

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNOPSYS, INC.
Petitioner

v.

Patent of MENTOR GRAPHICS CORPORATION
Patent Owner

Case IPR2012-00042 (SCM)
Patent 6,240,376 B1

Mail Stop *Patent Board, PTAB*
United State Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
MOTION TO EXCLUDE DECLARATION TESTIMONY
OF DR. BRAD HUTCHINGS UNDER 37 C.F.R. §42.64(c)**

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Petitioner Synopsys, Inc. opposes Patent Owner's motion to exclude the Declaration of Dr. Brad Hutchings (SYNOPSISYS 1013) filed in support of Petitioner's Opposition to Patent Owner's Substitute Motion to Amend. Patent Owner's motion to exclude Dr. Hutchings' declaration is meritless and the Board should deny it for both procedural and substantive reasons.

First, Rule 42.64(b)(1) requires that "[o]nce a trial has been instituted, any objection must be served within five business days of service of evidence to which the objection is directed." The Board should deny Patent Owner's motion because Patent Owner failed to serve any objection to Dr. Hutchings' declaration.

Second, the Board should deny Patent Owner's motion on the merits because Dr. Hutchings' testimony is competent. Patent Owner argues that Dr. Hutchings' testimony is not competent and should be excluded because he did not separately opine on the elements of the *unamended* original claims. However, because Mentor's proposed substitute claims were contingent on the Board already having found that Gregory (SYNOPSISYS 1007) anticipates the original claims there was no need for Dr. Hutchings to separately address the unamended limitations of the original claims. Patent Owner cites no law that imposes a requirement that an expert engage in an unnecessary exercise. To the contrary, courts regularly permit experts to rely on the law of the case, a court's claim construction, a party

admission, or stipulation from an opposing party regarding one or more claim terms or elements.

I. THE BOARD SHOULD DENY PATENT OWNER'S MOTION BECAUSE THE PATENT OWNER FAILED TO OBJECT TO THE EVIDENCE IT NOW SEEKS TO EXCLUDE.

The Board should deny Patent Owner's motion to exclude Dr. Hutchings' declaration (SYNOPSIS 1013) because Patent Owner failed to object to the declaration. Rule 42.64(b)(1) requires that "[o]nce a trial has been instituted, any objection must be served within five business days of service of evidence to which the objection is directed." *See also* OPTPG at II.K ("A party wishing to challenge the admissibility of evidence must object timely to the evidence at the point it is offered and then preserve the objection by filing a motion to exclude the evidence."). Patent Owner does not dispute that it failed to comply with this rule. Mot. at 4. Neither was Patent Owner's non-compliance a mere technicality. Rather, it was a wholesale failure to serve any objections.

As when the Patent Owner ignored the Board's page limit rules by filing oversize papers without permission (*see, e.g.*, Request for Rehearing (paper 19) and Motion to Amend (paper 29)), Patent Owner believes it should be exempt from the Board's procedural rules on evidence. Patent Owner argues that it would be "irrational and unjust" to apply Rule 42. Mot. at 4; *see also* Mot., n.3 (requesting

“waiver of Rule 42.64(b)(1)”). To the contrary, it would be irrational and unjust to excuse Patent Owner's admitted non-compliance with the rule.

Patent Owner seeks to excuse its failure to object by arguing that it learned for the first time during cross-examination that Dr. Hutchings did not render an “opinion regarding the scope and meaning of the claim term ‘execution status’”¹ from the unamended original claims. Mot. at 2-4. Apparently, Patent Owner failed to read Dr. Hutchings' declaration where he stated that “I understand that, with the exception of claim 37, all of Mentor's proposed substitute claims are contingent on the Board finding that the corresponding original claims are anticipated by Gregory.” Dec. of Dr. Hutchings (SYNOPSIS 1013), ¶ 26. The fact that Dr. Hutchings confirmed this during his deposition does not excuse the Patent Owner's failure to file objections.²

¹ The only thing the numerous citations to Dr. Hutchings' deposition testimony on pages 6-7 of Patent Owner's motion show is that counsel for Patent Owner repeatedly asked the same question over and over again.

² Patent Owner's further excuse that it could not have acted more diligently because “it was required under the Rules to notice the deposition of Dr. Hutchings ten business days in advance of the deposition” (Mot. at 4) is a non-sequitur. Patent Owner is seeking to exclude Dr. Hutchings' declaration and a deposition was not needed to read Dr. Hutchings' declaration.

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