

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

United Services Automobile Association,
Petitioner,

v.

NADER ASGHARI-KAMRANI and KAMRAN ASGHARI-KAMRANI,,
Patent Owner

Case CBM2016-00063
Patent 8,266,432

**PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO
MOTION TO EXCLUDE EVIDENCE**

PO's Opposition (Opp'n) to Petitioner's Motion to Exclude (Mot.) fails to address the evidentiary issues concerning Ex. 2008 and Ex. 2010. The Opp'n also mischaracterizes the Mot. as a request to invalidate Ex. 2008. Petitioner's Mot. should be granted.

I. PO's Opp'n Does Not Seek To Address Evidentiary Issues Raised By Mot.

PO asserts that "the COC is not evidence that is subject to exclusion" because "the COC is part of the '432 Patent itself." Opp'n at 1. PO misses the point. 35 U.S.C. 255, as cited by PO, states: "Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions *for causes thereafter arising* as if the same had been originally issued in such corrected form." *Id.* (emphasis added). Trial institution was on 9/21/2016, more than two months before PO sought to enter the COC (Ex. 2008) on 12/5/2016. Paper 14. The instituted trial is not a cause arising thereafter, as required by 35 U.S.C. 255. The Opp'n offers no support for the overbroad assertion that "the corrections identified in the COC have the same effect as if the '432 Patent had been originally issued in such corrected form." Opp'n 1-2. Such overstatement directly contradicts 35 U.S.C. 255.

The issue raised by Petitioner's Mot. is the admissibility of the exhibits in dispute when they were submitted more than two months after trial institution and the

parties still dispute whether the inexplicable delay of nearly 8 years for PO to request the COC (Ex. 2008) to amend priority is unintentional. *See e.g.*, Ex. 1069. In asserting, without legal support, that “the COC is not evidence that is subject to exclusion,” the Opp’n does not address evidentiary issues raised by Mot. Opp’n at 1.

II. PO’s Opp’n Mischaracterizes The Mot.

PO’s Opp’n mischaracterizes the Mot. as inviting the Board to decide on the validity of the COC (Ex. 2008). Opp’n at 2. To reiterate, Petitioner’s Mot. invites the Board to exercise its discretionary power to *exclude evidence*. *See* 37 C.F.R. § 42.104(b)(5) (“The Board *may exclude* or give no weight to the evidence....”) (cited by USPTO in Ex. 1070 at 10) (emphasis in original).

III. Petitioner’s Motion Remains In Full Force And Effect

A. Exhibit 2008 Should Be Excluded

1. Exhibit 2008 should be excluded as unduly prejudicial

As stated, “the entry of this Exhibit 2008 creates a moving target for the instant CBM proceeding” that is “unfairly prejudicial” to the Petitioner and the Board. Mot. at 2-3. PO does not dispute knowledge of (i) letter from Petitioner’s litigation counsel (Ex. 1046); (ii) terminal disclaimer (Ex. 1041); (iii) powers of attorney (Ex. 1053); (iv) non-publication request (Ex. 1047); and (v) interviews conducted on the same day with the same Examiner (Ex. 2015 ¶63). PO’s only response is that *one* (but not all) of its three previous patent counsels, Mr. Fortkort “who signed and filed the terminal disclaimer,” “was not aware that a priority should have been claimed to

the ‘400 application.” Opp’n at 3 (citing newly introduced Ex. 2016). To downplay this conspicuous failure, PO cites to the newly introduced Expert Report of Q. Todd Dickinson (Ex. 2015) proffered in litigation over the same ‘432 patent. *See e.g.*, Ex. 2015 at ¶¶152-53 (discussing that Mr. Godici concluded “Mr. Fortkort knew, or should have recognized....”) and ¶67 (discussing that Petitioner’s technical expert concluded “the specification ... does not fully support any claim of the ‘432 Patent.”). PO conspicuously fails to reveal that, while they cite his Expert Report, the Court found Mr. Dickinson’s testimony *untruthful*. Ex. 1072 at 1033:24-1034:9 (“I did not find Mr. Dickinson's testimony truthful.”). Further, these newly introduced exhibits reinforce Petitioner’s position that “the entry of this Exhibit 2008 creates a moving target for the instant CBM proceeding,” (Mot. at 2), necessitating additional fact-finding inquiries that runs afoul of the Congressional mandate for “speedy, and inexpensive resolution of a proceeding.” 37 C.F.R. § 42.1(b), § 42.5(a) and (b); Ex.1072 at 1036:11-1039:22.

In prior proceedings, the Board has foiled the moving-target strategy employed by the PO. In IPR 2015-00559, the Board instituted two IPRs for the same patent on 4/15/2015 and 5/11/2015, respectively. 00559 Paper 44 at 3 (cited by Mot. at 3). The Patent Owner there waited until 7/2015 to request their COC. *Id.* Noting that “the parties ... prepared their papers based upon the present language of the claims,” the Board concluded that “changes to the claims at this stage could

lead to a moving target that is unfair to Petitioner given the circumstances discussed above.” *Id.* Here, the Petitioner “prepare[d] the CBM petition based on the original priority chain” and the Board instituted trial on 9/21/2016. *See* Paper 14. PO waited until 12/5/2016 to seek entry of the COC (Ex. 2008) that introduces a new priority chain involving the ‘400 application. *See* Paper 22. “To reach consistent and fair outcomes in performing its duties, the Board similarly must follow set rules and conduct its proceedings in an orderly fashion.” Ex. 1071 at 15-16 (exercising discretion to deny entry of “new evidence advanced in the Reply.”)

2. PO mischaracterized the facts and the rule

PO asserts that Petitioner mischaracterized the relevant rules by suggesting that 37 CFR 1.78 “requires the *patent owner’s* statement that the entire delay was unintentional [but] does not require personal knowledge of the patent owner’s *current counsel* who filed the petition [to request COC].” Opp’n at 4-5. (emphasis in original). PO does not point to any legal support, and Petitioner is unaware of any, for this reading. *See* 37 CFR 1.78(e)(3) (“A statement that the entire delay between the date the benefit claim was due under paragraph (d)(3) of this section and the date the benefit claim was filed was unintentional.”) Indeed, in the instant case, with respect to this COC, the Office recognized the need for information from sources other than *current counsel* to determine whether the delay was unintentional. Ex. 2005 at 4-5 (“the entire delay...was not unintentional if Law Firm 1,

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