

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 REPLY
IN SUPPORT OF MOTION TO EXCLUDE EVIDENCE**

FILED VIA PRPS

I. Dr. Shamos's Obviousness Options Should Be Excluded

A POSITA is a “legal construct” presumed to have available “all prior art references in the field of invention.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Although Dr. Shamos testified that he “look[ed] at” the specification, he did so only “to see what level of education and background would be needed to understand it.” Shamos Dep. at 70:2–4. There is no evidence that he tried to understand the prior art to see what a POSITA would have known, especially since he deemed it “irrelevant” in determining the level of skill. *Id.* at 70:20–22.

Further, the '805 Patent's discussion of the prior art is bare bones. The patent cites three references on the cover (and none of the prior art of record in this IPR) and does not mention any of them in the specification. The background section is only two paragraphs long. *See* '805 Patent, 1:23–56. In a few sentences, it describes alleged shortcomings of “prior techniques” but does not identify any prior art or explain what the “techniques” entail. Nor does it offer insight into prior art solutions, the rapidity of innovations, the sophistication of the technology, or the skill and knowledge level of active workers in the field. Nor does it discuss analogous prior art, which a POSITA is also presumed to know. *See Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 313 (Fed. Cir. 1985).

OpinionLab tries to sidestep the issue by claiming that Dr. Shamos applied Qualtrics's definition for the level of ordinary skill. But regardless of the level Dr.

Shamos allegedly applied, a POSITA must *know* all pertinent prior art and the person's opinions must be *from that perspective*. As a matter of law, Dr. Shamos cannot properly apply Qualtrics's level of skill where he did not consider the prior art presumptively known. In *Sloan Valve v. Zurn Industries.*, the court struck the expert's testimony on obviousness because he was not a POSITA and so was not "qualified" to give obviousness opinions "based on the *perspective* of a POSITA." 2013 WL 6068790, *7 (N.D. Ill. 2013). This is precisely the situation here.

For example, whether a POSITA would have found certain claims obvious in view of the prior art or been motivated to combine prior art references depend on what the POSITA would have known and considered, i.e., all pertinent prior art. Dr. Shamos confirmed that he did not—and indeed could not—apply that test because he did not consider all of the pertinent art. A bald statement that he applied Qualtrics's level of skill cannot cure these fundamental defects.

II. Dr. Shamos's Secondary Considerations Opinions Should Be Excluded

Because Dr. Shamos is not a qualified financial or online survey expert, and because he did not talk to anyone at OpinionLab or adequately investigate the facts and circumstances of these secondary considerations, his opinions are based *solely* on information from OpinionLab's counsel. It presents attorney argument under the guise of expert testimony and should be excluded. In *AMO v. Alcon*, the court excluded the patentee's expert from testifying on commercial success where the

expert did not disclose any basis supporting his opinion except for information from patentee's counsel. 2005 WL 782809 (D. Del. 2005). *See also Rambus. v. Hynix.*, 2008 WL 5411571, *13 (N.D. Cal. 2008) ("To give expert testimony, Mr. Murphy must use his expertise to rigorously analyze an issue and present his opinion. . . . Rambus may not put on its closing argument through Mr. Murphy as 'expert testimony.'"). Again, that is the same situation here. Shamos is simply parroting information supplied to him by counsel, not giving expert opinion.

Further, Dr. Shamos does not even attempt to make a showing of nexus for the vast majority of OpinionLab's alleged customers. Apart from a cursory discussion of Bank of America, Dr. Shamos provides *no* evidence that any other customer actually practices the '805 Patent. This is important because OpinionLab's claim of commercial success and industry recognition is not based on Bank of America alone, but on its entire list of alleged customers. To show commercial success and industry recognition, Dr. Shamos must satisfy the nexus requirement for *every* customer he relies on, which he utterly fails to do.

Finally, Dr. Shamos's failure to consider many other important factors relevant to secondary considerations goes directly to admissibility. By not considering whether these other factors were partly or wholly responsible for the alleged considerations, Dr. Shamos's methodology is unreliable. Fed. R. Evid. 702.

III. Qualtrics’s Objections Are Proper and Timely

Qualtrics’s motion to exclude Dr. Shamos’s testimony and opinions is proper and based on the following objections made in the record:

Evidence To Exclude	Where the Objection Was Made
Obviousness opinions, including Shamos Decl. ¶¶ 26–32, 37–100. Relied upon by OpinionLab in ’805 Response at 14–44.	Qualtrics “objects to the Shamos declaration to the extent that Dr. Shamos provides . . . testimony that relies <i>on an incorrect statement of the law</i> , including, for example, ¶¶ [26–32; 39–40; 41–50; 51–52; 56–59; 60–63; 65–69; 70–73; 77–81; 82–83; 86–100].” Petitioner’s Objections to Evidence Submitted by Patent Owner (Ex. 2025) at 2.
Secondary considerations opinions, including Shamos Decl. ¶¶ 101–114. Relied upon by OpinionLab in ’805 Response at 44–53.	Qualtrics objects to the Shamos declaration “in its entirety on the ground that Mr. Shamos <i>does not have the requisite experience and expertise</i> to offer an expert opinion in this proceeding.” Petitioner’s Objections at 1. “Petitioner further objects to the Shamos declaration to the extent that Dr. Shamos provides <i>unsupported factual testimony</i> . . . including, for example, ¶¶ [101, 103–14].” <i>Id.</i> at 2. “Petitioner further objects to the Shamos Declaration to the extent that Dr. Shamos lacks personal knowledge of the facts asserted and he purports to <i>rely on information that is not reasonably relied on by experts in the field</i> , including, for example, ¶¶ [101–114].” <i>Id.</i>

Qualtrics stated the same objections that are the basis of this motion and identified exemplary paragraphs in Dr. Shamos’s declaration—including almost all

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