

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISNEY MEDIA & ENTERTAINMENT DISTRIBUTION LLC,
Petitioner

v.

DIGITAL MEDIA TECHNOLOGY HOLDINGS, LLC,
Patent Owner.

Case No. IPR2024-00736
U.S. Patent No. 7,574,725

**PETITIONER'S MOTION TO
EXCLUDE EXPERT DECLARATIONS
EX-2121 AND EX-2131**

I. INTRODUCTION

Petitioner moves to exclude the Declaration of Harris E. Tulchin (Ex-2131) signed on February 24, 2025, and the Declaration of John Daniels in Support of Response to Petition for *Inter Partes Review* of U.S. Patent No. 7,574,725 (Ex-2121) signed on February 25, 2025, pursuant to 37 C.F.R. § 42.64. Petitioner timely objected to these exhibits on March 6, 2025. Paper 20. These exhibits should be excluded because: (A) Mr. Tulchin and Mr. Daniels are not POSITAs under Patent Owner's proposed definition nor the definition the Board preliminarily adopted in its Institution Decision; (B) non-POSITA "expert" declarations are inadmissible because they fail to meet the requirements of Fed. R. Evid. 702; and (C) even if the declarations were relevant, they pose a substantial risk of confusing and misleading the Board, relative to any alleged probative value they may have, and should be excluded under Fed. R. Evid. 403.

II. ARGUMENT

A. Mr. Tulchin and Mr. Daniels Are Not POSITAs

"The descriptions in patents are not addressed to the public generally, to lawyers or to judges, but, as section 112 says, to those skilled in the art to which the invention pertains or with which it is most nearly connected." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005). In this case, the Board preliminarily determined that a person skilled in the art possesses "a Bachelor of Science degree

in electrical engineering, computer engineering, computer science, or a related field plus one year of experience related to marketing and distribution of multimedia material over a computer network, or the equivalent.” Paper 15 (“Institution Decision”) at 9. While they are both lawyers, neither of Messrs. Tulchin nor Daniels are sufficiently “skilled in the art to which the invention pertains or with which it is most nearly connected.” *Phillip*, 415 F.3d at 1313 (quoting *In re Nelson*, 280 F.2d 172, 181 (C.C.P.A. 1960)).

Mr. Tulchin is not a POSITA. Mr. Tulchin “received a BS in industrial labor relations, ... [his] law degree in 1978[,]” and he has “[no] other advanced degrees” or “professional certifications[.]” Ex-1028 at 10:4-14. When asked whether he had “a degree in electrical engineering, engineering physics, computer engineering, computer science, or a similar field[,]” Mr. Tulchin replied, “Absolutely not.” *Id.* at 10:18-22. Mr. Tulchin concedes “the testimony that [he] offer[s] is based on [his] expertise in business areas, [and] not necessarily technical areas.” *Id.* at 11:23-12:1.

Nor is Mr. Daniels a POSITA. Mr. Daniels contends that he has experience “working in [his] own companies in the research, development and prototyping/commercialization of a number of different technologies, principally including ... digital video file transport, storage and processing.” Ex-2121 ¶ 3. Yet, this experience is notably missing from his resume, *see* Ex-2120, and still would not suffice under Patent Owner’s own proposed level of skill or the level of skill the

Board adopted in its Institution Decision. This is especially so considering Patent Owner's repeated distinction between "marketing and distribution" and mere file transport. *See, e.g.*, Paper 18 at 12, 20-21, 53, 67-68; Paper 28 ("PO Sur-Reply") at 13 (arguing that "bare file transfer is not distribution").

Patent Owner contends that Mr. Daniels "was involved (at the time of the filing of the application which matured into the '725 Patent) in making inventions, that dealt with interactive television, video pause buttons and video file provision over the Internet." PO Sur-Reply at 6. But this is still unresponsive to Petitioner's argument that "neither Mr. Daniels's nor Mr. Tulchin's opinions ... satisfy the *Phillips* standard because neither is a POSITA under [Patent Owner's] proposed level of skill." Paper 27 at 3 n.2. Put simply, Patent Owner has not provided any evidence showing that Mr. Daniels has the minimum required "one year of experience related to marketing and distribution of multimedia material over a computer network, or the equivalent." Institution Decision at 9.

