

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

FUJIFILM CORPORATION,
Plaintiff,
v.
MOTOROLA MOBILITY LLC,
Defendant.

Case No. 12-cv-03587-WHO

**ORDER REGARDING PLAINTIFF’S
MOTION FOR PARTIAL SUMMARY
JUDGMENT; DEFENDANT’S MOTION
TO STRIKE**

Re: Dkt. Nos. 190, 195

INTRODUCTION

This is a patent infringement action. Plaintiff Fujifilm Corporation (“Fujifilm”) accuses defendant Motorola Mobility LLC (“Motorola”) of infringing claims 1, 2, 7, and 11 of U.S. Patent No. 6,144,763 (the ’763 patent); claim 1 of U.S. Patent No. 8,306,285 (the ’285 patent); claim 11 of U.S. Patent No. 7,327,886 (the ’886 patent); and claims 1, 13, and 35 of U.S. Patent No. 6,915,119 (the ’119 patent). Each of the asserted patents concerns technology used in digital cameras and cellular telephones. Trial is set for April 20, 2015.

This order addresses two motions: Fujifilm’s motion for partial summary judgment on the date of the hypothetical negotiation to be used for determining reasonably royalty damages, and Motorola’s motion to strike portions of Fujifilm’s expert’s testimony on infringement and validity of the ’119 patent. While I agree with Fujifilm’s argument that the hypothetical negotiation date must be based on the date when infringement by the accused products began, there is a genuine dispute of material fact over when that occurred. Fujifilm’s motion for partial summary judgment is DENIED. Motorola’s most recent attempt to resolve factual disputes over the plain and ordinary meaning of claim terms before trial, through its motion to strike, is DENIED. Its other requests to strike are GRANTED IN PART and DENIED IN PART.

United States District Court
Northern District of California

BACKGROUND

1
2 Fujifilm filed its initial complaint on July 10, 2012 and a first amended complaint on
3 November 19, 2012. Dkt. Nos. 1, 16. Motorola served its initial invalidity contentions on April
4 19, 2013 and its supplemental invalidity contentions on February 7, 2014. The supplemental
5 invalidity contentions assert that the '119 patent is invalid, among other reasons, because the
6 claimed subject matter was invented by "Nokia, including engineers at Nokia," during a period of
7 collaboration between Fujifilm and Nokia in 1999 and 2000. Dkt. No. 96 at 5.

8 In November 2014, the parties submitted a joint statement regarding Fujifilm's request to
9 designate a substitute damages expert due to concerns regarding the credibility of its original
10 damages expert, Dr. Gordon Rausser, that had emerged in an unrelated case pending in another
11 district. Dkt. No. 145. I granted the request subject to certain limitations on the substitute expert's
12 testimony and instructed the parties to meet and confer on an appropriate schedule to
13 accommodate the substitution without requiring modification of the schedule for dispositive
14 motions or trial. Dkt. No. 147. The parties stipulated to a separate round of partial summary
15 judgment motions focused exclusively on damages, with the following relevant deadlines:
16 (1) motions due on or before February 20, 2015; (2) oppositions due on or before February 27,
17 2015; and (3) replies due on or before March 6, 2015. Dkt. No. 150.

18 In December 2014, Motorola moved for summary judgment of noninfringement on each of
19 the patents in suit, and Fujifilm moved to strike various portions of two expert reports on
20 invalidity submitted by Motorola. Dkt. Nos. 153, 160. I granted in part and denied in part both
21 motions. Dkt. No. 196. Relevant here, I denied Motorola's motion for summary judgment as to
22 each of the patents in suit except U.S. Patent No. 5,734,427 (the '427 patent) (thereby removing
23 the '427 patent from the case) and granted Fujifilm's motion to strike testimony by Fujifilm's
24 expert, Dr. Bims, regarding the Fujifilm-Nokia collaboration. *See id.*

25 Per the stipulation, Fujifilm filed its motion for partial summary judgment on damages on
26 February 20, 2015. Dkt. No. 195. Motorola did not move for partial summary judgment on any
27 damages issues. I heard argument from the parties on Fujifilm's motion for partial summary
28 judgment and Motorola's motion to strike at the pretrial conference on March 12, 2015.

LEGAL STANDARD**I. SUMMARY JUDGMENT**

A party is entitled to summary judgment where it “shows that there is no genuine dispute as to any material fact and [it] is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). A dispute is genuine if it could reasonably be resolved in favor of the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is material where it could affect the outcome of the case. *Id.*

The moving party has the initial burden of informing the court of the basis for its motion and identifying those portions of the record that demonstrate the absence of a genuine dispute of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). Once the movant has made this showing, the burden shifts to the nonmoving party to identify specific evidence showing that a material factual issue remains for trial. *Id.* The nonmoving party may not rest on mere allegations or denials from its pleadings, but must “cit[e] to particular parts of materials in the record” demonstrating the presence of a material factual dispute. Fed. R. Civ. P. 56(c)(1)(A); *see also Liberty Lobby*, 477 U.S. at 248. The nonmoving party need not show that the issue will be conclusively resolved in its favor. *Liberty Lobby*, 477 U.S. at 248-49. All that is required is the identification of sufficient evidence to create a genuine dispute of material fact, thereby “requir[ing] a jury or judge to resolve the parties’ differing versions of the truth at trial.” *Id.* (internal quotation marks omitted). If the nonmoving party cannot produce such evidence, the movant “is entitled to . . . judgment as a matter of law because the nonmoving party has failed to make a sufficient showing on an essential element of her case.” *Celotex*, 477 U.S. at 323 (internal quotation marks omitted).

On summary judgment, the court draws all reasonable factual inferences in favor of the nonmoving party. *Liberty Lobby*, 477 U.S. at 255. “Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge.” *Id.* However, conclusory and speculative testimony does not raise a genuine factual dispute and is insufficient to defeat summary judgment. *See Thornhill Publ’g Co., Inc. v. GTE Corp.*, 594 F.2d 730, 738-39 (9th Cir. 1979).

1 **II. MOTION TO STRIKE**

2 Federal Rule of Evidence 702 allows a qualified expert to testify “in the form of an opinion
3 or otherwise” where:

4 (a) the expert’s scientific, technical, or other specialized knowledge
5 will help the trier of fact to understand the evidence or to determine
a fact in issue;

6 (b) the testimony is based on sufficient facts or data;

7 (c) the testimony is the product of reliable principles and methods;
8 and

9 (d) the expert has reliably applied the principles and methods to the
facts of the case.

