

1 IN THE UNITED STATES DISTRICT COURT
2 FOR THE EASTERN DISTRICT OF TEXAS
3 TYLER DIVISION

4 NETWORK-1 TECHNOLOGIES, INC.)
5 -vs-) DOCKET NO. 6:13cv72
6 HEWLETT-PACKARD COMPANY, ET AL) Tyler, Texas
7) 12:06 p.m.
8) May 15, 2018

9 TRANSCRIPT OF BENCH TRIAL
10 INEQUITABLE CONDUCT
11 BEFORE THE HONORABLE ROBERT W. SCHROEDER III,
12 UNITED STATES DISTRICT JUDGE

13 A P P E A R A N C E S

14 FOR THE PLAINTIFF:

15 MR. GREGORY DOVEL
16 MS. CHRISTIN CHO
17 MR. JONAS JACOBSON
18 MR. RICK LYON
19 DOVEL & LUNER
20 201 Santa Monica Blvd., Ste. 600
21 Santa Monica, CA 90401

22 MR. T. JOHN WARD, JR.
23 WARD, SMITH & HILL, PLLC
24 1507 Bill Owens Parkway
25 Longview, TX 75604

COURT REPORTER: MS. SHEA SLOAN
FEDERAL OFFICIAL COURT REPORTER
211 W. Ferguson
Tyler, TX 75702

Proceedings taken by Machine Stenotype; transcript was
produced by computer-aided transcription.

1 FOR THE DEFENDANTS:

2

3 MS. JENNIFER DOAN
4 MR. JOSH R. THANE
5 MR. KYLE AKIN
6 HALTOM & DOAN
7 6500 Summerhill Road, Ste. 100
8 Texarkana, TX 75503

7

8 MS. NATALIE A. BENNETT
9 MCDERMOTT WILL & EMERY LLP
10 500 North Capitol Street, NW
11 Washington, DC 20001

10

11 MR. HERSH H. MEHTA
12 MCDERMOTT WILL & EMERY LLP
13 444 West Lake St.
14 Chicago, IL 60606-0029

14

15 MR. MARK S. OUWELEEN
16 BARTLIT BECK HERMAN
17 PALENCHAR & SCOTT LLP
18 54 W. Hubbard St., Ste. 300
19 Chicago, IL 60654

17

18

19

20

21

22

23

24

25

1 you, Mr. Godici.

2 Pass the witness.

3 THE COURT: Cross-examination.

4 CROSS-EXAMINATION

5 BY MR. JACOBSON:

6 Q. Mr. Godici, good afternoon.

7 A. Good afternoon.

8 Q. It's nice to meet you, sir.

9 A. Good to meet you.

10 Q. Mr. Godici, if an expert sees evidence that he knows is
11 important, should he omit that from his report?

12 A. Depends on what the issues in the report are structured
13 towards, but I am not sure how further to answer the
14 question. Depends on the purpose of the report and what
15 information you are talking about.

16 Q. Well, what about this: If an expert sees information
17 that he knows is important, should he omit it from his report
18 because it hurts the side that hired him?

19 A. No, I think that, again, depending upon the task given
20 to the expert and the type of information that you are
21 talking about, there shouldn't be a situation where an expert
22 would necessarily hide information. But this kind of
23 theoretical, I don't know what you are referring to.

24 Q. That is what you did here, sir?

25 A. No, I don't believe I did.

1 Q. When you reviewed the file history and the IPRs, you saw
2 that the Cisco Markman could not be material and, therefore,
3 could not be a basis for inequitable conduct, but you omitted
4 that from your report. Right?

5 A. No, I don't know if I omitted that. I mean, I think we
6 talked about it just a little while ago on the timeline that
7 the Cisco Markman was submitted in an IDS. I didn't hide
8 that or say anything about it.

9 Q. But you knew it wasn't material, right, sir?

10 A. Well, I didn't give opinions with respect to what
11 documents were material or immaterial. I talked about what
12 was submitted and what -- and what wasn't submitted.

13 Q. That's exactly my question. You knew it wasn't
14 material, and you didn't write that down in your report
15 right?

16 MS. DOAN: Objection, Your Honor. So Mr. Jacobson
17 objected when we started talking about materiality, et
18 cetera, and he said that he wasn't going to allow questions
19 about that, and now he is cross-examining him on whether
20 something is material or not --

21 THE COURT: This is cross-examination.

22 MR. JACOBSON: Thank you.

23 BY MR. JACOBSON:

24 Q. Sir, you knew it was material, but you omitted it from
25 your report, true?

1 A. No, no. I -- I clearly have indicated and I testified
2 today that the -- that that Markman ruling was submitted in
3 the -- in the file history. And with respect to what is
4 material and not material with respect to claim
5 interpretation, that is something that was Dr. Neikirk's
6 bailiwick and not mine. I didn't opine on claim construction
7 or the meaning of the terms.

8 So as far as disclosing the fact that it was in the
9 file, yes. Interpreting that Markman ruling, that is not
10 something that I would do.

11 Q. When you did your analysis, you understood there is a
12 materiality standard for inequitable conduct, true?

13 A. Yes.

14 Q. And you understood that information is only material if
15 it would have changed the examiner's decision and caused them
16 not to allow the claims, right?

17 A. Yes. My understanding is it is called the "but-for"
18 standard that is in the Therasense case.

19 Q. Right. If it wouldn't have made a difference in the
20 examiner's decision, it is not material, true?

21 A. That's the current law as I understand it, yes.

22 Q. And when you did your analysis you also understood that
23 when the examiners decide whether or not to allow the new
24 claims, they have to apply the broadest reasonable
25 interpretation of the claims, right?

