

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
VISA INC., and VISA U.S.A. INC.,

Petitioners,

v.

UNIVERSAL SECURE REGISTRY, LLC,
Patent Owner.

Case CBM2018-00025

U.S. Patent No. 8,577,813¹

**PETITIONER APPLE INC.'S OPPOSITION TO PATENT OWNER'S
MOTION TO STRIKE**

¹ Visa Inc. and Visa U.S.A. Inc., which filed a petition in CBM2019-00026, have been joined as a party to this proceeding.

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I. INTRODUCTION

Patent Owner's motion to strike should be denied because the Juels Declaration (Ex. 1126) directly responds to the Jakobsson Declaration (Ex. 2013) regarding a prior art patent on which Dr. Juels and Dr. Jakobsson are co-inventors. Petitioner Apple had no reason to submit the Juels Declaration with its petition because it could not have anticipated that Dr. Jakobsson would submit a declaration that interprets the prior art WO 2004/051585 publication ("585 reference") in a manner inconsistent with its disclosure. It is permissible rebuttal evidence.²

Indeed, the Federal Circuit and the Board have consistently found that rebuttal evidence like the Juels Declaration is appropriate on reply, especially where, as here, the Patent Owner was offered the opportunity to take a deposition concerning the declaration it now seeks to strike and where the Patent Owner still has a full opportunity to respond.

² This motion is one of four virtually-identical motions filed in CBM2018-00024 (Paper No. 35), IPR2018-00809 (Paper No. 36), and IPR2018-00813 (Paper No. 34).

II. ARGUMENT

A. **Dr. Juels' Declaration Is Permissible Because It Directly Responds to Arguments Made by Dr. Jakobsson.**

It is well settled that expert declarations are permitted on reply where, as here, the declarations respond to arguments made by the patent owner or its expert. “[T]he petitioner in an inter partes review proceeding may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner” *Anacor Pharm., Inc. v. Iancu*, 889 F.3d 1372, 1380-81 (Fed. Cir. 2018); *see also Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1078 (Fed. Cir. 2015) (holding that a reply declaration that fairly responds to arguments made by patent owner’s expert was permissible on reply); *Square, Inc. v. Unwired Planet, LLC*, Case No. CBM2014-00156, Paper No. 40, 2015 Pat. App. LEXIS 12583, at *54 (PTAB Dec. 22, 2015) (same); *Hughes Network Systems, LLC v. California Institute of Technology*, Case No. IPR2015-00059, Paper No. 42, 2016 Pat. App. LEXIS 1867, at *51 (PTAB Apr. 21, 2016) (allowing Petitioner’s reply because “[t]he submission of rebuttal evidence with Petitioner’s reply is both permitted and customary”).

The Federal Circuit’s opinion in *Belden Inc. v. Berk-Tek LLC* is instructive. In *Belden*, the petitioner submitted an expert declaration with its reply to rebut arguments made by the patent owner’s expert. The patent owner moved to exclude that declaration, arguing that it was not permissible on reply, and that there was no

fair opportunity respond. 805 F.3d at 1077-1078. The Board denied the motion, and the Federal Circuit affirmed. *Id.* at 1078. In affirming, the Federal Circuit explained that “[e]ach of the points that Mr. Baxter made in his declaration responds to a statement made in Mr. Clark’s declaration,” and concluded that “Mr. Baxter’s declaration fairly responds only to arguments made in Mr. Clark’s declaration and Belden’s response.” *Id.* at 1078. The Federal Circuit also rejected the patent owner’s contention that it had no opportunity to respond, noting that there are “multiple ways” to respond, including by cross-examining the expert, submitting a surreply, or by disputing the substance of the declaration at oral hearing. *Id.* at 1081.³

Here, the Juels Declaration responds directly to the Jakobsson Declaration. Dr. Juels begins his declaration by explaining: “I submit this Declaration to respond to the statements and opinions provided by Markus Jakobsson, my co-inventor on the ’585 reference and Patent Owner’s expert witness.” Ex. 1126 ¶ 2. Each of the points Dr. Juels made in his declaration thereafter responds to a

³ The August 2018 Trial Practice Guide—which Patent Owner cites repeatedly in its motion—specifically references *Belden* when instructing that “a petitioner may submit directly responsive rebuttal evidence in support of its reply.” *See* August 2018 Practice Guide at 14.

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