10 Fed. R. Evid. 702.

11 Expert testimony is admissible under Rule 702 “if it is both relevant and reliable.” *Cooper*
12 *v. Brown*, 510 F.3d 870, 942 (9th Cir. 2007). “[R]elevance means that the evidence will assist the
13 trier of fact to understand or determine a fact in issue.” *Id.* Under the reliability requirement,
14 expert testimony must “relate to scientific, technical, or other specialized knowledge, which does
15 not include unsubstantiated speculation and subjective beliefs.” *Id.* “Importantly, there must be a
16 recognized body of knowledge, learning, or expertise upon which the witness relies. Where there
17 is no field of expertise, nobody will qualify as an expert witness on the subject.” *Perez v. Seafood*
18 *Peddler of San Rafael, Inc.*, No. 12–cv–00116–WHO, 2014 WL 2810144, at *2 (N.D. Cal. June
19 20, 2014) (internal quotation marks omitted). The burden is on the proponent of the expert
20 testimony to show, by a preponderance of the evidence, that the admissibility requirements are
21 satisfied. Fed. R. Evid. 702 advisory committee’s note.

22 **DISCUSSION**

23 **I. FUJIFILM’S MOTION FOR PARTIAL SUMMARY JUDGMENT**

24 Fujifilm’s motion for partial summary judgment concerns a single issue: the date of the
25 hypothetical negotiation to be used for determining reasonable royalty damages. A patentee who
26 prevails in an infringement action is entitled to “damages adequate to compensate for the
27 infringement, but in no event less than a reasonable royalty for the use made of the invention by
28 the infringer.” 35 U.S.C. § 284. Where an established royalty does not exist, a court may

1 determine a reasonable royalty based on a hypothetical negotiation between the parties. *Applied*
2 *Med. Res. Corp. v. U.S. Surgical Corp.*, 435 F.3d 1356, 1361 (Fed. Cir. 2006). The hypothetical
3 negotiation is a legal construct that “attempts to ascertain the royalty upon which the parties
4 would have agreed had they successfully negotiated an agreement just before infringement
5 began.” *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1324 (Fed. Cir. 2009). In
6 other words, the “basic question” answered by a hypothetical negotiation is: “if, on the eve of
7 infringement, a willing licensor and licensee had entered into an agreement instead of allowing
8 infringement of the patent to take place, what would that agreement be?” *LaserDynamics, Inc. v.*
9 *Quanta Computer, Inc.*, 694 F.3d 51, 76 (Fed. Cir. 2012). “The correct determination of the
10 hypothetical negotiation date is essential for properly assessing damages.” *Id.* at 75 (internal
11 quotation marks and modifications omitted). “In general, the date of the hypothetical negotiation
12 is the date that the infringement began.” *Id.*

13 Fujifilm seeks an order (1) establishing that the hypothetical negotiation date for the
14 purposes of this litigation is June 2010, and (2) excluding from trial testimony inconsistent with
15 this hypothetical negotiation date. Reply 1. In its opening brief, Fujifilm argued that the
16 hypothetical negotiation date should be December 2009. *Id.* That date was based on the first sales
17 in the United States of the Motorola Brute i680, which Fujifilm accused of infringing the ’427
18 patent. Shortly after Fujifilm filed its opening brief, however, I issued the order granting Motorola
19 summary judgment of noninfringement of the ’427 patent. Dkt. No. 196. In response to that
20 order, Fujifilm changed course and now argues for the June 2010 hypothetical negotiation date.
21 Reply 1. That date is based on the first sales in the United States of the Motorola Droid X, which
22 Fujifilm asserts is now the first accused product to have been sold in the country. *See* Macartney
23 Decl. ¶ 8 (Dkt. No. 238-1).

24 Motorola contends that Fujifilm’s motion for partial summary judgment should be denied
25 because it is “contrary to fact.” Opp. 1. It points to the opinion of its damages expert, Dr. Nisha
26 Mody, who asserts that the hypothetical negotiation date should be in 2007, when Motorola first
27 began to sell a product (the Motorola Razr V8) which incorporated features accused of infringing
28 one of the asserted patents (specifically, the ’119 patent). *Id.* at 2; Mody Rebuttal Rpt. ¶¶ 115, 116

1 n.211 (Dkt. No. 231-2). The Razr V8 is not one of the accused products in this case.
2 Nevertheless, Motorola contends that in light of Mody's opinion, Fujifilm's motion "at most . . .
3 raises a genuine issue of material fact as to whether the Razr V8 incorporated features accused of
4 infringing the '119 patent." Opp. 2.

5 Fujifilm responds that Mody's opinion is based on the erroneous proposition that the
6 hypothetical negotiation date should be based on the date on which any infringing activity by the
7 defendant began, irrespective of whether that activity is accused of infringement. Reply 1-3. It
8 asserts that under Federal Circuit precedent, the hypothetical negotiation in this case should be set
9 just before the start of infringement by the Motorola products actually accused of infringement,
10 not just before the start of infringement by any Motorola product that incorporates allegedly
11 infringing features.

12 I agree with Fujifilm. The Federal Circuit, as well as courts in this and other districts, have
13 repeatedly and consistently based the hypothetical negotiation date on the start of the activity
14 actually accused of infringement. *See, e.g., LaserDynamics*, 694 F.3d at 75-76 (determining
15 hypothetical negotiation date based on the first sales of the "accused laptop computers" in the
16 United States); *Integra Lifesciences I, Ltd. v. Merck KGaA*, 331 F.3d 860, 870 (Fed. Cir. 2003)
17 *vacated on other grounds*, 545 U.S. 193 (2005) (finding that the record did not clearly indicate
18 whether the hypothetical negotiation date should be in 1994 or 1995 where it was "not evident
19 whether the 1994 [experiment accused of infringement] was considered by the jury for
20 infringement purposes"); *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 869 (Fed. Cir. 1993)
21 ("Wang argues that negotiations should have been hypothesized at the start of infringement, i.e.,
22 when both a patent had issued and [the] accused products were sold. We agree."); *Oracle Am.,*
23 *Inc. v. Google Inc.*, 798 F. Supp. 2d 1111, 1116 (N.D. Cal. 2011) (excluding expert testimony
24 concerning hypothetical negotiation date which failed to consider when the "accused product
25 [was] developed and tested . . . in the United States") (emphasis omitted); *Conceptus, Inc. v.*
26 *Hologic, Inc.*, 771 F. Supp. 2d 1164, 1179-80 (N.D. Cal. 2010) (setting hypothetical negotiation
27 date according to date that accused product was first offered for sale in the United States); *see also*
28 *Boston Scientific Corp. v. Cordis Corp.*, 777 F. Supp. 2d 783, 791-93 (D. Del. 2011); *Henrob Ltd.*

1 v. *Bollhoff Systemtechnik GmbH & Co.*, No. 05-cv-73214, 2009 WL 3199855, at *1-2 (E.D.
2 Mich. Sept. 29, 2009). Motorola does not provide a single case in which the court based the
3 hypothetical negotiation date on the start of activity not specifically accused of infringing the
4 asserted claims, and I have not found one either.