1 A. That's correct. Within the PTO, BRI, or the broadest
2 reasonable interpretation, is the standard.

3 Q. If the examiners have a construction that they know is
4 not the broadest reasonable interpretation, can they apply
5 that to decide the claim scope?

6 A. Well, it is possible. The bottom line is a lot of times
7 there might be a Phillips standard for a term and a BRI
8 standard for a term that might be the same. I mean, they
9 could be different, but it is possible they could be the
10 same.

11 Q. My question is about when they are different. If the
12 examiner's have a district court construction that is
13 different from the broadest reasonable interpretation, can
14 they apply that when they decide whether to allow the
15 claims?

16 A. Well, no. Within the PTO you use the BRI standard. If,
17 in fact, there was a difference, they used the BRI
18 standard.

19 Q. And that's true for claim broadening, right, the
20 examiners need to use the broadest reasonable
21 interpretation?

22 A. Inside the Patent Office, the Patent Office always uses
23 BRI.

24 Q. That's true for everything the Patent Office does,
25 right?

1 A. Correct.

2 Q. And based on the evidence that you saw, you knew that
3 the Cisco Markman was not the broadest reasonable
4 interpretation, so it couldn't have made a difference in the
5 examiner's decision to allow the claims, right?

6 A. Well, again, I didn't -- I didn't interpret the Cisco
7 Markman from a technical standpoint of whether it broadened
8 or didn't broaden. I relied on Dr. Neikirk's opinions with
9 respect to those types of issues.

10 Q. No, sir, not a technical question. From a Patent Office
11 procedure perspective, you knew that the Cisco Markman
12 couldn't have changed the examiner's decision to allow the
13 claims because it wasn't the broadest reasonable
14 interpretation, right?

15 A. Well, theoretically, I guess that is a fair statement to
16 make. I mean, the PTO uses a BRI. The Cisco Markman uses
17 the Phillips standard, the way I understand it. It doesn't
18 mean that it wouldn't have been interesting or important for
19 the PTO to see it. But I'm not sure -- you know, the PTO
20 would have had to use the BRI standard in making their final
21 determination.

22 Q. I didn't ask you if it was interesting or important,
23 sir. Let me ask my question again.

24 You knew that the examiners -- let me ask that
25 differently. You knew that the Cisco Markman couldn't make a

1 difference in the examiner's ultimate decision to allow the
2 claims because they have to apply the BRI standard, right?

3 A. Well, examiners apply the BRI standard. I can't get in
4 the examiner's head to know how he looked at the other
5 standard. But the examiners do apply the BRI standard. You
6 are asking me to opine on what was going on in the -- what
7 might go on in the examiner's head, and I can't do that.

8 Q. No. Sir, if the examiners were following the rules in
9 the patent manual they would not apply a construction that
10 was not the BRI, right?

11 A. Well, that question is correct. They would use the BRI
12 standard, which I have said several times.

13 Q. So if the examiners here followed the rules and the
14 Cisco Markman was not the broadest reasonable interpretation,
15 it wouldn't have changed their decision to allow the claims,
16 right?

17 A. It is possible theoretically. I mean, they apply the
18 BRI standard.

19 Q. And if it wouldn't have changed their decision, you
20 understand it is not material for inequitable conduct,
21 right?

22 A. Well, under the rule for materiality, it would have to
23 be something that was significant that changed the outcome of
24 the claim.

25 Q. So if it wouldn't have changed the outcome, it is not

1 material?

2 A. Under that hypothetical, that is correct.

3 Q. You didn't write down that opinion in your report,
4 right, sir?

5 A. Again, what I wrote in my report and is very clear is
6 the fact that there was information that was available and
7 was not submitted to the Patent Office.

8 I didn't opine on the scope of the claims or
9 interpreted claim language, and I also -- also indicated that
10 there was an IDS that the Cisco Markman was submitted. So we
11 are not -- I am not stating that it wasn't.

12 Q. We will get to the IDS, sir. First, let's discuss what
13 you saw on what the broadest reasonable interpretation of the
14 claims was.

15 You reviewed the IPR proceedings, right?

16 A. Correct.

17 Q. And an IPR proceedings -- those are done by the Patent
18 Trial and Appeal Board, right?

19 A. Yes.

20 Q. The Appeal Board must use the broadest reasonable
21 interpretation of the claims, correct?

22 A. Correct.

23 Q. Now, shortly after this reexamination began, the '401
24 reexamination, it was stayed and halted by an order from the
25 Appeal Board, true?

1 A. True.

2 Q. The Appeal Board ordered that the examiners could not go
3 forward until the Appeal Board made its determinations about
4 the claims, right?

5 A. Right.

6 Q. And the Appeal Board gave the reason for that order, it
7 didn't want any inconsistencies between what the examiners
8 did and what the Appeal Board did, right?

9 A. I don't remember the exact wording, but that sounds
10 about right.

11 Q. I'm showing you Defendants' 597. This is the order
12 staying the reexam. The Appeal Board said: Conducting the
13 reexam of the '930 patent concurrently with the instant
14 proceeding, however, would duplicate efforts within the
15 office and could potentially result in inconsistencies
16 between the proceedings?

17 That is what the Appeal Board said, right?

18 A. Now, I see that, yes.

19 Q. They didn't want the examiners doing anything
20 inconsistent with what they did, right?

21 A. Right.

22 Q. And when the Appeal Board gives an order, the examiners
23 have to follow it, right?

24 A. Generally, yes.

25 Q. Now, in the IPR the Appeal Board construed certain

1 claims of the '930 patent, right?

