the side of you, so we can have

1 it at both places at the same time.

2 A. Okay. That would be helpful.

3 Q. Just make sure it's clean for us.

4 So Dr. Greenberg, I'm going to have you help us
5 step through the Swartz patent and what it
6 discloses with each and every one of the
7 limitations from Claim 1.

8 A. Sure. But let's back up one more
9 step, because -- and even again remember that
10 I'm talking about the data docket software is
11 kind of watching what's going on, and the data
12 docket software actually has software that's
13 equivalent to the -- what we'll see here is a
14 context component and also the tracking
15 component. So now we can move through that.

16 Later I'll talk about it being a
17 network-based system. But here we have the data
18 docket context software is a context component
19 and it captures the context information
20 associated with the user-defined data.

21 So if we step through this, again
22 we see here at the bottom, it's talking about a
23 captured metadata associated with the
24 information. So it's characterized in context.

1 So there we go, we're characterizing context.

2 And then it says, the context
3 component dynamically storing the context
4 information in metadata. And that's mentioned.
5 That quote also captures that.

6 We see the captures metadata and
7 so it's there.

8 Q. So Dr. Greenberg, I'm sorry. Just
9 to slow down one second.

10 A. Yeah.

11 Q. So which portions of Claim 1 are
12 you saying map to the quote that we have here on
13 the screen?

14 A. Okay. Right now I'm looking at
15 the first element of Claim 1.

16 Q. So is that computer-implemented
17 context component of the network-based system
18 for capturing context information associated
19 with user-defined data created by user
20 interaction of a user in the first context of
21 the network-based system?

22 A. That's correct.

23 Q. Okay.

24 A. And then I went on to talk about

1 the context component dynamically storing the
2 context information metadata. And we see the
3 metadata over there.

4 Q. And which -- which portion of this
5 language -- seems a little obvious, but which
6 portion of this language tells you that?

7 A. Well, captures metadata associated
8 with the information shared, stored and accessed
9 by the users of the data.

10 Q. So is that just generic metadata
11 or is that a specific type of metadata?

12 A. No, this is -- well, it's very
13 specific, because it says below, so as to
14 characterize the contents. Right.

15 This is all about what are people
16 doing in a context? What exactly is happening?
17 As in this case, they're using that customer
18 data analysis software system.

19 Q. Thank you. Please go on.

20 A. Okay. Can I see the next
21 animation just to -- okay.

22 So we have in the second claim, we
23 have a computer-implemented tracking component
24 of the network-based system for tracking a

1 change of the user from the first context to a
2 second context of the system and then
3 dynamically updating the stored metadata based
4 on the change.

5 Now, here in this quote, he says
6 we have this knowledge integration middleware,
7 so that does some of the tracking that's
8 preferably employed to identify, including
9 tracking, monitoring and analyzing the context
10 in which information is employed.

11 So, again, we have the tracking
12 coming into play, which is what that claim is
13 all about. And if we keep on going.

14 And here we see in the claim, it
15 generates an audit trail. And that's part of
16 the storage functionality. Right.

17 As people are doing what they're
18 doing, it's being stored. And we see that in
19 Claim 5 as well. That is the dynamically
20 stored. Right.

21 So we're dynamically storing
22 information about these transactions as people
23 are doing them.

24 Q. How do we know that it's the same

1 metadata that's being updated?

2 A. Well, this is a whole point of the
3 system. Right.

4 It's about capturing this
5 knowledge path, which I mentioned before. It's
6 about what is it that people are doing and can
7 we actually create that as a knowledge path.

8 So it's all related. It's not
9 just different stuff. It's related from what
10 happens within a context.

11 How do we track what people are
12 doing as they move from one context to the
13 other? How do we store what happens in the
14 second context? How do we store all that as
15 metadata?

16 So it presents this knowledge
17 path.

18 Q. And where was Mr. Swartz when he
19 wrote this patent?

20 A. I'm not sure where he went to. I
21 do know that the patent was assigned to -- was
22 assigned to Xerox. So I can assume that he was
23 working for Xerox at the time or he had some
24 relationship with them.

1 But I don't know that for sure.

2 All I know is that Xerox is, in fact, the actual
3 assignee.

4 Q. And when was this, again?

5 A. I'll have to look back on that
6 first page, but I said it was late '90s.

7 Q. Could I just have it right in
8 front of me?

9 Q. That's okay. So when was that
10 filed again?

11 A. So he filed it in 1998, and I
12 think this is, what, five years before the '761.
13 So quite a long time before the '761 patent.

14 Q. Dr. Greenberg, what is your
15 opinion as to whether or not Swartz discloses
16 each and every element of Claim 1 of the '761
17 patent?

18 A. My opinion is that it does
19 disclose each and every element of the -- of
20 Claim 1 of the '761 patent.

21 Q. And what does that mean?

22 A. Well, what it means is
23 essentially -- well, what it means is that the
24 ideas that are presented in the '761 patent

1 appear in the Swartz patent. So -- so and I
2 should be more specific.

3 The ideas that are present in each
4 and every element of Claim 1 are presented in
5 Swartz. Swartz actually had these ideas well
6 before that and published it.

7 Q. And do you have an opinion as to
8 whether or not that affects the validity of the
9 '761 patent, Claim 1?

10 A. Yes. My understanding of patent
11 law is that prior art essentially discloses each
12 and every element in the claim and that that
13 claim would be invalid.

14 Q. Have you also applied the
15 teachings from the Swartz patent to the other
16 claims of the '761 patent?

17 A. Yes, I have.

18 Q. And can we go through those now?

19 A. Sure.

20 Q. Put up Claim 4.

21 A. I think before that, I had
22 something that actually looked at the language
23 of Claim 1.

24 Q. Absolutely.

1 A. Yeah, because I think -- I don't
2 think I finished with Claim 1 because there's
3 another point that I -- well.

4 Q. Oh, no. Thank you very much.
5 Sorry if I missed a step.

6 A. So what I wanted to say, these are
7 -- on the left, we see excerpts from Claim 1
8 from the elements of Claim 1. On the right, we
9 see language from Swartz.

10 And I think you've seen some of
11 this before. But I really want to stress that
12 not only are the ideas that Swartz talks about
13 essentially or they disclose what's in those
14 claims, but he uses almost exactly the same
15 language. So we have -- it's not just, oh,
16 Here's an idea. There's debates about it.

17 But the language in it is very,
18 very similar language. So in the '761 patent,
19 the element -- one of the elements talks about
20 dynamically storing the context information and
21 in metadata associated with the user-defined
22 data, the user-defined data metadata stored, and
23 a storage component.

24

1 And we look at Swartz, and he says
2 such a system also preferably captures metadata
3 associated with the information shared, stored
4 and accessed by users of the data, so as
5 characterized the context in which information
6 is being used.

7 So we see the words are the same.
8 Well, the ideas are the same and the words are
9 the same.

10 If we can keep on going here in
11 the '761 patent element in the of Claim 1, we
12 see the tracking component of a network-based
13 system for tracking a change of the user from
14 the first context to a second context. And you
15 see in the quotes on the right where he talks
16 about his knowledge integration middleware that
17 is employed to identify.

18 And here he talks about including
19 tracking the context so as to enable the use of
20 such context in the management of knowledge.
21 So, again, we see the idea of tracking context
22 and other things in the Swartz.

23 Furthermore, in the '761, it talks
24 about dynamically updating metadata on the

1 database.

2 On a change in Swartz, he says the
3 recording of the data should be done
4 automatically, electronically, with dynamic
5 linkages to the source information, so all this
6 is happening as things occur.

7 I believe there's one more at the
8 end of claim one. It says "wherein the user
9 accesses the data from the second context," and
10 in Swartz, Swartz says "such a system also
11 preferably captures metadata associated
12 with the system changed, stored, and
13 accessed by the users of the data so as
14 to characterize the context in which the
15 information is being used."

16 Very similar words. There's many
17 ways to describe the invention. What I found
18 compelling about Swartz is not only does he have
19 the same ideas, the words he uses are identical
20 to what the 761 patent had five years later.

21 Q. Thank you. Can we move on to
22 claim four.

23 A. Sure, I think that's it on that.

24 Q. Here's claim four. Are you

1 familiar with claim four?

2 A. Yes.

3 Q. And do you have an opinion as to
4 whether or not the Swartz patent discloses as
5 prior art the information claimed in claim four?

6 A. Yes, they do, and my opinion is
7 that it does disclose it.

8 Q. Why is that?

9 A. Well, claim four adds that the
10 context information includes a relationship
11 between the users and at least one of an
12 application, application data user, and
13 environment.

14 I've already spoken about how
15 Swartz defines a knowledge path. That captures
16 everything that's going on. We showed a quote
17 that says this is the user information and the
18 application data. That's satisfied here.

19 Q. What is your opinion about claim
20 four?

21 A. That Swartz essentially discloses
22 what's in claim four.

23 Q. Essentially or --

24 A. It does. Sorry. It does disclose

1 what's in claim four.

2 Q. Do you have an opinion regarding
3 claim seven?

4 A. Yes, I do.

5 Q. Is this claim seven?

6 A. Yes.

7 Q. What does claim seven add?

8 A. Claim seven adds that data created
9 in the first context is associated with data
10 created in the second context.

11 I addressed this with the tracking
12 and by Swartz's use of language like "knowledge
13 path," that essentially it's not just
14 recapturing what happens here, and they're
15 disconnected.

16 He really is interested in the
17 whole path of knowledge as a sequence over time.
18 We already saw terms like audit trails. All
19 these things are to take the data and relate
20 them together across all these contexts.

21 Q. What is your opinion regarding
22 Swartz and claim seven?

23 A. Swartz anticipates claim seven.

24 Q. When you say anticipate, what do

1 you mean?

2 A. It means it discloses the idea in
3 claim seven.

4 Q. Do you have an opinion as to claim
5 nine?

6 A. I do.

7 Q. What is your opinion regarding
8 claim nine?

9 A. So claim nine is a variation of
10 claim one. In claim one it -- so here we have
11 -- in claim nine -- instead of --

12 So we talk about a
13 computer-implemented method. Now, Swartz is
14 describing a system, so it's obviously a
15 computer-implemented method, and it comprises
16 computer-executable acts. We're talking about a
17 computer system, so it does that.

18 Creating data within a user
19 environment. Now, this is one of the
20 differences. In claim one, it talks about
21 context. In claim seven, it talks about user
22 environment. The Court has actually construed
23 context to be the same as environment. That's
24 how it defines it. In one sense, that's

1 satisfied.

2 More generally, Swartz is
3 describing all the stuff people are doing in a
4 system, so that's their environment for doing
5 their work, so that's all satisfied by Swartz.

6 Then it says of a web-based
7 computing platform. And this is also another
8 difference from claim one, and I identified
9 parts in the patent that shows Swartz discloses
10 the web-based computing platform.

11 Q. This one of those?

12 A. Yes, it is. Here's an excerpt
13 from Swartz.

14 He says, "Knowledge management
15 level also includes data docket web-based
16 knowledge reporter." So clearly this is a
17 web-based system or it has capabilities of a
18 web-based system, so this is a web-based
19 platform.

20 At the bottom we see the data
21 docket being accessed by the web browser.
22 Clearly this is a web-based platform.

23 Q. What about the other elements of
24 claim nine?

1 A. So okay. So the rest of claim one
2 is pretty well -- the rest of the first element
3 of claim one is what we've seen before in a user
4 interaction with the user environment or context
5 by user using an application. The data and form
6 and files and documents. We talked about this.

7 The second paragraph says
8 "dynamically associates metadata with the data
9 and the data and metadata stored on a storage
10 component of the web-based computing platform."
11 We've already seen it's web based.

12 Q. Is it stored?

13 A. Yes.

14 Q. And is the metadata dynamically
15 associated with the data?

16 A. We -- all that before when I
17 talked about dynamic, the bottom part says the
18 information includes -- metadata includes the
19 information related to the user, the data, the
20 application, and the user environment.

21 The third element says tracking
22 movement of the user from the user environment
23 of the web-based computing platform to a second
24 user environment of the web-based computer

1 platform, and we talked about that in claim one,
2 except here it's web based, and we showed that's
3 web based.

4 Finally, dynamically updating
5 stored metadata with an association of the data
6 to the application and the second user
7 environment. For this entire claim, we've
8 already covered -- we talked about dynamically
9 updated stored metadata.

10 Q. For the very last portion?

11 A. Remember that this is all about
12 users being able to review their decisions and
13 to see all the things that have happened, so
14 this is where a person can employ at least one
15 application from the data to the second
16 environment, second context in fact, at any
17 time.

18 Q. What does that mean to you? The
19 user employed one of the applications and the
20 data?

21 A. It means they can look at the data
22 at a later time. It's not just stored in the
23 system for nobody to look at it. This is
24 something for people to use and review.

1 Q. What is your opinion regarding
2 claim nine and the Swartz patent?

3 A. That claim nine anticipates the
4 761 patent. That is, it discloses each and
5 every element.

6 Sorry. Said that wrong. Swartz
7 discloses each and every element of claim nine
8 of the 761 patent.

9 Q. Thank you.

10 Do you have an opinion regarding
11 claim eleven of the 761 patent regarding the
12 Swartz reference?

13 A. Claim eleven essentially adds
14 comprising indexing contents of the user
15 environment such that a plurality of users can
16 access the content from an associate plurality
17 of user environments.

18 Q. Let's start from the --

19 A. Okay.

20 Q. -- very beginning --

21 A. Claim nine.

22 Q. -- claim eleven.

23 A. Sorry. Claim eleven adds the
24 method of claim nine further comprising indexing

1 content of the user environment subset of
2 plurality of users can access the content from
3 an associated plurality of user environments.

4 Q. From a plurality of user --

5 A. Plurality of users can access the
6 content from an associated plurality of user
7 environments.

8 Q. What does that mean?

9 A. Essentially this means that the
10 content is indexed, so an index is created so
11 that one or more people can access it from one
12 or more user environments.

13 Q. Is that disclosed in the Swartz
14 patent?

15 A. Yes, it is. I believe I
16 identified the part. Here it is.

17 Here's an example. This is
18 something that's fairly familiar to most people,
19 is part of searching. So the ability to
20 initiate and retrieve information that indexes
21 documents across the enterprise by accessing
22 industry standard databases and presenting the
23 results ins an easy-to-use and read format.

24 Q. What is your opinion regarding

1 claim eleven and the Swartz patent as it relates
2 to the 761 patent?

3 A. My opinion is that Swartz
4 anticipates or discloses claim eleven of the 761
5 patent.

6 Q. Do you have ran opinion regarding
7 claim twenty-one --

8 A. Yes, I do.

9 Q. -- of the 761 patent as it relates
10 to Swartz?

11 A. Yes, my opinion as before is that
12 Swartz discloses each and every element of claim
13 twenty-one.

14 Q. How is that?

15 A. Again there's a lot of
16 similarities between this and the previous
17 claims. I'm going to highlight the differences.

18 We're talking about a
19 computer-readable medium for storing
20 computer-executable instructions. Essentially
21 this means we have a computer program that's
22 stored somewhere.

23 And again Swartz describes a
24 computer-based system, so anyone skilled in the

1 art knows that would be on a computer-readable
2 medium.

3 And the first element, he talks
4 now about the user workspace instead of a
5 context or user environment. There's parts of
6 the patent where the 761 patent talks about a
7 user workspace as being the same as an
8 environment or context, but it's safe to say
9 that Swartz is describing a system where people
10 are working within that system, so that's their
11 using workspace, so whether or not we look at
12 the definitions, that this is what Swartz is all
13 about as well.

14 Then he talks about a web-based
15 computing platform. We talked about that. We
16 talked about dynamically associating metadata
17 with data. We talked about everything in that
18 second element before. We talk about tracking
19 movement, and I've talked about web-based
20 computing platform.

21 In the third element, we have
22 tracking movement from the user workspace to the
23 second user workspace of the web-based computing
24 platform. Swartz talks about tracking movement.

1 Essentially the systems are using workspaces,
2 and it's a web-based computing platform.

3 Then the fourth element says
4 dynamically associated with data and the
5 application of the second user workspace and the
6 metadata such that the user employed the
7 application and data from the second user
8 workspace --

9 I remember to slow down.

10 -- and again we've seen all that
11 before. This is just done in the context of a
12 user workspace instead of environment.

13 And the final one, he adds
14 indexing the data creating the user workspace
15 such that a plurality of different users can
16 access the data via the metadata from a
17 corresponding plurality of the different user
18 workspaces. It's just bringing what is -- I
19 think it was claim eleven that talks about
20 indexing, so I've already spoken about how
21 Swartz discloses that.

22 Q. What is your opinion regarding
23 claim twenty-one of the 761 patent vis-a-vis
24 Swartz?

1 A. My opinion is that Swartz
2 discloses each and every element of claim
3 twenty-one of the 761 patent.

4 Q. Do you have an opinion regarding
5 claim twenty-three?

6 A. This is very much the same with
7 some minor differences. I know it seems
8 tedious.

9 Here he talks about a
10 computer-implemented system, and again Swartz is
11 talking about a computer system, so it's a
12 computer-implemented system.

13 Now he's talking about a
14 computer-implemented context component. Swartz
15 is talking about the data docket system, which
16 is software, computer-implemented context
17 component.

18 Now, a web-based server instead of
19 a web-based platform, I believe, and we saw how
20 we can access this system via the web, so this
21 would give it the functionality of a web-based
22 server for defining, first, user work space of
23 the web-based server assigning one or more
24 applications to the first user work space

1 capturing context data associated with user
2 interaction of the user while in the first user
3 workspace.

4 Essentially I've already spoken
5 about that in terms of how Swartz says we try to
6 capture everything people are doing. Within the
7 system context user workspace, this includes
8 applications and other things and then it says
9 for dynamically storing the context data as
10 metadata on a storage component of a web-based
11 server.

12 Again I addressed all this before.
13 We talked about how it's dynamically stored. We
14 talked about how this is a web-based server, and
15 it says metadata which is dynamically associated
16 with data created in the first user workspace.
17 That's all things I mentioned before.

18 The second element is very similar
19 to what was previously seen. You have a
20 computer-implemented tracking component, and
21 again the data docket software includes the
22 computer software, so it's computer implemented
23 and does tracking.

24 We talked about the server aspect

1 and tracking change information associated with
2 the change in access from the first user
3 workspace to a second user workspace, and we
4 talked about storage component as part of the
5 metadata and the user accessing that data from
6 the second workspace.

