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January 27, 2012

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VIA ELECTRONIC FILING

The Honorable James R. Holbein
Secretary
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 112A
Washington, DC 20436

Re: *Certain Handheld Electronic Computing Devices, Related Software and Components Thereof, Inv. No. 337-TA-769*

Dear Secretary Holbein:

Attached please find Microsoft's Motion in Limine to Exclude Expert Testimony and Related Evidence on Word 1995 as Purported Prior Art (Doc. ID #469508).^{*} This Motion was timely filed on Monday, January 24, 2012, but the header on Exhibit A was marked inadvertently as "In Camera," and with an RX number with a confidential "C" suffix. Per Sally Bromley's recommendation, Microsoft hereby re-files this Motion in its entirety with a properly-designated exhibit.

Please do not hesitate to contact me at 202-467-6300 with any questions or concerns.

Sincerely,

Rowan E. Morris

REM:jep
cc: *See Certificate of Service*
MSFT702612-2

^{*}Microsoft is concurrently re-filing its Microsoft's Motion in Limine to Preclude Untimely Claim Constructions (Doc. ID #469506), also timely filed on Monday, January 24, 2012.

HARVEY B FOX (1941-2010)

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CARLOS MOORE, PRESIDENT

*admitted to a bar other than DC; practice limited to federal courts & agencies

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before the Honorable Theodore R. Essex
Administrative Law Judge

In the Matter of

CERTAIN HANDHELD ELECTRONIC
COMPUTING DEVICES, RELATED
SOFTWARE, AND COMPONENTS
THEREOF

Investigation No. 337-TA-769

**COMPLAINANT MICROSOFT CORPORATION'S MOTION IN LIMINE TO
EXCLUDE EXPERT TESTIMONY AND RELATED EVIDENCE ON WORD 1995 AS
PURPORTED PRIOR ART**

Complainant Microsoft Corporation ("Microsoft") moves *in limine* to preclude any testimony by Respondents' expert Dr. Goldberg, and any related exhibits or other evidence, as appearing in Dr. Goldberg's witness statement, purporting to relate to operation of "Word 1995." Respondents apparently seek to introduce evidence relating to Word 1995 as prior art against Microsoft's U.S. Patent 6,891,551. This evidence is both untimely, since it was not disclosed on Respondents' original notice of prior art, and is subject to exclusion because the version of Word 1995 that Goldberg purports to demonstrate has not been authenticated.

Furthermore, in his witness statement (Respondents' exhibit RX-2876C), Goldberg refers to a video that supposedly records this demonstration. The relevant portions of his witness statement (answers to question numbers 687, 695, 696, 849, 904, 973 and 1033) are attached hereto as Exhibit A. The video itself appears on Respondents' exhibit list as RDX-8, and is attached as Exhibit B hereto. Microsoft moves for exclusion of the relevant portions of RX-

2876C (answers to question numbers 687, 695, 696, 849, 904, 973 and 1033), RDX-8, and any other testimony or evidence relating to Word 1995 or Dr. Goldberg's alleged demonstration of it.

Certification Pursuant to Ground Rule 3.2

Microsoft certifies that it made reasonable, good-faith efforts to contact Respondents to resolve the matter presented in this motion but the parties were not able to reach agreement. Respondents were not available to meet and confer. The Commission Investigative Staff indicated it will take a position on the motion after reviewing the papers.

Date: January 23, 2012

Respectfully submitted,



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UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before the Honorable Theodore R. Essex
Administrative Law Judge

In the Matter of

CERTAIN HANDHELD ELECTRONIC
COMPUTING DEVICES, RELATED
SOFTWARE, AND COMPONENTS
THEREOF

Investigation No. 337-TA-769

**BRIEF IN SUPPORT OF MICROSOFT CORPORATION'S MOTION IN LIMINE TO
EXCLUDE EXPERT TESTIMONY AND RELATED EVIDENCE ON WORD 1995 AS
PURPORTED PRIOR ART**

Pursuant to the Rules of the Commission and this Court's Ground Rules, Complainant Microsoft Corporation ("Microsoft") moves *in limine* to exclude testimony by Respondents' expert Dr. Goldberg, and any related exhibits or other evidence, as appearing in Dr. Goldberg's witness statement, purporting to relate to "Word 1995" or the operation of that program as prior art. This evidence is both untimely, since it was not disclosed on Respondents' original notice of prior art, and is subject to exclusion because the version of Word 1995 that Goldberg purports to demonstrate has not been authenticated.

The facts justifying grant of this motion are clear and straightforward. Dr. Goldberg's witness statement refers to a video he prepared (identified as RDX-8 in Respondents' direct exhibit list) purporting to show the operation of a copy of Word for Windows 1995 that had been installed and running on one of his own computers. *See* Ex. A (Answers to Question Nos. 687, 695, 696, 849, 904, 973 and 1033 from Dr. Goldberg's witness statement, Respondents' exhibit RX-2876C); EX. B (video identified as Respondents' exhibit RXD-8).

But Respondents did not identify Word 1995 on their original Notice of Prior Art (due and submitted on October 7, 2011). Word 1995 was first identified as potential prior art in Goldberg's opening expert report served on October 21, 2011, in which he simply stated, at several points, that it was

a product that was publicly available and would have been well known to a person of ordinary skill, one could highlight a portion of text, or extend an existing highlight, using a mouse (or Shift key in combination with cursor keys or mouse clicks), and when the mouse was dragged to the right or left of the initial selection point, the selection encompassed the text between the current mouse (or cursor) position and the initial selection point. Thus, the "upstream" and "downstream" selection points were exchanged depending on whether the selection extended to the left or right of the initial selection point.