2 A. Yes, that's my recollection.

3 Q. You reviewed the institution decision for the '071 IPR,
4 right?

5 A. Yes.

6 Q. Showing you P502, this is the institution decision. The
7 Appeal Board looked at the claim term secondary power source,
8 right?

9 A. Yes, I see that.

10 Q. Showing you page P50213 here. And the Appeal Board
11 considered the district court's construction of this term in
12 the Cisco litigation, right?

13 A. Yes.

14 Q. Then the Appeal Board determines the broadest reasonable
15 interpretation of the claims, right?

16 A. Yes, I see that.

17 Q. Let's look at the Cisco construction. This construction
18 from the Cisco district court required that the main power
19 source and secondary power source must be physically
20 separate, true?

21 A. I see those words, yes.

22 Q. And in the broadest reasonable interpretation, the main
23 power source and secondary power source did not have to be
24 physically separate, right?

25 A. Again, I see the words. I am not trying to interpret

1 their meaning or understand their meaning, but I can see the
2 words in the two.

3 Q. You understand the Cisco district court construction
4 says "must be physically separate," right?

5 A. I see that. I see the words, yes.

6 Q. The opposite words are in the broadest reasonable
7 interpretation, right, does not have to be physically
8 separate?

9 A. Well, it says a little bit differently. It says: We do
10 not interpret claim 6 as requiring that they be physically
11 separate.

12 Q. It is not required that they be physically separate,
13 true?

14 A. That's the way they say.

15 Q. And that's the broadest reasonable interpretation?

16 A. Correct, that's what the Board said.

17 Q. Now, the Board also construed the claim term low level
18 current, showing you P502, Page 10. And on Page 8 the Appeal
19 Board considered the Cisco district court construction for
20 low level current, right?

21 A. They mentioned it, yes.

22 Q. Well, they actually recited it, right, sir, they recited
23 the construction?

24 A. That's what I meant, yeah.

25 Q. And then the Appeal Board determined what the broadest

1 reasonable interpretation is of low level current, true?

2 A. Correct.

3 Q. Do you see in the Cisco construction this limitation
4 "cause the access device to start up"?

5 A. I see that is underlined, yes.

6 Q. Those words aren't in the broadest reasonable
7 interpretation, right?

8 A. Those exact words are not there, no. Again, I don't
9 know the difference in the meaning, but I just can look at
10 the words.

11 Q. There is no cause start up in the broadest reasonable
12 interpretation, true?

13 A. Those words do not appear in the BRI interpretation.

14 Q. Now, you also reviewed the Board's final written
15 description in the IPR -- this is D97, 602?

16 A. Correct.

17 Q. And you saw in this decision the Board affirmed its
18 determination of the broadest reasonable interpretation of
19 the claims, right?

20 A. They affirmed it?

21 Q. Showing you Pages 611 to 612. And they gave the
22 broadest reasonable interpretations of low level current and
23 secondary power source as in the institution decision,
24 right?

25 MS. DOAN: Objection, Your Honor. I think he can

1 give him the document and not just snippets from the
2 document.

3 MR. JACOBSON: Your Honor, I am showing the actual
4 full page and then pulls from here. He is not having any
5 issues.

6 MS. DOAN: But you -- he is asking him what they
7 construed secondary power source to be. And, Your Honor, I
8 mean in all candor they didn't construe it in the final
9 written decision. I would like for him to see an actual copy
10 of the opinion rather than just snippets.

11 MR. JACOBSON: I can pull it up --

12 THE COURT: Let's do that.

13 MR. JACOBSON: Sure.

14 BY MR. JACOBSON:

15 Q. I'm showing you did D97, Page 611.

16 Do you see here the Board determined the broadest
17 reasonable interpretation of low level current?

18 A. I see that, yes.

19 Q. And there is no "cause start up" words in that like
20 there was in the Cisco construction, right?

21 A. The words "cause start up" are not in this sentence,
22 no.

23 Q. Now, sir, I pulled from the bottom on Page 10 spilling
24 over on to Page 11. Do you see there the Board addresses
25 secondary power source?

1 A. I see the mention of main power source and secondary
2 power source, yes.

3 Q. You see they say: We did not interpret main power
4 source and secondary power source as requiring physically
5 separate devices?

6 A. I see that.

7 Q. That was different from the Cisco court's construction,
8 right?

9 A. It is my recollection that that is different, yes.

10 Q. This final written decision, you saw this in the reexam
11 file, true?

12 A. Correct.

13 Q. The reexaminers had this, right?

14 A. Yes, I believe they had this.

15 Q. They said they would read this order from the Appeal
16 Board, right?

17 A. Right.

18 Q. Now, sir, you saw the reexaminers actually ordered
19 the -- let me ask that a different way. You saw the Board
20 actually ordered the examiners to be consistent with its
21 determinations in the IPR, right?

22 A. Well, the exact wording was a little different from that
23 at the end. It said that they shouldn't do anything that
24 would be inconsistent, I believe that was the wording with
25 their order.

1 Q. Let's talk about the wording.

2 That order was part of the final written decision,
3 right?

4 A. Right.

5 Q. And the Board ordered that the reexamination stay is
6 lifted so that any necessary action that is consistent with
7 the Board's orders can be taken. Do you see that?

8 A. Correct.

9 Q. They ordered the examiners to be consistent with their
10 determinations, true?

11 A. Correct.

12 Q. They didn't say, do what you want, examiners, right?

13 A. No, they said to be consistent.

14 Q. They didn't say be consistent or be inconsistent,
15 right?

16 A. Correct.

17 Q. They said be consistent?

18 A. Yes.

19 Q. And one of the Board's determinations in this order were
20 the broadest reasonable interpretations, right?

21 A. The Board would use that standard when interpreting
22 claim language, yes.

23 Q. They determined in this order the broadest reasonable
24 interpretations of secondary power source and low level
25 current, right?

