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 15 UNITED STATES DISTRICT COURT
 16 NORTHERN DISTRICT OF CALIFORNIA
 17 SAN JOSE DIVISION

19 HTC CORPORATION, HTC AMERICA,
 INC.,

20 Plaintiffs,

21 v.

22 TECHNOLOGY PROPERTIES
 23 LIMITED, PATRIOT SCIENTIFIC
 CORPORATION, and ALLIACENSE
 24 LIMITED,

25 Defendants.

Case No. 5:08-cv-00882 PSG

**DEFENDANTS' OPPOSITION TO
 EMERGENCY MOTION TO ENFORCE
 MIL ORDER (DKT. NO. 564)**

Complaint Filed: February 8, 2008
 Trial Date: September 23, 2013

Date: September 30, 2013
 Time: 9:00 a.m.
 Place: Courtroom 5, 4th Floor
 Judge: Hon. Paul S. Grewal

1 Yesterday, HTC substantially revised its initial designations for Mr. Russell H. Fish's
 2 deposition testimony. Based upon both HTC's revised affirmative designations and HTC's
 3 emergency motion (Dkt. No. 633) regarding this Court's Order on Motions *in Limine* (Dkt. No.
 4 564), Defendants' motion *in Limine* based upon their concerns that Plaintiffs would seek to
 5 introduce inadmissible testimony from Mr. Russell H. Fish was well-founded.

6 HTC has repeatedly represented that it will offer Mr. Fish's testimony only for the limited
 7 purposes of establishing what Mr. Fish thought of his invention or to counter TPL's claim of
 8 willful infringement. *See*, Dkt. 564 at 5-6; M. Leary email to J. Phillips, 09/29/2013, ("[HTC]
 9 plans to use the designated Fish testimony for purposes that include establishing what Mr. Fish
 10 thought of his invention and to counter TPL's claim of willful infringement."). The Court denied
 11 TPL's motion *in Limine* based on these representations. Dkt. 564 at 5-6.

12 However, contrary to HTC's representations, a host of the testimony HTC designated has
 13 no bearing on either willfulness or Mr. Fish's beliefs regarding his invention. Instead, the
 14 testimony relates to Mr. Fish's alleged encounters with Messrs. Daniel and Mac Leckrone, and
 15 Mr. Fish's interpretation of the '336 patent as it regards his invention (*i.e.*, claim construction).

16 **I. Testimony Regarding Messrs. Leckrone.**

17 Defendants inquired as to the relationship Mr. Fish's testimony regarding Messrs.
 18 Leckrone might have on either willfulness or Mr. Fish's subjective beliefs regarding his
 19 invention:

20 If these are the only purposes for which HTC intends to use the
 21 designated testimony, then I am at a loss as to why HTC designated
 22 the testimony related to Messrs. Leckrone, as that has nothing to do
 with willfulness or establishing what Mr. Fish thought of his
 invention. Would you please let me know how that testimony is
 relevant to either topic? J.Phillips email to M.Leary, 09/29/2013.

23 HTC did not respond. There really was nothing to say. Mr. Fish's testimony related to Messrs.
 24 Leckrone has no bearing on any issue in this litigation¹ -- certainly not whether HTC willfully

25
 26 ¹ Mr. Fish's testimony regarding Messrs. Leckrone is also inadmissible to attack
 27 their credibility. Fed. R. Evid. 608(b) specifically excludes such testimony-- "extrinsic evidence
 28 is not admissible to prove *specific instances* of a witness's conduct in order to attack or support
 the witness's character for truthfulness." (emphasis added).

1 infringed the '336 patent, or Mr. Fish's subjective belief regarding the scope of his invention.
 2 This testimony is irrelevant and inadmissible under Fed. R. Evid. 401 and 402, and more
 3 prejudicial than probative under Fed. R. Evid. 403.