Likewise, at his deposition, Goldberg simply said that he had a copy of Word 1995 installed on his computer and that he played around with it, but did not offer any detail beyond what was in his report (Goldberg tr. at 426:17-430:8). Respondents did not produce a copy of the Word program that Goldberg had on his computer and did not offer it up for inspection.

Furthermore, it was not until Dr. Goldberg's direct witness statement that he (or Respondents) first disclosed that Goldberg had made a video (RDX-8) purportedly demonstrating his use of Word 1995 on his computer and intended to introduce it as evidence of prior art. *See Ex. A.*

There are several reasons why this video, any other exhibits or other testimony or evidence relating to Word 1995 as prior art, should be excluded.

The mere lateness of the disclosure is reason enough for exclusion. This reference was not included in Respondents' original Notice of Prior Art (or even any supplement to it). Its disclosure as prior art was therefore untimely and should be excluded.

Furthermore, the failure to make a copy of the Goldberg-tested version of the program to Microsoft provides another reason to exclude it. Microsoft has been denied the opportunity to

inspect the tested version of the program and to ensure that it is in fact an authentic version of Windows 1995 and that the version that Dr. Goldberg demonstrates in the video has not been modified, altered, or corrupted as to the relevant features.

Accordingly, Microsoft moves for an order excluding any testimony by Dr. Goldberg (including his answers to question nos. 687, 695, 696, 849, 904, 973 and 1033 in his witness statement, which are attached as Exhibit A hereto), and any related exhibits or other evidence (including but not limited to RDX-8, which is attached as Exhibit B hereto) purporting to relate to Word 1995 or the operation of that program as prior art.

Date: January 23, 2012

Respectfully submitted,



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*Counsel for Complainant Microsoft
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MSFT701912-2.DOCX

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **COMPLAINANT MICROSOFT CORPORATION'S MOTION IN LIMINE TO EXCLUDE EXPERT TESTIMONY AND RELATED EVIDENCE ON WORD 1995 AS PURPORTED PRIOR ART** was served to the parties, in the manner indicated below, this 23rd day of January 2012:

The Honorable James R. Holbein
Secretary
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 112A
Washington, DC 20436

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- VIA HAND DELIVERY

The Honorable Theodore R. Essex
Administrative Law Judge
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 317N
Washington, DC 20436

- VIA HAND DELIVERY

Jeffrey Hsu
Office of Unfair Import Investigations
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 404-J
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- VIA HAND DELIVERY
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**Counsel for Respondents Barnes & Noble, Inc.
and barnesandnoble.com LLC and
Inventec Corporation**

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- VIA FIRST CLASS MAIL
- VIA OVERNIGHT DELIVERY

/s/ Sara J. Ferguson
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Exhibit A



Q691. Are these the slides that you are referring to?

A691. Yes they are.

Q692. What were you asked to do with respect to the '551 patent?

A692. I was asked to analyze the claims of the '551 patent that are being asserted both with respect to the questions of infringement and invalidity.

Q693. And did you perform these analyses?

A693. Yes, I did.

Q694. OK. For the time being, I would like to focus on the invalidity analysis that you performed. Is that alright?

A694. Sure.

Q695. You discussed earlier the nature of the supposed problem that the '551 patent describes. Did the patent itself provide any description of the state of the prior art at the time of its filing?

A695. Yes, as I discussed earlier, the '551 patent describes the general functionality of prior art word processing systems, including the version of Microsoft Word that was available at the time, as being able to select text within the document but not resize that text after the initial selection was completed without restarting the selection process and erasing the initial selection.

Q696. Do you have any personal knowledge that this is the case?

A696. Well, I have used Microsoft Word for at least the last 20 years, so I have personal knowledge of how it operates in that sense. But I also have a copy of Word for Windows 95 that is installed and running on one of my computers, so I was able to confirm that it operates in the way described in the patent. In fact, I prepared a short video showing this operation so that the operation was clear and you can get a sense of what was generally known to a person of ordinary skill in the art at the time that the application for the '551

patent was filed at least with respect to the operation of available text editing products (RDX-8).

Q697. Does the '551 patent cover all methods of resizing text selections?

A697. No, the '551 patent's "selection handles" method is merely one way in which resizing can be performed.

Q698. How important to a user's overall experience is the "selection handles" method described in the '551 patent?

A698. Because the '551 patent's "selection handles" method is merely one way in which resizing can be performed, it would be of limited importance. Barnes & Noble's Nook products also have a variety of important features that have nothing to do with what Microsoft alleges are "selection handles," including, for instance, the ability to purchase and display electronic books. In this sense, the claims of the '551 patent are trivial with respect to Barnes & Noble's Nook products.

Q699. I think that you said that you looked at the claims of the '551 patent. Did you review anything else?

A699. Yes, I reviewed the rest of the specification for the '551 patent and its prosecution history.

Q700. Are there any portions of the prosecution history for the '551 patent that you found particularly relevant?

A700. Nothing that isn't already required by the claim language itself, although I think that it provides insight as to why the claim language is what it is.

Q701. What do you mean by that?

A701. Well, the claims each require a "plurality of selection handles," which means more than one selection handle is required. This is something that was added during prosecution to overcome a rejection of the claims as originally filed.

Exhibit B

PLACEHOLDER

RDX-8

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **COMPLAINANT MICROSOFT CORPORATION'S MOTION *IN LIMINE* TO EXCLUDE EXPERT TESTIMONY AND RELATED EVIDENCE ON WORD 1995 AS PURPORTED PRIOR ART (PUBLIC VERSION)** was served to the parties, in the manner indicated below, this 27th day of January 2012:

The Honorable James R. Holbein
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