1 A. We saw that, that they had an interpretation of those
2 terms, yes.

3 Q. And to be consistent with the Board's determination, the
4 examiners would have to apply those broadest reasonable
5 interpretations, right?

6 A. Well, it would seem that that would be consistent unless
7 there was some information that they put forward.

8 Q. The Board had the Cisco Markman, right?

9 A. They did.

10 Q. They considered it?

11 A. I don't know if -- the Board had the Cisco -- yes, I'm
12 sorry, the reexamination guys, yes.

13 Q. They considered it, right, sir?

14 A. Yes, they did.

15 Q. They rejected that as the broadest reasonable
16 interpretation, true?

17 A. Well, they had their own broadest reasonable
18 interpretation.

19 Q. Which was different, right?

20 A. In some respects. I'm not sure in all respects. But in
21 the ones that you pointed out, yes.

22 Q. To be consistent with the Board's orders, the examiners
23 would have used the Board's broadest reasonable
24 interpretation, right?

25 A. For those terms, yes.

1 Q. And, sir, as we discussed, if the Cisco Markman could
2 not have changed the examiner's decision to allow the claims,
3 then it is not material for inequitable conduct, right?

4 A. Well, again, I guess that is a hypothetical. If you are
5 saying that it would not have, then, yes, it would not be
6 material. To be material the definition of materiality is
7 that it would have changed the final decision.

8 Q. And if the examiners couldn't have applied the Cisco
9 Markman when they decided the scope of the claims, could it
10 have changed their decision?

11 A. The Cisco Markman ruling itself?

12 Q. Yes, sir.

13 A. Well, again, they would have had to use the BRI standard
14 rather than the Cisco standard for those particular claim
15 terms, and then they would have made their decision with
16 respect to broadening based on their analysis.

17 Q. So for the -- let me back up. So the Cisco Markman
18 could not have changed the examiner's decision with respect
19 to the claims of low level current and secondary power
20 source, right?

21 A. Well, again, you are asking me to kind of get into the
22 head of the examiners that were doing the reexamination. And
23 what I am saying is that they would have used the BRI
24 standard that was -- that we have discussed which is proper
25 in the Patent Office. I don't know what decision they would

1 have come to if they used any other decision or any other
2 standard.

3 Q. Well, if they were following --

4 A. You are asking me I think to -- to get inside the head
5 of an examiner. And I can't really do that.

6 Q. No, sir. If the examiners were following the Patent
7 Office rules, then could the Cisco Markman have determined
8 their decision on whether these claims should be allowed?

9 A. Well, all I can tell you is that they were required to
10 use the BRI standard. Now, what the outcome would have been,
11 I don't know.

12 Q. The Cisco Markman was not the BRI?

13 A. The BRI was different in some respects to the Cisco
14 Markman, yes.

15 Q. Let's talk about disclosure. Now, in your direct
16 examination you testified that you had some opinions that
17 Network-1 violated the duty of disclosure, right?

18 A. Yes.

19 Q. But you didn't offer the opinion that Network-1 violated
20 the duty of disclosure specifically with respect to the Cisco
21 Markman order, true?

22 A. I don't recall that that specific issue was in my
23 report. I didn't opine on that. I clearly opined on other
24 omissions that were made, in my view.

25 Q. Right. In your report you didn't offer the opinion that

1 Network-1 violated the duty of disclosure with respect to the
2 Cisco Markman order, true?

3 A. I didn't do that. And I think we have talked about it
4 earlier. Eventually the Cisco Markman order was submitted to
5 the Patent Office in an IDS.

6 Q. That's exactly right. You saw that it was submitted in
7 an IDS, and you concluded, looks like the duty of the
8 disclosure is satisfied here with respect to the Cisco
9 Markman, right?

10 A. They did submit it to the Patent Office, yes. I
11 understand that, and I saw that.

12 Q. And you concluded that it looked like the duty of
13 disclosure was satisfied by that, right?

14 A. Well, it was submitted to the Patent Office. Whether or
15 not there were then statements made with respect to the Cisco
16 order, that is not something that I addressed, and that is
17 not something that I reviewed.

18 But the mere fact that it was submitted to the
19 office is clear. Whether -- and then it is my understanding,
20 based on what I have heard from Dr. Neikirk, is that there
21 were some inconsistencies in terms of what actually occurred
22 with respect to the Cisco order in statements made by
23 Network-1.

24 Q. But, sir, you offered no opinion in your report that
25 there were any misrepresentations made by Network-1, true?

1 A. Well, I didn't make an independent review of any of the
2 materiality. I relied on Dr. Neikirk for materiality in my
3 report. I indicated what I saw with respect to the duty of
4 disclosure and the duty of candor in my report.

5 Q. Listen to my question, sir. In your report you didn't
6 identify any misrepresentations made by Network-1 to the
7 Patent Office, right?

8 A. I don't recall making a statement with respect to
9 misrepresentations myself, no.

10 Q. And if there were no misrepresentations and the Cisco
11 Markman order was disclosed on an information disclosure
12 statement, you understand that satisfies the duty of
13 disclosure, right?

14 A. Well, no. You just said if there were no misstatements.
15 And, again, I beg to differ that maybe there were some
16 misstatements. So you are asking me a hypothetical if there
17 were none.

18 Q. That's right, sir.

19 A. If there were no misstatements -- I don't necessarily
20 agree with that statement. If there were none, then I agree
21 with your --

22 Q. You agree if there is no misrepresentations disclosing
23 the Cisco Markman order on an information disclosure
24 statement, satisfies the duty of disclosure, right?