4 Further, despite the already irrelevant and prejudicial nature of this testimony, HTC
 5 **compounded** the prejudice by selectively editing its initial affirmative deposition designations.
 6 For example, HTC initially designated 26:9-28:14 from Mr. Fish's 12/17/2010 deposition. (Dkt.
 7 519) These pages relate to Mr. Fish's unsupported allegations that Mac Leckrone wanted Mr.
 8 Fish to change his testimony. But in the designations HTC disclosed yesterday, HTC altered its
 9 initial designation. Instead of the unbroken range (26:9-28:14), HTC split the designated
 10 testimony in to three separate ranges: 26:9-27:8, 28:2-28:9, and 28:12-14. Why? To eliminate
 11 from the Jury's consideration Mr. Fish's testimony that he **never** had any interaction with Mac
 12 Leckrone. HTC removed the following testimony from its designations:

13 Q. When did Mac Leckrone visit you?

14 A. I believe it was three days ago.

15 MR. MELITO: Objection to -- object to form. It's ambiguous
 because they did not meet.

16 A. That's correct. We did not meet.

17 Q. (By Mr. Walker) How did Mr. Leckrone -- how did Mac
 Leckrone contact you?

18 A. I arrived at my attorney's office for a purported conference call
 and noticed Mr. Leckrone was on the sign-in sheet.

19 Q. And did -- did you have a conversation with Mr. Leckrone?

20 A. No.

21 Q. Did you meet with Mr. Leckrone?

22 A. No.

23 Q. Did you receive any written communication from Mr. Leckrone?

24 A. No. R. Fish Depo, 12/17/2010, 27:9-28:1.

25 This selective editing serves no purpose other than to mislead and confuse the jury.
 26 Further, despite only informing TPL yesterday that HTC was altering its initial deposition
 27 designations to exclude this testimony, HTC now objects to TPL providing the Jury with the
 28 complete transcript. (Dkt. 564 at 3). Disingenuously, HTC calls TPL's corrective designations of
 the above testimony "never-before disclosed designations." In a way, HTC is correct. TPL did
 not counter-designate this testimony. There was no reason--HTC's initial designations included

1 it. Accordingly, it served no purpose for TPL to “counter-designate” what was already part of
 2 HTC’s initial designation. Fed. R. Evid. 106.

3 HTC cannot colorably argue that its attempt to introduce Mr. Fish’s testimony regarding
 4 Messrs. Leckrone has any bearing on either willfulness or Mr. Fish’s beliefs regarding his
 5 invention. To the extent such testimony might have a scintilla of relevance; its inflammatory
 6 nature renders it more prejudicial than probative. It is properly excluded (1) pursuant to Fed. R.
 7 Evid. 401, 402, 403, and 608(b), and (2) based upon HTC’s repeated affirmative representations
 8 that it would *only* introduce Mr. Fish’s testimony for purposes of countering TPL’s willfulness
 9 allegations, or to show Mr. Fish’s beliefs regarding his invention.² To the extent the Court
 10 permits HTC to introduce this testimony, TPL requests the Court compel HTC to include in its
 11 presentation the corrective counter-designations TPL provided to HTC yesterday.³

12 II. Testimony Regarding Claim Construction.

13 Despite representations to the contrary, HTC has elected to offer into evidence Mr. Fish’s
 14 testimony regarding his belief of the scope of his invention *as it relates to the ’336 patent*--claim
 15 construction by any other name. Not only is this inappropriate expert testimony, offered without
 16 foundation from a witness who has expressly disclaimed knowledge regarding the scope of his
 17 invention as it relates to the ’336 patent, HTC has elected to offer this testimony despite the
 18 Court’s admonition that it would tolerate no interference with regard to the Court’s claim
 19 construction:

20 But let me be clear about one thing. This court's claim construction
 21 will govern how this jury understands what this invention is and is
 22 not, and I would caution both sides not to tinker in any way, shape,
 or form with the language that's been provided to the parties
 construing the claims. HT 09/24/2013, 241:10-14

23 ² HTC designated the following testimony regarding Messrs. Leckrone: R. Fish
 24 Depo., 12/17/2010: 25:11-12; 25:19-19; 25:24-26:3; 26:9-27:8; 28:2-9; 28:12:14; 28:17-19;
 25 28:21-21; 137:14-18; 137:21-24; 138:2:8; and R. Fish Depo., 1/28/2013: 225:17-227:17; 264:17-
 266:2; 271:14-272:13.

