

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,
v.

Bradium Technologies, LLC
Patent Owner.

Case IPR2016-00449
Patent 8,924,506 B2

BRYAN F. MOORE, BRIAN J. McNAMARA, and MINN CHUNG,
Administrative Patent Judges.

CHUNG, *Administrative Patent Judge.*

DECISION ON PATENT OWNER'S MOTION TO EXCLUDE
37 C.F.R. § 42.64

On March 24, 2017 Patent Owner filed a Motion to Exclude. Paper 44 (“PO Mot. to Exclude”). On March 31, 2017 Petitioner filed an Opposition to Patent Owner’s Motion to Exclude. Paper 46 (“Pet. Opp. to PO Mot. To Exclude”). On April 7, 2017, Patent Owner filed a public version and a confidential version of its Reply (Papers 55 and 56, respectively).

In its Motion, Patent Owner moved to exclude the following evidence: Exhibit 1015 (a Linked In profile of inventor Isaac Levanon), Exhibit 1017 (Declaration of co-inventor Yonatan Lavi (“Lavi Decl.”)), Exhibit 1020 (Fujitsu Stylistic Technical Reference Guide), Exhibit 1022 (NGA Office of GEOINT Sciences “The Universal Grid System”), Exhibit 1023 (Wayback Machine FXT1:3dx Texture Compression), Exhibit 1027 (Bing Maps Preview), Exhibit 1028 (System Requirements Windows 8.1), Exhibit 1029 (Compaq home and office computing), Exhibit 1030 (Microsoft TerraServer: A Spatial Data Warehouse), Exhibit 1031 (Intel Atom Microprocessor Quick Reference Guide), and redirect testimony of Dr. William R. Michalson in Exhibit 2078 (Deposition Transcript of Dr. Michalson (“Michalson Tr.”)).

Patent Owner’s Motion to Exclude is moot as to all objected-to Exhibits other than Exhibit 1017, as our Final Written Decision does not reference any of the Exhibits that are the subject of Patent Owner’s Motion to Exclude.

Patent Owner moves to exclude Exhibit 1017, the Declaration of co-inventor Yonatan Lavi because Petitioner did not make Mr. Lavi available for cross-examination. PO Mot. to Exclude 2–7. Patent Owner states that on February 9, 2017 shortly after receiving the Petitioner Reply on Feb. 6, 2017, Patent Owner requested Petitioner produce Mr. Lavi in the United States for deposition on March 2, 2017. *Id.* at 2–3. Patent Owner states that it corresponded with Petitioner on February 13, 2017 and on February 14, 2017, served Notice of Deposition to occur

on March 2, 2017 at the offices of Patent Owner's counsel. *Id.* at 3. Patent Owner states that on February 28, 2017 Petitioner notified Patent Owner that it would need to request the Board to submit a Letter of Request to the Israel Central Authority under the Hague Convention, a process that would extend the deposition past the hearing date of this proceeding. *Id.* Mr. Lavi did not appear for deposition.

Petitioner responds that in related district court litigation, Patent Owner did not identify Mr. Lavi as a person with knowledge of facts relevant to the case in its initial disclosures under F.R. Civ. P. 26. Pet. Opp. to PO Mot. to Exclude 1–2. Petitioner also states that Patent Owner informed the district court judge that it has no relationship with Mr. Lavi, so Petitioner located co-inventor Lavi in Israel and obtained the declaration that is now the subject of Patent Owner's Motion to Exclude. *Id.* at 2. Petitioner states that after it filed and served Mr. Lavi's declaration, Patent Owner threatened retaliation against Mr. Lavi for breaching undisclosed confidential obligations to 3DVU (a company Mr. Levanon purportedly set up to exploit the technology), despite the fact that 3DVU has not existed for a number of years. As a result, Mr. Lavi ceased cooperating with Petitioner, resulting in the need to invoke Hague Convention provisions. *Id.* at 3.

The circumstances in this case are far from clear. Mr. Lavi is a co-inventor. We are troubled by the allegation that Patent Owner informed the district court it has no relationship with Mr. Lavi, but that Patent Owner now asserts a confidentiality relationship exists. We cannot determine whether Mr. Lavi is under any obligation of confidentiality, the duration of any such obligation, to whom any such duty is owed, and the scope of that obligation, if any such obligation exists.

Nevertheless, we are able to reach a final decision on the relevant issues in this case based on other evidence. Thus, in view of Petitioner's inability to make Mr. Lavi available for cross examination, we exclude Exhibit 1017.

Patent Owner also moves that we exclude portions of Exhibit 1016, Reply Declaration of Dr. William R. Michalson ("Michalson Reply Decl.") that reference the Lavi Declaration. We do not rely on Dr. Michalson's testimony concerning Mr. Lavi's declaration and find Patent Owner's motion with respect to Exhibit 1016 to be moot.

ORDER

In consideration of the above it is

ORDERED that Patent Owner's Motion to Exclude Exhibit 2017 is GRANTED; and

FURTHER ORDERED that the remainder of Patent Owner's Motion to Exclude is DISMISSED as moot.

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