

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 CBM2016-00064
Patent 8,266,432

PETITIONER'S MOTION FOR OBSERVATIONS

Petitioner submits the following observations regarding the March 28, 2017, cross-examination testimony of Petitioner's Reply declarant, Dr. Seth Nielson.

1. In Ex. 2014, Deposition Transcript of Seth Nielson, Ph.D., on page 146, line 3 to page 152, line 6, Dr. Nielson testified:

Q. You've been handed what's been marked as Exhibit 10. What is this document?

A. It appears to be patent owner response identified CBM2016-00064.

Q. And what is Exhibit 2?

A. So it says that it's patent owners' response, identified CBM2016-00063.

...

Q. Okay, thank you. Dr. Nielson, based on the differences that you identified between Exhibits 2 and Exhibits 10, do any of those differences change your opinions set forth in your declarations -- in your declaration, which is marked as Exhibit 1?

A. No.

This testimony is relevant to the two substantially identical Patent Owner's Responses, considered by Dr. Nielson, and whether they fail to establish that either the '676 or the '129 provide written description support for the claims of the '432

2. In Ex. 2014, on page 152, line 7 to page 153, line 2, Dr. Nielson testified:

Q. Now turning to Exhibit 1, you were asked some questions earlier regarding whether or not you agreed with patent owner if you did not address a point raised by patent owner in its patent owner response...

...

Q. If you could turn to paragraph 19 of your declaration, which is on page 9 of 52 of Exhibit 1, and please read that into the record.

A. "I have not set forth an opinion about each and every statement in either patent owners' response or Dr. Weaver's declaration. Nevertheless, I explicitly disclaim endorsement for any opinion not specifically addressed herein."

Q. Do you wish to change anything that you've stated in paragraph 19?

A. No.

This testimony is relevant to the mapping of claim terms stated in Appendices 1 and 2 of the Patent Owner's Responses and to the arguments on pages 2-27, Appendix 1, and Appendix 2 of the Patent Owner's Responses

3. In Ex. 2014, on page 38, lines 1 to 12, Dr. Nielson testified:

Q. So given that the '837 patent was originally filed in 2001, the '837 patent is the grandparent of the '432 patent, and the '837 patent has the same exact specification and figures as the '432 patent, would you conclude that the '837 patent

is a single parent application whose original disclosure supports each -- the entire disclosure of the '432 patent?

...

A. So I would say no based on the legal principles as I understand them.

This testimony is relevant to whether the application for the '837 Patent provides written description support for the subject matter claimed by the '432 Patent

4. In Ex. 2014, on page 64, lines 3 to 15; page 65, lines 3 to 21; page 74, line 19 to page 75, line 10, Dr. Nielson testified (emphasis added):

Q. Can you show me an example of that in your declaration please?

...

*A. ...I set forth that conclusion that **user** as disclosed and **claimed in the '432 patent** is broader than **individual as disclosed in the '129 patent**, and the '129 patent therefore does not provide sufficient written description support.*

...

Q. So in the entire section A, do you mention what a POSITA would consider reasonable?

...

*A. As I set forth in the beginning principles, yes. I didn't -- I put those there to describe the principles that I used throughout, and where I thought it was helpful, I emphasized one or another throughout the report, but **all of the principles are applied in my analysis.***

Q. They're applied but they're not written in your analysis, correct?

...

*A. So this is my analysis section, but **in the opinions I set forth, they're all based on these legal principles** as I've been given them. That's why they're included in the report.*

...

Q. But as we previously discussed, merely asserting that a term is broader than its corresponding disclosure is not sufficient by itself to establish lack of written description support, correct?

...

*A. The key thing here is that **the trusted relationship** is an important part of how the -- the '129 patent is set forth. The trusted relationship is a -- is not a minor part of the disclosure. **Somebody of skill in the art looking at the '129 patent is not going to reasonably conclude that that describes the user who does not have to have that trusted relationship.***

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