

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., EVENTBRITE INC., STARWOOD HOTELS & RESORTS
WORLDWIDE, INC., EXPEDIA, INC., FANDANGO, LLC,
HOTELS.COM, L.P., HOTEL TONIGHT, INC., HOTWIRE, INC.,
KAYAK SOFTWARE CORP., OPENTABLE, INC., ORBITZ, LLC, PAPA
JOHN'S USA, INC., STUBHUB, INC., TICKETMASTER, LLC, LIVE
NATION ENTERTAINMENT, INC., TRAVELOCITY.COM LP,
WANDERSPOT LLC, AGILYSYS, INC., DOMINO'S PIZZA, INC.,
DOMINO'S PIZZA, LLC, HILTON RESORTS CORPORATION,
HILTON WORLDWIDE, INC., HILTON INTERNATIONAL CO., MOBO
SYSTEMS, INC., PIZZA HUT OF AMERICA, INC., PIZZA HUT, INC.,
and USABLENET, INC.,
Petitioner,

v.

AMERANTH, INC.,

Patent Owner.

Case CBM CBM2015-00082¹
Patent 6,871,325

**PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE PURSUANT TO 37 C.F.R. § 42.64(c)**

¹ CBM2015-00097 has been consolidated with this proceeding.

I. INTRODUCTION

Patent Owner (PO)'s motion to exclude (Paper 35, "Mot.") should be denied, because it fails to establish that any of the Exhibits submitted with Petitioner's Reply brief are inadmissible under the Federal Rules of Evidence (F.R.E.). PO seeks to exclude portions of Petitioner's expert declaration and cited evidence as irrelevant, simply because this evidence is not cited in Petitioner's Reply brief. However, this is not the standard articulated by F.R.E. 401-403. This evidence is relevant and admissible, because it demonstrates facts of consequence to this proceeding, including the state of the art, how a person of ordinary skill in the art ("POSITA") would interpret the claims and how a POSITA would interpret the prior art. PO also seeks to exclude various Exhibits on the grounds of authentication or hearsay. However, PO ignores evidence demonstrating that the challenged Exhibits are authentic or self-authenticating. PO also ignores that many of the challenged Exhibits are not relied upon for the truth of any matters asserted, and are therefore not hearsay. PO's Motion should therefore be denied.

II. EXHIBIT 1070 SHOULD NOT BE EXCLUDED

A. PO's Relevance Objections Should Be Rejected

PO contends that certain paragraphs of Exhibit 1070, the supplemental declaration of Petitioner's expert Dr. Don Turnbull, are irrelevant under F.R.E. 401-402, simply because the paragraphs were not cited in Petitioner's Reply Brief. Mot. at 2-3 (objecting to Exhibit 1070, ¶¶ 1-4, 18, 19, 22-24, 33, 37, 38, 41-51, 55,

60-63, 65, 67-70, 78-93 and 95). However, there is no requirement in this proceeding (and PO cites none) that Petitioner must cite to each and every paragraph in an expert declaration to satisfy the relevance requirements of the Federal Rules of Evidence.

Rather, F.R.E. 401 provides:

Evidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.

Exhibit 1070 sets forth in detail Dr. Turnbull's analyses and opinions regarding PO's Responses and the testimony of its expert, Dr. Alfred Weaver. *See generally* Exhibit 1070. Dr. Turnbull's analyses and opinions are directly relevant to issues in this proceeding, because they have a tendency to make various facts of consequence in determining this action more probable. For example, Dr. Turnbull provides analysis and opinion relating to (1) how a POSITA would interpret the Challenged Claims in view of the plain meaning of claim limitations and disclosures in the patent specification (*e.g.* ¶¶ 6-12, 19-20, 27-31), (2) how a POSITA would interpret disclosures in the DeLorme reference (*e.g.* ¶¶ 21, 24-27, 41-48, 60-66), (3) inherent disclosures in the DeLorme reference (*e.g.* ¶¶ 50-54), (4) whether various modifications to the DeLorme system would have been obvious to a POSITA (*e.g.* ¶¶ 71-77), and (5) whether PO's cited evidence demonstrate non-obviousness of the claimed inventions (*e.g.* ¶¶ 78-96).

Moreover, the relevance of Dr. Turnbull's opinions to particular issues of consequence in this proceeding is plainly evident from the declaration itself, and from Petitioner's Reply brief. For example, Section I of Exhibit 1070, entitled "Analysis of PO's Responses Regarding Patentability of the '850 and '325 Patents," includes ten sub-sections, each specifically identifying the specific issues to which the paragraphs within the sub-section relate. *See generally* Exhibit 1070. Furthermore, the sub-section headings mirror similar headings in Petitioner's Reply brief. *Compare*, Exhibit 1070 §§ I.A-G, I-J *with* Reply §§ II.A-H, J.

Because the entirety of Exhibit 1070 is directed to Dr. Turnbull's analyses and opinions which have a tendency to make facts of consequence in determining this action more probable, Exhibit 1070 is relevant under F.R.E. 401. Indeed, PO does not dispute the relevance of much of Dr. Turnbull's testimony. Exhibit 1070 is therefore admissible under F.R.E. 402 ("Relevant evidence is admissible...").

PO also objects to paragraphs 1-4, 18, 19, 22-24, 33, 37, 38, 41-51, 55, 60-63, 65, 67-70, 78-93 and 95 in Exhibit 1070 on the ground that any probative value is substantially outweighed by unfair prejudice and waste of time under F.R.E. 403, because these paragraphs were not specifically discussed or cited in Petitioner's Reply brief. Mot. at 3. However, because the entirety of Exhibit 1070 is directly responsive to arguments raised in PO's Response, this Exhibit is neither unfairly prejudicial nor a waste of time.

B. Exhibit 1070 Was Not Incorporated By Reference

Contrary to PO's contention, Petitioner did not incorporate by reference any portion of Exhibit 1070 in its Reply brief. Mot. at 4. As PO acknowledges, the paragraphs of Dr. Turnbull's supplemental declaration which PO contends were incorporated by reference were *not* cited in the Reply. *Id.* Accordingly, these paragraphs could not include arguments incorporated by reference in contravention of 37 C.F.R. § 42.6(a)(3).

Moreover, the prior Board decisions cited by PO confirm that Petitioner's narrowly tailored citations to Dr. Turnbull's declaration are appropriate. Mot. at 4-5. In these cases, the Board stated that it was improper to incorporate by reference arguments from an expert declaration (*e.g.* by citing large portions of the declaration), because allowing such a practice would allow Petitioners to subvert the strict page limits set forth in the Board's regulations. For example, in *Cisco Systems*, the Petition included numerous footnotes, that collectively cited to large portions of an expert declaration. *Cisco Systems, Inc. v. C-Cation Tech., LLC*, IPR2014-00454, Paper No. 12 at 7-8. The Board determined that citing "large portions of another document, without sufficient explanation... amounts to incorporation by reference." *Id.* at 8. However, Petitioner's Reply brief did not cite large swaths of Dr. Turnbull's declaration. It did the opposite, narrowly

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