5 Motorola's reliance on *Applied Medical Resources Corp. v. U.S. Surgical Corp.*, 435 F.3d
6 1356 (Fed. Cir. 2006), is unconvincing. In that case, the Federal Circuit rejected the defendant's
7 argument that the district court erred in refusing to give collateral estoppel effect to a jury's
8 reasonable royalty determination in an earlier case involving infringement of the same patents by
9 similar accused products. *Id.* at 1360-62. The Federal Circuit reasoned that "the issue of
10 reasonable royalty damages in [the first case] is not identical to the issue of reasonable royalty
11 damages in [the second case] because the infringements requiring compensation began at separate
12 and distinct times . . . Because [the products accused of infringement in the first and second cases]
13 caused two separate infringements, and each infringement commenced on a different date, it
14 follows that the reasonable royalties may well be different from each other." *Id.* at 1361-62. The
15 court also noted, however, that "there may be instances, which we do not address here, in which
16 two products, even if not identical, may present the same damages analysis." *Id.* at 1363.

17 Motorola seizes on this last sentence, asserting that the similarities between the Razer V8
18 and other Motorola phones actually accused of infringing the '119 patent make this a case in
19 which a single damages analysis is appropriate. Opp. 4-5. If the issue here was whether a
20 previous determination of reasonable royalty damages for infringement of the '119 patent by the
21 Razer V8 was also binding in this case, Motorola might have a point. But that is not the issue here.
22 *Applied Medical* does not stand for the proposition that the hypothetical negotiation date may be
23 linked to the start of infringement by a product not accused of infringing the asserted claims. The
24 case does not help Motorola.

25 If anything, *Applied Medical* adds further support to Fujifilm's position. In distinguishing
26 between the reasonable royalty findings in the first and second cases, the court in *Applied Medical*
27 emphasized that "reasonable royalty damages are not calculated in a vacuum without
28 consideration of the infringement being redressed. We are required to identify the infringement

1 requiring compensation, and evaluate damages based on a hypothetical negotiation at the time that
2 infringement began, not an earlier one.” 435 F.3d at 1361 (internal citations omitted). The
3 infringement “being redressed” and “requiring compensation” in this case is the infringement
4 allegedly done by the accused Motorola products; accordingly, the hypothetical negotiation date
5 should be based on “the time that infringement began, not an earlier one.” *Id.*

6 This leaves the question of whether Fujifilm has established as a matter of law that
7 infringement by the accused products began in June 2010. Because Fujifilm did not raise this date
8 until its reply brief, Motorola did not have an opportunity to respond in writing. At oral argument,
9 Motorola offered evidence indicating that, even assuming the first domestic sales of the Motorola
10 Droid X were not made until June 2010, the product was developed and tested in this country
11 significantly earlier. Motorola asserts this evidence precludes summary judgment on the
12 hypothetical negotiation date.

13 Motorola is right. Infringement occurs where one “without authority makes, uses, offers
14 to sell, or sells any patented invention, within the United States or imports into the United States
15 any patented invention during the term of the patent.” 35 U.S.C. § 271. As Judge Alsup observed
16 in *Oracle*, infringement in connection with an accused product does not necessarily begin on the
17 date the product is first offered for sale:

18 [I]n some cases, such as where a foreign defendant expands its sales
19 of an accused product into the United States market, the date the
20 product is first offered for sale in the United States may in fact be
21 the date infringement began. *Where an accused product is developed and tested here in the United States, however, “use” and therefore infringement will almost always begin well before the first sale.*

22 798 F. Supp. 2d at 1116 (emphasis in original); *see also Medtronic Sofamor Danek USA, Inc. v.*
23 *Globus Med., Inc.*, 637 F. Supp. 2d 290, 310 n.26 (E.D. Pa. 2009) (setting hypothetical negotiation
24 at time the accused product was first “available for use and sale”); *Georgia-Pac. Corp. v. U.S.*
25 *Plywood Corp.*, 318 F. Supp. 1116, 1123 (S.D.N.Y. 1970) (settling hypothetical negotiation at
26 time the accused product was “first manufactured”). In light of this principle and the conflicting
27 evidence of earlier development and testing in the United States offered by Motorola, the fact that
28 Motorola began selling the Droid X in June 2010 does not establish as a matter of law the date on

1 which infringement began for the purpose of determining the hypothetical negotiation date. When
2 the accused products first infringed the asserted claims remains a triable question of fact.

3 Fujifilm's motion for partial summary judgment is DENIED.

4 **II. MOTOROLA'S MOTION TO STRIKE**

5 Motorola's motion to strike focuses on three aspects of the expert reports submitted by
6 Martin Haerberli, Fujifilm's expert on infringement and validity of the '119 patent: (A) Haerberli's
7 application of certain of the '119 patent's claim terms to the accused products and the prior art;
8 (B) Haerberli's testimony regarding the Fujifilm-Nokia collaboration; and (C) Haerberli's testimony
9 regarding whether the Nokia 9000i Communicator telephone constitutes prior art that anticipates
10 the asserted claims of the '119 patent. I address each issue in turn.

11 **A. Claim Terms**

12 Similar to its summary judgment motion, Motorola's motion to strike includes a number of
13 arguments regarding the meaning of claim terms that neither party requested construction of
14 during the claim construction process. Motorola argues that Haerberli's opinions regarding the
15 terms "at least one of," "transmitting and receiving buffer," and "data" as used in the '119 patent
16 reflect "incorrect constructions" of those terms and should be struck. By "incorrect
17 constructions," Motorola means that Haerberli's interpretations of the terms are either (i) "contrary
18 to [their] plain and ordinary meaning," or (ii) foreclosed by prosecution history disclaimer. *See*
19 *Mot. 1.*

20 Motorola initially did not provide any legal basis for striking Haerberli's testimony on this
21 ground. *See Mot. 1-10.* In its reply brief, Motorola cites two cases. *See Reply 2-3.* In *Apple, Inc.*
22 *v. Samsung Electronics Co.*, No. 12-cv-00630-LHK, 2014 WL 660857 (N.D. Cal. Feb. 20, 2014),
23 Judge Koh considered Samsung's motion to strike various portions of Apple's expert reports on
24 the ground that they included "a host of new claim constructions that were never disclosed during
25 fact discovery, despite being directly responsive to Samsung's Interrogatory No. 46." *Id.* at *1
26 (internal quotation marks omitted). Interrogatory No. 46 had requested from Apple a list of all
27 claim terms that Apple contended "ha[d] a meaning other than the plain meaning and should be
28 construed by the Court." *Id.* Judge Koh resolved the motion by examining the "new claim

1 constructions” in Apple’s expert reports to determine whether they “exceed[ed] the bounds” of the
2 claim terms’ plain meaning. *Id.* at *6. Where they did not, Judge Koh declined to strike them.