26 ³ Contrary to HTC’s allegations, all of the counter-designations TPL provided HTC
 27 were disclosed by either HTC or TPL as testimony that might be introduced from Mr. Fish’s
 28 depositions. Dkt. 519. TPL provided HTC with the following specific corrective counter-
 designations based upon HTC’s revisions to its initial designations to Mr. Fish’s testimony
 regarding Messrs. Leckrone: R. Fish Depo, 12/17/2010, 27:9-28:1.

1 As noted above, Mr. Fish expressly disclaimed any knowledge of what the '336 patent "is
2 or isn't":

3 Q. So the ShBoom microprocessor is intended to be an embodiment
4 of inventions disclosed in the '336 patent?

5 A. The '336 patent as I understand it -- actually, let me make -- I'm
6 not a -- I'm not a lawyer. ***I can't tell you what the '336 is or isn't.***
7 What I can tell you was what the Fish clock was and how it relates
8 to the microprocessor. R. Fish Depo, 12/17/2010, 55:2-8 (emphasis
9 added).

10 Despite Mr. Fish's disclaimer, HTC's affirmative representations, and the Court's
11 admonition, HTC now seeks to introduce testimony where Mr. Fish identifies, in his opinion,
12 elements of the '336 patent. For example,

13 Mr. Fish, if the frequency of an oscillator or a clock is determined
14 by a control voltage, would you agree ***it cannot be a variable speed
15 oscillator or clock under the '336 patent?***

16 A. Yes. R. Fish Depo. 01/28/2013, 244:9-13 (emphasis added).

17 And,

18 Q. So any variations based on these PVT parameters that a PLL-
19 based frequency synthesizer may experience, ***those are
20 substantially different than the variable speed discussed in the
21 '336 patent.*** Is that correct?

22 A. Correct. R. Fish Depo. 01/28/2013, 237:5-9 (emphasis added).

23 And,

24 Q. And just to confirm, if one were to time their CPU using a PLL-
25 based frequency synthesizer as we've defined it, ***that would defeat
26 the purpose of the '336 patent.*** Correct?

27 A. That is correct. R. Fish Depo. 01/28/2013, 237:10-14 (emphasis
28 added).

And,

My questions are going to pertain to a crystal reference phase
locked loop. So just to provide a little context, if you have a crystal
that feeds into the phase comparator of a phase locked loop and
there's a divider in the loop between the oscillator, the VCO, and
the phase comparator, is that what you've referred to as a frequency
synthesizer?

A. Yes.

1 Q. And for ease of reference for my questions, can we call that
circuit that I've just described a PLL-based frequency synthesizer?

2 A. That would be reasonable.

3 Q. Okay. Now, I believe you testified earlier that if you would time
4 a CPU using a PLL-based frequency 1 synthesizer as we've
described, *that would defeat the purpose of the variable speed*
5 *timing described in the '336 patent*. Is that fair?

6 A. Yes.

7 Q. Is that because the purpose of a PLL is to not vary from that
reference crystal signal?

8 A. The purpose of the synthesizer is to not vary. R. Fish Depo.
9 01/28/2013, 231:12-232:7 (emphasis added).

10 The testimony HTC seeks to admit ventures far afield from Mr. Fish's subjective belief
11 regarding the scope of his invention and trespasses upon the field of claim construction. As the
12 Court noted, "it is not unusual for there to be a significant, actual difference between what the
13 inventor thinks her patented invention constitutes and the ultimate scope of the patent claims
14 following issuance from the PTO." Dkt. 564 at 5. Mr. Fish's testimony on what the '336 patent does
15 or does not require or contemplate is irrelevant to any issue in in dispute in this litigation, constitutes
16 improper opinion testimony from a lay witness, is more prejudicial than probative, and likely to
17 confuse the jury. Accordingly, because the above testimony relates to Mr. Fish's unsupported opinion
18 regarding the scope of the '336 patent and not to either willfulness or Mr. Fish's belief regarding his
19 invention, TPL requests the Court exclude this testimony.