25 A. Based on the assumption -- or that there were no

1 misstatements, yes.

2 Q. And you didn't identify any misstatements in your
3 report, right, sir.

4 A. To the best of my recollection, I did not.

5 Q. Now, sir, you mention that the Cisco Markman order was
6 disclosed on an information disclosure statement, right?

7 A. Correct.

8 Q. This is D97, Page 868. This is that IDS, true?

9 A. I assume so, once I see the rest of the pages, but I
10 think so, yes.

11 Q. And if we look at Page 861 here, we see the Cisco
12 Markman order is disclosed, right?

13 A. Correct.

14 Q. Now, the Cisco Markman order was not just disclosed on
15 this IDS, it was affirmatively considered by the examiners,
16 true?

17 A. Yes. It is my recollection that the examiner
18 initialed -- checked the block or initialed at the bottom
19 that all of the documents in this IDS were considered.
20 Obviously, I testified earlier this afternoon what it means
21 to be considered and how an examiner considers documents in
22 an IDS. But, yes, it was indicated as being considered.

23 Q. Your opinion is that the examiner initialed this IDS,
24 and it indicates that it was considered, true?

25 A. That's my recollection, yes.

1 Q. Well, let me show you what HP contends.

2 Based on the factual -- I'm showing you -- this is
3 HP's proposed findings of fact and conclusions of law,
4 Paragraph 63.

5 Based on the factual record, it seems unlikely that
6 the examiners ever saw the Cisco Markman order even if it was
7 included in an IDS. There was no indication that the
8 documents submitted in the IDS filed on July 28, 2014, were
9 considered by the examiners because there was no mention in
10 the notice to issue reexamination certificate of the IDS or
11 initials on the IDS form indicating that the documents were
12 considered.

13 Do you see that?

14 A. I see that. And I would like to take responsibility for
15 that. This was in my report. It is an error in my report.
16 In one of the paragraphs in my report indicated this exact
17 wording. And later I found the fact that the examiner had
18 initialed the IDS, so it is possible that this statement came
19 from my report. And I have since found that that was
20 not -- that was a mistake on my part, and I found the form
21 later that -- where the examiner initialed the form.

22 Q. And you told that to HP?

23 A. Pardon me?

24 Q. When you realized you made a mistake, you told that to
25 HP, right?

1 A. I think there was some discussion with attorneys that
2 they had -- this was not -- this was a mistake. You saw --
3 you saw the file history. It is very -- it is very thick and
4 voluminous. And when I first wrote the report two years ago,
5 I saw the submission of the IDS with the Cisco Markman, but I
6 didn't locate the second document where there were initials
7 on it. I have since found that document.

8 Q. And you told that to HP, right?

9 A. Yes.

10 Q. HP submitted this contention to the Court; do you know
11 that?

12 A. Well, I don't know the exact timing of when this was
13 submitted and, you know, when we discussed that fact. I
14 don't know the timing.

15 Q. And in -- what HP says in its contention is just dead
16 wrong, right, that there were no initials on that IDS?

17 A. And, again, I take responsibility for that. That was
18 something that I initially wrote in my report, but then found
19 the document in the -- in the file.

20 Q. HP didn't ask you about that on direct examination, did
21 they?

22 A. Today?

23 Q. Yes, sir.

24 A. That was not something that was brought up. I think
25 there was no question -- I mean, we -- there was no question

1 that the Cisco Markman was submitted. We talked about that
2 in my direct. And so, I mean, that was a non-issue. I mean,
3 we didn't -- there was no contention that the Cisco Markman
4 wasn't submitted to the Patent Office.

5 Q. I had to bring it out on cross, right, sir?

6 A. The initial part of it.

7 Q. Initialed and considered?

8 A. Well, yes, and I am telling you that was my mistake.

9 Q. When did you tell HP that what they had here in this
10 contention was false?

11 A. I don't recall exactly when I said that.

12 Q. A week ago?

13 A. I am not sure.

14 Q. Two weeks ago? A month ago?

15 A. I'm not sure.

16 Q. Six months ago?

17 A. I don't know.

18 Q. You don't know if it was a week ago or six months ago,
19 sir?

20 MS. DOAN: Your Honor, objection, harassing.

21 THE COURT: Overruled.

22 BY MR. JACOBSON:

23 Q. When did you tell them?

24 A. It may have been -- it may have been weeks ago. It may
25 have been a month or two ago. I can't remember exactly how

1 it came up.

2 Q. A month or two ago?

3 A. I don't know.

4 Q. And HP never changed this contention, right?

5 A. I just don't know exactly when they were aware of it or
6 who on the HP side was aware of it.

7 Q. Sir, let's look at that initialed copy of the IDS. This
8 is Defendants' 97, 1407.

9 This is a copy of that information disclosure form
10 we just looked at, true?

11 A. Yeah, this is the copy where the examiner's initials are
12 on the form, and this is the one that I initially couldn't
13 find, but then I found it later.

14 Q. And when the examiner puts his initials here, PK, next
15 to the Cisco Markman, that indicates he considered the Cisco
16 Markman, right?

17 A. He considered it to the extent that I've explained
18 earlier, yes.

19 Q. And the examiner actually wrote the date he considered,
20 here?

21 A. Yes.

22 Q. July 21st, 2014, right?

23 A. Correct.

24 Q. And the examiner typed a note at the bottom here: All
25 references considered except where lined through, PK.

1 Right?

2 A. Yes.

3 Q. PK is the examiner's initials, Peng Ke, true?

4 A. Yes.

5 Q. And he didn't line through the Cisco Markman?

6 A. No, he did not.

7 Q. That means he considered it right, sir?

8 A. Correct.

9 Q. Now, sir, you understand that for inequitable conduct to
10 be material, information has to have changed the examiner's
11 decision to allow the claims, right?