7 Q. What is your opinion regarding
8 twenty-three?

9 A. That Swartz discloses each and
10 every element of the twenty-three.

11 Q. Do you have an opinion regarding
12 claim twenty-five?

13 A. Sure.

14 So claim twenty-five adds on to
15 claim twenty-three where he says the context
16 component captures relationship data associated
17 with the relationship between the first user
18 workspace and at least one other workspace.

19 I spoke about this earlier when I
20 talked about the knowledge path. It's capturing
21 the relationship within a context or system or
22 user workspace and how they move to the next one
23 over the knowledge path, what happens over time.

24 Q. Do you have an opinion regarding

1 claim twenty-three?

2 A. Yes, that, Swartz anticipates.

3 Q. I'm sorry. Twenty-five. I said
4 it wrong.

5 With respect to claim twenty-five,
6 do you have an opinion?

7 A. Yes, Swartz anticipates or
8 discloses claim twenty-five of the 761 patent.

9 Q. Do you have an opinion regarding
10 claim thirty-one?

11 A. Sure. Claim thirty-one says
12 essentially -- takes -- I have to stop using
13 essentially.

14 Takes claim twenty-three and adds
15 that the storage component stores the data and
16 the metadata according to at least one other
17 relational and object storage methodology, so it
18 has to do at least one or the other.

19 Q. What is a relational storage
20 methodology?

21 A. Well, a relational storage method
22 is a relational database. It's a method used
23 for many decades in the industry to store data
24 on tables for later retrieval.

1 Q. Does Swartz disclose this?

2 A. Yes, I believe what he discloses
3 specifically is the second part of that, where
4 there's an object.

5 Can we go back to the claim. Just
6 go back one.

7 So what he disclosed specifically
8 is an object storage methodology, although
9 relational storage would be known to one skilled
10 in the art as well.

11 If we go back, we see Swartz says
12 another aspect of the present invention
13 visualizes objects and linkages maintained in
14 the integration knowledge base, so here he talks
15 about objects being maintained in the knowledge
16 base.

17 Q. Do you have an opinion regarding
18 thirty-one?

19 A. Yes.

20 Q. What is that?

21 A. That Swartz anticipates or
22 discloses the claim.

23 Q. Thirty-one?

24 A. Thirty-one.

1 Q. Do you also have an opinion
2 regarding, finally, claim thirty-two?

3 A. Yes. So Claim 32 adds onto Claim
4 23 where it says storing of the metadata in the
5 storage component in association with data
6 facilitates many-to-many functionality of the
7 data via the metadata.

8 Q. What does that mean?

9 A. Well, what the Court has construed
10 is that many to many means that essentially two
11 or more people can access -- I'm trying to
12 remember what the Court's construction was.

13 Q. You used --

14 A. Two or more people. I used the
15 Court's. Essentially it means that two or more
16 people can access two or more things in here.

17 And what we're really getting at
18 is that this isn't just a system for one person
19 to access one thing. It's for many people to
20 access many things from many different places.

21 I think that's the essence of it.
22 Now, just to remind you what Swartz is all about
23 is about this knowledge path.

24 Right. He's talked about this big

1 system where people from a whole bunch of
2 different places can query to find out what is
3 it that people did? What is it that they did in
4 this context and that context? Where were
5 decisions made? How can I understand what's
6 happened over time?

7 So -- so this is exactly what
8 Swartz is about. This isn't a single user
9 system. It's an enterprise-wide system that
10 allows multiple people to access data from
11 multiple places.

12 Q. So what is your opinion regarding
13 Claim 32?

14 A. That Swartz anticipates Claim 32
15 of the '761 patent.

16 Q. Can we pull up the face page of
17 the '761 patent, please? Can we highlight the
18 box that's titled References Cited, please?

19 Dr. Greenberg, do you see the
20 Swartz patent mentioned here?

21 A. No, I do not.

22 Q. So just in sum, what is your
23 opinion as it relates to how the prior art
24 Swartz patent applies to the asserted claims of

1 the '761 patent?

2 A. So overall, Swartz, which was, as
3 I said, about five years before the patent
4 application, the '761 application discloses each
5 and every element of the asserted claims of the
6 '761 patent.

7 Q. Can we go back to your summary
8 slide, please?

9 What is the next piece of prior
10 art that you studied?

11 A. The next piece of prior art is the
12 iManage Desk Site User Reference Manual which
13 describes the workings of the iManage 6.0
14 system.

15 Q. Can you pull that up, the face
16 page of iManage, Ken?

17 What is iManage?

18 A. So -- well, iManage is a document
19 management system, and I will have some
20 disclosures in there that talk about what it is.
21 But essentially iManage is a way for people,
22 groups of people to manage all their documents.

23 Q. And I apologize, this may be a
24 little bit tedious, but we're going to have to

1 go through this kind of just the same way we did
2 with the last one.

3 So when was iManage published?

4 A. Well, if we look at the second
5 page of the manual, it includes a date in it.
6 So this would be the second page of the iManage
7 Reference Manual.

8 No. No, it's not power point.
9 It's the reference manual itself. There.

10 There, that's it. Oh, it is power
11 point.

12 So the second page actually says
13 when this manual was last updated and we see
14 that the date is July 26th, 2001. Again, before
15 the filing date of -- well before the filing
16 date of either the provisional or the '761
17 patent.

18 Q. Can you please turn to DTX 1010 in
19 your binder?

20 A. I see it.

21 Q. And what is that document?

22 A. That's the iManage Desk Site 6.0
23 User Reference Manual that I used.

24 MS. KEEFE: Your Honor, may I

1 please move DTX 1010 into evidence?

2 MR. ANDRE: No objection.

3 THE COURT: It's admitted.

4 MS. KEEFE: Thank you.

5 BY MS. KEEFE:

6 Q. So can you give us a little bit of
7 a description of what iManage is and what this
8 document describes?

9 A. Sure. And I believe what I
10 identified, a part of this manual that gives an
11 overall summary of that. But iManage Desk Site
12 if you pull out that little bit at the bottom.

13 So this is using their own words.
14 It's essentially a -- it's an enterprise-wide
15 mission critical DMS or document management
16 system.

17 And this quote captures by, With
18 iManage DeskSite, you can simplify the task of
19 managing repositories of millions of documents
20 and making them available to thousands of users.

21 . So here what we're talking
22 about is -- this isn't like using your own
23 personal computers where you're trying to manage
24 your own files. This is all about how can we

1 actually create a system, a document management
2 system that will manage documents created by,
3 for example, people in your company, so we can
4 keep them in a safe and one place where all
5 those people can access all those documents.

6 And iManage, you know, in its own
7 flavor has a whole variety of functions that it
8 has. Now, I'm not going to walk through each
9 one of them, but it wants to bring your
10 attention to the last one where it says -- where
11 it tracks document usage and history because
12 that's the part of iManage that really spoke to
13 what we saw in the '761 patent.

14 Q. And so what do you -- what do you
15 understand that to mean?

16 A. Well, so in high-level terms, what
17 we're -- what iManage does, just as in Swartz,
18 it tries to track what people are actually doing
19 with their stuff as they -- you know, with one
20 or more documents as they do the work.

21 And when it says and history, it
22 means that we really want to create a record of
23 what's happening over time as people do the work
24 from different places with all these documents.

1 Q. And why would someone want to do
2 that?

3 A. Well, it's really important if
4 you're trying to figure out what happens in the
5 evolution of a document. So if you see the
6 terms above, we see create new version of
7 documents and check in and check out documents.

8 If you have people in an
9 organization working on a document, that this
10 could be like either a document for reading or
11 could be a program code, you often -- what
12 happens is that you will take a document, you
13 will check it out for your own use, so at any
14 time people know who has a copy of that
15 document.

16 You can create a new version of
17 it. And from that version, you can actually do
18 your own work and maybe somebody else will also
19 create a new version. And they'll do their own
20 work and maybe want to combine it at a later
21 time.

22 So all this is really part of how
23 do documents evolve over time? And it's real
24 important, if you're going to coordinate with

1 each other as a team or organization, that you
2 know what's happening to documents when and
3 where, and that you can actually go back and
4 review what's happened.

5 Q. Have you actually created some
6 graphics to help us understand how iManage
7 works?

8 A. Yes, I have. So what I'm going to
9 start with is a very -- is essentially -- well,
10 I'm going to start with what a user would see in
11 terms of the history system.

12 So remember that last thing says
13 that it tracks document use as a use and
14 history. And that is from the iManage manual?

15 Q. When you say "this", you mean the
16 box that we see here?

17 A. Yes. That window entitled history
18 - document. And I'm going to use this as a
19 context for explaining some of the inner
20 workings, because in the end this is a user
21 accessing some of the information.

22 So we see that at the top that
23 this window is referring to a particular
24 document underscored which is title 2_2.

1 Document. And actually this references a
2 certain topic. In this case, the topic is
3 iManage Travel Policy.

4 And typically documents are
5 created with a topic in mind what we see at the
6 bottom is a example of the information that
7 iManage -- that is tracked on the histories of
8 that document.

9 So starting at the first row, we
10 see that initially we had a user whose name was
11 Bowen.

12 Q. Now, where are you? Where are you
13 in the document?

14 A. The very first row right under
15 where it says -- so really it is the third line
16 of the window, the first highlighted line that's
17 highlighted in gray. Keep going.

18 Q. And just so our record is clear,
19 how do we know that we're on -- we're accessing
20 the history information of this iManage
21 document? Is there something on the bottom that
22 helps you with that?

23 A. Well, if you look at the tab on
24 the bottom right, it says History. And, in

1 fact, the title bar says History.

2 So this is the history and it's in
3 the section of the manual titled History. So
4 this is the history system.

5 Q. Okay. So when you were talking
6 about the first row, what did you want to have
7 us know?

8 A. Okay. So this is the -- kind of
9 the after the fact. This is a user viewing some
10 of the things that the system has tracked.

11 So we see that in the first line
12 that the system has tracked that there is a user
13 named Bowen by their log-in name, using an
14 application WinWord, which is likely Microsoft
15 Word, has checked in a document at a certain
16 time and has had that for a certain duration.

17 That person hadn't printed out any
18 pages from it. And it's at the location Bowen,
19 which because it's the same as the name, I would
20 assume is the user's computer; that they named
21 their computer the same as their log-in name.

22 And that the person has not added
23 any comments. So that's kind of the very last
24 thing that they did.

1 If you look at this list, it's
2 kind of in reverse time order, the last -- very
3 last thing they did at the top. Previous to
4 that, they had -- they had that same user using
5 WinWord, had actually modified the document.

6 And before that --

7 Q. And how do you know that?

8 A. Well, because it says modified
9 activities. The activity says modified.

10 In fact, let me just flip the
11 order of this. I think it will be easier to
12 understand.

13 Let's start with the bottom. So
14 we -- here we see at the bottom Bowen user.
15 Bowen using the Manage 32 system has created a
16 new version of this document.

17 Q. And what is a Manage 32 system?

18 A. This would probably be an iManage
19 document, the repository system itself.

20 So it's a different context. They
21 are using simply a different application.

22 They're going to the iManage system and saying,
23 I want to use -- I want to create a version.

24 And, in fact, the person has added a comment

1 that says created from version one.

2 And the next thing that they did
3 is that they checked out that version from the
4 Manage 32 system and then using WinWord or
5 Microsoft Windows. They modified that version.

6 So essentially -- well, what's
7 happening is they're really -- as I would read
8 this, they're starting with what's likely an
9 empty document and they're adding, starting to
10 create it.

11 And then they -- after doing some
12 work on it, they checked it back in. They're
13 checking it back in from Microsoft Windows.

14 Now, the reason we're seeing that
15 for Microsoft Windows is that the iManage system
16 also has parts of it that integrate with many of
17 the standard Windows applications like Office,
18 like Microsoft Window, Excel and those kinds of
19 things.

20 So what we have here is a history
21 of what's happened to the document as people
22 move between applications as they work over
23 time, and also, although we see only one
24 location here, it's also as they move across

1 different computers or different locations. So
2 all these define essentially context of work.

3 Q. Have you created a graphic to
4 demonstrate how the iManage system would work?

5 A. Yes, I have.

6 Q. Would you please walk us through
7 that?

8 A. Sure. So here we have what we've
9 seen before in that history system.

10 We have in this case a person
11 using Microsoft Word and that document and all
12 the activities that happen around that really
13 are what defines a context. So, as I mentioned,
14 the iManage Desk Site system is actively
15 integrated with most major Windows applications.

16 So you can actually change Windows
17 to interact with the iManage system that's from
18 Page 125 of the reference manual.

19 So we have a person comes in, if
20 we animate. Oh, sorry. And at the bottom, we
21 have the iManage library. And this is where
22 things are stored.

23 And here's a quote from Page 19 of
24 the manual, that phrase that, What is an iManage

1 library? And at the bottom, it says, Each
2 iManage library is actually composed of these
3 three parts a file server that stores the actual
4 documents, a set of information tables or
5 database that stores information about the
6 documents, that's the metadata, and a set of
7 index collections of the full text of documents
8 in the library, which is used for searching.

9 So this is -- if we animate again,
10 that's the storage component. So all the
11 activity that a person does in their first
12 context -- in this case, they're using Microsoft
13 Word creating a document -- in a certain
14 location is captured by the iManage history
15 system.

16 Now, if you go on.

17 It's stored in the library as part
18 of that. In this case, it's part of that
19 history record.

20 And we actually see here some of
21 the things that are attached to documents. And
22 again, this is something -- some of the
23 information captured by the system.

24 We see that every document has a

1 document profile record that includes things
2 like the author of the document, the operator
3 who or the user had entered into the library,
4 the date it was created, the version number, the
5 user who last edited it. So all these are being
6 tracked by the system.

7 Q. And what would -- is there a word
8 in the '761 patent that would apply to what you
9 just described?

10 A. Yeah, so this is metadata. We're
11 talking about capturing and storing metadata
12 here.

13 And now if we go on, I've shown
14 before how the history window will track what
15 people do across the different contexts. In
16 this case, they move from one application
17 setting where they're working on documents to
18 another one.

19 And in the manual itself on Page
20 13, it says that one of the functions of the
21 iManage system is to track document uses and
22 history. So we saw that history window. This
23 person had moved over to a different context.

24 And if we go on. Then that kind

1 of activity is actually captured and stored.

2 And here's an example from Page 828 to 83.

3 Some of the things that may be
4 captured, things like opening a document,
5 editing the document's profile, checking out,
6 copying or checking in a document, whether
7 somebody viewed it or whether somebody created a
8 new version.

9 This is just a system sampling of
10 the content information that can be tracked.
11 And now if we go on. I think there's one more.

12 The person can access that
13 information from any time. We saw them
14 accessing their history record from the history
15 window. But I believe there's also means to
16 access the document itself.

17 Q. Are there particular features --
18 so are the particular features of the system you
19 just described applicable to the claims of the
20 '761 patent?

21 A. Well, yes.

22 Q. Can you use Claim 1 as an example
23 and walk us through it?

24 A. Sure. So here's Claim 1.

1 And we saw in the first part
2 here -- well, first it says a
3 computer-implemented network-based system.
4 IManage -- first, it should say that iManage is
5 network based and I believe I've identified a
6 part of the manual that shows that.

7 Do we have that? Yes, there it
8 is.

9 So here -- here's the way that
10 iManage shows itself. We see a client-server
11 relationship which is vernacular for -- for one
12 application talking to another kind of -- sorry,
13 one system using -- usually on a PC talking to
14 another system called the server or the network.

15 And we see that -- that we have
16 all -- all these things are networked together.
17 Essentially these little lightning bolts that
18 says that we can access those stored across
19 different cities or places. So the
20 network-based system.

21 Q. Just so the record is clear, where
22 is this in the document?

23 A. Well, this is Figure 1.1.

24 Q. Thank you.

1 Does the iManage documentation
2 include other elements from Claim 1?

3 A. Yes. So we then have in the first
4 element, it says the computer-implemented
5 context component. I've already described how
6 the history system can capture information that
7 happens within a certain application setting of
8 the document. That is, people are using with
9 this that setting or from particular locations.

10 We already talked about how it's
11 network based. And I've shown you how it
12 captures context information. We saw that in
13 that history window.

14 That is associated with
15 user-defined data which is the third line. When
16 the user-defined data -- in this case, the
17 documents they're working on, we saw that
18 Microsoft Window document.

19 Clearly the user is interacting in
20 a first context of a network-based system in
21 this case. iManage actually has many different
22 contexts that you could use. It talks about the
23 location the computer's using it on and the
24 things you're doing on that computer is one

1 possible context.

2 It talks about here's the
3 application. You're using the document. You're
4 using it in that application and the stuff
5 you're doing with in that. And that's another
6 example of a context.

7 Then if we go on, it says the
8 context component dynamically storing the
9 context information in metadata associated with
10 the user-defined data.

11 Now, we saw that in the history
12 list, the history list says here's the data.
13 That is the name of the file that we're working
14 on and here's all the activities that people are
15 doing on it.

16 Q. Is there a portion of the iManage
17 documentation that describes some of the other
18 metadata that may also be captured?

19 A. Yes. And I believe I've
20 identified that.

21 If we can bring that up. So this
22 is the part of the iManage manual and I can't
23 recall what page it's on.

24 Q. Could it be in chapter 3?

1 A. It's very possible. So here this
2 is the section of the manual that says history
3 of document activity. This is what we're
4 talking about, the activities or metadata that
5 can be captured.

6 And it says displaying history of
7 document activity. And it says -- let me just
8 try to go to the bottom just above the bullet
9 point. The line says the types of activities
10 typically recorded in the document activity
11 record.

12 So this is of the history. Right,
13 the history system you saw are things like
14 opening and closing the document in an
15 integrated application that we saw an example of
16 that with Word, how long the document was open.
17 Whether the document's profile was edited,
18 changing the access rights of the document.

19 Q. What does that mean?

20 A. It means who can actually see,
21 read or edit the document usually. Printing a
22 document and how many pages were printed.

23 And this is, for example, if you
24 want to do an accounting and actually charge

1 people for printing, that would be a use of
2 that.

3 Checking out, copying and/or
4 checking in the document. So that's who has
5 copies currently out. So that if I know that
6 you have a copy of a document out, maybe if
7 you're editing it, then I may not want to change
8 it, because otherwise we'll have two different
9 versions and it will enter into confusion.