20 To the extent the Court permits HTC to introduce this testimony, TPL requests the Court
21 compel HTC to include in its presentation the corrective counter-designations TPL provided to
22 HTC yesterday, specifically, the disclaimer identified above.⁴

23 **III. Testimony Regarding the "Fish Clock".**

24 HTC also seeks to admit Mr. Fish's testimony regarding the "Fish Clock." The Fish
25 Clock is what Mr. Fish asserts is his invention, and the Court indicated HTC would be permitted

26 _____
27 ⁴ TPL provided HTC with its corrective counter-designation based upon HTC's
28 revisions to its initial designations. TPL disclosed its counter-designation (R. Fish Depo,
12/17/2010, 55:2-8) in Dkt. 519 on 8/22/2013, and again via email to HTC yesterday.

1 to introduce admissible evidence on this topic. However, to the extent the Court permits HTC to
 2 introduce evidence on Mr. Fish's beliefs as to what constitutes a Fish Clock, TPL requests the
 3 Court order HTC to include the following counter-designation, pursuant to Fed. R. Evid. 106:

4 Q. Was the Fish Clock implemented in the Sh-Boom processor?

5 A. No.

6 Q. When I say "implemented," I mean was it implemented in any
 7 prototype, any production version, anything?

8 A. No. R. Fish Depo. 01/28/2013, 117:11-17.⁵

9 This testimony clarifies for the Jury that to the extent Mr. Fish is testifying about the "Fish
 10 Clock" and the Sh-Boom processor, he is discussing two separate and distinct items. According
 11 to Mr. Fish, so far as he knows, the Sh-Boom processor did not include what he terms a "Fish
 12 Clock." Accordingly, the Jury should be permitted to assess what weight to give his testimony
 13 about what does or does not constitute a Fish Clock, and the relevance that testimony should have
 14 in their deliberations.

15 Further, while TPL agrees that HTC may properly introduce evidence regarding what Mr.
 16 Fish thought of his invention, much of the testimony HTC designated is objectionable on other
 17 grounds. For example, HTC seeks to introduce Mr. Fish's opinions regarding illustrations
 18 included in the prior art, and whether those illustrations constitute a "Fish Clock". *See, e.g.*, R.
 19 Fish Depo. 01/28/2013, 85:25:86:1 (testimony regarding U.S. Patent No. 4,931,748). Mr. Fish's
 20 examination of an illustration in a prior art patent and his subsequent opinion as to whether that
 21 figure discloses the requisite elements sufficient to constitute a "Fish Clock" in his opinion,
 22 constitutes impermissible opinion testimony, pursuant to Fed. R. Evid. 701.

23 **IV. Conclusion**

24 HTC requests this Court enforce its order regarding TPL's motion *in Limine*. But that
 25 order was predicated on HTC's affirmative representations that it would offer Mr. Fish's

26
 27 ⁵ HTC initially designated this testimony, but then elected to exclude it from the
 28 testimony identified yesterday. Accordingly, TPL provided HTC with this corrective counter-
 designation based upon HTC's revisions to its initial designations to Mr. Fish's testimony.

1 testimony only for the limited purposes of establishing what Mr. Fish thought of his invention or
2 to counter TPL's claim of willful infringement. The testimony HTC identified in its revised
3 deposition designation cannot colorably be claimed to relate only to these two topics. Further, the
4 Court's ruling on TPL's motion *in Limine* does not preclude TPL's legitimate evidentiary
5 objections to the testimony HTC seeks to admit. Finally, HTC has long been aware that the
6 testimony contained in TPL's counter-designations might be admitted in this litigation--they
7 designated much of it themselves, and the rest TPL identified on August 22, 2013, in Dkt. 519.
8 Accordingly, the Court should deny HTC's motion.

9
10 Dated: September 30, 2013

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12 By: /s/ J. Phillips

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