

PUBLIC VERSION

**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

**In the Matter of
CERTAIN GAMING AND
ENTERTAINMENT CONSOLES,
RELATED SOFTWARE, AND
COMPONENTS THEREOF**

Inv. No. 337-TA-752

Order No. 49

Complainants Motorola Mobility LLC and General Instrument Corp. (collectively, “Motorola” or “Motorola Mobility”) and respondent Microsoft Corporation (“Microsoft”) filed five related motions to strike certain expert reports and to preclude evidence. The motions are ruled upon, below.

1. Motion Nos. 752-53, -54, and -55

Motorola moved to strike the two “Contingent Expert Reports” filed by Microsoft on October 12, 2012, and to preclude Microsoft from presenting testimony and evidence concerning invalidity allegations at the upcoming remand hearing in this investigation. Motion Docket No. 752-53. Microsoft filed an opposition.

Microsoft filed related motions to strike the five Motorola expert reports filed October 12, 2012, and a separate motion to strike the expert report of Dr. R. Sukumar filed October 12, 2012. Motion Docket Nos. 752-54 and -55.¹ Motorola filed oppositions to both motions.

¹ Microsoft moved to file a reply in support of Motion No. 752-55. Motion Docket No. 752-63. Motorola filed an opposition. Motion No. 752-63 is granted.

PUBLIC VERSION

Arguments of the Parties

In Motion No. 752-53, Motorola argues that Microsoft's "Contingent Reports" should be stricken because "the issues on remand are properly limited to whether Microsoft's acts of importation or sale after importation are, themselves, cognizable as acts of infringement that violate section 337 under . . . *Certain Electronic Devices with Image Processing Systems, Components Thereof, and Associated Software*, Inv. No. 337-TA-724 (*'Electronic Devices'*)."

Motion No. 752-53 at 1. Motorola argues that "good cause exists for striking both of Microsoft's 'Contingent Reports' and precluding testimony and evidence on invalidity, because they do not relate to any issue that is reasonably within the scope of these remand proceedings under *Electronic Devices*." *Id.* at 7. In opposition, Microsoft argues that Motorola's five expert reports ("Motorola's October 12 Expert Reports") "represent Motorola's attempt to reargue and re-litigate the issue of indirect infringement for all asserted patents." Motion No. 752-53 Opp'n at 1. Microsoft argues that "it would be gross error to accept the Motorola resurrected liability theory without also accepting Microsoft's defense." *Id.* at 10.

In Motion No. 752-54, Microsoft argues that "Motorola's indirect infringement claims have been fully litigated and resolved, and are clearly outside the scope of these limited remand proceedings." Motion No. 752-54 Mem. at 10. In response, Motorola argues that "Motorola Mobility's approach to the Investigation was informed by the pre-*Electronic Devices* prevailing approach to establishing violation of method claims." Motion No. 752-54 Opp'n at 6. Motorola argues that "Motorola Mobility did not conduct discovery or develop the original Hearing record with *Electronic Devices* in mind." *Id.* at 10. Motorola argues that "the Commission remanded this Investigation with express instructions to consider a *new* issue and to conduct remand

PUBLIC VERSION

proceedings as the ALJ deems appropriate, which may include reopening the record.” *Id.* (emphasis in original).

In Motion No. 752-55, Microsoft argues that Dr. Sukumar’s expert report should be stricken because “Dr. Sukumar was not disclosed as an expert in this case until [Oct. 12, 2012].” Motion No. 752-55 Mem. at 1. Microsoft argues that “[t]he identification of expert witnesses was due in this investigation on April 25, 2011.” *Id.* In response, Motorola argues that the procedural schedule leading up to the remand hearing “did not provide for a deadline for expert disclosures.” Motion No. 752-55 Opp’n at 2. Motorola argues that “the natural course of action was to file Dr. Sukumar’s expert disclosure along with his report.” *Id.* at 3.

Discussion and Ruling

Microsoft requests that the Madisetti, Drabik and Sukumar expert reports be stricken in their entirety.² Yet, Motorola has shown that each contains, at least in part, subject matter directly related to a holding in the Commission’s *Electronic Devices* opinion. *See* Motion No. 752-54 Opp’n at 11-13 (regarding Madisetti expert report), 13-17 (regarding Drabik and Sukumar expert reports). Further, the remand procedural schedule did not provide a deadline for expert disclosures. Motion Nos. 752-54 and -55 are denied.

The administrative law judge does not find that Microsoft’s expert reports concerning invalidity are directly related to a holding in the Commission’s *Electronic Devices* opinion. Indeed, Microsoft admits that that is the case. *See* Motion No. 752-53 Opp’n at 2 (“The ALJ should strike Motorola’s October 12, 2012 Expert Reports *and* the contingent expert reports filed

² Questions concerning the Acampora and Risavalto reports, at issue in the Microsoft motion, are now moot because those reports pertain only to patents that have been withdrawn from this investigation. *See* Motion No. 752-54 Opp’n at 1 n1.

PUBLIC VERSION

by Microsoft's experts as all being outside the proper scope on remand." (emphasis in original)).

Thus, Motion No. 752-53 is granted.