10 Whether the document is viewed or
11 who's viewing it. Whether the document was
12 mailed, whether somebody created a new version
13 of the document. A computer location where the
14 activity took place.

15 Q. What does that mean?

16 A. It means essentially what computer
17 did you do all this activity from? So was this
18 from your home computer, your laptop, your
19 office computer, internet cafe? Where did you
20 do your work?

21 And finally, any comments the user
22 wanted to make about their own activities. So
23 this is a free-form field where you can put in
24 any information you want.

1 So really this captures a lot of
2 information about what people are doing.

3 Q. And what about the rest of the
4 elements of Claim 1?

5 A. Well, let's go back to Claim 1.
6 So we were -- where were we?

7 Here?

8 Q. I think.

9 A. So we talked about capturing
10 context information. We're in the first
11 element.

12 So we talked about what -- where
13 are we? Okay.

14 Q. I think we're at the part of the
15 storage.

16 A. So the context component
17 dynamically --

18 THE REPORTER: Could you please
19 slow down.

20 THE WITNESS: Thanks. Keep
21 reminding me.

22 The context component dynamically
23 storing the context information in metadata. We
24 saw that associated with the user-defined data.

1 We saw that.

2 That's -- it's like -- that's the
3 document people are using.

4 The user-defined data and metadata
5 stored on a storage component of the
6 network-based system. And early identified that
7 iManage has those storage components. In fact,
8 that was also in that graphic that I showed up.

9 The second element talks about a
10 computer-implemented tracking component of the
11 network-based system. And this is software
12 that's also part of the history system, because
13 we saw how it could track what people are doing
14 across computer locations, across applications
15 and, in fact, across many activities for
16 tracking a change of the user from the first
17 context to a second context.

18 And we saw that in the history
19 window where you could see the sequence of
20 events, how people would do things in one place
21 and then they would actually do things in a
22 different or separate context.

23 We saw it. It was a network-based
24 system and as well, this is dynamic, because

1 this history list is -- this history record is
2 created on the fly.

3 As people do things, the system
4 will actually record all the events that they're
5 doing. And then finally, it says, Wherein the
6 user can access the data from the second
7 context. And I have a slide here -- sorry, not
8 a slide, but a part of the reference manual that
9 I'd like to illustrate for this one.

10 Yes.

11 Q. Where are we in the document?

12 A. So we're on Chapter 3, Page 3,
13 Figure 3.26.

14 So if we expand that. This is the
15 figure we've seen before, but now if you look at
16 the very bottom, we're in the history tab. But
17 if you look over one, two, three left, we see
18 something called Quick View.

19 And Quick View is an ability to
20 look at that document and read a read-only
21 version of that document. So here we have that
22 last part of that claim element where users can
23 access the data.

24 I should add that you can also

1 that -- iManage lets you do more. You can also
2 manage the document version. And there's a tab
3 for that or even related documents or the
4 profile of that document you can access.

5 Q. So after all of that, Dr.
6 Greenberg, do you have an opinion regarding the
7 Swartz, the iManage publication and how it
8 relates to Claim 1 of the '761 patent?

9 A. Yes, I do.

10 Q. And what is that?

11 A. That the iManage reference manual
12 discloses each and every element of Claim 1.

13 Q. Do you have an opinion regarding
14 the iManage documentation vis-a-vis Claim 4 of
15 the '761 patent?

16 A. Yes, I do. So here we see -- I've
17 mentioned this before in talking about Swartz,
18 that this adds a relationship between the user
19 and at least one of an application data and user
20 environments is clearly disclosed in the history
21 table.

22 I've shown you -- we saw the user
23 -- we saw the application data, which is the
24 document name, user environment, things like the

1 application they're using, and so on.

2 Q. Do you have an opinion regarding
3 claim four?

4 A. Yes.

5 Q. What is your opinion regarding
6 claim four and the iManage reference manual?

7 A. That the iManage reference manual
8 discloses claim four.

9 Q. And I'm sorry we have to go
10 through this with such tedium, but the law makes
11 us do it.

12 Do you have an opinion regarding
13 claim seven?

14 A. Claim seven adds "where data
15 created in the first context is associated with
16 data created in the second context." We saw
17 that again in the history system, where it was
18 shown as a record of here's what happened at one
19 step versus another versus another.

20 So it shows a movement between
21 these and thus the relationship.

22 Q. What is your opinion regarding the
23 iManage reference manual and claim seven?

24 A. That the iManage reference manual

1 discloses claim seven.

2 Q. Do you have an opinion regarding
3 claim nine?

4 A. Claim nine.

5 THE COURT: Let me interrupt
6 before we go to claim nine. We'll take a break
7 for fifteen minutes.

8 MS. KEEFE: Thank you, Your Honor.

9 THE CLERK: All rise.

10 (The jury exited the courtroom at
11 2:59 p.m.)

12 THE COURT: Feel free to step
13 down.

14 Mr. Andre.

15 MR. ANDRE: Your Honor, based on
16 counsel representation, I had our expert fly in
17 last night to be prepared to testify this
18 morning, and obviously I don't think we'll be
19 lucky to get this witness off the stand at this
20 point, so do I have your permission to send him
21 home?

22 THE COURT: Ms. Keefe, how much
23 longer do you think this will be?

24 MS. KEEFE: It all depends on how

1 long his cross is.

2 THE COURT: How much time do you
3 anticipate?

4 MS. KEEFE: I hope to finish it by
5 four o'clock. I think it will get faster at
6 this point.

7 THE COURT: We really need to have
8 the doctor slow down.

9 MR. ANDRE: They're going to have
10 the rest of the claims, another reference, after
11 this obviousness. If we get our witness up on
12 the stand at all, it will be five or ten
13 minutes. He flew from Pittsburgh to be here.
14 I'd like to get him home.

15 THE COURT: I think it's okay to
16 let him go. We're going to start our prayer
17 conference, so if we start a little earlier,
18 that's fine. We'll see you at 3:15.

19 (The proceedings reconvened at
20 3:17 p.m.)

21 THE CLERK: All rise. Court now
22 in session.

23 MR. RHODES: Your Honor, we were
24 just talking about scheduling, and I think we

1 can get it all done Monday. The only thing I
2 want you to think about, if the first witness
3 goes on and off and we go to late morning, then
4 you instruct --

5 THE COURT: Let's talk about this
6 after we get through the evidence today.

7 THE CLERK: All rise.

8 (The jury entered the courtroom at
9 3:18 p.m.)

10 THE CLERK: Please be seated.

11 THE COURT: Welcome back, and
12 let's get started.

13 MS. KEEFE: That's fine. Just --
14 you don't need to put it back. Thank you,
15 though.

16 BY MS. KEEFE:

17 Q. Dr. Greenberg, I think right
18 before the break we were going to dive into the
19 claim nine and apply it to the iManage Reference
20 Manual.

21 A. That's correct.

22 Q. Do you have an opinion regarding
23 claim nine and the iManage Reference Manual?

24 A. Yes, I do.

1 Q. What is that opinion?

2 A. That iManage discloses each and
3 every element of claim nine.

4 Q. Why is that?

5 A. If we go through this, we see a
6 computer-implemented method of managing data
7 comprising computer-executable acts, so iManage
8 defines a computer system; therefore, it's a
9 computer-implemented method.

10 We see creating data within the
11 user environment of a web-based computing
12 platform. I believe I've identified some parts
13 of the iManage manual that show it's web based
14 if we could bring that up, so here's one part,
15 which is on --

16 Q. Where are we in the document?

17 A. Unfortunately it's hidden by this.
18 Chapter three, page three.

19 It says "In order to send a
20 document URL link, your system must include an
21 iManage worksite web component server." So this
22 illustrates that iManage has web capabilities.
23 It's a web platform.

24 If we can go on, and there's

1 another one where it says here, on page
2 seventy-four, it says you can send a copy of a
3 document, a link of a document, or URL link of a
4 document through e-mail from iManage desk site.
5 The fact that you can send a URL to a document
6 also says that iManage must be web based.

7 Q. Anything else?

8 A. I believe there's one more, and
9 here it says -- in chapter six, page
10 fifty-seven, it says in the worksite box, you
11 can enter the URL for accessing the iManage
12 worksite in the base path field, and there's
13 further things that talk about sending document
14 to URL link or sending folder to URL link.

15 Q. Was there a figure that showed
16 that in the reference manual?

17 A. Yes. Well, it doesn't show this.
18 It shows another capability where we see that
19 iManage itself, in fact, has an address bar, and
20 this is where it says web URL. That's directly
21 from their image, so you can access things from
22 the web, so yet again shows capabilities of a
23 web-based platform.

24 Q. What about the remaining elements

1 of claim nine?

2 A. Let's take a look. So it
3 continues in the first paragraph "via user
4 interaction with the user environment by a user
5 using an application." The data, in the form of
6 at least files and documents.

7 We've seen that before. We're not
8 talking about user environment. The Court has
9 defined the context to be the same as
10 environment.

11 Regardless of that, the iManage
12 system, all these contexts are user environments
13 where users do their work.

14 The next element says dynamically
15 associating metadata with the data, and we've
16 seen that before. We saw that in the history
17 list.

18 The data and metadata stored on a
19 storage component or a web-based computing
20 platform, which is the same as claim one, but it
21 now has web-based computing platform.

22 And we saw that the metadata
23 includes information related to the user, the
24 data, the application, and the user environment.

1 And again we saw that before as part of the
2 history record as well as the documents that
3 list what iManage can, do and there it all is
4 right there.

5 So if we can go on --

6 Q. What about the remaining elements
7 of claim nine?

8 A. Back to claim nine. So now we're
9 at the third element or third paragraph, where
10 it says "tracking movement of the user from the
11 user environment of the web-based computing
12 platform to a second user environment of the
13 web-based computing platform."

14 This is all things we've seen
15 before except that it uses different words,
16 "user environment," that we addressed,
17 "web-based computing platform" that we
18 addressed, so this is all covered.

19 Q. What about the last section?

20 A. Again very similar to what we've
21 seen before.

22 "Dynamically associating the
23 stored metadata with an association of
24 the data, the application, and the

1 second user environment, wherein the
2 user employs at least one of the
3 application and the data from the second
4 user from the second environment."

5 And again this is all things we've
6 seen before. We saw that in the history record.
7 I've shown how you can access information
8 through those tabs on the bottom of the history
9 window. I've shown how you dynamically update
10 the stored metadata as part of this history
11 record.

12 Q. So what is your opinion regarding
13 claim nine and how it applies to the iManage
14 Reference Manual?

15 A. That iManage discloses each and
16 every element of claim nine.

17 Q. Do you have an opinion regarding
18 claim eleven?

19 A. Yes, I do.

20 Q. What is that?

21 A. That iManage discloses claim
22 eleven.

23 Q. What does claim eleven add to
24 claim nine?

1 A. Claim eleven adds "further
2 comprising indexing content to the user
3 environment such that a plurality of
4 users can access the content from an
5 associated plurality of user
6 environments."

7 Q. Where is that in the iManage
8 Reference Manual?

9 A. I showed a quote previously.
10 We'll bring it up again.

11 When the iManage system describes
12 itself, it describes itself as having three
13 distinct entities: A file server, a set of
14 information tables, or database. And these, by
15 the way, have indexes to them and then it also
16 says a set of index collections to the full-text
17 documents in the library.

18 Q. Where is this in the iManage
19 Reference Manual?

20 A. This is chapter one, page
21 nineteen. If you look at the bottom, it says
22 these three components work together to organize
23 and index your documents, so for emphasis of
24 that.

1 Q. With that, what is your opinion
2 regarding how the iManage Reference Manual
3 applies to claim eleven?

4 A. My opinion is that iManage
5 discloses what's in claim eleven.

6 Q. Do you have an opinion regarding
7 claim sixteen and how it applies to the iManage
8 Reference Manual?

9 A. Yes, this is one we haven't seen
10 before, at least not in my testimony. It's the
11 method of claim nine further comprising
12 accessing the user environment by importable
13 wireless device.

14 Q. What does that mean?

15 A. Well, it essentially means can we
16 access the -- we can access all the stuff from a
17 wireless device such as laptop or PDA or
18 something like that.

19 Q. What is your opinion regarding
20 claim sixteen?

21 A. That iManage discloses claim
22 sixteen.

23 Q. How does it do that?

24 A. I brought an identified part in

1 the reference manual that talks about iManage
2 portable, and if we look at the first paragraph,
3 it says a portable mode of operation allows you
4 to take an iManage desk site document management
5 system on the road with you, and it helps you
6 synchronize your work with the network.

7 So this is around the year 2000
8 and -- sorry. 1999. I can't recall the exact
9 date, but at that time there was a lot of stuff
10 about what we called road warriors. These are
11 people who would work in the office and then
12 would take their stuff on the road and access
13 their materials from computers elsewhere, a
14 portable computer, or wireless laptop computer.

15 And what iManage has in this
16 disclosure, it says that you can take your stuff
17 on the road with you, and you can access -- not
18 only will we let you work disconnected, but if
19 you're connected at any time -- and that could
20 be through your wireless device -- you would be
21 able to access all the information as if you
22 were wired.

23 Q. And where in the iManage Reference
24 Manual are we looking at?

1 A. We're on the first page of chapter
2 eight.

3 Q. What is your opinion regarding
4 claim sixteen and the iManage Reference Manual?

5 A. That the iManage Reference Manual
6 discloses the information in claim sixteen.

7 Q. Do you have an opinion regarding
8 claim twenty-one and how it applies to the
9 iManage Reference Manual?

10 A. Yes.

11 Q. What is that?

12 A. That the iManage discloses what
13 each and every element of claim twenty-one.

14 Q. How is that?

15 A. Again we see the computer-readable
16 medium for storing computer-executable
17 instructions, and this is -- again iManage
18 Reference Manual describes a computer system;
19 therefore, one skilled in the art would know it
20 would be on a computer-readable medium for
21 storing computer-executable instructions.

22 And the system manages data and
23 then it says "creating data related to user
24 interaction of a user within a user workspace of

1 a web-based computing platform."

2 We talked about all this before.
3 The only difference is that it's a user
4 workspace. IManage gives a place for people to
5 do their work, so by definition it gives them a
6 user workspace, so that's covered.

7 The second elements is dynamically
8 associated metadata with the data. We saw that
9 on the history system. The data and metadata
10 stored on the web-based computing platform, and
11 again we talked about all this before.

12 The metadata includes information
13 related to the user of the user workspace to the
14 data, to the application, and to the user
15 workspace. We saw that before in the history
16 record plus the section that describes what the
17 information captured.

18 Q. How about the tracking?

19 A. So we see tracking movement of the
20 user from the user workspace to a second user
21 workspace of the web-based computing platform,
22 and again we've seen that this is just now in
23 the context of a user workspace.

24 Do I have to read each and every

1 one of these?

2 Q. Unfortunately we have to go
3 through each one so we know that each reference
4 applies to every element.

5 A. Okay.

6 Q. What about the dynamic association
7 of the data and the application with the second
8 user workspace and the metadata?

9 A. Again we've seen that before. We
10 talked about the history record shows the data
11 and the application and the second user
12 workspace, and that's stored as metadata.

13 Q. What about the user employing the
14 application and data from the second user
15 workspace?

16 A. Again we've seen that before. We
17 saw that we have a history record people can
18 see. They can actually bring up the document,
19 and they have other means for accessing versions
20 of that document.

21 Q. And finally, what about the
22 iManage Reference Manual's discussion of
23 indexing the data created in the user workspace
24 such that a plurality of different users can

1 access the data via the metadata from a
2 corresponding plurality of different user
3 workspaces?

4 A. Again we've seen that before in
5 the previous claim about indexes, so this is
6 covered as well.

7 Q. What is your opinion regarding
8 claim twenty-one and the iManage Reference
9 Manual?

10 A. That -- that the iManage Reference
11 Manual discloses each and every element of the
12 claim twenty-one.

13 Q. What about claim twenty-three?

14 A. Claim twenty-three talks about a
15 computer-implemented system that facilitates
16 management of data. The iManage Reference
17 Manual talked about a computer-implemented
18 system.

19 Q. Does the iManage Reference Manual
20 have a computer-implemented context component?

21 A. Yes, it does, and in this case, it
22 also says it's of a web-based server. You can
23 access things from it via the web; therefore,
24 there has to be a server as well.

1 Q. Does the iManage Reference Manual
2 disclose workspaces?

3 A. Yes, it does, and we already spoke
4 about user workspaces.

5 Q. What about capturing context data
6 associated with user interaction of a user while
7 in the first user workspace?

8 A. Yes, it does, and we talked about.

9 Q. What about the rest?

10 A. All this was spoken about
11 previously. It dynamically stores the context
12 data as metadata on a storage component.

13 In this case it's on a web-based
14 server, which it is, and data is associated with
15 data created in the first user workspace.

16 Q. What about the
17 computer-implemented tracking component of the
18 web-based server for tracking change in
19 information associated with a change in access
20 of the user from the first user workspace to the
21 second user workspace? Is that in the iManage
22 Reference Manual?

23 A. Yeah, it is.

24 Q. What about the rest?

1 A. Essentially it's a rewording of
2 everything I've covered already.

3 Q. What is your opinion regarding
4 claim twenty-three as it applies to the iManage
5 Reference Manual prior art?

6 A. That iManage covers -- discloses
7 each and every element of claim twenty-three.

8 Q. Almost there.

9 What about claim twenty-five? Do
10 you have an opinion on claim twenty-five?

11 A. Okay. So claim 1025 is that the
12 context component capturing relationship data
13 associated with a relationship between the first
14 user workspace and at least one other user
15 workspace, and I've already described that, in
16 that people are working, user workspace, and
17 this is shown as part of the history system.

18 Q. Where is that? Here?

19 A. Yes.

20 Q. And here, for the record, would be
21 in figure 3.26; is that correct?

22 A. That's correct. We see that as
23 part of the user's view of the history.

24 Q. What is your opinion regarding

1 claim twenty-five?

2 A. That the iManage Reference Manual
3 discloses claim twenty-five.

4 Q. With respect to claim thirty-one,
5 do you have an opinion?

6 A. Yes, this claim says that the
7 storage component stores the data and the
8 metadata according to at least one of a
9 relational or object storage methodology, and
10 we've seen that before in the description of
11 what iManage does. It actually talks about
12 databases. It talks about tables and things
13 like this.

