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

1275

1   APPEARANCES CONTINUED:

2

3

4   BLANK ROME, LLP
          BY: STEVEN L. CAPONI, ESQ.
5
                    -and-
6
          COOLEY, GODWARD, KRONISH, LLP
7   BY: MICHAEL RHODES, ESQ.
          BY: HEIDI L. KEEFE, ESQ.
8   BY: JEFFREY NORBERG, ESQ.
          BY: MARK WEINSTEIN, ESQ.
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                         Counsel for Defendant
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 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
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1277

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 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
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1278

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.

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 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
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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.

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 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.
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1284

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

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 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.
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1287

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

1288

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 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
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 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.
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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?

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 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.
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 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 --
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1294

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 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
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1295

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 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.
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1296

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;

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 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?
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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.

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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

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 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.
```

1302

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.
```

1308

```
 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:
```

1309

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
```

1313

```
 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

1315

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.

1317

```
 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
```

1320

```
 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
```

1325

```
 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.
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 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.
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1330

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 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
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1333

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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.
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1334

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 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.
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 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
```

1336

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,
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1338

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 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.
```

1339

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.

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 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
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 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.
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1342

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 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
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1343

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 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
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 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.
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 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?
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1346

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 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
```

1347

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,

1348

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

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 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
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1350

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 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
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1351

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 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
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 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.
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1353

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 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
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1354

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 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.
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1355

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 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
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1356

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
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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."
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1359

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 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
```

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 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
```

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 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?
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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
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 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:
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1366

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 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?
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 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.
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1368

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 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.)
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 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 --
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 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

1372

 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

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 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.
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 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?
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1375

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 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.
```

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 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
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1377

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 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
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1378

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 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,
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 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?
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 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?
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 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.
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1382

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 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
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 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?
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1384

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 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.
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1385

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 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
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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 --
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 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
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1388

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 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
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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. KEEFE:

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

1392

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 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?
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1393

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 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 to in my job has

23      a lot to do with designing new ways to think

24      about technology.
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 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
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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

1396

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

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 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
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1398

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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.
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 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
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 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
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 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

1403

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 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

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 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
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1407

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.

1408

```
 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?
```

1410

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

1415

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

1418

```
 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?
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 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.
```

1420

```
 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
```

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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?
```

1422

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
```

1424

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 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.

1426

```
 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.
```

1431

```
 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

1433

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

1434

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

1435

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
```

1438

```
 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 it 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 is this code

15      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
```

1441

```
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.
```

1442

```
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. KEEFE:

24             Q.   Dr. Greenberg, one of the terms we
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 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
```

1444

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 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
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1445

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.

1446

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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
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1447

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 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
```

1448

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?
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1450

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 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.
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1451

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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
```

1452

```
 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
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1453

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 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
```

1454

```
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.
```

1455

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.

1456

```
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

1458

```
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.
```

1459

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 --

1460

```
 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.
```

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 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 an

 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
```

1464

 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

1466

```
 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

1468

```
 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.
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1469

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 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                      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
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1470

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 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.
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1471

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 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
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1472

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 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
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1473

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 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
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1474

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 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
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1475

```
 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
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1476

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 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
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1477

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 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?
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1478

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 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
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1479

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 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
```

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 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
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1483

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 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.
```

1484

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?

1485

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

1487

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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
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1488

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 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.
```

1489

```
 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
```

1495

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.

1496

```
 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.

1498

```
 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
```

1499

```
 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.
```

1500

```
 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

1502

```
 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
```

1503

```
 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

1505

```
 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.
```

1506

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.

1507

```
 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
```

1508

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?

1509

```
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
```

1510

```
 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.
```

1511

```
 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

1513

 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
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 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
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 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
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1517

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

1523

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 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?
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 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
```

1528

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.

1531

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 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

1533

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 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?
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 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
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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:
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1536

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 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
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1537

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 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
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1538

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 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. KEEFE:

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

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 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
```

1542

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.
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1544

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. KEEFE:

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

1546

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.
```

1550

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 --

1551

```
 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?
```

1552

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?

1554

```
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.
```

1555

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
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 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.
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1558

```
 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.
```

1559

1   Q.   And does Hubert also disclose the

2   computer-implemented tracking component?

3   A.   Yes, it does, in much the came

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?

1561

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 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

1565

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 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
```

1566

```
 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
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1567

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 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
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1568

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 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
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 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.
```

1570

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

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 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?
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1572

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 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
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 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
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1574

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 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
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1575

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.

1576

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 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.
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1577

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 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
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 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
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 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
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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?

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 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
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1582

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 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:
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 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.
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 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.
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 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
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1586

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 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?
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1587

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

1588

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

1589

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

1590

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 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.
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 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,
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 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
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 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?

1595

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 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
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1596

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.

1597

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 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.
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 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
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1599

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

1600

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 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.
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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.

1602

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

1603

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.

1604

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 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,
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1605

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 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.
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1606

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 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
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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 contractural

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

1608

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 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
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1    think this is going to drop out.

2                    MS. KOBIALKA:  And that would

3    include the vitiation?

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.
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1610

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 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
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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

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 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.
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 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
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1614

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 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
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 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 connecter

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.

1617

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 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   connecter 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.
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1618

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 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

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 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.
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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

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 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, end 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,

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 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
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 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
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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

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 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.
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 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
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 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
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 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
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 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.
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 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
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 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 an 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
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 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
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1636

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 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
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1637

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 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
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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.

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 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
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 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
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1641

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 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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 1    State of Delaware    )
                           )
 2   New Castle County )

 3

 4

 5              CERTIFICATE OF REPORTER

 6

 7        I, Heather M. Triozzi, Registered

 8   Professional Reporter, Certified Shorthand Reporter,

 9   and Notary Public, do hereby certify that the

10   foregoing record, Pages 1274 to 1642 inclusive, is a

11   true and accurate transcript of my stenographic notes

12   taken on July 23, 2010, in the above-captioned

13   matter.

14

15        IN WITNESS WHEREOF, I have hereunto set my

16   hand and seal this 23rd day of July, 2010, at

17   Wilmington.

18

19

20                   _____

21                   Heather M. Triozzi, RPR, CSR
                     Cert. No. 184-PS
22

23

24
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