

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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DISNEY MEDIA & ENTERTAINMENT DISTRIBUTION LLC,  
Petitioner,

v.

DIGITAL MEDIA TECHNOLOGY HOLDINGS, LLC,  
Patent Owner.

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

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**PATENT OWNER'S OPPOSITION TO  
PETITIONER'S MOTION TO  
EXCLUDE EXPERT DECLARATIONS**

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## I. THE PRESENT MOTION

The declarations of expert witnesses Daniels and Tulchin contain a number of straightforward statements respecting issues relating to patentability, and the usage of terms in the movie business. Daniels worked in the field at the time of the filing of the '725 Patent and provides the Board with reliable, germane evidence. Those terms are included in the patent simply because the invention is applied in the movie industry, and using the vocabulary of that industry to discuss the background of the invention and its application in the field was natural and proper. Tulchin, as a movie industry executive at the time of the filing is particularly well suited to testify on this subject.

Petitioner's objections all essentially relate to credibility and weight. Thus, the present motion is thus not well taken. Accusations that their testimony is misleading or confusing are made without pointing to a single word in the record supporting the contention. Finally, Petitioner tries to make some argument that the witnesses are biased, lamely pointing to previous relationships with the undersigned counsel and a company related to Patent Owner, but those relationships ended many years ago.

## II. BACKGROUND

Petitioner has moved to exclude the declarations of Tulchin and Daniels on the ground that the testimony, for unstated and unexplained reasons, will confuse and/or mislead the Board. None of the testimony at issue has been discussed, or, for that matter even identified by Petitioner.

Similarly, Petitioner's arguments are not specifically applied to the witnesses. Rather, Petitioner's only ground appears to be general contentions respecting credibility and prejudice, in that both witnesses, in addition to their non-legal work experience related to the issues in this lawsuit, have worked in the legal field – Mr. Daniels as a law clerk for the undersigned over thirty years ago (Exhibit 1023, page 100, line 24), and Mr. Tulchin over a eight years ago as counsel to a company related to Patent Owner. The Petitioner's position thus ignores the witnesses' work experience outside the legal field.

### (a) Credibility Is Not at Issue on a Motion to Exclude

What the Petitioner has essentially focused on, credibility, goes to the weight to be given to the evidence, not its admissibility. A motion to exclude is not properly used to challenge the sufficiency of the evidence or as a vehicle for addressing the weight to be given to evidence. PTAB Consolidated Trial Practice Guide, page 79. Thus, the present motion should be denied.

### (b) Fundamental Differences between the Two Declarations

At the outset, it is noted that the declarations of Tulchin and Daniels, despite their broad stroke unitary treatment in the motion, are fundamentally different. Daniels, both an experienced tech company executive and an inventor of video file related technology (which technology was sold to a major company (Exhibit 1023, page 98, line 16 to page 99, line 13)), testified as a POSITA on questions relating to patentability, including the vague and generally inadequate alleged disclosure of the Kosten magazine article. In contrast, Tulchin, a production company executive, testified to the meaning of various terms in the movie business. As is apparent from his resume, he is certainly well-qualified to speak about the meaning, in the movie business, of such terms of exhibition, distribution and so forth.

While Petitioner, in conclusory fashion, alleges that there is a substantial risk of confusing and misleading the Board, no factual basis or even bare reasoning is proposed. Accordingly, these contentions, being conclusory, unsupported and unargued, are properly ignored.

(c) Daniels Declaration

In Exhibit 2121, Mr. Daniels notes his degree in engineering physics (§2), work experience in R&D, and prototyping/commercialization, including digital video file transport, storage and processing (§3). As noted in his resume (Exhibit 2120), Mr. Daniels worked in various technologies, including work developing prototypes between 1998 and 2001, and between 2001 and 2010 inventing

printable LED systems. In addition, he has been involved as CEO in two medical device startups since 2017, in which positions he continues through the present.

His work has included being actively involved, in 1998 (Exhibit 23, page 99, line 12; record corrected at page 109), in the invention of video pausing technology (which involved the marketing and distribution of media over a communications network) and was covered by a suite of patents (Exhibit 1023, page 99, lines 5-25 and page 102, lines 1-7) which related to interactive television and a video pause button. This is particularly relevant as the work was done at about the time of the invention of the '725 Patent (Exhibit 1023, page 98, line 16 through page 99, line 25). These inventions were sold to a major player (page 98, line 16-page 99, line 13). That experience, involving video pause, and video file transport is exactly on point for the technology involved and the opinions which Mr. Daniels expressed, and stands in stark contrast to Dr. Houh's generalized (and essentially unrelated) experience, with the only commonality being the use of the Internet.