B. Non-POSITA "Expert" Opinions Are Irrelevant

Because Mr. Tulchin and Mr. Daniels fail to qualify as POSITAs, their declarations are irrelevant as a matter of law. "[T]o be qualified to offer expert testimony on issues from the vantage point of an ordinarily skilled artisan in a patent case, an expert must at a minimum possess ordinary skill in the art." *Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n*, 22 F.4th 1369, 1377-78 (Fed. Cir. 2022)

(holding that because an expert witness did “not have ordinary skill in the art[,] ... the ALJ abused his discretion by admitting [the expert's] testimony on any issue that is analyzed through the lens of an ordinarily skilled artisan”); *see Billerud Aktiebolag (Publ) v. Westrock MWV, LLC*, IPR2023-01206, Paper 60 at 10, 61 (PTAB Mar. 12, 2025) (excluding expert testimony because “although [the witness had] a Master's of Science in chemical engineering, he lack[ed] any experience or specialization in paperboard manufacturing” as required by the Board's definition of a POSITA).

To the extent that Mr. Tulchin and Mr. Daniels seek to offer opinions from the vantage point of a *non*-ordinarily skilled artisan, such opinions are inadmissible as lay witness opinion testimony. For example, in *Billerud Aktiebolag (PUBL) v. Westrock MWV, LLC*, IPR2023-01206, Paper 60 at 60-61, the Board held that “[T]echnical analysis of the prior art, as compared with the challenged claims ... [is] not admissible as the opinion testimony of a lay witness,” and violates the requirements of Fed. R. Evid. 702. In *Billerud*, the excluded testimony was offered by “a European Patent Attorney with a Swedish law firm representing Petitioner.” *Id.* The Board excluded the testimony because the lawyer witness “is not a person of ordinary skill in the relevant art.” *Id.* Any opinion regarding claim construction coming from persons who are not skilled in the art will not “help the [Board] to understand the [patent] or to determine a fact in issue[,]” Fed. R. Evid. 702(a), nor are such opinions “the product of reliable principles and methods.” Fed. R. Evid.

702(c). Put simply, Mr. Tulchin's and Mr. Daniels's declarations, from two non-POSITA lawyers, are irrelevant to this case. *See Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 591 (1993). To consider them is to consider the legal equivalent of "nothing more than advocacy from the witness stand."¹ *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1364-65 (Fed. Cir. 2008).

The case for excluding Mr. Tulchin's declaration is even stronger in this case as compared to *Billerud*. In *Billerud*, the Board excluded expert witness testimony despite the witness having the requisite technical degree. *Billerud*, Paper 60 at 61. Here, Mr. Tulchin does not even have the requisite degree. *See supra* Part A. The case for excluding Mr. Daniels's declaration is similarly strong: Mr. Daniels lacks the required practical experience related to marketing and distribution. *See supra*

¹ This is especially true with respect to Mr. Tulchin, who was unable to separate his role as a witness/deponent from his role as advocate during his deposition. *See, e.g.*, Ex-1028 at 29:11-14 (prompting counsel to object on his behalf because Mr. Tulchin "[didn't] like the question").

Part A. This is just like the witness in *Billerud*, who lacked the required practical experience related to paper manufacturing. *See Billerud*, Paper 60 at 61.

C. Notwithstanding a Determination of Relevance, Mr. Tulchin and Mr. Daniels Have Personal Biases that Risk Confusing and Misleading the Board's Claim Interpretations

“The [Board] may exclude relevant evidence if its probative value is substantially outweighed by a danger of ... confusing the issues, [or] misleading the [Board.]” Fed. R. Evid. 403. Mr. Tulchin is personally biased toward Patent Owner with a decades-long business relationship that cannot conceivably allow him to evaluate the '725 Patent in an objective manner. *See* Ex-1028 at 14:23-15:1, 16:7-10 (noting that Mr. Tulchin has made “[h]undreds of thousands of dollars” as the '725 Patent inventor's personal entertainment lawyer over “20 years or more”).

