

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

**MONARCH NETWORKING
SOLUTIONS LLC,**

Plaintiff,

V.

CISCO SYSTEMS, INC.,

Defendant.



Civil Action No. 2:20-cv-00015

JURY TRIAL DEMANDED

**MONARCH’S DAUBERT MOTION TO STRIKE OPINIONS OF
CISCO’S EXPERT DR. JEFFAY THAT RELY ON INVENTOR
TESTIMONY TO SUPPLY A LIMITATION MISSING FROM WAINNER**

I. INTRODUCTION

Cisco's expert Dr. Jeffay opines that "Wainner" (U.S. Pub. No. 2007/0239891) is anticipatory prior art to the asserted '775 Patent under § 102. Ex. 1 at ¶¶ 1318, 1380. Dr. Jeffay does not offer any obviousness opinions about Wainner.

As part of his anticipation analysis, Dr. Jeffay states that Wainner discloses "three multi-segment pseudowires" and specifically relies on two of these alleged multi-segment pseudowires to opine that Wainner anticipates the "first pseudo-wire" and "second pseudo-wire" limitations of claims 1 and 6 of the '775 Patent. *See, e.g.*, Ex. 1 at ¶¶ 1323, 1384; *see also id.* at ¶¶ 1385, 1389, 1395, 1397.

The Wainner reference itself does not mention any "multi-segment pseudowires" nor does it use any equivalent terminology. *See generally* Ex. 2. Instead, Dr. Jeffay relies on the testimony of one of Wainner's inventors, Mr. Luca Martini, to prove that these multi-segment pseudowires are allegedly present.

Monarch respectfully moves the Court to preclude Dr. Jeffay from relying on the testimony of Mr. Martini as part of his anticipation analysis of Wainner. Dr. Jeffay's reliance on Mr. Martini's testimony is improper because: (1) an expert may not combine multiple references in an anticipation analysis, and (2) Mr. Martini's testimony is inadmissible because it is the uncorroborated testimony of an interested inventor.¹

II. LEGAL STANDARDS

"An 'anticipating' reference must describe all of the elements and limitations of the claim in a single reference and enable one of skill in the field of the invention to make and use the claimed

¹ Moreover, Mr. Martini's testimony was not mentioned or disclosed in Cisco's Invalidity Contentions.

invention.” *Merck & Co. v. Teva Pharm. USA, Inc.*, 347 F.3d 1367, 1372 (Fed. Cir. 2003) (emphasis added). “Although we have permitted the use of additional references to confirm the contents of the allegedly anticipating reference, we have made clear that anticipation does not permit an additional reference to supply a missing claim limitation.” *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1335, 63 USPQ2d 1374 (Fed. Cir. 2002)(citations omitted); *see also Studiengesellschaft Kohle, m.b.H. v. Dart Indus., Inc.*, 726 F.2d 724, 726-27 (Fed. Cir. 1984) (“It is hornbook law that anticipation must be found in a single reference, device, or process. Dart’s reliance on the caveat to that rule permitting the use of additional references to interpret the allegedly anticipating reference is misplaced. ... What Dart asked the trial court to do, and what it would have us do on appeal, is to combine the teachings of the references to build an anticipation. That would be contrary to settled law, and the trial court was correct in refusing to do so.”).

“Testimonial evidence of invalidity must be corroborated.” *Rosco, Inc. v. Mirror Lite Co.*, 120 F. App’x 832, 836 (Fed. Cir. 2005). “The purpose of this corroboration requirement is to prevent fraud, namely to ‘provide [] an additional safeguard against courts being deceived by inventors who may be tempted to mischaracterize the events of the past through their testimony.’” *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1374-75 (Fed. Cir. 2009).

III. ARGUMENT

A. Dr. Jeffay Relies on Mr. Martini’s Testimony as an Additional Reference

Dr. Jeffay opines that “a POSITA would have understood that the P2MP pseudowire in Figure 2 is set up using multiple multi-segment (MS) pseudowires, including (1) a first MS pseudowire connecting the input router PE1 and the output router PE2 and (2) a second MS pseudowire connecting the input router PE1 and the output router PE4.” Ex. 1 at ¶ 1384. It is undisputed that Wainner itself does not mention “multi-segment pseudowires,” “MS pseudowires” or any equivalent term, and Dr. Jeffay cites no examples of this. Rather, Dr. Jeffay justifies his

opinion by saying “one of the inventors of Wainner—Mr. Luca Martini—agreed with my reading of Wainner,” citing Mr. Martini’s deposition testimony. *Id.*

It is well settled that an anticipating reference must (1) describe all of the elements of the claim in a single reference, and (2) enable one of skill in the field of the invention to make and use the claimed invention. *Merck*, 347 F.3d at 1372. It is not proper to combine references in an anticipation analysis. If an invalidity expert needs to use more than one reference to prove anticipation, this implies that either (1) not all elements are disclosed in a single reference, or (2) the reference is not sufficiently enabling.

