

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 RESPONSE TO PATENT OWNER'S MOTION FOR
OBSERVATION REGARDING CROSS EXAMINATION OF REPLY
WITNESS DR. SETH NIELSON**

Petitioner submits the following response to Patent Owner's ("PO") observations regarding the March 28, 2017, cross-examination testimony of Petitioner's Reply declarant, Dr. Seth Nielson.

I. RESPONSE TO OBSERVATION 1

PO's Observation, with emphasis, mischaracterizes Dr. Nielson's testimony and the positions outlined in Dr. Nielson's Declaration, and omits relevant testimony. As made clear later in the deposition testimony, Patent Owner's Responses were substantively identical, and Dr. Nielson considered the entirety of Patent Owner's Responses and Dr. Weaver's Declaration in forming his opinions. *See, e.g.,* Ex. 2014, 146:3-152:6; USAA-1054, ¶¶ 4-5. Thus, Dr. Nielson's analysis was properly focused on responding to the technical aspects of Patent Owner's Responses and Dr. Weaver's Declaration. Contrary to PO's contentions, the cited portion of Dr. Nielson's testimony is not relevant to whether the specification of the '129 patent or the specification of the '676 patent describe the subject matter claimed in the '432 patent in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of, as of the earliest filing date of the application relied on, the specific claimed subject matter in view of the claim constructions, arguments, or mappings of claim features asserted in the PO's Responses.

II. RESPONSE TO OBSERVATION 2

Similar to Observation 1, PO's Observation, with emphasis, mischaracterizes Dr. Nielson's testimony and the positions outlined in Dr. Nielson's Declaration, and omits relevant testimony. As made clear later in the deposition testimony, Patent Owner's Responses were substantively identical, and Dr. Nielson considered the entirety of Patent Owner's Responses and Dr. Weaver's Declaration in forming his opinions. See, e.g., Ex. 2014, 146:3-152:6; USAA 1054, ¶¶ 4-5. Thus, Dr. Nielson's analysis was properly focused on responding to the technical aspects of Patent Owner's Responses and Dr. Weaver's Declaration. The cited portion of Dr. Nielson's testimony is completely unrelated and irrelevant to the credibility of Dr. Nielson's Declaration, in which it clearly sets forth that he considered the technical issues set forth in PO's Responses in each matter, as well as the opinions set forth in Dr. Weaver's Declaration. See, USAA 1054, ¶¶ 4-5.

III. RESPONSE TO OBSERVATION 3

PO's Observation, with emphasis, is immaterial to any potential conclusions regarding what a person of ordinary skill in the art would reasonably conclude because Dr. Nielson merely stated that he did not remember, in response to the question. Again, as made clear later in the deposition testimony and in Dr. Nielson's Declaration, Dr. Nielson considered the entirety of Patent Owner's Responses,

which includes Appendices 1 and 2, and Dr. Weaver's Declaration in forming his opinions. See, e.g., Ex. 2014, 146:3-152:6; USAA 1054, ¶¶ 4-5.

IV. RESPONSE TO OBSERVATION 4

PO's Observation is irrelevant to the technical analysis and conclusions that Dr. Nielson provided in his Declaration. Dr. Nielson is neither a patent attorney, nor an expert in patent law. His legal understanding of the term "co-pending" is irrelevant to his technical opinions and whether the application that issued as the '837 patent was not actually co-pending with the application that issued as the '432 patent, so as to not be entitled to claim the benefit of priority pursuant to 35 U.S.C. § 120.

V. RESPONSE TO OBSERVATION 5

PO's Observation is irrelevant to the technical analysis and conclusions that Dr. Nielson provided in his Declaration because Dr. Nielson merely stated that he had not done the analysis as to whether the '837 patent provides sufficient disclosure supporting each and every claim limitation of the '432 patent. Thus, contrary to PO's contention, the cited portion of Dr. Nielson testimony is entirely irrelevant to whether the application that issued as the '837 patent provides written description support for the limitations of the '432 patent's claims. Moreover, PO's Observation mischaracterizes the legal requirement as "whether the inventors had possession of the subject matter *disclosed* in the '432 patent *when it was filed*," rather

than the subject matter *claimed* in the '432 patent at the time of the earliest date to which priority is claimed.

VI. RESPONSE TO OBSERVATION 6

PO's Observation, with emphasis, mischaracterizes Dr. Nielson's testimony and is irrelevant to the technical analysis and conclusions that Dr. Nielson provided in his Declaration. Dr. Nielson is neither a patent attorney, nor an expert in patent law. As he states in his testimony, Dr. Nielson's technical analysis and conclusions based on that analysis use "a set of foundation principles," and in particular, use "legal principles that have been provided." Ex. 2014, 56:17-57:8. The cited portion of Dr. Nielson's testimony is immaterial to any potential conclusions regarding whether the '837 patent fails to provide supporting disclosure that establishes the PO had actual possession of the subject matter claimed in the '432 Patent at the time of the earliest date to which priority is claimed and what a person of ordinary skill in the art would reasonably conclude because Dr. Nielson merely stated that he is not a lawyer and he is not making legal opinions, but rather has conducted a technical analysis based on provided legal principles. *Id.*

VII. RESPONSE TO OBSERVATION 7

PO's Observation, with emphasis, mischaracterizes Dr. Nielson's testimony and is irrelevant to the technical analysis and conclusions that Dr. Nielson provided in his Declaration. Specifically, the hypothetical proposed in the question does not

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