Thus, Mr. Daniels' experience makes his testimony respecting patentability issues highly credible. In his declaration, Mr. Daniels makes a number of factual statements respecting the art cited by the Petitioner, noting the incomplete and contradictory nature of the Kosten magazine article, and gives his opinion respecting the Grounds alleged by Petitioner. Petitioner has not explained why it is contending that Daniels' testimony is confusing or misleading.

Indeed, during his deposition, Mr. Daniels was challenged by Petitioner who failed to develop any facts as to why the testimony was misleading, confusing or otherwise inadmissible.

(d) Tulchin Declaration

In addition to the technological description of the invention, the ‘725 Patent uses a number of movie and entertainment industry business terms. Petitioner attempts, for example, to redefine the term “distribution” (a term that relates to the movement of celluloid prints, marketing materials, and other activities) as electronic file transfer. In addition to acting as legal counsel to major studios, Mr. Tulchin is the chairman of Tulchin entertainment where he has produced more than twenty movies (Exhibit 2131, ¶4. He is thus particularly well-suited to testify respecting the meaning of those terms.

Moreover, Petitioner’s attempt to use Tulchin’s additional experience working as an attorney is nonsensical. His additional experience does not affect his competence and credibility to testify respecting the movie industry.

III. DISCUSSION

(a) Neither Daniels nor Tulchin Are Lay Witnesses in Fields of Their Testimony

Citing *Billerud Aktiebolag (PUBL) v. Westrock MWV, LLC*, IPR2023-01206, Paper 60 at 60-61, a case involving patent attorney testimony, Petitioner

challenges the testimony of Daniels and Tulchin arguing that technical analysis of the prior art, as compared with the challenged claims is inadmissible as lay opinion testimony. Presumably, referring to their competence in the legal field, Petitioner characterizes their testimony as nothing more than “advocacy from the witness stand.”

However, Petitioner fails to recognize that, far from being a disqualifier, knowledge of patent law is a prerequisite for giving an opinion relating to patentability.

(b) Even If an Attorney, a Witness Can Give Testimony If Qualified As an Expert

Moreover, *Billerud* is not on point. The witness was excluded in *Billerud*, not because he was an attorney, but because the testimony related to whether the “Papermaking and Gratton [references] disclose products that fall below the Y<sub>2</sub> curve in claim 1 and Figure 8 of the ’142 Patent,” and the witness “lack[ed] any experience or specialization in paperboard manufacturing.” This stands in stark contrast to Mr. Daniels, who, in addition to having a degree in engineering physics, has numerous patents dealing with digital video file transport, storage and transport of media over a communications network, interactive television and video pause technology sold to a major player (page 98, line 16-page 99, line 13).

As stated by the Federal Circuit in *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1362 (Fed. Cir. 2008), the rule against admitting the

testimony of a patent lawyer on “technical issues [, validity and infringement,]” does not apply where the attorney is “also a qualified technical expert.” Brackets in original. Certainly, Mr. Daniels is, by virtue of education, experience and achievement, a qualified technical expert. Indeed, even after over three hours of examination, Petitioner can make no substantive argument to the contrary, questioning only the level of detail in his resume and other minutiae.

(c) Daniels Has Extensive and Successful Track Record as an Inventor and CEO

Petitioner asserts, without explanation or reference to any facts, that Mr. Daniels lacks the required practical experience related to marketing and distribution. But the facts show that he does have substantial practical expertise relevant to marketing and distribution. Over the years he has functioned as a CEO in tech companies. In addition, on the technology side, he has worked on systems involving video file marketing and distribution. Page 99, line 6-25; page 101, lines 1-21; page 102, lines 1-13. Certainly, as the CEO of a tech company dealing with an invention centering on the distribution of multimedia material over a communication network, he would gain a good understanding of marketing and distribution in that industry.

Similarly, Mr. Tulchin, who has produced over 20 movies through his production company is certainly competent to testify respecting the meaning of

terms used in the entertainment and movie business, including exhibition, distribution, broadcast, broadcast exhibitor, marketing, sales, etc.