3 In *MediaTek inc. v. Freescale Semiconductor, Inc.*, No. 11-cv-05341-YGR, 2014 WL
4 971765, at *1 (N.D. Cal. Mar. 5, 2014), Judge Gonzalez Rogers considered a motion to preclude
5 the defendant’s expert from testifying as to the “understanding that someone of ordinary skill in
6 the art would have as to . . . certain terms that were never previously identified for claim
7 construction.” *Id.* at *2. Judge Gonzalez Rogers recognized that evidence regarding the plain and
8 ordinary meaning of claim terms is not necessarily inadmissible at trial:

9 At trial, parties may introduce evidence as to the plain and ordinary
10 meaning of terms not construed by the Court to one skilled in the
11 art, so long as the evidence does not amount to arguing claim
12 construction to the jury. Arguing claim construction to the jury is
13 inappropriate because it risks confusion and the likelihood that a
14 jury will render a verdict not supported by substantial evidence.
15 Whether any evidence as to a term’s plain and ordinary meaning is
16 admissible must be considered in the context of the issues to be
17 tried.

18 *Id.* at *4 (internal quotation marks, citations, and modifications omitted). However, she rejected
19 the defendant’s assertion that its expert was “merely offering testimony within the purview of the
20 plain and ordinary meaning of the . . . claim terms.” *Id.* at *5. She found that the expert’s
21 testimony relied “heavily” on intrinsic and extrinsic evidence to explain specific meanings of the
22 terms at issue; the testimony thus “extend[ed] too far into the territory of claim construction” to be
23 presented to the jury. *Id.* at *5-6. Accordingly, she granted the motion. *Id.* at *7.

24 The instant case is plainly distinguishable from *Apple* and *MediaTek*. Motorola does not
25 argue that Haerberli’s opinions were improperly withheld during discovery. Nor does Motorola
26 seriously argue that Haerberli’s opinions delve too deeply into claim construction to be presented
27 to the jury. Rather, Motorola’s position is that Haerberli’s opinions are simply wrong as a matter
28 of law, and that on this ground alone, they should be struck.

This is not a proper basis for striking Haerberli’s testimony at this time. Motorola’s
arguments regarding the meaning of “at least one of,” “transmitting and receiving buffer,” and
“data” could have and should have been raised at summary judgment (if not during the claim
construction process). Indeed, at summary judgment, Motorola raised several arguments

1 regarding the meaning of various claim terms that, like “at least one of,” “transmitting and
2 receiving buffer,” and “data,” had not been identified for construction during the claim
3 construction process. *See* Dkt. No. 153. There, as here, Motorola’s principal position was that
4 Fujifilm’s interpretations of the claim terms were either (i) contrary to their plain and ordinary
5 meaning, or (ii) foreclosed by prosecution history disclaimer. *See id.* There is no reason Motorola
6 could not have included its current arguments regarding the meaning of the ’119 patent’s claim
7 terms in its summary judgment motion. Motorola’s assertion that it did not raise the arguments
8 because they are not “issue dispositive” rings hollow. At the very least, the arguments would have
9 been dispositive on the issue of whether Haeberli’s interpretations of the disputed claim terms fit
10 within the scope of their plain and ordinary meaning. *See* Fed. R. Civ. P. 56(a) (“A party may
11 move for summary judgment, identifying each claim or defense – *or the part of each claim or*
12 *defense* – on which summary judgment is sought.”) (emphasis added).

13 Motorola’s request to strike Haeberli’s testimony for applying “incorrect constructions” of
14 claim terms amounts to a second summary judgment motion. This alone justifies denying the
15 request. The Ninth Circuit has recognized a district court’s “discretion to entertain successive
16 motions for summary judgment,” in particular when made “on an expanded factual record.”
17 *Hoffman v. Tonnemacher*, 593 F.3d 908, 910-11 (9th Cir. 2010). But I am unaware of any
18 authority requiring a district court to entertain a second summary judgment motion where the
19 motion is based on previously available evidence. A number of courts have explicitly rejected
20 such motions, including when brought “under the guise of a motion to strike.” *Purchase Partners,*
21 *LLC v. Carver Fed. Sav. Bank*, No. 09-cv-09687, 2013 WL 1499417, at *7 (S.D.N.Y. Apr. 10,
22 2013) (“Plaintiffs cannot now raise this issue under the guise of a motion to strike, as doing so
23 would be the functional equivalent of bringing a second summary judgment motion. The law is
24 clear that it is improper for a party to file a successive motion for summary judgment which is not
25 based upon new facts and which seeks to raise arguments it could have raised in its original
26 motion.”) (internal quotation marks omitted); *Armentero v. Willis*, No. 08-cv-02790, 2013 WL
27 144253, at *2 (E.D. Cal. Jan. 11, 2013) (declining to hear second summary judgment motion
28 where “the ‘expanded factual record’ that defendant claims to now have before it does not include

1 any evidence that could not have been obtained and included in defendant’s first motion for
 2 summary judgment”). Moreover, my Standing Order for Civil Cases “limit[s] [parties] to filing
 3 one motion for summary judgment” and requires “parties wishing to exceed this limit [to] request
 4 leave of the Court.” Standing Order for Civil Cases § 6.¹ Motorola did not seek leave to file a
 5 second summary judgment motion in connection with its motion to strike.

6 I would deny Motorola’s motion to strike because it is functionally equivalent to an
 7 improper second summary judgment motion. But the motion is also deficient on the merits.
 8 Because I took the time to review and hear argument on the motion, I will explain why.

9 **1. “at least one of”**

10 Motorola moves to strike several portions of Haeberli’s expert reports on the ground that
 11 they rely on “incorrect constructions” of the term “at least one of” as used in claims 1 and 35 in
 12 the ’119 patent. Motorola is wrong, and the testimony will not be struck. Further, in line with
 13 Haeberli’s testimony, I will construe “at least one of” as used in claims 1 and 35 of the ’119 patent
 14 as “one or more of the following.”

15 **a. “a menu comprising selections for at least one of . . .”**

16 Claim 35 of the ’119 patent includes the following limitation: “wherein said display
 17 includes a menu comprising selections for **at least one of** a transmit image mode for transmitting
 18 an image from the wireless telephone to an apparatus, a receive mail mode for receiving
 19 characters, and a transmit mail mode for transmitting characters.” ’119 patent 9:58-65 (emphasis
 20 added).

