

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 REPLY TO
PO'S OPPOSITION TO
MOTION TO EXCLUDE**

I. INTRODUCTION

Mr. Tulchin's and Mr. Daniels's non-POSITA testimony is irrelevant and runs a substantial risk of misleading or otherwise prejudicing the Board's claim constructions. PO's contrary contentions amount to a mischaracterization of Petitioner's arguments and a misapplication of the law. The Board should exclude Exhibits 2121 and 2131 from consideration. *See* Paper 33 ("Motion").

II. MR. TULCHIN AND MR. DANIELS ARE NOT POSITAS

This is not a close call. Both PO, in its opposition, and Mr. Tulchin himself, in his deposition, concede that Mr. Tulchin is not a POSITA. *See* Paper 34 ("Opp.") at 9-10 (conceding that Mr. Tulchin's "declaration does not relate to any analysis through the lens of an ordinary skilled artisan"); Ex-1028 at 11:23-12:1 (conceding that "the testimony that [Mr. Tulchin] offer[s] is based on [his] expertise in business areas, [and] not necessarily technical areas").

Regarding Mr. Daniels, *Billerud Aktiebolag (PUBL) v. Westrock MWV, LLC*, IPR2023-01206, Paper 60 (PTAB Mar. 12, 2025), resolves the issue. In that case, the Board excluded expert testimony because "[a]lthough [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. *Id.* at 61. In response, PO mischaracterizes Petitioner's Motion as arguing that Mr. Daniels is not a POSITA because he is an attorney. But that is not

Petitioner's argument. Just as in *Billerud*, where the attorney lacked "experience or specialization," Mr. Daniels is not a POSITA because he does not have "one year of experience related to marketing and distribution of multimedia material over a computer network." Paper 18 ("POR") at 11.

PO argues that Mr. Daniels "has numerous patents dealing with digital video file transport, storage and transport of media over a communications network." Opp. at 6. Yet other than this bare assertion, PO produces no such documentary evidence. For example, PO discusses Mr. Daniel's work on patents related to "video pause button[s,]" Opp. at 4, but does not provide any evidence of what this work is or how it satisfies the experience required of a POSITA. Mr. Daniels himself acknowledged that this experience was not part of his resume because "[i]t was just too distant and not relevant to this resum[e]" that he submitted as Ex-2120 in this proceeding. Ex-1023 at 102:8-19; *see* Ex-2120. Regardless, even accepting these general points as true (despite that they are unsupported by the record), the best PO can come up with are high-level assertions related to Mr. Daniel's "Successful Track Record as an Inventor and CEO." Opp. at 7. Respectfully, this assertion simply does not demonstrate the particular level of skill that all parties seem to agree is required for these patents.

III. MR. TULCHIN'S AND MR. DANIELS'S NON-POSITA "EXPERT" OPINIONS ARE IRRELEVANT

PO asks the Board to ignore binding Federal Circuit precedent,¹ asserting, without any explanation, that it "is off point here." *See* Opp. at 3, 9 (criticizing *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 [a POSITA]")). Moreover, PO's assertion that "helpful" testimony must be admissible under Rule 702 is not the law. Fed. R. Evid. 702 (reciting a four-part admissibility test for testimony from a witness with "scientific, technical, or other specialized knowledge"). PO is wrong.

PO tries to get around *Kyocera* by saying that "[Mr.] Tulchin's testimony relates to issues other than those 'analyzed through the lens of an ordinarily skilled artisan.'" Opp. at 9. But PO admits that it is offering "[Mr.] Tulchin's testimony respecting the meaning of terms in the industry[.]" Opp. at 9. This plainly contradicts *Phillips*, which says "[i]t is the person of ordinary skill in the field of the invention

¹ Instead, PO relies on a non-binding decision from the District of Delaware, which is entirely distinguishable. In that case, the Expert testimony was sought to be excluded because it was conclusory, not for failure to meet the definition of a POSITA. *See* Motions to Exclude Expert Opinions and Testimony at 1, *EMC Corp. v. Pure Storage, Inc.*, 154 F. Supp. 3d 81 (D. Del. 2016) (No. 13-1985), Dkt. No. 204 (moving to exclude opinions by "technical expert" "stated in [allegedly] conclusory terms").

through whose eyes the claims are construed.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005). Mr. Tulchin’s personal and colloquial uses of movie industry terms and Mr. Daniels’s advocacy² are simply not valid subjects for purported expert testimony in this case. And PO’s attempts to imbue patent terms with those meanings is contrary to controlling Federal Circuit law and highly prejudicial. *See id.* (“The descriptions in patents are not addressed to the public generally ... [but] to those skilled in the art to which the invention pertains[.]”). Because Mr. Tulchin and Mr. Daniels are not POSITAs, *Phillips* and *Kyocera* render their testimony irrelevant as a matter of law.

IV. MR. TULCHIN’S AND MR. DANIELS’S TESTIMONY IS MISLEADING

Contrary to PO’s assertion that the misleading nature of Mr. Tulchin’s and Mr. Daniels’s testimony is unfounded, Petitioner’s extensive review of the record in its Motion is fatal to the admissibility of PO’s declarations. Beginning with Mr. Tulchin, PO concedes that Mr. Tulchin’s “understanding of the technology” in the patent is “beyond the scope” of his expertise, while simultaneously trying to admit his declaration as evidence for the Board to use to better understand the technology. Opp. at 10. That defies common sense. While PO implies its declarants’ personal

² *See* Motion at 8 (explaining how Mr. Daniels testified that “in preparing for his deposition, he was ‘putting [his] mindset back into a patent prosecuting attorney’”—that is, the mindset of an advocate rather than an objective expert).

biases have faded, the record says otherwise. For example, Mr. Tulchin appeared to be acting as an attorney for PO³ while he was being deposed as a witness, calling for specific objections to questions instead of testifying in response. Motion at 5 n.1. And when he did answer, Mr. Tulchin provided testimony contradicting the literal words of the patent itself, even though there was no plausible explanation for it. *See* Motion at 7.

Regarding Mr. Daniels, PO has no response to Mr. Daniels's numerous personal biases.⁴ PO fails to address Mr. Daniels having testified from the perspective of an advocate rather than an objective expert. *Supra* note 4. PO fails to address that Mr. Handal personally mentored Mr. Daniels and gave him his first job out of law school. Motion at 8. And PO fails to address that Mr. Daniels performed a "superficial review of the key technical issues," "did not review the Petition at issue in this proceeding," and did not "thoroughly review the supporting declaration of Dr. Houh." *Id.* An expert without this necessary knowledge is no expert at all.

V. CONCLUSION

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

³ Mr. Tulchin acted as counsel for PO for two decades and received hundreds of thousands of dollars for his services during that time.

⁴ PO's sweeping contention that all past relationships have ended contradicts Mr. Daniels's own testimony. *See* Ex-1023 at 101:6-16 (noting that Mr. Handal and Mr. Tulchin "grew old together and stayed in contact").

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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 July 2, 2025, a true and correct copy of PETITIONER'S REPLY TO PO'S OPPOSITION TO MOTION TO EXCLUDE, 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 PO:

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