(d) No Argument Why Tulchin Testimony Is Misleading or Confusing

Once again, Petitioner fails to make any substantive criticism as toward why any of Tulchin's testimony is misleading, confusing or otherwise inadmissible. In a vein similar to its criticism of Mr. Daniels, Petitioner seems to question the competency of Mr. Tulchin in the movie and entertainment business, but points to nothing more than his having worked as a lawyer and his suggestion of an objection to a question during his examination.

(e) Daniels Is a POSITA and Tulchin's Testimony Is Reliable and Helpful

In short, it is clear that Mr. Daniels is a POSITA, by any definition, and his detailed testimony respecting, *inter alia*, the general inadequacy of the Kosten reference (Exhibit 2121, ¶7), not to mention its internal inconsistencies and indefiniteness (*id.*, ¶ 11), and missing elements in Garfinkle (*id.*, ¶ 9) is admissible. That detail easily satisfies the standard in *Daubert*, 509 U.S. at 592 n. 10, that the expert explain how and why he reached the conclusion being proffered and constitutes a basis more than a subjective belief.

(f) Flexible Admissibility Standard

Moreover, there are no rigid rules defining admissibility of expert testimony in patent cases. For example, in *EMC Corp v. Pure Storage, Inc.*, 154 F.Supp.3d

81 (D. Del 2016), expert testimony was allowed even without the specific citation of evidence in support of the opinion, because the expert adequately explained his reasoning by reference to the function/way/result test.

Likewise, Mr. Tulchin’s testimony respecting those non-technical aspects of the disclosure of the invention which relate to the movie business is also clearly admissible. Being an opinion of the head of a movie production company, Tulchin’s testimony respecting the meaning of terms in the industry certainly meets Rule 702's "helpfulness" standard. Moreover, no reasoning is argued respecting the unsupported contention that Tulchin’s testimony is misleading and confusing.

(g) Tulchin’s Testimony Not on Issue Analyzed through Lens of Skilled Artisan

Petitioner’s attempt to discount the testimony of Mr. Tulchin is fundamentally flawed. While Petitioner relies upon *Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1377-78 (Fed. Cir. 2022) for the proposition that “to 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,” that is off point here.

(h) Tulchin Testimony Evidences Business Term Meanings Familiar to POSITA

Tulchin’s testimony relates to issues other than those “analyzed through the lens of an ordinarily skilled artisan.” Tulchin’s testimony was strictly limited to the

meaning of terms used in the movie industry. While Petitioner did spend significant time examining Mr. Tulchin on technical issues, the same was beyond the scope of his declaration. That declaration does not relate to any analysis through the lens of an ordinary skilled artisan.

Moreover, Tulchin, as a movie industry executive and producer, is exactly the person that a POSITA would communicate with when discussing issues relating to exhibition, distribution, marketing, broadcasting, advertising, and so forth. Accordingly, his understanding of various movie industry terms is reliable, relevant, and, most importantly, helpful to the Board.

Thus, Tulchin's testimony is not even remotely misleading or confusing. Petitioner's accusations to the contrary are bare, unsupported and unreasoned, and are properly dismissed out of hand.

(i) Tulchin Studied All Aspects of '725 Patent Relevant to His Opinion

Petitioner also tries to discount Tulchin's testimony arguing that he did not thoroughly read the '725 Patent. However, Tulchin was clear that his testimony was related to the business aspects of the Patent, and Petitioner can point to no fault relating to Tulchin's understanding of the technology, even though it was beyond the scope of the Tulchin Declaration. In any case, no rationale is offered as toward why Tulchin's testimony would confuse or mislead the Board.

#### IV. CONCLUSION

As is apparent from the above, Petitioner has shown no basis to even suspect that the subject testimony is confusing and/or misleading. Likewise, it is clearly relevant to the issues at hand. Accusations of biased witnesses make no sense where they are limited to an employment relationship with the undersigned counsel which terminated 35 years ago, and an attorney-client relationship with a company related to Patent Owner which ended over eight years ago.

Moreover, Petitioner has not addressed any of the testimony involved or shown why his arguments are supported by the nature or content of that testimony.

Accordingly, it is proper for the Board to consider the declarations of Exhibits 2121 and 2131, as well as the deposition testimony of Mr. Daniels and Mr. Tulchin given during their depositions in this matter.

Dated: June 25, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Opposition to Petitioner's Motion to Exclude Expert Declarations has been served via Electronic Mail on Petitioner's counsel of record as follows:

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Dated: June 25, 2025

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