UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALTRICS, LLC
Petitioner

v.

OPINIONLAB, INC.
Patent Owner

Case IPR2014-00366
U.S. Patent 8,041,805

PETITIONER QUALTRICS, LLC'S MOTION TO EXCLUDE EVIDENCE

FILED VIA PRPS

Table of Contents

I. INTRODUCTION

Petitioner Qualtrics, LLC moves to exclude the opinions of Patent Owner OpinionLab, Inc.'s expert Dr. Shamos regarding obviousness and secondary considerations. Dr. Shamos applied the wrong legal standard in determining the level of ordinary skill and thus his determinations on obviousness are flawed and inadmissible. Further, Dr. Shamos's opinions on secondary considerations are also flawed and inadmissible because they (a) go beyond his qualifications, (b) fail to show the required nexus, and (c) ignore many other important factors relevant to secondary considerations. Thus, Qualtrics moves to exclude:

- Dr. Shamos's opinions regarding obviousness, including ¶¶ 26–32, 37–100 of his declaration (Ex. 2002 ("Shamos Decl.")) and the portions of his deposition testimony (Ex. 1028 ("Shamos Dep.")) regarding obviousness.
- Dr. Shamos's opinions regarding secondary considerations, including ¶¶ 101–114 of his declaration and the portions of his deposition testimony discussing secondary considerations.

II. MOTION TO EXCLUDE AND AUTHORIZATION

A "motion to exclude evidence" must be filed by each party to preserve any objection. 37 C.F.R. § 42.64(c). The motion may be filed without prior authorization from the Board. *Id*. The Scheduling Order governing this IPR

specifically authorizes each party to file a motion to exclude evidence by Due Date 4 or February 27, 2015. (Paper 16.)

III. DR. SHAMOS'S OPINIONS REGARDING OBVIOUSNESS SHOULD BE EXCLUDED

The Federal Rules of Evidence apply to PTAB Proceedings. 37 C.F.R. § 42.62(a). And expert testimony that is premised on an incorrect legal standard is inadmissible under FRE 702. *See, e.g., Hebert v. Lisle Corp*., 99 F.3d 1109, 1117 (Fed. Cir. 1996) ("We encourage exercise of the trial court's gatekeeper authority when parties proffer, through purported experts, not only unproven science, but markedly incorrect law. *Incorrect statements of law are no more admissible through 'experts' than are falsifiable scientific theories*.") (emphasis added).

Dr. Shamos's opinions regarding obviousness should be excluded because he applied the wrong legal standard in determining the level of ordinary skill. To do so, he considered *only* the '805 Patent and failed to assess the prior art in the field in making his determination. Indeed, Dr. Shamos conceded in his deposition that he looked solely at the '805 Patent specification and claims:

> I look at the field of the invention as defined by the inventor. I look at the specification to see what level of education and background would be needed to understand the specification. And then I look at the claims to see what one would need to know in order to implement the invention as claimed. And . . . I'm able to formulate a level of skill

from that.

(Shamos Dep. at 70:1–9.)

Dr. Shamos deemed the prior art "irrelevant" and confirmed his belief that the level of ordinary skill is determined by reference to the '805 Patent alone:

Q: Did you consider the prior art that was referenced in the petitions?

. . .

A: I don't recall having done so. . . . It's difficult for me to imagine how it would be relevant.

Q: And why would that not be relevant?

A: Because the person of ordinary skill in the art is determined by reference to the patent.

(*Id.* at 70:10–25.)

But since a person of ordinary skill is "presumed to know the relevant art," such relevant prior art must be considered to properly assess the skill level. *See In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). To determine the skill level, the Federal Circuit and Patent Office have emphasized five factors: "[1] type of problems encountered in the art; [2] prior art solutions to those problems; [3] rapidity with which innovations are made; [4] sophistication of the technology; and [5] education level of active workers in the field." *Id.*; MPEP § 2141.03; *accord. Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666–67 (Fed. Cir. 2000); *Custom*

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.