21 Motorola contends that the only reasonable understanding of the plain and ordinary
 22 meaning of the “menu comprising” limitation is, “a menu comprising selections for at least one of
 23 a transmit image mode . . . , [at least one of] a receive mail mode . . . , and [at least one of] a
 24 transmit mail mode . . .” Mot. 2. Haeberli, on the other hand, asserts that the limitation is present
 25 in the accused devices because they contain a menu which “includes an option for an image
 26 transmission mode by Bluetooth or WiFi.” Haeberli Infringement Rpt. 29 (Jones Decl. Ex. A,
 27

28 ¹ Available at <http://cand.uscourts.gov/whoorders>.

1 Dkt. No. 189-3). Motorola contends this opinion is wrong as a matter of law and should be struck
2 because it assumes that the “menu comprising” limitation may be found in a menu which includes
3 only a “transmit image mode” and no “receive mail mode” or “transmit mail mode.” Mot. 2.

4 Fujifilm counters that the plain and ordinary meaning of “at least one of” as used in the
5 “menu comprising” limitation is properly understood as “one or more of the following.” Opp. 8.
6 Fujifilm states that Haerberli’s testimony is consistent with this understanding of “at least one of”
7 and thus may be shared with the jury.

8 I agree with Fujifilm. Motorola’s position is based principally on *SuperGuide Corp. v.*
9 *DirectTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004), in which the Federal Circuit considered
10 the meaning of “at least one of” as used in the limitation, “means for storing at least one of a
11 desired program start time, a desired program end time, a desired program service, and a desired
12 program type.” *Id.* at 884 (emphasis omitted). The court held that the limitation “requir[es] that
13 the user select at least one value for each category; that is, at least one of a desired program start
14 time, a desired program end time, a desired program service, and a desired program type.” *Id.* at
15 886. The court explained:

16 The phrase “at least one of” precedes a series of categories of
17 criteria, and the patentee used the term “and” to separate the
18 categories of criteria, which connotes a conjunctive list. A common
19 treatise on grammar teaches that “an article of a preposition
20 applying to all the members of the series must either be used only
21 before the first term or else be repeated before each term.” William
22 Strunk, Jr. & E.B. White, *The Elements of Style* at 27 (4th ed.
23 2000). Thus, “[i]n spring, summer, or winter” means “in spring, in
24 summer, or in winter.” . . . Applying this grammatical principle
25 here, the phrase “at least one of” modifies each member of the list,
26 i.e., each category in the list.

27 *Id.* Motorola asserts that here also, “[t]he phrase ‘at least one of’ precedes a series of categories of
28 criteria, and the patentee used the term ‘and’ to separate the categories of criteria, which connotes
a conjunctive list.” *Id.*

29 *SuperGuide* did not erect a universal rule of construction for all uses of “at least one of” in
30 all patents, however. The *SuperGuide* court’s construction of “at least of” was based on the
31 particular facts of the particular patent at issue there. *See, e.g.*, 358 F.3d at 887 (finding that
32 “[e]very disclosed embodiment teaches that the user must choose a value for each designated

1 category” and that “nothing in the specification rebuts the presumption that the [] patentee
2 intended the plain and ordinary meaning of [‘at least one of’]”). Accordingly, numerous courts
3 have declined to follow the *SuperGuide* court’s construction of “at least one of” where the facts
4 before them called for a different understanding of the term. *See, e.g., VendoNet, Inc. v. Redbox*
5 *Automated Retail, LLC*, No. 13-cv-03475, 2014 WL 4555287, at *4 (N.D. Ill. Sept. 15, 2014)
6 (“[*SuperGuide*] did not announce that its rule of grammar was a mandatory rule of claim
7 construction, to be used even when unnecessary to serve the purpose of the invention.”); *Inventio*
8 *AG v. ThyssenKrupp Elevator Americas Corp.*, No. 08-cv-00874, 2014 WL 129799, at *3-4 (D.
9 Del. Jan. 14, 2014) (distinguishing *SuperGuide* and construing “at least one of [A] or [B]” as “[A],
10 [B], or [A] and [B]”); *Dealertrack, Inc. v. Huber*, No. 06-cv-02335, 2008 WL 5792509, at *7-8
11 (C.D. Cal. Sept. 27, 2008) (finding *SuperGuide* “inapplicable” in part because the limitation at
12 issue in *SuperGuide* included categories with values “that users . . . could choose ‘at least one
13 of’”); *Power-One, Inc. v. Artesyn Technologies, Inc.*, No. 05-cv-00463, 2007 WL 896093, at *14
14 (E.D. Tex. Mar. 22, 2007) (distinguishing *SuperGuide* and construing “at least one of X, Y, and
15 Z” as “a group [of X, Y and Z from which] at least one is selected”).

16 Several factors distinguish the “menu comprising” limitation from the limitation at issue in
17 *SuperGuide* and make Fujifilm’s reading of “at least one of” an appropriate reading of that term.
18 First, contrary to Motorola’s assertion, the modes of operation listed in the “menu comprising”
19 limitation (i.e. “transit image mode,” “receive mail mode,” and “transmit mail mode”) are not
20 categories comprised of “many possible values” that users must choose “at least one of” for the
21 invention’s purpose to be served. *See Dealertrack*, 2008 WL 5792509, at *7-8 (distinguishing
22 *SuperGuide* on the same ground).

23 Second, the “menu comprising” limitation is not the only place where “at least one of”
24 appears in claim 35. It also appears in the following two limitations: (1) “a wireless telephone that
25 receives data of **at least one of** an image and characters through a transmitting provider,” and
26 (2) “a display device [for] displaying a menu for designating **at least one of** transmitting data and
27 receiving data.” ’119 patent 9:43-45, 48-55 (emphasis added). Motorola does not dispute that in
28 these two instances, the plain and ordinary meaning of “at least one of” is reasonably understood

1 as “one or more of the following.”² Claim terms are “presumed to have the same meaning
 2 throughout all of the claims in the absence of any reason to believe otherwise.” *Digital-Vending*
 3 *Servs. Int’l, LLC v. Univ. of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012); *see also Fin*
 4 *Control Systems Pty, Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1318 (Fed. Cir. 2001) (“[W]e begin with
 5 the presumption that the same terms appearing in different portions of the claims should be given
 6 the same meaning unless it is clear from the specification and prosecution history that the terms
 7 have different meanings at different portions of the claims.”). Apart from citing *SuperGuide*,
 8 Motorola does not explain why, in this case, “at least one of” should mean different things in
 9 different parts of the same claim.