2. Motion Nos. 752-58 and -62

Motorola moved to strike the contingent expert rebuttal report of James T. Geier, filed October 19, 2012, and to preclude Microsoft from presenting testimony and evidence concerning alleged substantial non-infringing uses. Motion Docket No. 752-58. Microsoft filed an opposition. Microsoft filed a related motion to strike the Second Supplemental Expert Report of Dr. Vijay K. Madiseti filed on October 31, 2012. Motion Docket No. 752-62. Motorola filed an opposition.

Arguments of the Parties

In Motion No. 752-58, Motorola argues that the Geier expert report should be stricken because Microsoft refused to provide discovery regarding substantial non-infringing uses earlier in the discovery process, and should not be allowed to provide contentions and identify underlying facts now, because "Motorola Mobility is prejudiced in its ability to effectively inquire into and respond to those facts and contentions." Motion No. 752-58 at 2. Motorola argues in the alternative that "good cause exists for granting Motorola Mobility leave to file a second supplemental report of Dr. Madiseti directed to Microsoft's new contentions and alleged facts." *Id.* at 6. In opposition, Microsoft argues that "Motorola is not entitled to any relief based upon discovery requests that were the subject of Motorola's denied motion to compel, or based upon additional irrelevant or cumulative discovery requests that were never the subject of a motion to compel during discovery." Motion No. 752-58 Opp'n at 2. Microsoft argues that the Geier expert report is "purely a supplemental rebuttal expert report providing Mr. Geier's opinions directly in response" to the opinions contained in the Madiseti expert report. *Id.* at 1.

PUBLIC VERSION

In Motion No. 752-62, Microsoft argues that “[t]he Madisetti Second Supplemental Report should be stricken because . . . it was filed without leave and out of time, almost two weeks after the deadline for final supplemental rebuttal expert reports and on the date of the close of discovery.” Motion No. 752-62 at 3. Microsoft argues that the Madisetti expert report is a “sur-rebuttal report” and that “no sur-rebuttal reports are allowed under the procedural schedule ordered by the ALJ.” *Id.* at 3-4. In response, Motorola argues that “[t]he parties are currently operating on a very tight schedule,” and “Motorola Mobility should not be chastised for promptly notifying Microsoft and the Administrative Law Judge of Dr. Madisetti’s supplemental opinions.” Motion No. 752-62 Opp’n at 6. Motorola argues that “neither the Procedural Schedule (Order No. 46) nor the Ground Rules (Order No. 40) disallow the filing of sur-rebuttal reports.” *Id.* at 5.

Discussion and Ruling

The Geier rebuttal expert report addresses the opinions that are expressed in the Madisetti expert report, and it has not been shown that Motorola will be prejudiced by the Geier report. *See* Motion No. 752-58 Opp’n at 6-7. Motion No. 752-58 is denied. Similarly, the second Madisetti report addresses the opinions that are expressed in the Geier rebuttal report. *See* Motion No. 752-62 Opp’n at 3-4. Motion No. 752-62 is denied.

* * *

PUBLIC VERSION

Within seven days of the date of this document, each party shall file with the Commission Secretary a statement as to whether or not it seeks to have any portion of the document redacted from the public version. Any party seeking to have a portion of this document redacted from the public version must submit to this office a copy of this document with red brackets indicating the portion, or portions, asserted to contain confidential business information.

So ordered.

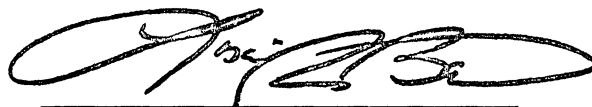


David P. Shaw
Administrative Law Judge

Issued: November 21, 2012

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER NO. 63** was served upon the following parties as indicated, on DEC 21 2012.



Lisa R. Barton, Acting Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112A
Washington, DC 20436

FOR COMPLAINANTS MOTOROLA MOBILITY, INC.; AND GENERAL INSTRUMENT CORPORATION:

Stephen J. Rosenman, Esq.
ROPES & GRAY LLP
One Metro Center
700 12th Street, NW, Suite 900
Washington, DC 20005

- Via Hand Delivery
- Via Overnight Mail
- Via First Class Mail
- Other: _____

FOR RESPONDENT MICROSOFT CORPORATION:

Brian R. Nester, Esq.
SIDLEY AUSTIN LLP
1501 K Street, NW
Washington, DC 20005

- Via Hand Delivery
- Via Overnight Mail
- Via First Class Mail
- Other: _____

**CERTAIN GAMING AND ENTERTAINMENT
CONSOLES, RELATED SOFTWARE, AND
COMPONENTS THEREOF**

Inv. No. 337-TA-752

PUBLIC MAILING LIST

<p>Heather Hall LEXIS-NEXIS 9443 Springboro Pike Miamisburg, OH 45342</p>	<p><input type="checkbox"/> Via Hand Delivery <input type="checkbox"/> Via Overnight Mail <input checked="" type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____</p>
<p>Kenneth Clair Thomson West 1100 13th Street, NW, Suite 200 Washington, DC 20005</p>	<p><input type="checkbox"/> Via Hand Delivery <input type="checkbox"/> Via Overnight Mail <input checked="" type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____</p>