12 A. Yes.

13 Q. Here the examiner actually considered the Cisco Markman,
14 right?

15 A. He considered it to the extent that I have explained,
16 yes.

17 Q. And the examiner has allowed the claims, true?

18 A. The examiners did allow those new claims, yes.

19 Q. So you mentioned when the examiners considered this,
20 they do a brief or cursory consideration, right?

21 A. This information that is submitted in this format,
22 yes.

23 Q. But even a brief examination would tell the examiners
24 that this document is just not relevant to the reexamination,
25 right?

1 A. You mean because of the fact that it is -- uses the
2 standard?

3 Q. Yes, sir.

4 A. Well, that is a possibility, yes.

5 Q. If the examiners just looked at the first page of this
6 document, they could see that it is -- I'm showing you DX97,
7 1357. This is the Cisco Markman, right?

8 A. Yes.

9 Q. If the examiners just looked at the first page, they
10 could see that this is a Markman order from the district
11 court in the Cisco case, right?

12 A. They could see that from the first page, yes.

13 Q. And from the patent manual, examiners know that district
14 courts don't apply the broadest reasonable interpretation,
15 true?

16 A. Well, the examiners understand that there is a different
17 standard that is used in court than at the PTO, yes.

18 Q. Right. District courts don't use the broadest
19 reasonable interpretation standard, true?

20 A. Yes, they understand that.

21 Q. And the examiners could flip through and see these
22 constructions were different from the Board's broadest
23 reasonable interpretations, right?

24 A. Well, yes, if they went into the document they could see
25 what the Markman definitions were, yes.

1 Q. And they would know this document, which does not apply
2 the broadest reasonable interpretation, can't change their
3 decision about the scope of the claims, right?

4 A. Well, again, I can't get into the head of the examiners.
5 The examiners use a BRI standard when they review -- when
6 they review the patentability of claims. And this would be a
7 ruling that is using a different standard. That may be
8 interesting to the examiner or significant to the examiner or
9 it may not be. I don't know.

10 Q. If the examiners were following the rules in the patent
11 manual, they could not use this district court interpretation
12 to decide the scope of the claims, right?

13 A. Well, they would use the BRI standard, and I want to go
14 back to this. I said it before. It is possible that a BRI
15 standard and a Phillips standard could line up. It is
16 possible that they have the same definition of a term, so --

17 Q. That's right, sir.

18 A. -- you are asking me a hypothetical, and I am saying it
19 is not necessarily true.

20 Q. Here, the broadest reasonable interpretation was
21 different from the Cisco constructions, right?

22 A. Well, in this particular case you pointed out two or
23 three of the constructions that were different when the Board
24 made their determination.

25 Q. And the patent manual tells the examiners that if a

1 construction is different from the BRI, they don't use it to
2 decide the scope of the claims, right?

3 A. Well, as I said, the standard within the Patent Office
4 is BRI.

5 Q. That means if it is not the BRI, the examiners can't use
6 it, right?

7 A. They use BRI, yes, they use BRI.

8 Q. If it is not the BRI, the examiners cannot use it, true?

9 A. If it is not the BRI, I guess that is a true statement.
10 I guess I would have to agree with that, yes.

11 Q. All right. Now, sir, the information disclosure form
12 can disclose prior art documents, right?

13 A. Yes.

14 Q. And it can also disclose documents that is not prior
15 art, like the Cisco Markman, right?

16 A. Correct.

17 Q. There is nothing improper about sticking a document like
18 the Cisco Markman on an IDS, right?

19 A. That's correct.

20 Q. Well, let me show you what HP contends.

21 I'm showing you HP's proposed findings of fact and
22 conclusions of law, Docket 1003.

23 Moreover, as Defendants' experts pointed out, IDS
24 submissions are proper for prior art references. The Cisco
25 Markman order was not a prior art reference and should not

1 have been disclosed through an IDS.

2 Do you agree with that opinion?

3 A. Well, the bottom line is, the Cisco Markman order isn't
4 a piece of prior art, I agree with that part.

5 Q. Do you agree with the statement that it is not a prior
6 art reference and should not have been disclosed through an
7 IDS?

8 A. Well, let's put it this way: I guess it wouldn't -- it
9 is not improper -- let's put it this way: It is not improper
10 to list it on an IDS, and you see it all the time.

11 Q. Do you agree with the statement it is improper?

12 A. Well, it is permissible, it is permissible to do that.

13 Q. Well, sir, this is referring to an opinion from you,
14 right?

15 A. I am not sure which expert this is pointing to.

16 Q. It says, Defendants' experts pointed out; do you see
17 that?

18 A. Right.

19 Q. This is a contention about Patent Office procedure,
20 right, sir?

21 A. I assume so.

22 Q. You are HP's Patent Office procedure expert, right,
23 sir?

24 A. Yeah, well, let me clarify a little bit. The bottom
25 line is what may be referred to here is the fact that in

1 reexamination only patents in printed publications -- prior
2 art can be used to -- in the reexamination and considered for
3 patentability purposes. So that may be what is being
4 referred to here.

5 Q. Sir, the words are, the Cisco Markman order was not a
6 prior art reference and should not have been disclosed
7 through an IDS; do you see those words?