10 Third, Motorola’s construction of “at least one of” would effectively read the term out of
 11 the “menu comprising” limitation. Claim 1 of the ’119 patent includes a limitation that is almost
 12 identical to the “menu comprising” limitation in claim 35. The claim 1 limitation provides:
 13 “wherein said menu comprises selections for a receive mode for indicating that data has been
 14 received, a transmit image mode for transmitting an image from the wireless telephone to an
 15 apparatus, a receive mail mode for receiving characters, and a transmit mail mode for transmitting
 16 characters.” ’119 patent 4:50-55. Unlike the “menu comprising” limitation in claim 35, the claim
 17 1 limitation does not use the term “at least one of” before listing each mode of operation. The
 18 parties do not dispute that the claim 1 limitation requires that each listed mode of operation be
 19 included in the disclosed menu. *See, e.g.*, Opp. 8 n.3. Under Motorola’s construction of “at least
 20 one of,” however, the “menu comprising” limitation would require the same thing, effectively
 21 nullifying the fact that “at least one of” appears in the “menu comprising” limitation but not in the
 22 claim 1 limitation. This would be “contrary to the well-established rule that claims are interpreted
 23
 24

25 ² Indeed, as discussed below, Motorola argues that as a result of prosecution history disclaimer,
 26 the limitation, “a display device [for] displaying a menu for designating at least one of
 27 “transmitting data” option and a “receiving data” option. By relying on the doctrine of
 28 prosecution history disclaimer to make this argument, Motorola implicitly concedes that the plain
 and ordinary meaning of the limitation extends to a menu that includes only one or the other of the
 options.

1 with an eye toward giving effect to all terms in the claim.” *Digital-Vending*, 672 F.3d at 1275
 2 (internal quotation marks omitted).

3 Motorola’s motion to strike Haerberli’s testimony regarding the “menu comprising”
 4 limitation is DENIED.

5 **b. “a menu for designating at least one of . . .”**

6 Motorola’s second “at least one of” argument has no more merit than the first. Claims 1
 7 and 35 of the ’119 patent both recite the following limitation: “a menu for designating **at least one**
 8 **of** transmitting data and receiving data.” ’119 patent 4:43-48, 9:53-55 (emphasis added).

9 Motorola seeks to preclude Haerberli from testifying that the “menu for designating” limitation
 10 may be satisfied by a menu that includes only one of these options – i.e., a menu that includes only
 11 a “transmitting data” option or a “receiving data” option. Mot. 5-6. Motorola asserts this
 12 restriction on Haerberli’s testimony is warranted because, during prosecution of the ’119 patent,
 13 Fujifilm stated that the limitation could only be satisfied by a menu containing both a
 14 “transmitting data” option and a “receiving data” option. *See id.* On this ground, Motorola seeks
 15 to strike the following portions of Haerberli’s infringement and rebuttal reports: (1) infringement
 16 report, page 29, lines 16-21; (2) infringement report, page 33, lines 18-21; and (3) rebuttal report,
 17 page 24, lines 4-13. *Id.*

18 I am not convinced. The statements cited by Motorola do not constitute the sort of “clear
 19 and unmistakable disavowal” necessary to trigger prosecution history disclaimer. *Biogen Idec,*
 20 *Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013). For example, Motorola relies
 21 on the following passage from the ’119 patent’s file history:

22 **Importantly, the claimed telephone also includes a display device for**
 23 **displaying a menu for designating at least one of transmitting and**
 24 **receiving data.**

25 **Conventional telephones may include a display device. However,**
 26 **such conventional phones do not provide a user with an ability [to]**
 27 **designate one of transmitting or receiving data. Thus, the display**
 28 **device in conventional telephones does not display a menu for**
 29 **designating at least one of transmitting data and receiving data.**

30 **The claimed invention, on the other hand, provides a user with an**
 31 **ability [to] designate at least one of transmitting and receiving data.**
 32 **Thus, the display device in the claimed telephone displays a menu**

1 for designating at least one of transmitting data and receiving data.
 2 For example, when the telephone detects data which may be
 3 received/transmitted, a user may view the menu on the display
 device and use a designating device to designate whether the data
 should be received by the telephone or transmitted to a designated
 apparatus.

4 October 26, 2000 Second Amendment Under 37 C.F.R. § 1.116 at
 5 474 (Jones Decl. Ex. D, Dkt. No. 190-4) (emphasis omitted).

6 This is a not an unambiguous disavowal of all menus which offer only one of a
 7 “transmitting data” option or a “receiving data” option. The passage either quotes the limitation
 8 itself (i.e., “at least one of transmitting and receiving data”) or refers to transmitting “or” receiving
 9 data. *See id.* It is not clear how such language could possibly result in prosecution history
 10 disclaimer, and Motorola does not offer any explanation. *See* Mot. 5-6; Reply 11-12. Motorola
 11 merely adds emphasis to the final words of the quoted passage (i.e., “use a designating device to
 12 designate whether the data should be received by the telephone or transmitted to a designated
 13 apparatus”) and states, “In other words, the claimed invention of the ’119 patent must present both
 14 options . . . to the user.” Mot. 5-6. The other statements cited by Motorola are likewise
 15 ambiguous at best and supportive of Fujifilm’s reading of the “menu for designating” limitation at
 16 worst. Motorola’s motion to strike Haeberli’s testimony regarding the limitation is DENIED.

17 c. Claim Construction Ruling

18 Having considered the parties’ evidence and arguments regarding the meaning of “at least
 19 one of” as used in claims 1 and 35 of the ’119 patent, I find that this dispute presents a
 20 “fundamental dispute regarding the scope of a claim term,” *O2 Micro Int’l Ltd. v. Beyond*
 21 *Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008), that is likely to generate
 22 improper claim construction arguments at trial, *see Cordis Corp. v. Boston Scientific Corp.*, 561
 23 F.3d 1319, 1337 (Fed. Cir. 2009). Accordingly, I find it appropriate to construe the term at this
 24 time. I construe it as “one or more of the following.” The parties shall not introduce evidence or
 25 argument inconsistent with this construction at trial.

26 2. “transmitting and receiving buffer”

27 Motorola next contends that Haeberli improperly attempts to distinguish prior art by
 28 inserting an additional limitation into the “transmitting and receiving buffer” limitation of claim

1 13 of the '119 patent. Mot. 10-11. Motorola moves to strike page 39, line 12 to page 40, line 5 of
2 Haerberli's rebuttal report on this ground. In that portion of the rebuttal report, Haerberli describes
3 the "transmitting and receiving buffer" disclosed in claim 13 as follows:

4 The buffer must buffer data received from the transmitting provider
5 and destined for another device, and must also buffer data from the
6 other device destined to be transmitted to the transmitting provider.
 In other words, it buffers both data transmission and data reception,
 hence its name: transmitting and receiving buffer.