Applying these principles, the Federal Circuit has affirmed a district court’s exclusion of the testimony of an alleged prior art inventor, because “any information he might have to offer beyond the words of the [prior art reference] would be irrelevant.”

The district court also concluded that [prior artist] Dr. Cha’s testimony should be limited because **any information he might have to offer beyond the words of the Cha PCT application would be irrelevant** to the issue before the jury of ‘whether the Cha [PCT] application was sufficient in itself to have informed a person of ordinary skill in the art in 1992 how to distinguish among HCV genotypes by using probes in the 5’ UTR.’” **As the inventor behind the Cha PCT application, Dr. Cha could have added information that might not have been understood by a person of ordinary skill in the art just from reading the application**, such as the conditions he used for his experiments or explanations for anomalous results. ... Therefore, we affirm the district court’s evidentiary ruling because it was not an abuse of its discretion.

Innogenetics, N.V. v. Abbott Labs., 512 F.3d 1363, 1375 (Fed. Cir. 2008) (emphasis added).

There are only two possibilities. Either Mr. Martini’s testimony does not add anything to Wainner, in which case it is unnecessary and redundant, or Mr. Martini’s testimony does add something to Wainner, in which case it is improper in the context of anticipation. In either case, the Court should exercise its gatekeeping authority to exclude Dr. Jeffay from relying on Mr. Martini’s testimony to support his anticipation analysis.

B. Mr. Martini's Testimony is Inadmissible because it is Uncorroborated

Mr. Martini's testimony is also inadmissible because it is the uncorroborated testimony of an alleged prior art inventor. His deposition was taken in 2021, almost fifteen years after the alleged 2006 priority date of Wainner. In such a situation, there is a significant risk that his testimony will be influenced by factors like hindsight bias, imperfect memory, motivated reasoning, and/or his interest in the case as a former employee of defendant Cisco and a current employee of former defendant Charter.

Corroboration acts as "an additional safeguard against courts being deceived by inventors who may be tempted to mischaracterize the events of the past through their testimony." *Martek*, 579 F.3d at 1374-75; *see also Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996) ("This [corroboration] requirement arose out of a concern that inventors testifying in patent infringement cases would be tempted to remember facts favorable to their case by the lure of protecting their patent or defeating another's patent.").

The corroboration safeguard is especially important here because there is no mention of "multi-segment pseudowires" anywhere in Wainner. Dr. Jeffay does not identify any place where Wainner discloses multi-segment pseudowires, and Cisco's counsel was not able to identify any examples during the parties' meet and confer call. This creates a strong temptation for a prior art inventor, viewing his patent fifteen years later through the lens of hindsight, to back-fill missing claim limitations. A jury is likely to be confused or prejudiced by this uncorroborated, after-the-fact testimony. As an inventor of Wainner, Mr. Martini will likely seem like an authoritative source, and a jury may be tempted to rely on what Mr. Martini says rather than what Wainner actually teaches.

To be clear, Monarch is not attempting to preclude Dr. Jeffay from opining that Wainner itself discloses multi-segment pseudowires (assuming he believes this to be true), but his anticipation

opinions should be grounded in what Wainner itself teaches, not what an interested witness said fifteen years later without corroboration.

IV. CONCLUSION

Monarch respectfully moves the Court to preclude Dr. Jeffay from relying on the testimony of Mr. Martini as part of his anticipation analysis regarding Wainner.

Dated: February 24, 2021

Respectfully submitted,

/s/ Alden G. Harris

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**ATTORNEYS FOR MONARCH
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CERTIFICATE OF SERVICE

The undersigned certifies that on this 24th day of February 2021, the foregoing document was electronically filed with the Clerk of the Court using the CM/ECF system and all counsel of record will receive an electronic copy via the Court's CM/ECF system.

/s/ Alden G. Harris

Alden G. Harris

CERTIFICATE OF SERVICE

The undersigned certifies that the parties met and conferred on February 23, 2021 by teleconference pursuant to Local Rule CV-7(h). The following attorneys for Monarch were present: Alden Harris, Allan Bullwinkel, Steven Shepard, Eric Enger, Wills Collier. The following attorneys for Cisco were present: Michael Rhodes, Tamir Packin, Mike Jones, Raymond Habbaz. The parties reached an impasse because Cisco contends its expert's opinions are admissible under Rule 702. This motion is opposed.

/s/ Alden G. Harris

Alden G. Harris