8 A. I see that.

9 Q. Those are not your words, right?

10 A. I don't believe that I actually wrote those exact words
11 anywhere --

12 Q. And you don't agree with that --

13 A. -- you are showing me one paragraph here in a
14 document --

15 Q. And you don't agree --

16 THE COURT: Mr. Jacobson, don't interrupt the
17 witness.

18 MR. JACOBSON: I apologize.

19 A. What I am saying here is that I look at this, and I can
20 see a way of interpreting this that I think would be
21 reasonable. And that is in reexamination only patents in
22 printed publications can be used to reject claims. And,
23 therefore, that may be what is being referred to here in
24 terms of the fact that the Markman order is not prior art.

25 Q. Mr. Godici, do you agree that the Cisco Markman order

1 should not have been disclosed through an IDS?

2 A. Again, what I am saying is that it could be, or it is
3 permissible.

4 Q. And this --

5 A. Yes or no, I mean, it could go either way is what I am
6 saying.

7 Q. So when HP showed this to you, you told them, hmm, that
8 is not right, that is misleading. Right?

9 A. I am not sure that I have actually reviewed this
10 particular paragraph.

11 Q. They didn't show this to you?

12 A. I don't recall seeing this paragraph, no. I don't
13 recall.

14 Q. Now, one reason HP wouldn't show this to you is because
15 they knew if they did, you would have to point out, hmm, I
16 don't offer that opinion, and that is misleading. Right?

17 A. Well, I can't speak for what the reaction might be and
18 so on and so forth. But what I can tell you is that I can
19 see an interpretation for this that is reasonable, and I can
20 see how it could be submitted, but I don't recall seeing it
21 in the past.

22 Q. Can you think of any other reason why HP would make this
23 contention about Patent Office procedure, cite Defendants'
24 experts, and not show it to their Patent Office procedure
25 expert?

1 A. Maybe there were -- maybe there is -- I don't know. I
2 just don't know. Maybe there is another expert they are
3 referring to.

4 Q. Is there some other expert that you know of that is a
5 Patent Office procedure expert?

6 A. Well, it just says Defendants' experts. It doesn't say
7 Patent Office procedure expert.

8 Q. You didn't answer my question, though. Is there another
9 expert that is a Patent Office procedure expert that you know
10 of?

11 A. Not that I know of.

12 Q. Did you see in Dr. Neikirk's report the opinion that an
13 IDS is not proper to disclose -- or that the Cisco Markman is
14 not proper to disclose through an IDS?

15 A. I don't recall seeing that in Dr. Neikirk's report,
16 so...

17 Q. Now, sir, I just want to clear up the timing here. We
18 have been talking about the Cisco Markman order and the '401
19 reexam, right?

20 A. Yes.

21 Q. The '401 reexam started on July 20th, 2012, true?

22 A. Yes.

23 Q. And that exam ended when the reexam certificate issued
24 in October of 2014, right?

25 A. Yes.

1 Q. Now, on direct examination you talked about Defendants'
2 4-2 disclosures and Defendants' amended invalidity
3 contentions and Defendants' 4-3 disclosures, right?

4 A. I did, yes.

5 Q. Those are the charts that Ms. Doan showed you?

6 A. Correct.

7 Q. Those documents didn't exist during the first reexam,
8 right?

9 A. That's correct.

10 Q. And if a document doesn't exist, is there an obligation
11 to disclose it?

12 A. Well, not in the first reexam. But if there is another
13 reexamination, yes. That's what I testified to.

14 Q. The first reexam is the '401 reexam right, sir?

15 A. Correct. But in my report I stated that, clearly, the
16 '444 reexamination was in process, and these documents were
17 submitted in that report.

18 Q. I understand --

19 A. In that reexamination.

20 Q. I understand.

21 A. Yes.

22 Q. Did HP show you that their contentions in this case were
23 limited to the '401 reexam?

24 A. Pardon me?

25 Q. Did they show you that their contentions in this case

1 were limited to the '401 reexam?

2 A. I'm not sure. I don't understand your question.

3 MS. DOAN: Objection, Your Honor. That is just not
4 accurate. They may be the rule -- the order of this Court,
5 but our contentions, they are preliminary findings of fact
6 and conclusions of law. They are not final, and they have
7 not been entered. We will definitely submit them again.

8 THE COURT: Mr. Jacobson, you want to rephrase your
9 question again.

10 MR. JACOBSON: That's all I wanted to do on this
11 topic. I will move on.

12 BY MR. JACOBSON:

13 Q. Well, one more question. You certainly have no opinion
14 that any of these documents should have been disclosed during
15 the '401 reexam, right?

16 A. Well, they couldn't have because they didn't exist then.
17 That is obvious.

18 Q. And you don't have an opinion that any of these
19 documents, these 4-2 disclosures, amended invalidity
20 contentions, or 4-3 disclosures are material, right?

21 A. Well, I'm not sure I exactly agree with that.

22 Q. In your report, sir, you didn't offer the opinion that
23 any of these documents were material, right?

24 A. Well, in my report I rely on materiality and Dr.

25 Neikirk. And I, clearly, in my report I indicate that these

1 three documents were not submitted in the '444, so --

2 Q. You --

3 A. So -- and -- and it is my recollection that Dr. Neikirk
4 has opined that there was broadening of the claims, and
5 therefore, these documents would have been material.

6 Q. Sir, you didn't do any analysis of whether these
7 documents were material yourself, right?

8 A. Again, I relied on Dr. Neikirk for reviewing the
9 technical portions of the claims and indicating whether or
10 not those documents were material.

11 Q. Okay.

12 A. But I did indicate that I felt that they were -- there
13 was a violation of the duty of disclosure by not submitting
14 them.

15 Q. Sir, I think you are trying to answer my question, but I
16 need a direct answer. You yourself did not do any analysis
17 and conclude that these documents were material, right?