7 Haerberli Rebuttal Rpt. 39-40 (Jones Decl. Ex. B, Dkt. No. 189-4). Haerberli then states that the
8 invention claimed in the '119 patent, unlike the prior art, "buffer[s] data traveling in both
9 directions using the transmitting and receiving buffer." *Id.* Motorola asserts that Haerberli's
10 opinion is incorrect as a matter of law because it reads into the "transmitting and receiving buffer"
11 limitation an additional "bidirectional data flow" limitation. Reply 12.

12 This argument fails. Motorola concedes that "transmitting and receiving buffer" should be
13 given its plain and ordinary meaning and proffers no particular construction of the term except to
14 argue repeatedly that Haerberli's reading of it is wrong. Motorola provides almost no explanation
15 of what is wrong with his reading, however. Motorola cites only two items in support of its
16 position: (1) excerpts from Haerberli's deposition testimony in which he states that claim 13 "talks
17 only about data flowing in one direction" and does not use the term "bidirectional," Haerberli Dep.
18 51-53, 57-58; and (2) portions of the '119 patent's specification which describe data flowing
19 through the "transmitting and receiving buffer" in only one direction, not "bidirectionally," '119
20 patent 2:45-53, 3:60-65, 4:1-10.

21 Neither Haerberli's deposition testimony nor the cited portions of the specification establish
22 that Haerberli's reading of "transmitting and receiving buffer" is beyond the scope of the plain and
23 ordinary meaning of that term. At most, these items establish that the preferred embodiment
24 disclosed in the '119 patent does not involve "bidirectional data flow." But that alone is not
25 enough to render Haerberli's understanding of the plain and ordinary meaning of "transmitting and
26 receiving buffer" incorrect as a matter of law. *See Decisioning.com, Inc. v. Federated Dep't*
27 *Stores, Inc.*, 527 F.3d 1300, 1314 (Fed. Cir. 2008) ("[The] description of a preferred embodiment,
28 in the absence of a clear intention to limit claim scope, is an insufficient basis on which to narrow

1 the claims.”); *Spireon, Inc. v. CallPass Tech, LLC*, No. 12-cv-01903-SI, 2013 WL 706867, at *3
2 (N.D. Cal. Feb. 26, 2013) (“[L]imitations from a preferred embodiment described in the
3 specification generally should not be read into the claim language.”).

4 As Motorola provides no other grounds for holding that Haeberli’s reading of the
5 “transmitting and receiving buffer” limitation is incorrect as a matter of law, Motorola’s motion to
6 strike this testimony is DENIED.

7 3. “data,” “data file,” and “data set”

8 Motorola’s final group of arguments regarding the ’119 patent’s claim terms concerns
9 Haeberli’s interpretations of the terms “data,” “data file,” and “data set.” Mot. 7-10. Motorola
10 argues that Haeberli’s interpretations of these terms are unreasonable because (1) he relies on
11 claim preambles which are not properly construed as limiting in determining the plain and
12 ordinary meaning of “data” as used in claims 1 and 35; (2) at certain points in his testimony he
13 conflates the term “data” with the terms “data file” and “data set;” and (3) he unjustifiably
14 distinguishes between “data” as used in claim 13 and “voice data such as telephone
15 conversations.” Mot. 7-10; Reply 2-7.

16 As Fujifilm points out, Motorola’s scattershot arguments concerning the plain and ordinary
17 meaning of “data,” “data file,” and “data set” have no clear target. At best, these arguments reflect
18 a genuine dispute as to how a person of ordinary skill in the art would understand the plain and
19 ordinary meaning of the terms when reading them in the context of the ’119 patent. Such a
20 dispute “raises a factual question that must be resolved by the jury.” *Cave Consulting Grp., LLC*
21 *v. OptumInsight, Inc.*, No. 11-cv-00469-EJD, 2015 WL 740379, at *15 (N.D. Cal. Feb. 20, 2015).
22 It does not provide a basis for striking expert testimony. Motorola’s motion to strike Haeberli’s
23 testimony on the ground that it reflects unreasonable interpretations of “data,” “data file,” or “data
24 set” is DENIED.

25 B. Fujifilm-Nokia Collaboration

26 Motorola moves to strike portions of Haeberli’s expert reports on the ground that they
27 constitute improper lay testimony. Mot. 11-13. The portions are (1) Haeberli’s infringement
28 report at page 7, lines 5-12; (2) Haeberli’s rebuttal report from page 80, line 4 to page 83, line 24;

1 and (3) Haeberli's rebuttal report from page 94, line 18 to page 96, line 14. *Id.* Each of these
2 portions concerns the Fujifilm-Nokia collaboration. For example, page 7, lines 5-12 of Haeberli's
3 infringement report state:

4 While the Bluetooth standard was still under development, I
5 understand that Nokia approached Fuji Photo Film Co., Ltd. (now
6 Fujifilm Corporation) about collaborating to determine how to
7 implement Bluetooth for transmission of data between a digital
8 camera and a mobile phone. At that time, Fuji Photo was in the
9 midst of a successful shift from the film market to the digital
10 photography market, and had already established itself as a clear
11 leader in digital imaging. Fuji Photo implemented limited Bluetooth
12 functionality in a digital camera as part of the collaboration with
13 Nokia.

14 Haeberli Infringement Rpt. 7 (internal citations omitted). Motorola contends that testimony like
15 this is inadmissible at trial for the exact reason that Fujifilm previously (and successfully) moved
16 to strike similar expert testimony offered by Motorola: it "simply rehash[es] otherwise admissible
17 evidence about which [the expert] has no personal knowledge," *Highland Capital Mgmt., L.P. v.*
18 *Schneider*, 379 F. Supp. 2d 461, 468-69 (S.D.N.Y. 2005), and thus provides no more than a factual
19 narrative which "a lay juror is equally capable of constructing," *Taylor v. Evans*, No. 94-cv-08425,
20 1997 WL 154010, at *2 (S.D.N.Y. Apr. 1, 1997). Such evidence "is properly presented through
21 percipient witnesses and documentary evidence," not through expert testimony. *In re Rezulin*
22 *Products Liab. Litig.*, 309 F. Supp. 2d 531, 551 (S.D.N.Y. 2004).