14 Q. Where is that in reference manual?

15 A. I believe I identified it.

16 If we look at this here, there we
17 see the second one talks about information
18 tables or databases. We talked about the file
19 server and source of file. Files are objects,
20 so all that's covered.

21 Q. If we go back to the claim
22 language, and why does the mention simply of
23 tables tell us that we have relational and/or
24 object storage methodology?

1 A. It said databases before, and it
2 said a table, so that's a relational database.

3 Q. What's your opinion regarding
4 claim thirty-one?

5 A. That iManage discloses claim
6 thirty-one.

7 Q. And finally, claim thirty-two. Do
8 you have an opinion regarding thirty-two?

9 A. Yes, I do.

10 Q. What is your opinion regarding
11 claim thirty-two and the iManage Reference
12 Manual?

13 A. IManage discloses claim
14 thirty-two.

15 Q. Why is that?

16 A. Here we have -- this speaks to the
17 Many2Many functionality of data and iManage as a
18 document management system. That's what it's
19 for. As I mentioned at the beginning, it says
20 so thousands of users can access millions of
21 documents and all the information within them.
22 This is for multiple people to access multiple
23 things.

24 Q. What is your opinion regarding

1 claim thirty-two vis-a-vis the iManage Reference
2 Manual?

3 A. That the iManage Reference Manual
4 discloses what is found in claim thirty-two.

5 Q. Have you heard of the term
6 enabling reference or enables prior art?

7 A. Yes, I have.

8 Q. What does that mean?

9 A. It means that the description is
10 rich enough that one of ordinary skill in the
11 art could build a system that has those
12 characteristics.

13 Q. As far as the claims of the 761
14 patent -- just have those in mind -- is it your
15 opinion that the iManage Reference Manual is an
16 enabling reference?

17 MR. ANDRE: Objection, Your Honor.
18 Outside the scope of this expert's report.

19 THE COURT: We'll note the
20 objection. You may answer if you have the
21 question in mind.

22 THE WITNESS: Can you read back
23 the question, please, or restate the question.

24 BY MS. KEEFE:

1 Q. Do you believe that the iManage
2 Reference Manual is an enabling reference?

3 A. Yes, I do.

4 Q. Can you pull up the front page of
5 the patent and pull up the references cited
6 section, please. I think we're missing one from
7 the very bottom. The references cited are in
8 two places.

9 Dr. Greenberg, do you see the
10 iManage Reference Manual listed here?

11 A. No, I do not.

12 Q. So in conclusion, regarding the
13 prior art, iManage Reference Manual, what is
14 your opinion regarding the asserted claims of
15 the 761 patent?

16 A. So my opinion is that the iManage
17 Reference Manual discloses each and every
18 element of all of the certified claims of the
19 761 patent.

20 Q. And what does that mean for
21 validity of the 761 claims?

22 A. It means that the patent is
23 invalid. The ideas were expressed in this
24 publication well before the 761 patent was

1 filed.

2 Q. Thank you.

3 Can we pull up the summary slide
4 again, please. We're getting there. I promise.

5 What is the third document that we
6 see under the second opinion?

7 A. The third document is a European
8 patent application, by EP 1087306 A2, and the
9 inventor is Hubert, and I believe this patent
10 was assigned to Xerox.

11 Q. Do you have an opinion regarding
12 the Hubert patent?

13 A. I do.

14 Q. What is that?

15 A. That Hubert discloses all but
16 claim sixteen of each and every element of --
17 all but claim sixteen of the asserted claims of
18 the 761 patent.

19 Q. Can you please turn to DTX 0922 in
20 your binder.

21 A. I have it.

22 Q. Do you recognize that?

23 A. Yes, that is the Hubert patent.

24 MS. KEEFE: Your Honor, I would

1 move the DTX 0922 into evidence, please.

2 MR. ANDRE: No objection.

3 THE COURT: It's admitted.

4 BY MS. KEEFE:

5 Q. Pull up the front page of the
6 Hubert patent. When was it published,
7 Dr. Greenberg?

8 A. If we look at it, we see the date
9 of filing is August 29th of the year 2000, and
10 it was published on March 28, 2001. That's at
11 the very top.

12 Q. What does that mean, date of
13 publication?

14 A. Well, this is the date --

15 Q. Not a tricky question.

16 A. It means it's when it was
17 published.

18 Q. What -- does it mean is it
19 publicly available?

20 A. Publicly available, yes.

21 Q. What is the Hubert patent about?

22 A. The Hubert patent is actually
23 quite similar at a high level to what we saw
24 before with Swartz and with iManage. It was

1 really about --

2 Hubert was concerned as well with
3 how can we track all the activities as people
4 work across or within and between environments,
5 in particular within documents and the data that
6 they were using.

7 Q. Before I move on, I realized I
8 forgot to ask you another question about Hubert.
9 Could you please turn to DTX 0604.

10 A. I have it.

11 Q. And what is that?

12 A. This is the U.S. patent that was
13 granted to Hubert, where it's essentially the
14 same as the European patent application.

15 MS. KEEFE: I would also move DTX
16 0604 into evidence.

17 MR. ANDRE: Your Honor, may I have
18 one moment.

19 THE COURT: Sure.

20 MS. KEEFE: It relates back to the
21 European patent application.

22 MR. ANDRE: No objection, Your
23 Honor.

24 THE COURT: It's admitted.

1 BY MS. KEEFFE:

2 Q. You were just talking about what
3 the Hubert patent was about. Have you prepared
4 some graphics to illustrate what Hubert was
5 trying to accomplish?

6 A. Yes, I have.

7 Q. What was Hubert all about?

8 A. Hubert was -- again he had a
9 similar notion he had, that he wants to track
10 how data or documents would move between
11 different sources or different environments, so
12 in this case, we're talking about context.

13 If you look at the quote on the
14 bottom, it says "In some organizations the
15 document will be indexed and described
16 in terms of important keywords and
17 stored in a document-management
18 repository where it may be accessed via
19 an intranet or over the internet."

20 So here we have the storage
21 component as well. These are terms of Hubert.
22 He talked about sources and environments. If we
23 go on, Hubert came up with this idea, what he
24 calls a metadocument, and this is an object that

1 conveys, as we see in the quote, that conveys
2 document information, processing information
3 pertaining to the processing of the
4 metadocument, and metadata for indexes and
5 retrieving the processing information.

6 That's a bit of a mouthful. If we
7 go on to the next slide, this is what we have
8 here. So the idea in Hubert is that you have
9 those documents, a thing called the
10 metadocument. This is the picture on the right,
11 figure one from his patent.

12 And the idea is that the
13 metadocument would contain data, but it would
14 also contain metadata as well as the processing
15 information, which is yet another form of
16 metadata that captures all the things that
17 people are doing to that document over time, and
18 that information would be stored.

19 Now, if we go on some more, Hubert
20 talks about -- and this is a quote from him --
21 "when metadocument is transmitted from source to
22 source and processing information is created --"

23 So this is -- the things that are
24 done to a document, this is similar to a bee

1 traveling to a flower and picking up pollen. So
2 this is his own words. It's rare you find
3 metaphors like this in patents.

4 He had this idea that the document
5 would see all the things that would happen to
6 it, would capture all the things happening to it
7 in a certain source of environment, and move it
8 across the network from one environment to
9 another or from one context to another, that
10 that information would spread to other places.
11 It would keep on collecting pollen, so to speak,
12 or knowledge as metadata that it would store.

13 So if you go on, all that captured
14 knowledge is essentially, as it says here on the
15 quote, on the left is stored in the
16 metadocument, and we have that captured in this
17 figure on the right where you see stored data
18 processing information, metadata that describes
19 all the things that happen to this document in
20 these different environments.

21 Q. Are there other things in the
22 Hubert patent that help illustrate this?

23 A. If we look another figure two, so
24 we see Hubert drew three different sources or

1 environments, and again he uses the word
2 environment or context interchangeably, which is
3 defined as context by the Court,
4 interchangeably.

5 What we see in that little square
6 if the bottom is the metadocument, which is
7 seeing what's happening, what a person is doing
8 in each location, and as you move that document
9 from one source to another, one context to
10 another, in this case, over the internet, it
11 captures what goes on in those places as well,
12 and it pollinates it, which means it makes that
13 information available to those other sources.

14 Q. Before I forget to tie one loose
15 end, we mentioned Hubert filed his first patent
16 in Europe?

17 A. Yes.

18 Q. And then he filed in the United
19 States?

20 A. That's correct.

21 Q. Are the filings he made in Europe
22 and the United States similar?

23 MR. ANDRE: Objection. Outside
24 the scope of his report.

1 THE COURT: Objection noted.

2 THE WITNESS: Except for the
3 differences -- except for all the disclosures,
4 the text, the figures are identical, yes.

5 BY MS. KEEFFE:

6 Q. Are there particular features of
7 the system disclosed by Hubert in the European
8 patent application and the U.S.?

9 Let me back up. Are there
10 features in the Hubert reference that are
11 comparable to the elements of the claims in the
12 761 patent?

13 A. Yes, there are.

14 Q. And using claim one first as an
15 example, can we walk through the language and
16 compare it to the Hubert reference, please.

17 A. Sure. Here's claim one.

18 I think what I'd like to also do
19 is I have a PowerPoint slide that -- like with
20 Swartz, there's a lot of similar language that's
21 used, so like in Swartz we saw that they used
22 similar language.

23 Well Hubert, it's also the same.

24 Here's from the 761 patent from claim one, one

1 of the elements.

2 It says, "dynamically storing the
3 context information in metadata associated with
4 the user defined data." The user defined data
5 and metadata stored on the storage component,
6 this is what Hubert says. He says certain
7 additional data called metadata is stored with
8 the document.

9 Metadata is simply data about
10 data. Again similar words.

11 If we keep going, 761 describes
12 the tracking component for tracking a change of
13 the user from a first context to a second
14 context. Hubert says there is also a need for a
15 system and method managing documents which
16 tracks all of the information about what
17 happened to a document during its whole
18 lifetime.

19 I guess there is a further need
20 for a system and method of managing documents
21 that can track a document's path of
22 distribution, so by path we're talking about its
23 movement from environment to environment,
24 context to context. It's very similar language

1 that Hubert uses.

2 Q. Thank you. We now go back and try
3 to apply the language you found in Hubert to
4 claim one of the 761 patent, please.

5 A. Sure. So we see a
6 computer-implemented, network-based system.
7 That's what Hubert is describing, that it's
8 network based. Well, it's running over the
9 internet, and we see the first element, a
10 computer-implemented context component of the
11 network-based system for capturing context
12 information.

13 Now I've identified places in
14 Hubert that shows us if we could bring that up,
15 so here we have page four of Hubert. It talks
16 about the -- what's something that in part
17 behaves as a context component. It says
18 optional tool eighteen is shown in metadocument
19 ten, and let me find the relevant part to it.

20 To continue in this embodiment,
21 tool eighteen is an embedded software program
22 which generates and stores processing
23 information for this, and associated metadata
24 for indexing and retrieving the processing

1 information, it follows by saying whenever the
2 metadocument is accessed or processed, the tool
3 generates a piece of processing information and
4 metadata to record that fact. And this is
5 exactly what a context component is supposed to
6 do.

7 I should mention there's another
8 embodiment or method where this system, instead
9 of being part of the metadocument, is part of
10 the source or environment. Hubert has several
11 ways of describing a context component.

12 Q. What about the remaining elements
13 of claim one?

14 A. Let's take a look where are we.

15 Q. We're at dynamically storing the
16 context information.

17 A. That claim essentially says the
18 same thing, that information is captured and
19 stored as it happens.

20 Then for the second element, it
21 talks about a computer-implemented tracking
22 component for tracking a change of the user from
23 a first context to a second context of the
24 computer-based system.

1 And I've identified a part in the
2 Hubert that shows this. Okay. So if we go
3 to -- let me see here.

4 Okay. So at the end of that first
5 line, it says Source 32 includes a processing
6 program, if we can highlight that, and which
7 processes the document information by copying
8 the document text and storing it in a new
9 document.

10 But most importantly, if you go to
11 the, let's see, the next line. Sorry, skip a
12 line. And it says a record of the fact that the
13 meta-document 20 was received at Source 32 is
14 stored as processing information and processing
15 information is part of the metadata. So this is
16 tracking the movement.

17 We see that we have this
18 processing program that tracks the movement in
19 this case, the receipt of this document of the
20 second source. So there is one example of a --
21 of a tracking component.

22 Q. And what about the next portion of
23 the claim that talks about dynamic updates?

24 A. Well, yes. As I mentioned before,

1 all this is happening on the fly and stored as
2 part of the document. So this is also disclosed
3 by Hubert.

4 Q. And what about the final portion
5 wherein the user accesses the data from the
6 second context?

7 A. Well, again, Hubert is all about
8 we have documents, and people should be able to
9 access that document and all the information at
10 any time. This is precisely what Hubert was
11 trying to do.

12 Q. So what is your opinion regarding
13 Claim 1 of the '761 patent vis-a-vis the prior
14 art Hubert patent?

15 A. My opinion is that Hubert
16 discloses each and every element of Claim 1.

17 Q. Do you have an opinion regarding
18 Claim 4 of the '761 patent vis-a-vis the Hubert
19 patent?

20 A. Yes, I do.

21 Q. And what is that?

22 A. So here we -- they add a
23 relationship between the user and at least one
24 of the application data and user environment.

1 Q. And where is that in Hubert?

2 A. I believe I've identified here --
3 let's see. So if we look at the second
4 sentence, it says namespaces. It says each of
5 them is, more or less, dedicated to an
6 application or a domain.

7 So it's talking about this as part
8 of the metadata model. Maybe I should start
9 from the beginning.

10 It says clearly, part of the value
11 of the metadata model depends on namespaces and
12 some of these namespaces are associated to an
13 application or domain.

14 Q. Dr. Greenberg, what is a
15 namespace?

16 A. A namespace is a way to
17 essentially uniquely identify a set of data. So
18 in this case, the name space would say, Here are
19 things that happen within this application or
20 within this domain.

21 So later on it's the last -- the
22 second to last line. It says suppose we want to
23 encode the identity of the reader, the rating he
24 or she gives an associated comment. So we --

1 here we see that the system also will capture
2 the user and that's enough to satisfy that claim
3 element.

4 Q. So what is your opinion regarding
5 claims regarding this Claim 4?

6 A. That Hubert discloses Claim 4.

7 Q. Do you have an opinion regarding
8 Claim 7?

9 A. Sure. Claim 7 says wherein data
10 created in the first context is associated with
11 data created in the second context.

12 Now, remember, we talked about the
13 meta for -- of the bee carrying pollen from
14 place to place. So there's the association.
15 It's capturing -- the meta-document is capturing
16 not only what happens in one environment, but
17 also what's happening between environments as
18 things are moved around between these contexts.

19 Q. So what is your opinion regarding
20 Claim 7 vis-a-vis the Hubert prior art patent?

21 A. That Hubert discloses everything
22 in Claim 7.

23 Q. Do you have an opinion regarding
24 Claim 9?

1 A. Yeah.

2 Q. And what is that?

3 A. So here we have a
4 computer-implemented method. You know, Hubert
5 is a computing system, so it discloses that.

6 We talked -- in the first element,
7 now it talks about a user environment. You
8 know, in fact, Hubert uses that term and uses
9 the term environment. And so we have that.

10 Hubert is a web-based computing
11 platform. I've shown you that Hubert says it
12 runs over the internet. And I believe I have a
13 few other places.

14 Do I? I can't remember.

15 Let me see.

16 Q. So what are we seeing here in
17 Paragraph 9?

18 A. I -- this isn't -- I don't think
19 this is the right one.

20 Q. But Hubert is a system that works
21 over the internet; is that right?

22 A. That's correct.

23 Q. And so is that really all you need
24 to establish that element?

1 A. Well, it's not all you need. It
2 certainly is one of skilled in the art would
3 know that. And I believe there's later
4 references I have that talk about it working
5 over at the -- over the web. So...

6 Q. What about the next element of
7 Claim 9?

8 A. Okay. So we have dynamically
9 associating metadata with the data. We saw that
10 Hubert had stored on the storage component. We
11 saw that.

12 We saw information related to the
13 user, the data, the application and the user
14 environment. I've actually covered that
15 already.

16 We saw this tracking of movement
17 and we have -- and that's already been
18 discussed. And we also saw the dynamic updating
19 stored metadata with all the other parts of that
20 element.

21 Q. And what about the last portion of
22 the user employing at least one of the
23 application and the data from the second
24 environment?

1 A. Yes. Well, this -- again, this is
2 the whole point of the system that as you -- you
3 can access your document at any time and see
4 what's happened to it. So clearly this is what
5 Hubert was all about.

6 Q. So what is your opinion regarding
7 Claim 9 and the Hubert prior art patent?

8 A. That -- that Hubert discloses each
9 and every element of Claim 9.

10 Q. Do you have an opinion regarding
11 Claim 11?

12 A. Okay. Let's take a look.

13 So this is the one that talks
14 about indexing the content of the user
15 environment.

16 Q. Does Hubert disclose indexing?

17 A. Yes, he does.

18 Q. Where is that?

19 A. So here we see in -- if you look
20 at the end of the second line or it's -- well,
21 there it says information pertaining to each
22 processing step is stored with the document
23 along with metadata for indexing and retrieving
24 the processing information.

1 Q. So do you have an opinion
2 regarding Claim 11 vis-a-vis the Hubert patent?

3 A. Yes, I do.

4 Q. And what is that opinion?

5 A. That Hubert discloses Claim 11.

6 Q. Do you have an opinion regarding
7 Claim 21?

8 A. Yes, I do.

9 Q. And what is that?

10 A. So that Hubert discloses each and
11 every element of Claim 21.

12 Q. Why is that?

13 A. Well, let's look at this again.
14 Hubert discloses a competing system.

15 So one skilled in the art would
16 know that's on the computer readable medium.
17 We've pretty well seen everything in the first
18 element with the exception that we're talking
19 about a user workspace. And again, we're
20 talking about a meta- document.

21 This is a place where people are
22 supposed to do their work. So, by definition,
23 this is a user workspace.

24 The second element talks about

1 dynamically associating metadata with the data.

2 We've seen that.

3 That's stored on web-based
4 computing platform. We talked about this. This
5 is on the internet. It's stored.

6 Q. What about the tracking of the
7 movement of the user from a first user workspace
8 to a second user workspace?

9 A. Yes. We've already seen that
10 where, in fact, in Figure 2 you saw how it
11 actually tracks the movement of a person from
12 one source or environment, which is also their
13 user workspace. And it's over the internet. So
14 it's a web-based computing platform.

