

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALTRICS LLC

Petitioner

v.

OPINIONLAB, INC.

Patent Owner

Case IPR2014-00366

Patent 8,041,805

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO EXCLUDE**

I. INTRODUCTION

Patent Owner OpinionLab, Inc. submits this Opposition to Petitioner's Motion to Exclude pursuant to 37 C.F.R. § 42.64(c) seeking exclusion of certain paragraphs of Exhibit 2002, the Declaration of Michael I. Shamos (the "Shamos Declaration").

Petitioner's motion seeks to exclude Dr. Shamos's entire opinion regarding obviousness based on its allegation that he applied the wrong legal standard in defining the level of ordinary skill in the art. Petitioner's motion should be denied at least because, for purposes of his opinion regarding obviousness, *Dr. Shamos applied the same definition for the level of ordinary skill as Petitioner's expert.* Petitioner provides no explanation as to how Dr. Shamos's obviousness analysis could possibly be impacted where he applied the same definition as Petitioner's expert. In addition, Petitioner relies almost entirely on its mischaracterizations of Dr. Shamos's deposition testimony. The entire argument boils down to the fact that Petitioner disagrees with Dr. Shamos's conclusions regarding obviousness. That is not a proper basis for a motion to exclude.

Petitioner similarly seeks to exclude Dr. Shamos's opinions on secondary considerations based on mischaracterizations of his deposition testimony and its disagreement with his conclusions. Petitioner alleges that Dr. Shamos does not

have the financial expertise required to offer opinions on secondary considerations, but Dr. Shamos does not purport to rely on financial statements, market analysis, or economic reports which would require such expertise. Dr. Shamos has ample expertise to support the opinions he has offered. Petitioner's remaining arguments regarding the nexus to the claims, the sufficiency of Dr. Shamos's investigation, and consideration of additional factors all go to the weight of the evidence, and are not a proper basis for exclusion.

Finally, Petitioner's objections to the evidence presented in OpinionLab's Opposition were overly broad and undecipherable. Petitioner's failure to provide OpinionLab with required notice as to the scope of the objections warrants denial of Petitioner's motion on that basis alone.

II. LEGAL STANDARD

“Admissibility of evidence is generally governed by the Federal Rules of Evidence.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012). Rule 403 of the Federal Rules of Evidence explains that relevant evidence may only be excluded “if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the [Board], undue delay, wasting time, or needlessly presenting cumulative evidence.”

A motion to exclude evidence must explain why the cited evidence is not admissible and must: (a) identify where in the record the objection originally was made; (b) identify where in the record the evidence sought to be excluded was relied upon by an opponent; (c) address objections to Exhibits in numerical order; and (d) explain each objection. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012).

III. ARGUMENT

A. Dr. Shamos's Opinions Regarding Obviousness Are Legally Sound and Should Not Be Excluded

Dr. Shamos applied the correct legal principles in determining that the '805 Patent was not rendered obvious by Petitioner's combination of references. This is certainly true in light of Dr. Shamos's definition of the level of ordinary skill in the art. Regardless, Petitioner's motion should be denied at least because, for purposes of his opinion regarding obviousness, *Dr. Shamos applied the same definition for the level of ordinary skill as Petitioner's expert*, which Petitioner acknowledged in the motion itself. *See* Motion at 5 n.1. Petitioner fails to explain how Dr. Shamos's obviousness analysis could possibly be impacted where he applied the very same definition as Petitioner's expert.

Although irrelevant to its motion to exclude in light of the above, Petitioner alleges Dr. Shamos applied the wrong legal standard in determining the level of ordinary skill because "he considered *only* the '805 Patent and failed to assess the

prior art in the field.” *See* Motion at 2. Petitioner further incorrectly claims that Dr. Shamos is limited to five factors for determining the level of ordinary skill, and that he *must* include reference to the prior art cited in the Petition to satisfy those five factors. *See* Motion at 3-4 (citing *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995)). However, *GPAC*’s 5-factor test is less rigid than Petitioner suggests. Particularly, the Federal Circuit states that the Court “may” consider certain factors and “[i]n a given case, every factor may not be present, and one or more factors may predominate.” *See GPAC*, 57 F.3d at 1579. Indeed, in the *GPAC* case the Federal Circuit never sought the extreme penalty of excluding expert testimony as a whole but merely sought to examine whether the district court below applied an appropriate skill level for determining obviousness. *See id.* at 1579-80.

The only support for Petitioner’s argument is its mischaracterization of Dr. Shamos’s deposition testimony. Petitioner alleges that “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.” Motion at 3. This is incorrect. As Dr. Shamos testified, he considered the patent specification (*see* Shamos Dep., at 70:1-9) which, in this case, includes reference to many of the factors identified in *GPAC*, including at least (1) “problems encountered in the art,” (2) “prior art

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