23 Fujifilm makes two counterarguments. First, Fujifilm contends that at least some of the
24 targeted portions of Haeberli's expert reports do more than "simply rehas[h] otherwise admissible
25 evidence." Fujifilm points to page 80, lines 4-18 of Haeberli's rebuttal report, where Haeberli
26 states in relevant part:

27 As discussed elsewhere in this report, transmission from digital
28 cameras to mobile phones (along with many other concepts known
for use with infrared and Bluetooth) are not the invention of the '119
Patent. In fact, wireless transmission from a digital camera to a
mobile phone is essentially what is shown on the left side of Figure
3 of the '119 Patent; as described above, the left side of Figure 3
appears to be a depiction of the prior art. The asserted claims of the
'119 Patent are directed to a different data flow, which is depicted
on the right side of Figure 3: receiving data from a transmitting
provider (such as a cellular carrier) to a mobile phone and
transmitting the data to a designated device without the transmitting

1 provider. The claims then further describe details of different
2 implementations of this data flow.

3 Haeberli Rebuttal Rpt. 19. Fujifilm asserts that this passage constitutes proper expert
4 testimony regarding technical aspects of the '119 patent. Opp. 21. Motorola concedes in its reply
5 brief that this particular portion of Haeberli's testimony "does not appear to be inappropriate,"
6 Reply 13, so to the extent Motorola's motion seeks to strike page 80, lines 4 to 18 of Haeberli's
7 rebuttal report, the motion is DENIED.

8 Fujifilm's defense of the rest of the targeted portions of Haeberli's reports is less
9 convincing. It states that the portions constitute Haeberli's response to Dr. Bims's testimony on
10 the Fujifilm-Nokia collaboration. Opp. 21. It asserts that it would be "unjust" to allow Motorola
11 to offer such testimony while precluding Fujifilm from doing the same. *Id.* Whatever the merits
12 of this argument in the abstract, it is not persuasive now that the contested portions of Dr. Bims's
13 expert report have been struck. Fujifilm offers no other grounds for allowing Haeberli to deliver
14 testimony regarding aspects of the Fujifilm-Nokia collaboration about which he has no personal
15 knowledge and no legally cognizable expertise. To the extent Motorola's motion seeks to strike
16 (1) Haeberli's infringement report at page 7, lines 5-12; (2) Haeberli's rebuttal report from page
17 80, line 19 to page 83, line 24; and (3) Haeberli's rebuttal report from page 94, line 18 to page 96,
18 line 14, the motion is GRANTED.

19 **C. Nokia Communicator 9000i**

20 Motorola moves to strike page 7, line 13 to page 11, line 5 of Haeberli's rebuttal report on
21 the ground that this portion of the report, like Haeberli's testimony regarding the Fujifilm-Nokia
22 collaboration, constitutes improper lay testimony. Mot. 13-14; Reply 14-15.

23 In this portion of the report, Haeberli rebuts Dr. Bims's opinion that the Nokia
24 Communicator 9000i ("Nokia 9000i") telephone is prior art that anticipates claims 1, 13, and 35 of
25 the '119 patent. *See* Haeberli Rebuttal Rpt. 7-11. Haeberli states that Dr. Bims's opinion is based
26 exclusively on Nokia 9000i manuals and deposition testimony regarding the telephone, not an
27 actual Nokia 9000i,³ and that Dr. Bims's opinion fails to provide clear and convincing evidence

28 ³ Dr. Bims admitted at his deposition that he did not review a Nokia 9000i in reaching his opinions
in this case. *See* Bims Dep. 149-51 (Dkt. No. 193-4).

1 that any of the Nokia 9000i manuals were publicly available by the relevant dates, as required to
2 constitute invalidating prior art. *Id.* at 8. Haerberli examines each manual on which Dr. Bims’s
3 opinion is based and details why, in his opinion, it is not clear when the manual became publicly
4 available. *Id.* at 8-9. Haerberli also asserts that Dr. Bims fails to provide clear and convincing
5 evidence that the functionality he claims was present in the Nokia 9000i was in fact present in the
6 actual telephone. *Id.* at 9. Haerberli emphasizes that there is no evidence that the manuals which
7 Dr. Bims reviewed accurately describe the Nokia 9000i, and that the deposition testimony cited by
8 Dr. Bims is unreliable. *Id.* at 10-11.

9 Motorola argues that Haerberli’s testimony regarding the Nokia 9000i is improper because,
10 like Haerberli’s testimony regarding the Fujifilm-Nokia collaboration, it is directed to “lay matters
11 which a jury is capable of understanding and deciding without the expert’s help.” *Andrews v.*
12 *Metro N. Commuter R. Co.*, 882 F.2d 705, 708 (2d Cir. 1989); *see also, Cooper*, 510 F.3d at 942
13 (evidence is only admissible under Rule 702 where it “will assist the trier of fact to understand or
14 determine a fact in issue”).

15 Fujifilm counters that Dr. Bims’s testimony regarding the Nokia 9000i is “misleading” and
16 “deficient,” and that Fujifilm “should not be denied the opportunity to explain its deficiencies to
17 the jury.” *Opp.* 22. Fujifilm states: “Mr. Haerberli’s testimony makes clear that Motorola failed to
18 adduce clear and convincing evidence of public availability, and Mr. Haerberli should be permitted
19 to rebut Motorola’s evidence at trial.” *Opp.* 23.

20 While I agree with Fujifilm that it should be permitted to rebut Motorola’s evidence
21 regarding the Nokia 9000i, for the most part, Haerberli’s proffered testimony is not an appropriate
22 means of rebutting it. With one exception, the testimony consists of “simple inferences drawn
23 from uncomplicated facts.” *Rezulin*, 309 F. Supp. 2d at 551. These inferences are properly raised
24 through cross examination and closing argument, not through expert testimony. The exception is
25 Haerberli’s opinion on whether the Nokia 9000i manuals reviewed by Dr. Bims accurately describe
26 the Nokia 9000i. Haerberli may offer his opinion on why a product manual of this type may fail to
27 accurately describe the underlying product, and why in this case he believes there is insufficient
28 evidence that the relevant Nokia 9000i manuals accurately describe the Nokia 9000i. To the

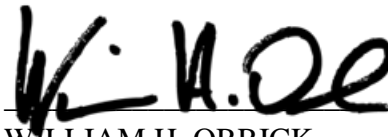
1 extent Motorola’s motion to strike is aimed at this testimony, the motion is DENIED. To the
2 extent the motion is aimed at other aspects of page 7, line 13 to page 11, line 5 of Haeberli’s
3 rebuttal report, the motion is GRANTED.

4 **CONCLUSION**

5 For the foregoing reasons, Fujifilm’s motion for partial summary judgment is DENIED.
6 Motorola’s motion to strike is GRANTED IN PART and DENIED IN PART. The term “at least
7 one of” as used in claims 1 and 35 of the ’119 patent is construed as “one or more of the
8 following.”

9 **IT IS SO ORDERED.**

10 Dated: March 19, 2015

11 

12 WILLIAM H. ORRICK
13 United States District Judge
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

United States District Court
Northern District of California