15 Q. And we can remember Hubert best
16 because of the little bumble bee; is that right?

17 A. Yeah. That's a whole tracking of
18 the movement thing. This whole idea of
19 pollenization, if you think of this little bee
20 going from flower to flower to flower, which in
21 this case would be user workspace collecting
22 stuff that's happened in each place and bringing
23 it to the next one and leaving it behind and
24 taking some more stuff that's happening and then

1 going onto the next. That's the knowledge
2 that's being captured.

3 Q. And what about the dynamic
4 association of the data and the application with
5 the second user workspace in the metadata?

6 A. Yeah. So that's -- well, we saw
7 that this is -- we've actually covered all of
8 that before and we've -- I've also described how
9 the person should be able to access all that
10 from any context. It's the whole point of
11 Hubert.

12 Q. And the last element of indexing?

13 A. That's essentially a remix of what
14 I discussed previously. I've shown you the
15 index in regard to this does do indexing and
16 it's just been remixed into here. I think I
17 covered that in Claim 11.

18 Q. Yes.

19 A. Yes.

20 Q. So what is your opinion regarding
21 Claim 21?

22 A. That Hubert discloses each and
23 every element of Claim 21.

24 Q. I'm sorry. We're almost there.

1 What about Claim 23? Do you have
2 an opinion there?

3 A. Yes, I do.

4 Q. And what is that?

5 A. That Hubert discloses each and
6 every element of Claim 23.

7 Q. And why?

8 A. So now we're talking about a
9 computer-implemented system. Again, this is
10 back to the same thing. Hubert's talking about
11 a computer system.

12 We now see a computer-implemented
13 context component of a web-based server. The
14 fact that you can access this information over
15 the internet would make it a web-based server.

16 We saw the first user workspace
17 before. In fact, we saw all of this. All of
18 this was essentially covered on the previous
19 screens on my discussion. We saw capturing of
20 context data associated with user interaction.

21 We saw dynamically storing the
22 context data as metadata on a storage. We saw
23 metadata being dynamically associated with data
24 created in the first user workspace.

1 Q. And does Hubert also disclose the
2 computer-implemented tracking component?

3 A. Yes, it does, in much the same
4 same way that I said before. Remember the bee
5 with its pollen.

6 There's a track component, that
7 processing part of the system that tracks the
8 change information associated with a user moving
9 between these user workspaces.

10 Q. And so what is your opinion
11 regarding Claim 23 vis-a-vis the prior art
12 Hubert patent?

13 A. That Hubert discloses each and
14 every element of Claim 23.

15 Q. Do you have an opinion on Claim
16 25?

17 A. Let's take a look. So here we're
18 talking about a relationship capturing a
19 relationship between the first user workspace
20 and at least one other user workspace. And I've
21 actually addressed this before.

22 But remember that bee with the
23 pollen. This is essentially -- it is capturing
24 their relationship, in this case, in the

1 meta-document itself.

2 Q. And so what is your opinion
3 regarding Claim 25?

4 A. That Hubert discloses Claim 25.

5 Q. Only two more. So what about
6 Claim 31, do you have an opinion?

7 A. Sure. So here it says the storage
8 component stores the data and the metadata
9 according to at least one of a relational and an
10 object storage methodology.

11 Q. And does Hubert disclose that?

12 A. Yes, he does.

13 Q. Where does he do that?

14 A. I have a call out here. Here we
15 see emerging technology such as RDF metadata and
16 DOM, document object model, will readily enable
17 implementation of meta-documents.

18 I should mention that RDF is a
19 standard that's developed for the web. So
20 again, it's, you know, another argument about
21 all this being web-based platform, web-based
22 system.

23 Q. So what is your opinion regarding
24 Claim 31?

1 A. That Hubert discloses Claim 31.

2 Q. And finally, do you have an
3 opinion regarding Claim 32?

4 A. Yes, I do.

5 Q. And what is that?

6 A. That Hubert discloses Claim 32.

7 Q. And why is that?

8 A. So this goes back to the
9 many-to-many functionality. And again, Hubert
10 was all about how can people access information
11 about these documents?

12 And this is -- you know, goes to
13 the heart of the Hubert system. It's all about
14 multiple people accessing information.

15 He even uses the example of people
16 trying to access ratings that people may give on
17 documents. So it's all about finding what's
18 happened.

19 Q. And so what is your opinion
20 regarding Claim 32 vis-a-vis the prior art
21 Hubert patent?

22 A. That Hubert discloses what's in
23 Claim 32.

24 Q. Could you please pull back up the

1 front page of the '761 patent? And again, show
2 exactly that.

3 A. There's also that reference on the
4 bottom left and one on the very bottom left.

5 Q. It's Pickett. I think he created
6 a new page for us. So Dr. Greenberg, do you see
7 the Hubert patent cited here?

8 A. No, I do not.

9 Q. So just to wrap up, Dr. Greenberg,
10 what is your opinion regarding the Hubert prior
11 art patent vis-a-vis the asserted claims of the
12 '761 patent?

13 A. Hubert discloses each and every
14 element of the asserted claim except in Claim
15 16. And I think I'll speak about that shortly.

16 Q. I think right now. So Dr. Greenberg,
17 we've been talking about references containing each
18 and every element. Is there a word for that in
19 patent law?

20 A. Yes. That's called anticipation.

21 Q. And your opinion, what is your
22 opinion regarding anticipation of all the claims
23 that we've been talking about and the reference
24 that we have been talking about?

1 A. Well, what I've talked about was
2 three references: Swartz, iManage and Hubert.
3 And that each one of them by itself anticipates
4 or discloses what's in the -- what's being
5 asserted with the exception of Claim 16, which
6 only Hubert or see -- sorry, which only iManage
7 discloses.

8 Q. Is there another way besides
9 anticipation for prior art references to
10 invalidate patents?

11 A. Yes, there is.

12 Q. And what is that?

13 A. So the other way is through what's
14 called obviousness.

15 Q. And what does obviousness mean?

16 A. So obviousness has a -- there's a
17 few different ways to do obviousness. One is if
18 it's obvious to one of normal skill in the art,
19 a person would know, hey, this is how you do
20 things. This would be, you know, pretty
21 natural, pretty straight forward. To do that
22 would be one way.

23 The other way is by combining
24 references. That is, instead of using a single

1 reference to say that everything's there, you
2 can actually use two or more references together
3 to actually show that the ideas have been out
4 there.

5 Q. And do you have an opinion
6 regarding each of the asserted claims and
7 whether or not they are obvious in light of
8 prior art?

9 A. Yes, I do.

10 Q. And what is that opinion?

11 A. So --

12 MR. ANDRE: Objection, Your Honor.
13 Outside the scope of his expert report.

14 THE COURT: The objection is
15 noted.

16 THE WITNESS: Okay. So my opinion
17 is that we can -- that if there's any perceived
18 weakness in my arguments, which I don't believe
19 there are about the Swartz patent, about the
20 iManage Reference Manual, about the Hubert
21 patent, we can combine all three of those
22 together to actually show that all the ideas are
23 collectively in those three prior art pieces.

24 Q. And can you explain: Why would

1 someone even think potentially to pull different
2 ideas from one reference or another?

3 A. Well, there's several reasons why
4 you want to look at these references together.
5 Well, the simple -- the simplest one is that two
6 of them are from Xerox. Like Xerox are the
7 assignees of them.

8 They're theirs. And Xerox is in
9 the business of document management.

10 iManage is a -- I guess would be a
11 competitor at the time. They do document
12 management. So it's the same stuff. They're in
13 the same business. So that's one of the
14 reasons.

15 The other reason is that they all
16 deal with the same thing. As I've mentioned,
17 they're all about, you know, what is a person
18 doing in a certain context? Can we capture
19 that?

20 Can we store that? Can we track
21 what they do when they move between context?
22 Can we capture and store that as well?

23 Can we revise that at a later
24 time? Can we access that? Can a person review

1 what has happened to all these documents, all
2 this information across these contexts?

3 So that's another reason it would
4 be obvious to combine in these three references.

5 Q. Let's talk about Claim 16. Can we
6 put Claim 16 on the board, please?

7 So what does Claim 16 add?

8 A. So Claim 16 essentially says we
9 can access the user environment via portable
10 wireless device.

11 Q. Do you have an opinion as to
12 whether or not Claim 16 would be obvious to
13 someone reading the Swartz patent?

14 A. Yes, I do. Well, there's two ways
15 it can be obvious.

16 So, first of all, if -- for one
17 skilled in the art, so this is -- so think back.
18 We're talking about around Swartz, the late '90s
19 or any time actually during the time of this.

20 We're talking about a wireless
21 laptop amongst other things, be a wireless
22 laptop, a PDA, those type of things. You know,
23 to actually say that, Gee, I can access a user
24 environment, not only by a computer that's wired

1 in, but by a wireless computer.

2 Well, not only would that have
3 been obvious to a computer professional, but if
4 you had an end user who was just using their
5 wireless computer at the time, they would just
6 do that as a matter of consequence of using a
7 wireless computer.

8 There's virtually nothing added by
9 this claim that wasn't known at the time.

10 That's --

11 Q. So do you have an opinion as to
12 whether or not the Swartz patent alone would
13 render Claim 16 obvious?

14 A. Well, yes.

15 Q. And do you have an opinion whether
16 the Hubert reference alone would render the
17 Swartz would render the Claim 16 of the '761
18 patent obvious?

19 A. Yes.

20 Q. And again, why?

21 A. For exactly the same reason. We
22 saw Hubert -- actually saw Hubert because this
23 would be obvious to one skilled in the art.
24 Somebody would read Hubert and this just

1 wouldn't add anything. People just know that,
2 yeah, you can access it via wireless device.

3 Q. You mentioned there was another
4 way that Claim 16 would be obvious in view of
5 Swartz.

6 A. Yes. And this goes back to
7 combining references.

8 So there's another patent by
9 Ausems, which actually discloses a portable --
10 well, exactly this concept. And maybe if we can
11 bring that up.

12 So here we have a patent by
13 Ausems. And if we look at the date that's sort
14 of below.

15 Okay. So here's the filing date.
16 It was filed in February 19th of 1999.

17 And there's a couple lines in here
18 that are worth noting. And maybe we can just
19 bring that up and highlight them.

20 I believe it's in the Summary of
21 the Invention. Right.

22 So here he's talking about -- he's
23 talking about a wireless telephone engine,
24 smart-card engine and a personal digital

1 assistant. So back in that time, we have
2 wireless computers, but you know there's also
3 PDA, essentially these little hand-helds.

4 And he says that the PDA engine is
5 configured to exchange data with a remote
6 computer via the wireless telephone engine. So
7 essentially he's saying, Gee, we can -- we can
8 access things wirelessly and we do things that
9 way.

10 So this is -- again, this is
11 something that's common to all of us today. It
12 was certainly common. It was certainly also
13 common that except in the context of a PDA. So
14 if we take Ausems and combine it with any one of
15 those other three references, we would have that
16 information.

17 Q. And so do you have an opinion as
18 to whether or not a combination of the teachings
19 of Swartz and the teachings of Ausems would
20 render Claim 16 obvious?

21 A. Yes, I do.

22 Q. And what is that opinion?

23 A. That they do render it -- sorry.

24 Say the words again.

1 Q. Would the combination of the
2 Swartz teachings and the teachings of Ausems
3 together render Claim 16 obvious?

4 A. Yes. Yes, it would.

5 Q. Do you have an opinion as to
6 whether or not the combination of the Hubert
7 patent and the Ausems patent would render Claim
8 16 obvious?

9 A. Yes, I do, and that would be
10 rendered obvious.

11 Q. Do you also have an opinion as to
12 whether or not combining Ausems with iManage
13 would render Claim 16 obvious?

14 A. Yes, I do, and it would render it
15 obvious.

16 Q. And just because I'm not sure my
17 record is completely clean, what is your opinion
18 regarding whether or not Claim 16 would be
19 obvious in view of Swartz by itself with the
20 knowledge of one of ordinary skill in the art at
21 the time?

22 A. That it would be obvious as well.

23 Q. And the same question for Hubert?

24 A. It would be obvious. And as I

1 said be -- yeah, it would be obvious.

2 Q. So can we go back to the summary
3 slide?

4 Oh, sorry. Go back to the -- you
5 were right. Ken was right.

6 Go back to the one with the
7 references cited that you had up just a second
8 ago. The front page of the patent. Just the
9 front page of the '761 and the References Cited
10 portion, please.

11 And Dr. Greenberg, do you see the
12 Ausems patent cited here?

13 A. No, I do not.

14 Q. And finally, the summary slide,
15 please.

16 Dr. Greenberg, just once more, for
17 the record, please, what is your opinion
18 regarding the Swartz patent?

19 A. Okay. So as written here, my
20 opinion is that Swartz discloses each element of
21 claims of the asserted Claims 1, 4, 7, 9, 11,
22 21, 23, 25, 31 and 32.

23 Q. And what is your opinion regarding
24 the iManage Reference Manual?

1 A. That it also discloses each and
2 every -- each and every element of the claims of
3 the same set of claims plus Claim 16.

4 Q. And what is your opinion regarding
5 the Hubert patent?

6 A. That it discloses each element of
7 all the claims of 1, 4, 7, 9, 11, 21, 23, 25, 31
8 and 32.

9 Q. And what is your opinion regarding
10 possible combinations of Swartz, iManage and
11 Hubert?

12 A. That it would render all those
13 asserted claims obvious.

14 Q. And what is your opinion regarding
15 the possible combination of Swartz, or iManage
16 or Hubert with the Ausems patent?

17 A. That it would render Claim 16 as
18 obvious.

19 MS. KEEFE: Thank you very much,
20 Doctor.

21 THE WITNESS: Thanks.

22 THE COURT: Cross-examination.

23 THE WITNESS: Is there water?

24 THE COURT: Can you provide

1 Dr. Greenberg with some water, please?

2 MS. KEEFE: Absolutely.

3 MR. ANDRE: Your Honor, should I
4 begin now or should we --

5 THE COURT: Yeah. Let's begin
6 now, but we'll stop at 4:30.

7 CROSS-EXAMINATION

8 BY MR. ANDRE:

9 Q. Good afternoon Dr. Greenberg. My
10 name is Paul Andre. I'll be asking you a few
11 questions this afternoon. Okay?

12 A. Absolutely.

13 Q. All right. You've demonstrated to
14 the jury four references here today; correct?

15 A. That's correct.

16 Q. And all those references were
17 given to you by counsel for Facebook; correct?

18 A. They were given to me for
19 analysis. Correct.

20 Q. And your understanding of Claim 1,
21 for example, is that Claim 1 has three separate
22 elements; correct? You have the context
23 component, the tracking or the tracking
24 component and then the wherein clause is a

1 separate element; correct?

2 A. Well, there's two elements there.
3 The second element has the two parts to it
4 separated by a comma.

5 Q. And in your analysis, you separate
6 those out as two separate elements, the part
7 two; right?

8 A. You're talking about in my claim
9 chart.

10 Q. Yes.

11 A. My claim chart -- for ease of
12 understanding, I actually break out the part of
13 the -- the second element. I take the first
14 part up to the comma and then the part after the
15 comma.

16 Q. So you treat them as two separate
17 elements essentially; right?

18 A. Well, they're not separate
19 elements. They're the same element. Just for
20 ease of comparison, I've just listed them
21 separately in my document.

22 Q. And in fact, can you go to Exhibit
23 1105, PTX 1105? This was a document that we had
24 claims written in your claim chart where you had

1 computer-implemented context component, tracking
2 component, and then the wherein clause; correct?

3 A. That's correct.

4 Q. And that's your handwriting here
5 on the side, isn't it, where you have the
6 preamble one, element, two, three; correct?

7 A. Well, that's not really correct.
8 If you notice, I have a one next to the first
9 element and I wrote two, three next to that
10 brace that actually collects both of them
11 together.

12 Q. Fair enough. Fair enough.

13 But you're doing this as a
14 three-step claim; correct?

15 A. I think you are misconstruing what
16 I did. So these claims are really dense, like
17 you've heard me read it out.

18 There's a lot of stuff in there.
19 And what I did for the analysis, I essentially
20 said, Here's things in Claim 1. Sorry. In the
21 first element of Claim 1.

22 And I --

23 Q. Okay. We heard how you
24 interpreted it. I get that.

1 A. Okay.

2 Q. My question is --

3 MS. KEEFE: Objection, Your Honor.
4 Interrupting the witness.

5 MR. ANDRE: He was answering a
6 question I didn't ask.

7 THE COURT: You can continue.
8 Overruled.

9 MR. ANDRE: Thank you.

10 BY MR. ANDRE:

11 Q. You're treating this as separate
12 from this; correct?

13 In other words, the updating the
14 metadata right here, the stored metadata is not
15 related to accessing it from the second context;
16 correct, in your analysis?

17 A. Well, that's -- I never say that
18 in my analysis. There's a comma there.

19 You know, there's a natural --
20 there's a natural break. All right.

21 You want me to continue.

22 Q. Go ahead. I'm sorry.

23 A. And it says -- oops. You switched
24 the slide on me.

1 Q. You can continue. I'm sorry.

2 A. Well, you switched the slide on
3 me.

4 Q. Go back. I'm sorry.

5 A. So there's a comma there and it
6 says wherein. So it's -- so this is -- you
7 know, it's part of the second element.

8 Q. And that makes it a natural break
9 and then you treat that as a separate step in
10 the claim; correct?

11 A. No, it's associated with the
12 second element. It's -- it just -- there's just
13 a comma there.

14 As I said for ease of analysis, I
15 -- you know, when I was doing my claim chart
16 that I said, Here's things that match the first
17 part of that claim element. And here's things
18 that match the second part of the claim element.

19 They're not -- they're not
20 completely separate. They're part of the same
21 thing. That's why I put a brace around there.

22 Q. Then I guess my question is: Do
23 you believe that the metadata is updated when or
24 in which the user accesses the data from the

1 second context?

2 A. Well, the word is not in which.
3 It's wherein.

4 So what that claim -- what that
5 element is stating is that, you know, it says
6 wherein, as a consequence, these are accessing
7 the data from the second context.

8 So --

9 Q. I'm sorry. Where did you see as a
10 consequence?

11 A. As a consequence.

12 Q. Where is that?

13 A. It's wherein. You said in which.

14 Q. That's the definition of wherein;
15 correct, in which?

16 A. Well, wherein is -- well, wherein
17 when I'm reading this says here is things that
18 happened, and as a consequence, the user can
19 access the data. So that's wherein the user
20 accesses the data from the second context.

