

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 NOTICE OF OBJECTIONS TO EVIDENCE

UNDER 37 C.F.R. § 42.64(b)(1)

Pursuant to 37 C.F.R. § 42.64(b)(1), Petitioner, United Services Automobile Association, (“Petitioner”), hereby submits its notice of objections to evidence that Patent Owner, NADER ASGHARI-KAMRANI and KAMRAN ASGHARI-KAMRANI, submitted as Patent Owner’s Exhibits 2008 and 2010 on 12/5/2016. Petitioner objects to Exhibit 2008 (Certificate of Correction) in its entirety on grounds of prejudice, confusion, and waste of time (FRE 403), relevancy (FRE 401 and 402), foundation and personal knowledge (FRE 602 and 701), and hearsay not subject to any exceptions (FRE 801). Petitioner further objects to Section VII, paragraphs 41 to 61 of Exhibit 2010 (Declaration of Alfred Weaver) on grounds of prejudice, confusion, and waste of time (FRE 403), and relevancy (FRE 401 and 402).

The following chart tabulates Petitioner’s objections to Exhibit 2008.

FRE 403:	Petitioner objects to Exhibit 2008 under FRE 403 on grounds of unfair prejudice, confusion of issues, and undue delay. This Exhibit was served on the Petitioner on 12/5/2016, more than two months after the Board had instituted the current CBM Review (CBMR). To the extent that
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Patent Owner (PO) argues that this filing was authorized by the Board, an issued that remains unclear¹, PO essentially seeks a new chain of priority (i.e., the chain that includes application No. 11/333,400 (the ‘400 application), now Pat. No. 8,281,129) so that even if the original priority chain (i.e., the chain that includes application No. 11/239,048, now Pat. No. 7,444,676) fails, the challenged claims may still be supported by the new priority chain. The entry of this Exhibit leads to a moving target for the instant proceeding that is unduly prejudicial to the Petitioner who had incurred great expenses in preparing the CBM Petition based on the original priority chain, which is all that is included on the face of the

¹ See Paper 10 at 9 (“FURTHER ORDERED that when a *decision* is rendered on any request for certificate of correction and petition filed by Patent Owner, Patent Owner shall file a copy of *the document* as an exhibit in the instant proceedings.”). (emphases added). Pursuant to this order, PO had already filed Exhibit 2005 (Decision to Dismiss Petition under 37 C.F.R. 1.78(c) and 1.78(e) to Request a Certificate of Correction and to Accept an Unintentionally Delayed Benefit Claim) and Exhibit 2006 (Decision to Grant a Renewed Petition under 37 C.F.R. 1.78(c) and 1.78(e) to Request a Certificate of Correction and to Accept an Unintentionally Delayed Benefit Claim).

'432 Patent. PO, on the other hand, had ample notice of amending its priority claim.² Indeed, Petitioner even alerted PO of the priority defect on 2/8/2016, long before the instant CBMR Petition was filed, and *specifically* advised PO that it intended to file a petition relying on the present priority chain, yet PO failed to add priority to the '400 application. *See* USAA-1046.³ In addition, by signing and filing a non-publication request (NPR) for the '400 application, PO admitted that the

² The prosecution record of the '432 Patent indicates that, on 12/12/2011, PO terminally disclaimed Application No. 11/333,400 (the '400 application) to the application for the '432 Patent. Even if PO had no knowledge of its own '400 application while filing for the '432 Patent, the double-patenting rejection put the PO on notice of the existence of both the '400 application and the potential relationship to the application under examination. Yet, PO chose to file the terminal disclaimer in the '400 application without amending the priority statement in the application for the '432 Patent.

³ PO filed a Request for Certificate of Correction to the '432 Patent on 2/22/16 that only sought to change the original claim to priority from a "continuation" to a "continuation-in-part", without seeking to add a priority claim to the '400 application.

	<p>'400 application discloses a different invention than the Grandparent; and thus, PO has expressly disclaimed the existence of priority extending through the '400 application and confirmed that the failure to claim priority was intentional. <i>See</i> USAA-1047</p> <p>This attempted entry of Exhibit 2008 would also require additional fact finding by the Board who had instituted the current CBMR, thereby leading to a slow-down 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). If the challenged claims are only supported by the new priority chain, allowing PO to amend priority chain <i>ex post facto</i> would be unfairly prejudicial as PO would have a free pass to torpedo a proceeding with new evidence after it has been instituted. <i>See e.g.</i>, IPR 2015-00559, Paper 44 (denying PO’s motion for Filing a Request for Certificate of Correction after institution on grounds of prejudice). If the claims are indeed supported by the original priority chain, PO is not disadvantaged in the absence of the new priority chain for the purpose of the instant proceeding; while Petitioner is greatly prejudiced by the introduction of such new evidence at this late timing.</p>
FRE 401 and 402:	Petitioner objects to Exhibit 2008 under FRE 401 and 402 for being irrelevant. The Petitioner prepared the CBM petition and the Board

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