18 A. That's correct. I left the analysis of the claim
19 language to the expert Dr. Neikirk.

20 Q. Now, sir, you mentioned that in your report you made a
21 mistake about the -- about whether the Cisco Markman was
22 actually considered by the examiners, right?

23 A. Yes, I did.

24 Q. Let's take a look at that part of your report.

25 This is Paragraph 85 from your report, right?

1 A. Yes. This is the one that I was talking about, yes.

2 Q. And you wrote: There was no indication that the
3 documents submitted in the IDS filed on July 28th, 2014, were
4 considered, since the examiner did not mention the IDS or
5 initial the IDS form indicating that the documents were
6 considered.

7 You wrote those words, right?

8 A. I did, yes.

9 Q. You understood them when you filed your report, you had
10 a duty to be truthful?

11 A. Yes.

12 Q. Turns out those words were false, right?

13 A. Well, as I said, I later found the form where -- that
14 had the examiner's initials on them, yes.

15 Q. You overlooked that information before, right?

16 A. I just couldn't find it. I didn't find it in my first
17 review of the large file.

18 Q. In fact, it was there, right?

19 A. Turns out I found it later, yes.

20 Q. So you just overlooked it in your first review, right?

21 A. I missed it, yes.

22 Q. Yeah.

23 Now, sir, From the fact that you overlooked or
24 missed information, can we infer that you had the intent to
25 deceive the Court?

1 A. Well, I didn't intend to deceive the Court. I made a
2 mistake. I didn't find that document, and I later found the
3 document. I remember writing a little note after the fact
4 that -- how I found the document -- that's all -- to
5 myself.

6 Q. Can we infer intent to deceive from the fact that you
7 omitted this information from your report?

8 A. There was no intent on my part to deceive. This is --
9 this is -- this is what I thought at the time that I wrote
10 this sentence, yes, and I later found the document.

11 Q. So just a good-faith mistake, right, sir?

12 A. In this case it was, yes.

13 Q. Maybe there was an administrative error, and one of your
14 staff didn't locate this document for you?

15 A. Well, the staff is me.

16 Q. So maybe you yourself --

17 A. It was me --

18 Q. -- made an administrative error?

19 A. I just -- as I said before, it is a very large file, and
20 I didn't find that the first go-through.

21 Q. When you are dealing with hundreds or thousands of
22 documents, things can get missed, right?

23 A. I don't know of hundreds of thousands, but, yes --

24 Q. Hundreds or thousands?

25 A. Oh, okay. Yes, I mean, I have said it over and over

1 again, I didn't find the initialed form until after I wrote
2 my report.

3 Q. And there is no email that you sent where you say I know
4 this IDS was considered, but I am going to say the opposite
5 in my report, right?

6 A. No, I didn't write that report -- email.

7 Q. If we looked in your files, we are not going to find a
8 note where you say, I know this Cisco Markman was considered,
9 but I am going to say the opposite. Right?

10 A. You won't find that.

11 Q. So we don't have any concrete evidence of intent to
12 deceive from you, true?

13 A. That's correct.

14 Q. So just from the fact that you overlooked the Cisco
15 Markman was considered, we can't infer you intended to
16 deceive, right?

17 A. Again, no, I didn't intend to deceive, and I think I
18 made it clear here today in public and in the transcript that
19 I made an error here, and I am attempting to straighten it
20 out.

21 Q. When you reviewed the prosecution history for the '930
22 patent, you didn't see any statements that suggested an
23 intent to deceive, right?

24 A. Say that again.

25 Q. Let me back up. When you reviewed the file history, you

1 didn't see any note from Mr. Wieland that said: I intend to
2 deceive the Patent Office. I know these claimed are
3 broadened. Right?

4 A. I didn't see that type of note, no. But as we heard
5 from today, there were statements made.

6 Q. Well, sir, you made the statement in your report that
7 was wrong, right?

8 A. Exactly. This was an error. I mean, you have to weigh
9 the significance of an error versus something that would be
10 more significant. But, yes, I made an error here.

11 Q. The significance -- HP felt this was important enough to
12 put in their contentions to the Court, right?

13 A. Again, I am not going to speak for HP, but the bottom
14 line is I am telling you now that I later found the form with
15 the initials on it, as I have stated several times now.

16 Q. HP put this in its contentions to the Court, right?

17 A. Well, and, again, I am taking the blame for that.

18 Q. I understand, sir. But I still need an answer to my
19 question. HP put this --

20 A. They did, they did, yes.

21 Q. Okay. And we can't infer you had the intent to deceive,
22 right?

23 A. I can just tell you I didn't have the intent to
24 deceive.

25 Q. Now, in your report you did not offer the opinion that

1 Network-1 had a duty to discuss the Cisco Markman order with
2 the examiners during the reexam, true?

3 A. In my report?

4 Q. Yes, sir.

5 A. I did not make that statement in my report, no.

6 MR. JACOBSON: I'll pass the witness, Your Honor.

7 REDIRECT EXAMINATION

8 BY MS. DOAN:

9 Q. Mr. Godici, in a litigation context, we have ability to
10 cross-examine and direct examination -- you are represented
11 by both sides, right?

12 A. Yes.

13 Q. Yeah. But in a reexamination, we don't have that, do
14 we? We just have the patent owner -- other than whoever
15 brings the reexamination at the very beginning. But in the
16 context of these newly added claims, was there anybody there
17 with Network-1?

18 A. No, there was not.

19 Q. There was nobody from HP or anybody else to raise the
20 kind of points that Mr. Jacobson was just raising, correct?

21 MR. JACOBSON: Objection, Your Honor. Nowhere in
22 his report.

23 THE COURT: I think it is fair rebuttal.

24 BY MS. DOAN:

25 Q. On a reexamination, correct?