21 Q. That's your interpretation of
22 wherein?

23 A. That's my interpretation. Yes.

24 Q. And that's what I am trying to

1 ask.

2 A. Yeah.

3 Q. So your interpretation is wherein
4 means as a consequence, you can do this?

5 A. Yes.

6 Q. It doesn't mean in which or during
7 which; correct?

8 A. It means -- well, let me see this.
9 Well, so when I say it has a consequence, it
10 could be during or after, right, it says
11 wherein. So --

12 Q. I want to make sure I get your
13 understanding. Now, you have looked at the
14 prosecution history in this case; correct?

15 A. Yes, I have.

16 Q. Okay.

17 A. It's been quite awhile now.

18 Q. Okay. And if you go to PTX 2, and
19 you go to Bates Number 668. Dr. Greenberg, this
20 is the Notice of Allowance of the '761 patent;
21 correct?

22 A. It looks like it.

23 Q. If you go to the next page, you'll
24 see that the examiner of the '761 patent put in

1 an amendment. Do you see that?

2 A. I see it.

3 Q. Okay. Basically saying that
4 changes and additions being unacceptable, the
5 applicant can appeal whatever. But this is the
6 basis for allowance; correct?

7 A. I'm not sure what you mean.

8 Q. Well, that's okay. It may be more
9 of a legal question.

10 A. Yeah.

11 Q. Any way the examiner is going to
12 amend the claims correct?

13 A. Okay.

14 Q. All right. So go to the next
15 page.

16 And the examiner here put in
17 language that talks about dynamically updating
18 the stored metadata wherein the user accesses
19 the data from the second context; correct?

20 A. I see that. Yes.

21 Q. And the examiner got rid of the
22 term and automatically updating the stored
23 metadata. Based on the change, just by itself,
24 she put those two elements in; correct?

1 A. That's what it looks like.

2 Q. And because the Patent Office on
3 the claim wanted the claims written this way,
4 wouldn't a reasonable interpretation be that the
5 dynamically updating happens in which user
6 accesses data from the second context?

7 MS. KEEFE: Objection.

8 THE COURT: Hold on.

9 MS. KEEFE: Objection, Your Honor.
10 Goes to issues we discussed before.

11 THE COURT: Sustained.

12 BY MR. ANDRE:

13 Q. If you go to the last page of the
14 examiner's amendment, you see Page 683?

15 A. Mm-hmm.

16 Q. And you see the examiner's name
17 here?

18 A. I do.

19 Q. Diane Mizrahi?

20 A. Yes.

21 Q. Go to PTX 1.and go up here to this
22 column here.

23 Now, Ms. Mizrahi cited certain
24 exhibits here, certain references against the

1 '761 patent; correct?

2 A. That's correct.

3 Q. And you saw the fact that like the
4 Swartz reference was not listed there; right?

5 A. That's correct.

6 Q. Now, the implication from you
7 pointing that out is that Ms. Mizrahi or Mizrahi
8 -- I'm probably butchering her name here -- she
9 was not aware of Swartz here and didn't put it
10 here; right? That is the implication?

11 MS. KEEFE: Objection?

12 THE WITNESS: Well, what I said --

13 THE COURT: Hold on.

14 MS. KEEFE: Objection, Your Honor.

15 THE COURT: Sustained.

16 BY MR. ANDRE:

17 Q. You're aware, of course, that the
18 examiner was aware of the Swartz patent;
19 correct?

20 MS. KEEFE: Objection, Your Honor.

21 THE COURT: Sustained. Move on,
22 if you have something else you can do in two
23 minutes.

24 BY MR. ANDRE:

1 Q. Go to DTX 919. Blow this up right
2 here.

3 This is the Swartz patent;
4 correct?

5 A. That's correct.

6 Q. Is not Ms. Mizrahi an examiner of
7 this?

8 MS. KEEFE: Objection, Your Honor.
9 Move to strike?

10 THE COURT: Sustained.

11 MR. ANDRE: Your Honor, it's on
12 the face of the patent.

13 THE COURT: It's stricken. Let's
14 move on.

15 MR. ANDRE: Your Honor, this would
16 be a good time to stop before I get into the
17 references and substance.

18 THE COURT: All right. That
19 sounds right.

20 Ladies and gentlemen of the jury,
21 we've come to the end of -- sorry. Okay. All
22 right.

23 First things first. Thank you for
24 your service this week.

1 I'll remind you that -- first of
2 all remind you, don't come here tomorrow.
3 You're not due back until Monday morning in time
4 to start at nine o'clock.

5 Over the weekend, don't do any
6 deliberating, any discussion about the case.
7 Don't do any research about the case.

8 Don't look at any media about the
9 case if there is any. Don't get on Facebook.

10 And what I've just been notified
11 is that there are several other trials on Monday
12 that are going to be going on in the building,
13 and so our Court security has requested that all
14 of you, being veterans at this point, that you
15 use our private entrance on Monday, which is on
16 the 8th street side of the building.

17 You might want to find it on your
18 way out today, so you know on Monday. And
19 hopefully it will be a little easier for you to
20 get in for, because there may be quite a crowd
21 on Monday.

22 And with that, I will excuse you
23 all for the week.

24 THE CLERK: All rise.

1 (Jury leaving the courtroom at
2 4:30 p.m.)

3 THE COURT: Doctor, you can step
4 down. The rest of you may be seated.

5 We're going to discuss jury
6 instructions and special verdict form. I
7 suppose it would may be helpful to me and maybe
8 all to us if we briefly assess where we are, so
9 I can have in mind when I'm likely to be
10 instructing the jury as I consider some of these
11 issues.

12 Mr. Rhodes, you're on your feet
13 first, so why don't you give me your sense.

14 MR. RHODES: And I apologize, Your
15 Honor, for trying to raise this at a break with
16 my zeal. I am just - my concern is really
17 simply about where we're going to be sort of
18 early Monday afternoon.

19 It looks like most of the morning
20 -- I don't know how long it will take Your Honor
21 to manually read them in. And if we assume -- I
22 think both Paul and I are relatively brief, but
23 if we assume that we're each in combination
24 going to take three hours or so for the two

1 arguments plus his rebuttal piece, I'm just
2 concerned about where that leaves us in terms of
3 how deep into Monday you want to go. That's all
4 I wanted to raise with you before.

5 THE COURT: Right.

6 MR. RHODES: I can't say I have
7 any particularly good idea.

8 THE COURT: Okay. Right.

9 MR. RHODES: I don't see I have
10 any particularly good idea --

11 THE COURT: And my sense of
12 roughly -- I'm not the official timekeeper, but
13 we are timing everything, so there is an outer
14 limit, not that you have to use it all.

15 My understanding is together the
16 parties have about seven-and-a-half hours left.
17 We've been getting in five-and-a-half hours of
18 jury time each day, which suggests to me that if
19 you're going to use all the time -- plus it's
20 going to take me some time to read the
21 instructions -- I suggest we may not be able to
22 get the case to the jury Monday. If you're not
23 going to use all the time, then we have a shot.

24 Any sense on that point?

1 MR. ANDRE: Your Honor, I don't
2 think that I'm going to have too long with their
3 expert relatively speaking, and our expert is
4 probably a couple hours. We don't know if we
5 could get it closed on Monday or Tuesday morning
6 at this point.

7 THE COURT: Right.

8 MR. RHODES: The only thing I
9 would ask Your Honor to think about as you're
10 thinking about the timing, what happens, for
11 example, if Mr. Andre finishes his closing at
12 3:30, and where does that leave me? I think it
13 would be very unfair to split it.

14 Like I said, I didn't have a
15 particularly good idea what to suggest to you
16 either.

17 THE COURT: And are both parties
18 still of the view that it's preferable for me to
19 instruct the jury prior to the closings?

20 MR. ANDRE: Yes, Your Honor.

21 MR. RHODES: I share that view.

22 THE COURT: Well, we're just going
23 to have to see, I guess, at the moment.

24 All I ask, say, is I'm open

1 certainly to the possibility of possibly ending
2 early on Monday and just starting fresh up with
3 the all the closings on Tuesday so as to avoid
4 any potential prejudice of splitting any
5 argument in the middle.

6 One thing I would welcome the
7 parties's views on, even though it is abstract,
8 is if I'm instructing first, what is your
9 feeling about possibly Monday ends with me
10 reading the instructions and then we only have
11 closings on Tuesday morning?

12 Mr. Andre.

13 MR. ANDRE: That's acceptable with
14 us, Your Honor.

15 MR. RHODES: I would be okay with
16 that. I wouldn't want to have the scenario of
17 twenty minutes left, and I do twenty minutes,
18 and it stops.

19 Either that, or we split them. I
20 like that idea better than the other one.

21 THE COURT: All right.

22 Well, again we'll deal it with on
23 Monday when we see where we are, and the only
24 thing I can tell you for sure is you're not

1 going to go beyond the total of the remaining
2 seven-and-a-half hours for argument plus
3 evidence.

4 Let's turn to the instructions and
5 special verdict forms, and I'm obviously going
6 to give both sides some time.

7 Let me start with Leader.

8 I do now have the official time.
9 I might as well tell you. According to my
10 deputy, Leader has used up eleven hours and
11 fourteen minutes, and Facebook has used up
12 eleven hours and eleven minutes. We're running
13 close, but Leader is a few minutes ahead.

14 Mr. Andre, or whoever wants to
15 speak for Leader.

16 MR. ANDRE: Your Honor, I'm not
17 sure what you want to address first. We
18 provided a special verdict form. I think it's
19 pretty standard in the district here, ones we've
20 seen from recent personal experience and also
21 experiences of others. It's straightforward.

22 THE COURT: One thing we found
23 curious on your special verdict form, Mr. Andre,
24 was it did not appear to be asking the jury to

1 consider several of the defenses on validity.

2 Was that intentional, or did I misread it?

3 MR. ANDRE: That should have been
4 two. Anticipation and obviousness were the only
5 two defenses raised during the trial.

6 THE COURT: I see. So you intend
7 for the jury to understand what the on-sale bar?

8 MR. ANDRE: It's an anticipation
9 defense. If you want us to split that out, we
10 can do that.

11 THE COURT: I think we will split
12 it out.

13 MR. ANDRE: That's fine. We
14 should have put them has a single anticipation,
15 on-sale combination.

16 THE COURT: At this point I'm not
17 giving you any direction as to what to do. I
18 may give you some direction over the next few
19 minutes, but right now I'm not directing
20 anything on the verdict form. That was my
21 question there.

22 MR. ANDRE: As far as the jury
23 instruction, Ms. Kobialka will be leading the
24 charge. I'll defer to her.

1 THE COURT: Let me hear from
2 Facebook on the verdict form before we dive into
3 the jury instructions.

4 MR. WEINSTEIN: Your Honor,
5 there's a couple of differences between the two
6 verdict forms that I wanted to point out for you
7 and give you our thoughts on the significance of
8 those differences.

9 One of the differences is that we
10 put in an element-by-element series of special
11 interrogatories with respect to the doctrine of
12 equivalence issue. We did that following
13 Dr. Vigna's testimony, so after Dr. Vigna's
14 testimony, it seems to us that a special
15 interrogatory regarding the specific claim
16 elements might be helpful.

17 This procedure has been adopted
18 and approved by the federal court in the Warner
19 Jenkinson case. There wasn't a place on the
20 verdict form to put authority. That's at 520
21 U.S. 17 at page thirty-eight, where the Supreme
22 Court says the special verdict and/or
23 interrogatories on each claim element would be
24 very useful in facilitating review, uniformity,

1 and possibly post-verdict judgments.

2 As a matter of law, the idea is
3 it's going to provide clarity on which elements,
4 if any, the jury would find on the doctrine of
5 equivalents. That's a difference I wanted to
6 explain to Your Honor.

7 On question number two of Leader's
8 special verdict form, there's a discussion of
9 inducement, and this is something that's going
10 to come out in the jury instructions as well.
11 There's a conflating of the three very distinct
12 standards of infringement that were seen in this
13 case, which is direct infringement, infringement
14 by direction or control -- which is direct
15 infringement -- and inducement.

16 The inducement theory requires
17 that they show that some third party has
18 performed each and every element of the claim.
19 That is, we have somehow induced that activity,
20 and I don't think the trial record has shown
21 that someone other than Facebook has performed
22 each and every element of the claim. I don't
23 think they're making that argument.

24 On number two, I'm not sure what

1 the basis of it, is and that's why ours does not
2 include that interrogatory, and theirs
3 discusses.

4 The same is true with respect to
5 number three.

6 Number five, with the prior art,
7 one, Your Honor already mentioned there's no
8 discussion of the on-sale bar or public use
9 defense. There's no separation between the
10 three different prior art references, that that
11 would be something that would provide a little
12 more clarity to make the verdict more useful.

13 We also think one of the
14 differences we think there should be in light of
15 the testimony regarding the priority date
16 issues, we think there should be an
17 interrogatory on whether or not the provisional
18 application supports the issue claims. That has
19 been a litigated issue that we think it would be
20 helpful to have a specialized interrogatory on
21 that.

22 And finally, Your Honor, our jury
23 verdict form includes an explicit series of
24 special verdict interrogatories on the question

1 of direction and control, and Your Honor has
2 heard testimony regarding whether Facebook can
3 control or has control over its users. That
4 goes to that issue, and that's going to be
5 important in the context of the bifurcated
6 trial.

7 THE COURT: On element-by-element
8 table, the case you cited was that a patent
9 case?

10 MR. WEINSTEIN: Yes, Your Honor,
11 that's the Warner Jenkinson Supreme Court case
12 on doctrine of equivalents. I left out Komar
13 Communications. That's 156 Federal Third 1182
14 at 1188, footnote one, and that's from the
15 federal circuit, 1998.

16 THE COURT: I would certainly have
17 a great deal of faith and confidence in the
18 jury, but it would be challenging, as we've seen
19 in court, to require them to go element by
20 element, claim by claim.

21 Of course they may do that in
22 their deliberations, and we won't know. What do
23 you say to the concern that this may just be too
24 daunting a task or might frighten them perhaps?

1 MR. WEINSTEIN: I have two. This
2 is an analysis they'll have to go through
3 anyway.

4 To the extent it's a daunting
5 process, it's a convenience of the fact they're
6 serving eleven claims, some of which they take
7 an entire whiteboard. That's not a daunting
8 task of our choosing. It's something they did
9 by asserting eleven claims in this litigation.

10 THE COURT: Anything else on the
11 verdict form?

12 MR. WEINSTEIN: No, Your Honor,
13 that's it.

14 THE COURT: Mr. Andre.

15 MR. ANDRE: I apologize, Your
16 Honor. I didn't have their verdict form. I
17 just got handed it, and it's a doozy.

18 I think Facebook stipulates to
19 infringement. The jury cannot find it with this
20 jury form, it's so daunting, and it's one-sided
21 that -- infringement is impossible to find.

22 The same standard is not held to
23 validity. They don't do element-by-element of
24 prior art or on sale. It's obviously trying to

1 get some very prejudicial form into the hands of
2 the jury.

3 THE COURT: How about an
4 interrogatory on control or direction? What's
5 your view of that?

6 MR. ANDRE: Your Honor, it comes
7 under the direct infringement, and you ask every
8 possible question there is that you could put
9 out there, you would be reading the instructions
10 and asking check this one and check this one.

11 The verdict form is supposed to
12 reflect the fact that the jury did listen to and
13 appreciate the actual instructions Your Honor is
14 going to read to them and apply analysis and
15 give the final result of the analysis on the
16 form itself.

17 It's not meant for them to go
18 through and have a worksheet to figure out how
19 to cover the deliberations and make it nearly
20 impossible to decipher what we're trying to ask
21 them to come to a decision on.

22 With the direction and control, I
23 don't think it's necessary to add another layer
24 of complication to it.

1 THE COURT: Okay. Let's move on
2 to the jury instructions at this point.

3 I'll hear from Leader first on
4 these.

5 MS. KOBIALKA: I'm not sure
6 exactly how you want to proceed with it.

7 THE COURT: I'm not sure either.
8 You've all thrown a lot at me.

9 Why don't you start. If you seem
10 to be spending too long on one I think is easy,
11 I'll let you know and move you on.

12 MS. KOBIALKA: Okay. And I think
13 we divided some of this up amongst us.
14 Depending on the issue, I can start with the
15 first one that's disputed and work through it.

16 THE COURT: Why don't we go
17 through all the ones you're yourself personally
18 covering, and we'll turn it over to the
19 colleague that's addressing the rest, and then
20 I'll turn it over to Facebook.

21 MR. RHODES: Since I'm not going
22 to have a voice, may I excuse myself for a
23 minute?

24 THE COURT: You may.

1 MS. KOBIALKA: I believe the first
2 dispute in the instruction is 1.3, and that
3 starts on page three. I'm hoping this is an
4 easy one.

5 THE COURT: That's an easy one.
6 You can move on.

7 MS. KOBIALKA: The next one is
8 1.9, and that relates to the deposition
9 testimony.

10 THE COURT: Deposition testimony.

11 MR. KOBIALKA: Correct. That
12 starts on page fourteen. The real difference
13 between our two instructions is that Facebook is
14 attempting to add a fair bit to just the
15 standard jury instruction, where it's basically
16 raising questions specifically directed at
17 Mr. Lamb, and this is frankly something that's
18 appropriate for closing argument but not
19 something that needs to be instructed to the
20 jury, so we object to the language proposed.

21 THE COURT: Did they actually
22 depose Mr. Lamb again after the errata sheet
23 went in?

24 MS. KOBIALKA: They moved and

1 withdrew the morning of the hearing. They never
2 followed up with that.

3 In early drafts of the pretrial
4 order, it indicated they were going to take
5 Mr. Lamb's deposition when he appeared at trial
6 and then they removed that issue.

7 THE COURT: I'm not indicating
8 that I'm agreeing with you, but that is an
9 easier one, so let's move on.

10 MS. KOBIALKA: On the burden of
11 proof, we just followed the jury instruction and
12 added in the names of the parties.

13 THE COURT: Tell me where you are,
14 please.

15 MS. KOBIALKA: 1.10, page twenty,
16 and so the dispute here is actually they did not
17 want to articulate who had the burden of proof
18 with respect to what issue. It was fine when
19 they had their claims in of inequitable conduct
20 and everything else, but once the claims got
21 bifurcated, they removed it and said we don't
22 want to say infringement is preponderance and
23 invalidity is clear and convincing.