Mr. Tulchin's personal bias is also apparent in that he did not even thoroughly read the patent whose terms on which he purports to be an expert. *See, e.g.,* Ex-1028 at 30:6-12 (“Q: Is there anywhere in the patent that specifically says that the term ‘distribution’ does not include file downloading? A: Well, that's not a matter that I considered when I rendered my opinion, and I'm not a technical expert on patents. So I can't tell you the answer to that question.”); *accord generally* Ex-1028 (containing more than thirty objections to questions regarding the '725 Patent as being “beyond the scope”). One would reasonably expect that an expert in a patent case has, at minimum, thoroughly read the materials on which they are opining. *See*

Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Mr. Tulchin's blinkered and lackluster review of the '725 Patent makes any of his testimony on the patent's terms confusing, misleading, and inadmissible.

Mr. Tulchin's personal bias is further apparent from his results-driven and objectively unreasonable "interpretations" of claim terms. For example, the '725 Patent explicitly states that "[t]he distribution of the multimedia includes downloading digital material." Ex-1028 at 30:24-31:1. But in response to the question of whether "the patent describes that distribution includes downloading digital material[,]" Mr. Tulchin stated that he "[didn't] read it that way," Ex-1028 at 31:6-10. Evidently, Mr. Tulchin disputes not just the meaning, but *the existence* of the plain text words in the patent. This serves as just one example that Mr. Tulchin was not hired to give his objective opinions on the '725 Patent, but to retroactively rewrite it to advance Patent Owner's business goals. Mr. Tulchin's testimony already begins with little to no probative value. *See supra* Part B. This, combined with his personal biases, non-technical background, and inadequate review of the patent, creates a substantial danger of confusing and misleading the Board's claim interpretations. The Board should therefore exercise its discretion to exclude Mr. Tulchin's declaration under Rule 403.

Similarly, Mr. Daniels is personally biased toward Patent Owner. Mr. Daniels admitted to a decades-long personal relationship with Patent Owner's counsel—the

same counsel that prosecuted the '725 Patent—and cannot conceivably evaluate the '725 Patent in an objective manner. Mr. Daniels referred to Patent Owner's counsel, Mr. Handal, as his “first mentor” and noted that they “grew old together and stayed in contact.” Ex-1023 at 101:6-16. Beyond that, Mr. Daniels's testimony also comes from the standpoint of advocacy rather than objectivity. Mr. Daniels testified that in preparing for his deposition, he was “putting [his] mindset back into a patent prosecuting attorney.” *Id.* at 103:18-20. That is, a mindset formed and mentored by the '725 Patent's prosecuting attorney, Mr. Handal, who gave Mr. Daniels his first job out of law school, and personally prosecuted the patent at issue in this case. *Id.* at 100:13-101:10.

Moreover, Mr. Daniels's personal bias is also apparent from his, at best, superficial review of the key technical issues. He did not review the Petition at issue in this proceeding, nor did he thoroughly review the supporting declaration of Dr. Houh. *Id.* at 104:7-15 (“I didn't really review it too closely, the declaration of Dr. Houh I don't remember going through ... the pleading or whatever that document is.”). It is unclear how Mr. Daniels could properly understand the specific grounds challenging the patent and supporting evidence without thoroughly reviewing Petitioner's positions. This, along with Mr. Daniels's personal biases, create a substantial danger of confusing and misleading the Board's analysis. The

Board should therefore exercise its discretion to exclude Mr. Daniels's declaration under Rule 403.

III. CONCLUSION

For the reasons given in this Motion, Petitioner requests that the Board exclude Exhibits 2121 and 2131 from consideration.

Dated: June 18, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. §42.6(e)(1))

The undersigned certifies pursuant to 37 C.F.R. § 42.6(e) that on June 18, 2025, a true and correct copy of PETITIONER'S MOTION TO EXCLUDE EXPERT DECLARATIONS, together with all exhibits filed therewith was served in its entirety by filing these documents through the PTAB P-TACTS System, as well as by email, on the counsel of record for the Patent Owner:

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