24 THE COURT: Okay. You can move

1 on.

2 MS. KOBIALKA: The next disputed
3 is 2.2, and this is just -- it's entitled the
4 parties' contentions.

5 The dispute here is that they
6 don't believe we should have the right to be
7 able to assert inducing infringement and
8 contributory infringement in the case.
9 Otherwise, I think we're in agreement with
10 regard to that particular --

11 THE COURT: Do you understand that
12 dispute to some extent to be whether or not you
13 provided adequate and timely disclosure of those
14 allegations and those theories? I'm trying to
15 understand.

16 Obviously you have alleged it at
17 trial, and I'm trying to understand the basis of
18 their belief that it's not in the case, which I
19 can direct to them, but if you have an
20 understanding of their position --

21 MS. KOBIALKA: This might be based
22 on their motion for summary judgment, but it
23 would be best to ask them. I didn't get very
24 far.

1 So then the next is 2.3. I'm not
2 sure why this is in dispute again, but they
3 don't like our inducing and contributory
4 infringement theory in the case. That was that.

5 The next dispute is 3.2. I'm
6 hoping this is another easy one. We're in
7 agreement for the most part. They're having
8 problems with the language Leader proposed. Not
9 brackets.

10 It's standard language. I believe
11 it comes from the model jury instructions. The
12 only thing we added at the end was the last two
13 sentences to clarify we have three different
14 claims -- the system claim, computer-readable
15 claim, and method claim -- so there wouldn't be
16 confusion.

17 THE COURT: That's going to take
18 us into one of the more difficult areas, the
19 direction and control issues. Are you here to
20 talk about those too? If not, that's fine.

21 MS. KOBIALKA: I'd have to look at
22 it. I'm trying to remember.

23 THE COURT: Let's move on then to
24 what you have next.

1 MS. KOBIALKA: The next dispute,
2 which once again should be straightforward, is
3 3.3.

4 We followed the model instruction.
5 Facebook wants to have the instruction include a
6 chart of the claims. We tried to compromise and
7 say this is claim one, independent, and these
8 other claims depend on it, but you can't really
9 read the chart to the jury.

10 THE COURT: It will be awkward,
11 but I think I can do it.

12 MS. KOBIALKA: We wrote the
13 language in our instructions.

14 THE COURT: I think I'm going to
15 read the language and the chart.

16 MS. KOBIALKA: The next one is 3.5
17 on page forty-six.

18 THE COURT: They've put in a new
19 3.4 today. I don't know if you've seen it.

20 MR. ANDRE: One moment, sir, I
21 just got handed it.

22 THE COURT: Sure.

23 MR. ANDRE: Your Honor, I've just
24 been handed the note. They just want the Court

1 to construe the new term "wherein" means in
2 which, not when. I'm not sure what the basis of
3 that is.

4 Obviously their expert testified
5 it doesn't mean in which. I don't mind. The
6 definition of the term means in which, but I
7 don't think not when. You never give a claim
8 interpretation the negative sense. This is what
9 it means, and everything else is what it doesn't
10 mean. We don't object to the term wherein
11 meaning in which.

12 THE COURT: I think they also
13 added that last paragraph about prosecution
14 history.

15 MR. ANDRE: I think that's -- can
16 I confer? I read it, and I think it's
17 self-apparent, but let me make sure I'm not
18 missing something.

19 THE COURT: Okay.

20 MR. ANDRE: Your Honor, we don't
21 think it's necessary. We think it's obviously
22 an attempt to undermine the evidence we put in
23 with our prosecution history for various other
24 purposes. We would object to it.

1 THE COURT: Okay. Ms. Kobialka,
2 do you have others?

3 MS. KOBIALKA: I know I do.
4 3.5 was the next one. This is
5 "comprising."

6 This language -- this is a
7 standard jury instruction that we have, and
8 Facebook just doesn't believe it's necessary,
9 but in cases where you have the word
10 "comprising" in the claims, just so there's no
11 confusion, this is an instruction that's given.

12 THE COURT: I'm inclined to do
13 some form of comprising, but address the issue
14 that Facebook raises on page forty-nine about
15 these claims being sequential. I'm not clear
16 why that is a problem for the comprising
17 language you proposed, but do you see any issue
18 with me addressing the sequential nature of the
19 terms?

20 You may want to pass the baton.

21 MR. HANNAH: This issue came up in
22 the other case, but this is contrary to the law.
23 The law says that unless there's a direct
24 relationship between the steps -- for instance,

1 if you introduced a step and then you referred
2 back to that step to say it had performed a
3 sequential step, then they would have to be read
4 in order. Otherwise, for the method claimed,
5 you can perform it in different orders.

6 THE COURT: Even when the Court
7 construes the dynamically language with having a
8 timing element?

9 MR. HANNAH: The timing element is
10 a technical. It's not a proceeding event in the
11 claim. It is a proceeding event that's
12 happening.

13 This is a computer program that
14 interacts with a user when a user uploads data.
15 That could be the event. When you put a -- it's
16 functional language. That's what dynamically
17 means. From the claim construction order, that
18 seems to be --

19 THE COURT: I see your point.

20 Ms. Kobialka, let's try to finish
21 up whatever you have.

22 MS. KOBIALKA: Okay. The next
23 jury instruction in this is the same issue, so
24 this is 3.6 on the inducing.

1 THE COURT: That just follows.

2 MS. KOBIALKA: A lot of them are
3 like that. They have that particular issue.

4 Now, the next one is on direct
5 literal infringement, and this goes to all their
6 arguments about direction. 3.7, direction and
7 control, and they just dispute whether or not
8 there is direction and control, which is a
9 factual issue. That's the center of the dispute
10 itself.

11 We have put all the different
12 types of direct, literal infringement in this
13 claim, and I think probably no one else is going
14 to address in the other cases.

15 To the extent we need to get into
16 it, this is one of the issues that I don't know
17 if you want further briefing on it. It's a fact
18 that the jury is supposed to determine, and the
19 question is what law do they need to be
20 instructed on.

21 THE COURT: What do you think of
22 the view that there's an issue of fact that's
23 almost logically prior? That is -- I forget
24 what the fantasy sports case is called -- that

1 maybe we need to ask the jury as a factual
2 matter, is this the type of software computer
3 system that's like fantasy sports, in which case
4 to assess direction and control, there's things
5 you can consider along the lines of what Leader
6 suggests. If as a jury you find as a factual
7 matter this program worked more like the one in
8 Muniauction, you're limited to direction and
9 control in terms of liability and contractual
10 relations.

11 Do you have thought to approaching
12 it that way?

13 MS. KOBIALKA: I think it's going
14 to be incredibly confusing.

15 THE COURT: You're right about
16 that.

17 MS. KOBIALKA: And now we're
18 starting to parse out a claim in a manner that
19 goes to their specific defenses. If you're
20 going to do it for one, you have to do it for
21 the other.

22 They are definitely issues we want
23 instruction on with respect to the references
24 and things like that. Once we start going down

1 this path, it's problematic.

2 I think when it comes to
3 instructing the jury, we need to provide them
4 with the law, and they can make the
5 determination. There's nothing in the cases
6 that say you need to specifically drop that
7 specific question on the verdict form itself.

8 THE COURT: Okay. Already I
9 should tell you I have a goal of getting us out
10 of here at 5:30, so as much as I enjoy this --

11 MR. RHODES: You had such
12 credibility.

13 THE COURT: I apologize.

14 MS. KOBIALKA: Let me see if I can
15 move through.

16 The next disputed one is 3.8(a).
17 We have a dispute about who has to prove what,
18 and that is really what the issue is that's on
19 page seventy, so largely the jury instruction
20 which follows the model is in there, but they're
21 asserting that Leader has the burden of showing
22 that proposed hypothetical claim.

23 THE COURT: I'm not going to ask
24 for an advisory verdict on ensnarement, so I

1 think this is going to drop out.

2 MS. KOBIALKA: And that would
3 include the vitiating?

4 THE COURT: I think so.

5 MS. KOBIALKA: That was the extent
6 of that one.

7 So the next one is 3.8(b), and
8 they just wanted another instruction on indirect
9 infringement, sort of reemphasizing all the
10 elements.

11 Our objection to this was this was
12 already covered in the previous jury
13 instruction, and no need to go over that again.

14 The next one is 3.9, and this is
15 on page eighty-one. Goes to active inducement.

16 THE COURT: Same issue.

17 MS. KOBIALKA: It is. There's
18 some dispute about how many times do they get to
19 emphasize within these jury instructions that
20 somebody else must directly infringe a claim.
21 It's fair game if you got it once, but second,
22 third, fourth time, it's too much.

23 THE COURT: I will endeavor to be
24 fair with respect to that.

1 MS. KOBIALKA: I think that's all.
2 Contributory infringement.

3 Mr. Andre was going address that.

4 MR. ANDRE: I was?

5 MS. KOBIALKA: You were.

6 THE COURT: Is there anything else
7 that you wanted to address that you think is
8 particularly important?

9 MS. KOBIALKA: I think another big
10 one that was in dispute was the 4.2, and this
11 one starts on ninety-eight.

12 THE COURT: This is about prior
13 art, and now I think we now know it's much more
14 limited prior art that's part of the case.

15 MS. KOBIALKA: Right. So what
16 issues come into play for purposes of conception
17 the effective filing date?

18 THE COURT: We'll hear from
19 Facebook on that, and I'll try to reserve you a
20 minute or two to respond if need be.

21 MS. KOBIALKA: So I think that
22 also delves into some of the ones thereafter
23 related.

24 4.4, the invention date conception

1 and reduction to practice. They're all centered
2 around similar disputes about how to get the
3 right language in, and part of this goes to
4 whether or not the provisional discloses enough
5 of the invention so we get that priority date.

6 THE COURT: I think I understand
7 those issues.

8 MS. KOBIALKA: Okay. So then we
9 should have put chapters in this thing.

10 Then the next dispute was 4.5 that
11 I was going to address. They have inherency
12 instruction that they would like. This is on
13 page 128.

14 Inherency has not been an issue
15 that any expert has opined on. We kept going
16 back and forth. Why are we giving an
17 instruction on inherency if there isn't any
18 evidence to it? So they didn't want to strike
19 it. That is the core of that dispute.

20 THE COURT: Just being mindful of
21 the time, I'm going direct you to one issue that
22 would be helpful to me and then let's move to
23 Mr. Andre, to his issue.

24 And level of ordinary skill and

1 whether I need an instruction directing the jury
2 as a functional matter that they're supposed to
3 determine that. What is your position?

4 MS. KOBIALKA: That there does
5 need to be an instruction, and the jury makes
6 that determination, what constitutes one of
7 ordinary skill in the art.

8 THE COURT: Facebook is of the
9 view that the Court has determined what a person
10 of ordinary skill in the art is. Do you have an
11 idea what that is?

12 MS. KOBIALKA: I think they're of
13 the view that you're supposed to decide that and
14 tell the jury what that is. I know there were
15 issues about on-sale bar and public use. There
16 were elements missing. Mr. Rovner was going to
17 address that. I don't want to shortchange him
18 on that. He's been preparing.

19 THE COURT: Mr. Rovner. Is he
20 here?

21 MR. ANDRE: He stepped back, Your
22 Honor.

23 THE COURT: We'll come back to him
24 if I need to.

1 Let's hear from Mr. Andre, and
2 then I want to give Facebook some time.

3 MR. ANDRE: Your Honor, on the
4 contributory infringement, it's a pretty
5 standard instruction. I don't see anything
6 extraordinary about the points, puts out the
7 elements as set forth, looks like Facebook wants
8 to insert the statute into the instruction to
9 some degree, and I don't think that's necessary
10 or appropriate at this point.

11 I don't see the big issue here
12 because the Thrasher case has come out and
13 determined that any type of contributory
14 infringement to the patent requires a product in
15 the stream of commerce, and then you have three
16 elements set for most part.

17 THE COURT: Let me turn it over to
18 Facebook at this point. Feel free to address
19 any of the issues that have been raised or
20 others if you think there are others that are
21 important, and basically we have up to
22 twenty minutes because I do want to leave the
23 last five minutes to hear from Leader.

24 MR. WEINSTEIN: There's only two

1 issues to address. The most critical ones on
2 jury instruction, 3.4.

3 Your Honor, I'd like to hand up a
4 portion of some of the transcript from the trial
5 to illustrate why we need an instruction that
6 "wherein" does not mean when.

7 THE COURT: You've already cited
8 pretty extensively in your support, which we
9 looked at, so in the spirit of compromise,
10 construing at this late moment the term
11 "wherein" to mean in which, which has been
12 agreed to by Leader, is not satisfactory to you?

13 MR. WEINSTEIN: It isn't, Your
14 Honor. The problem with in which, Your Honor,
15 they're going to make the exact, same argument
16 what I heard today, is they think this is a
17 factual issue to go to the jury.

18 When I read the '02 Micro case
19 last night, I was haunted how similar that case
20 is to this. There was a claim term only if like
21 there. This case, they presented witnesses and
22 cross-examined witnesses on what do you think
23 this term means.

24 What ultimately came down and the

1 Court decided, he was going to send it to the
2 jury. The federal circuit said when the parties
3 present a fundamental dispute regarding the
4 scope of a claim term, it is the Court's duty to
5 resolve it.

6 The fundamental dispute is
7 regarding does "wherein" mean when, or does the
8 claim require a dynamic element, which means you
9 look to the proceeding claim element? That's a
10 dispute Your Honor needs to resolve as a matter
11 of law.

12 THE COURT: Help me, though, why I
13 haven't resolve it by construing "wherein" to
14 mean in which, and you all make your arguments
15 or don't. You're stuck with the Court's claim
16 construction as a matter of law. The jury is
17 told they have to follow my claim construction.
18 How is that any different than all the other
19 claim construction issues?

20 MR. WEINSTEIN: Ultimately let's
21 say the construction comes in in which you can
22 say at which point. There's lots of different
23 definitions. Ultimately wherein is a connector
24 between two clauses.

1 The question is, does it connote a
2 temporal sequence like something happens when
3 the user accesses the data from the second
4 context? That's the argument.

5 They're taking the update of
6 method to metadata can happen when the user
7 accesses data. That's a claim construction
8 question. We think it's been resolved by Judge
9 Farnan's order.

10 THE COURT: Where is it resolved
11 in his order?

12 MR. WEINSTEIN: It's resolved in
13 his order.

14 THE COURT: Why do I even need to
15 define wherein if dynamically has done it?

16 MR. WEINSTEIN: The only reason we
17 need to define it, Leader is making these
18 arguments. They're putting prosecution history
19 evidence before witnesses and arguing the
20 meaning of claim terms, which is the exclusive
21 province of Your Honor. There's going to be
22 arguments in closing as to what ultimately the
23 legal implication of wherein is. That's
24 something that should not go to the jury.

1 THE COURT: And your paragraph on
2 prosecution history that you propose, that does
3 not take care of your problem if I were to keep
4 that in as well as your wherein construction?

5 MR. WEINSTEIN: The wherein
6 construction would not do it. The prosecution
7 history would help, but ultimately, Your Honor
8 has to decide whether or not the claims are
9 satisfied with dynamically updating the metadata
10 when user accesses.

11 If that issue is not resolved,
12 ultimately instituting "wherein" as some
13 connector is not going to stop the arguments
14 from being made that are legal in nature.

15 THE COURT: If I were to add line
16 five, which claims which would I put the term
17 "wherein" means in which. Perhaps, not when.
18 In which claims, what number claims, would I
19 write in?

20 MR. WEINSTEIN: Your Honor, the
21 claims that have the wherein clause are one,
22 nine, and four also, and --

23 MR. HANNAH: All the dependent
24 claims have wherein as well.

1 MR. WEINSTEIN: I don't think
2 that's right, but I know seven has wherein in
3 it.

4 The claims where it really matters
5 is one, nine, and twenty-three.

6 Twenty-one, very interestingly,
7 Your Honor doesn't use the word "wherein." It
8 uses the term "such that," and that is something
9 that we agreed to, is to construe "wherein" to
10 mean "such that," which is consistent with
11 what's in claim twenty-one. That's another
12 synonym that we think is clearer.

13 THE COURT: Okay. Certainly this
14 is an important issue. I agree with that, but I
15 assume there's probably another you want to
16 address.

17 MR. WEINSTEIN: On Mr. Lamb's
18 testimony, the only thing we wanted was to say
19 two points.

20 One is, a written correction to
21 the deposition does not erase the witness's
22 prior answer, and the jury is free to consider
23 the changes in any way they see fit, the same
24 way they would judge any issue of credibility.

1 We don't think what happened in
2 discovery is particularly relevant. The reason
3 we proposed it, if you recall, as doing the
4 read-back of Mr. Lamb, one of the proposals was
5 let's not present the testimony in the original
6 form, just the modified testimony. Both need to
7 come in, and the jury needs to know the
8 correction does not erase the testimony.

9 "Only comprising" claim. This is
10 again going back to the same issue about the
11 sequence of the steps in the claim. The patent
12 calls for a first context and second context.
13 That's a sequence.

14 It calls for dynamically
15 associates methodology with user-defined data in
16 the first. That's creation of the data.

17 Second claim element, creating the
18 user dynamically, means automatically responding
19 to the preceding event, moving from the first
20 context to the second context.

21 The claim requires a sequential
22 step of events. We're not arguing that because
23 Facebook has a bunch of other components, it
24 doesn't infringe. The issue is, does it have

1 all the claim elements in the claim?

2 We don't want a comprising claim
3 that's going to make them think, I don't have to
4 follow the sequence. As long as I think there's
5 something from or outside of that, I can find
6 infringement, and that's the problem with the
7 comprising claim.

8 THE COURT: Tell me again the
9 number of the comprising claim or what page it's
10 on in your joint summation.

11 So am I correct that your
12 objection is to the statements in 3.5, proposed
13 3.5, along the lines that if you find that
14 Facebook is practicing all the steps, the fact
15 that Facebook might include additional steps
16 would not avoid literal infringement? Do you
17 have an objection as well to the Court saying
18 what comprising means? That is, the other
19 portions of proposed 3.5.

20 MR. WEINSTEIN: The statement that
21 you meet all the claim elements, you don't avoid
22 infringement because you have other stuff, we
23 don't have a problem with that part of the
24 instructions. That's not controversial.

1 I'm not sure the instruction is
2 necessary, but that's not a position that we've
3 been taking.

4 THE COURT: I think I have
5 trouble. I understand the argument that you're
6 making about the sequential nature, and I want
7 to know what you propose I do about that if I
8 agree with you. I don't understand the connect
9 between that and 3.5 and why you have an
10 objection to 3.5.

11 MR. WEINSTEIN: I think, Your
12 Honor, because the claims have a very specific
13 cause and effect and because there isn't really
14 an issue of comprising versus consisting. The
15 instruction doesn't need to be given.

16 This is not an issue. None of our
17 non-infringement positions hinge on. We do
18 everything in the claim, but we do these other
19 things. That's not an argument we're making.

20 THE COURT: From your perspective,
21 if I eliminate 3.5, I've addressed your concern
22 about the sequential nature of the claims?

23 MR. WEINSTEIN: The sequential
24 nature of the claims goes to the wherein cause

1 that's addressed in 3.4. This problem goes to
2 an a number of instructions.

3 THE COURT: Does it come up in
4 other places, or is there some language you
5 proposed elsewhere that I didn't figure out the
6 connection? If you think of that, let me know.

7 MR. WEINSTEIN: And, Your Honor,
8 on the indirect and contributory instructions, I
9 think ultimately the question comes, who is the
10 third party who is directly infringing? In
11 other words, who is the third party, not
12 Facebook, who is performing each and every
13 element of the claims?

14 I don't think there's been an
15 identification of the third party, let alone a
16 showing that a third party performs each claim
17 step. The apparent purpose of these
18 instructions appears to be to, sort of, muddle
19 what they are required to prove with regard to
20 direction and control, and I'll note that in a
21 minute with respect to the evidence proffered
22 and the issues in the case and the fact that
23 they haven't identified a third party direct
24 infringer.

1 Their theory is it is all
2 happening on Facebook's back, and the user does
3 something under the direction and control of
4 Facebook. There's no instance in their theory
5 in which someone other than Facebook is doing
6 all the claim elements.

7 It's a confusing instruction given
8 the central issue of direction and control,
9 which I'll address.

10 We briefed the legal standard for
11 direction and control. The question is, should
12 Your Honor instruct on what it means to have
13 direction and control, and ultimately, Your
14 Honor, I think you have to.

15 What they want is you have to find
16 control or direction, and what they'll argue in
17 closing is they're directing it because they
18 have instructions on your website or they like
19 it when people log on to their site.

20 Ultimately, the Muniauction and
21 other cases we identified, they're a number of
22 cases that say here's what direction and control
23 is not. In Muniauction, direction and control
24 is not providing access to a system, controlling

1 access to a web site, and instructing users on
2 its use.

3 As a matter of law, Your Honor,
4 that is not direction and control, so I think
5 the jury should be told that.

6 THE COURT: I denied a motion for
7 summary judgment on Muniauction. If I give the
8 instruction you proposed, isn't that granting
9 your summary judgment motion?

10 MR. WEINSTEIN: I don't know what
11 the basis of your summary judgment motion was.

12 THE COURT: I haven't explained
13 it.

14 MR. WEINSTEIN: If it was legal or
15 factual, Your Honor may have found there was a
16 factual issue on direction and control, but your
17 denial could have been based on that if jury has
18 to be instructed on what is direction and
19 control and what is not direction and control.

20 This came up in the Muniauction
21 case. That was a case about a jury instruction.
22 What the district Court instructed in that case
23 was, he asked the jury to consider the following
24 question: Is there one party teaching,

1 instructing, or facilitating the other party's
2 participation in the electronic auction process?

3 That was the instruction they
4 gave, and the federal circuit says none of the
5 questions identified by the jury instruction are
6 left to whether Thompson satisfies the direction
7 and control standard. That's 532 Federal Third
8 1318 at 1330. So I guess the point here Your,
9 Honor, is this is not a fantasy. It's not a
10 fantasy football case, Your Honor. This is a
11 Muniauction case.

12 It came eight years after all the
13 cases dealing with websites and whether or not
14 the website operator or the server operator is
15 liable for the actions of the users in the
16 context of a direct infringement claim that
17 falls under the rubric of the Muniauction
18 decision.

19 I think the other
20 distinction is in the fantasy case and some of
21 the other cases they've cited, including Judge
22 Farnan's cases, those claims didn't require a
23 step where the user is actually performing one
24 of the claim elements. They were -- they were

1 more involving where you had an actual server
2 that was doing something and maybe something
3 gets pushed out, but you're not actually --
4 there's no actual distinct party in that sense,
5 legally distinct party that's performing the
6 other steps

7 And in this case, we
8 have a third-party end user who's performing at
9 least one, perhaps two steps of each claim
10 depending on the claim. And we have Facebook
11 providing allegedly the other elements. So they
12 are third infringement implicated end users and
13 the server.

14 Now, the reason this
15 is such an important issue, Your Honor, is
16 something that I alluded to earlier. This is a
17 bifurcated trial. The difference is in
18 implications of whether or not there's direction
19 and control are huge for a second phase trial.

20 I'll give you an example. Let's
21 say, for example, that the jury comes back and
22 says, Okay. Well, I think there was
23 infringement here, because I saw Mr. Wang say on
24 the screen that he uses Facebook, you know, in

1 his cubicle when he does things.

2 I mean, just to be clear, I don't
3 think there's any evidence of infringement, but
4 let's assume that they find that. Under their
5 jury verdict form, which is essentially a black
6 box form, they check yes.

7 So now the jury says, Well, we
8 don't think it was direction and control, but we
9 think there was -- you know, James Wang used it.
10 So the answer to infringement is yes, because
11 somebody infringed it somewhere.

12 Now we have to go to a second
13 trial. We bring our JMOL motion and say, Okay.
14 We don't think there was, but the bottom line is
15 if the jury concludes that there was no
16 direction and control of third-party Facebook
17 end users, there shouldn't be a second phase of
18 this trial. And our jury verdict form will make
19 sure that happens.

20 Under their jury verdict form,
21 we're going to be guessing as to what the jury
22 actually concluded. And that, I think, is
23 unfair.

24 This wasn't a problem before Your

1 Honor bifurcated the case, because we had
2 distinct damages theories on end users versus
3 internal. And really what it was, they have no
4 damages theory on internal use.

5 And their damages theory on
6 external use, when it was all in the same case,
7 that wasn't a problem. But Your Honor
8 bifurcated and that's why we need that
9 interrogatory and the instructions.

10 Your Honor, on the obviousness
11 issue, we were not asking whether or not the
12 level of ordinary skill in the art should be
13 determined by Your Honor. I think the reason
14 for the bracketed text was the definitions of
15 the ordinary skill in the art were relatively
16 close that we had put it in brackets with the
17 possibility that there might be a stipulation on
18 it. That was the reason for the brackets.

19 That is an issue that's not
20 determined by Your Honor. That's one of the
21 factors that the jury would consider is the
22 person of ordinary skill in the art for purposes
23 of obviousness. So it's because there is no
24 stipulation between them.

1 You know, we're okay with just
2 having the jury consider that fact as they
3 normally would. So I just wanted to clarify
4 that point, Your Honor.

5 THE COURT: Thank you. What about
6 anticipation, incorporation by reference?

7 MR. WEINSTEIN: I think in light
8 of the fact that the Lampin and Selger
9 references have not been the subject of
10 testimony, I don't think we need that
11 instruction anymore, Your Honor.

12 THE COURT: Okay.

13 MR. WEINSTEIN: With respect to
14 inherency, Your Honor, they don't think there
15 should be an instruction on inherency. I wasn't
16 in Court all day, but I do remember Dr.
17 Greenberg saying, for example, with respect to
18 the computer executable Claim 21, the preamble,
19 he was talking about how there's a server and
20 there is -- that's inherent in the idea of a
21 server that you have computer executable
22 instructions and a processor.

23 So, I mean, the fact is there
24 certainly is inherency in his arguments. So

1 that's something that should -- that should stay
2 in the jury instruction. That's Instruction
3 4.5.

4 THE COURT: Mr. Weinstein, I just
5 want to make sure the Doras and Hence
6 references, are they in the case any longer?

7 MR. WEINSTEIN: Not at this time
8 any longer.

9 THE COURT: Is there any chance
10 they're still coming in?

11 MR. WEINSTEIN: No, Your Honor.
12 Sorry. Lawyers never want to be --

13 THE COURT: I know you don't want
14 to concede anything until you have it.

15 MR. WEINSTEIN: Of course, but
16 that time has come on this.

17 Your Honor, with respect to one
18 other jury instruction, 4.2, there's this issue
19 of conception and reduction to practice, which
20 is -- this is another issue that might not be
21 relevant anymore in light of the fact that all
22 of the three prior art references that Dr.
23 Greenberg presented are undisputed prior art to
24 the claims of the '761, patent which is to say

1 they were either filed before their invention
2 date or they were published more than one year
3 before their filing date for the Patent Office.

4 So the issue of conception
5 reduction to practice would only be relevant if
6 they were trying to square back some of our
7 references. And because the three references
8 aren't subject to being a square back claim,
9 based on the fact in evidence here, and just the
10 fact that Swartz, for example, was published in
11 May of 2001.

12 So there's no way they can square
13 behind it under any theory here. Hubert was
14 published one year before 2002.

15 Even if you give him the
16 provisional filing date and even if you give
17 them their August invention date, all those
18 references predate it.

19 That includes the Ausems
20 reference, which was filed in February of '98.
21 So all the references predate any combination of
22 their case.

23 THE COURT: And what about the on
24 sale bar and the demonstrations? There's been a

1 lot of dates.

2 Is the jury still left with having
3 to decide something on the provisional
4 application?

5 MR. WEINSTEIN: Absolutely, Your
6 Honor. What I was talking about, reduction to
7 practice, I don't think it relates to the third
8 party prior art like the iManage -- the iManage,
9 Hubert and Swartz references. With respect to
10 -- the provisional is still very relevant to the
11 issue of the on-sale bar.

12 And I think, Your Honor, with
13 respect to the other instructions, there's quite
14 a bit of argument and briefing, unless Your
15 Honor has other questions, I'm okay with --

16 THE COURT: No.

17 MR. WEINSTEIN: -- the arguments
18 in our papers.

19 THE COURT: No. Give me one
20 second.

21 No. I think you've covered all of
22 our concerns. Thank you.

23 MR. WEINSTEIN: Thank you, Your
24 Honor.

1 THE COURT: Last few minutes go to
2 Leader.

3 MR. ANDRE: I'd like to have Mr.
4 Rovner argue the on-sale bar issues, to the
5 extent there are. But there's two other issues
6 that we probably should just make you aware of
7 that D2 limiting instruction that Your Honor
8 ordered. They're not included in that, I do not
9 believe.

10 THE COURT: They're not in here.

11 MR. ANDRE: I don't believe --

12 THE COURT: There was one on the
13 Yahoo! and eBay --

14 MR. ANDRE: Right.

15 THE COURT: -- that was included
16 in here. Which two are you referring to?

17 MR. ANDRE: Do not consider what
18 will happen after trial.

19 THE COURT: Right.

20 MR. ANDRE: And the other one is
21 compare the Facebook website to the asserted
22 claims of the patent, essentially not the
23 product of the company.

24 And then the stipulation that the

1 parties agree to was a commercial success
2 stipulation, but they have not reached agreement
3 on that as well. So those are the -- we can get
4 those to you as soon -- we'll keep working this
5 weekend and hopefully get them to you --

6 THE COURT: Right. So on all of
7 those issues, the limiting instructions and
8 which I think are limited to nine topics that
9 you just mentioned.

10 MR. ANDRE: Yeah.

11 THE COURT: I do want to see what
12 the parties propose, what their positions are,
13 and let's say by noon tomorrow. We're going to
14 follow this weekend the procedures we did last
15 week where I send -- if it's not under seal, go
16 ahead and do ECF. We can pull it off of ECF.

17 But if any portion of it is under
18 seal, email it to Mr. Golden and he'll get it to
19 the rest of us.

20 MR. ANDRE: Mr. Rovner will take
21 care of the rest.

22 THE COURT: Before you sit down,
23 whoever wants to address it on the 3.4 on this,
24 you know, is it enough for me to construe

1 wherein as in which and not go the extra mile
2 and say not when?

3 Mr. Weinstein, not that I don't
4 enjoy all my time with you, but I don't want to
5 sign up automatically for redoing this trial.

6 MR. ANDRE: Your Honor, the issue
7 of claim construction should have been brought
8 up a long time ago, if they want to bring it up.

9 The fact of the matter, experts
10 have been interpreting this how they've been
11 interpreting it. The expert on the stand, Dr.
12 Greenberg, has interpreted is as a consequence.
13 That's how he termed wherein.

14 Dr. Vigna determined it as in
15 which. I don't think, you know, if you say not
16 when is a negative limitation.

17 THE COURT: Let's be clear. If I
18 don't say not when, you're going to argue when.
19 They're going to argue not when.

20 MR. ANDRE: Well --

21 THE COURT: And you don't think
22 that means we're all going to get reversed the
23 minute we get to the Federal Circuit?

24 MR. ANDRE: Well, I'm not going to

1 argue when. I'm arguing which.

2 That's been our position
3 throughout this entire case. It is in which.
4 That's the dictionary's definition of the word.

5 So we think, as Mr. Hannah said,
6 the dynamically is a functional language, not
7 pure grammatical and temporal in that way. So
8 we're very confident that that's not going to be
9 an issue.

10 But if they start arguing, you
11 know, not thereafter, or as a consequence or
12 something along those lines like they had been,
13 their other expert, Dr. Kearns, did the same
14 thing. I asked him, I said, You mean
15 thereafter?

16 He said, Yeah, afterwards. So
17 everybody has had a different definition. If
18 you want to give a proper definition, give the
19 proper definition.

20 If you want to interpret, say what
21 it's not, we should also put some other things
22 what it's not as well as what your experts have
23 proposed. If you want to say it's not when,
24 then it should not say it's not thereafter or

1 it's not --

2 THE COURT: Right.

3 MR. ANDRE: -- as a consequence.

4 THE COURT: I understand your
5 point. Okay.

6 Let's start over, Mr. Rovner.

7 MR. ROVNER: In my minute, Your
8 Honor, let me just address --

9 THE COURT: It's the minute,
10 though, of the day.

11 MR. ROVNER: The minute. The last
12 minute.

13 THE COURT: The one we have all
14 been waiting for.

15 MR. ROVNER: I'm sure. I want to
16 deal with instructions 4.6 through 4.8.

17 4.6 and 4.7, Facebook doesn't
18 state the standard, the clear and convincing
19 standard. They do state in 4.8 now that we are
20 bringing them out in the jury instruction.

21 I think it's important that -- I
22 am sorry -- in the verdict form, we need to put
23 the standard in the instructions themselves. We
24 have them in 4.6, 4.7 and 4.8 I think where they

1 belong.

2 Your Honor pointed out something
3 that is the key point, certainly with respect to
4 4.6. And it's prevalent throughout, you know,
5 the three of them that it's the issue of the
6 effective filing date.

7 We -- in our instruction, we tell
8 the jury that that's something that they need to
9 decide and that's the effective filing date is
10 going to govern their findings. And we believe
11 that our instruction sets that out.

12 I don't believe that Facebook's
13 does. It basically assumes what they want it to
14 assume.

15 The other thing in 4.6 is that
16 we're talking about the experimental use and we
17 describe that in our instruction. It does not
18 get put forward in Facebook's description.

19 Also, in 4.6, they resort to the
20 totality of circumstances test, which has been
21 rejected in the Invitrogen case.

22 In 4.7, again, it's clear and
23 convincing standard. The other thing, the 4.7
24 is the on-sale bar instruction.

1 We believe, and it's, you know,
2 Judge Farnan in the Honeywell case in December
3 set the same standard that it has to meet each
4 of the claim limitations. We say that
5 specifically in our instruction and we think
6 that it belongs.

7 The other two issues with 4.7,
8 4.7, all of a sudden in Facebook's instruction,
9 proposed instruction, they start talking about
10 public policy. Now, we could talk about public
11 policy in every instruction. It doesn't -- it
12 doesn't belong in 4.7, for sure.

13 And the other thing is secrecy
14 versus non-secrecy. In terms of an on-sale bar,
15 it's really not relevant to the on-sale bar
16 issue. We're not claiming that the offers for
17 sale are -- whether they're confidential or not.
18 They are not. They more relate to public use,
19 not the on sale.

20 THE COURT: I thought it was you
21 guys that showed the NDAs today.

22 MR. ROVNER: But not for the on
23 sale. Whether it's on sale or not is not --
24 that wasn't an issue. They're raising the issue

1 and basically flagging it. And I don't believe
2 that belongs in 4.7.

3 In 4.8, let me get there. The
4 problem -- the biggest problem with Facebook's
5 instruction is that right in the very first
6 sentence, it says that, We're contending that
7 our offers for sale weren't offers because they
8 were experimental. We're not saying that.

9 What we're saying is they're not
10 offers for sale for other reasons as well.
11 That's assuming that you have -- you take
12 Facebook's instruction. You're assuming the
13 first step.

14 THE COURT: Right.

15 MR. ROVNER: And the other thing
16 is, again, it's the filing date issue, and
17 that's something that really does -- the jury
18 needs to consider.

19 THE COURT: Okay. Great.

20 MR. ROVNER: That's it in a
21 nutshell.

22 THE COURT: Thank you. Thank you
23 very much.

24 I appreciate everyone speaking

1 quickly, though hopefully not too quickly for
2 the court reporter, but you can't see the
3 expression on her face.

4 So all I can promise you is I'll
5 get you the jury instructions before you begin
6 your closings. If I have them sooner than that,
7 I'll get them to you.

8 But I can't promise you as to when
9 I will have them. And we will be in recess
10 until nine o'clock on Monday morning. Have a
11 nice weekend.

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CERTIFICATE OF REPORTER

I, Heather M. Triozzi, Registered Professional Reporter, Certified Shorthand Reporter, and Notary Public, do hereby certify that the foregoing record, Pages 1274 to 1642 inclusive, is a true and accurate transcript of my stenographic notes taken on July 23, 2010, in the above-captioned matter.

IN WITNESS WHEREOF, I have hereunto set my hand and seal this 23rd day of July, 2010, at Wilmington.

Heather M. Triozzi, RPR, CSR
Cert. No. 184-PS