

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVAYA INC., DELL INC., SONY CORPORATION OF AMERICA,
and HEWLETT-PACKARD CO.

Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.

Patent Owner

CASE IPR2013-00071
U.S. Patent No. 6,218,930

Before JONI Y. CHANG, JUSTIN T. ARBES, AND GLENN J. PERRY,
Administrative Patent Judges

PETITIONER AVAYA INC.'S MOTION TO EXCLUDE EVIDENCE

Since the inception of trial Patent Owner has attempted to circumvent the Board's strict page limits by improperly interjecting attorney argument into the record via its expert declarations. In the most recent (and egregious) example, Patent Owner submitted a 56-page second declaration (plus Appendix) from its expert, Dr. James Knox ("Knox"), in support of its 5-page reply. *Compare* Second Declaration of James Knox (Exhibit N1-2024) ("Second Declaration") *with* Reply to Opposition to Motion to Amend (Paper 65) ("Reply Brief"). Whole sections of attorney argument are made in the Second Declaration, but utterly absent in the Reply Brief.

Patent Owner uses its technical expert as a mouthpiece to "testify" on a mishmash of topics, including United States patent law, the beliefs of prior adverse parties, and the cost-effectiveness of *inter partes* proceedings compared to district court litigation. Indeed, if you strip away the perfunctory introductory statements of "It is my understanding ..." or "I understand that ...", then the expert Second Declaration reads almost exactly as a legal brief that could have been written by Patent Owner's counsel.

To condone Patent Owner's tactics would set a policy incentivizing future parties to cram arguments *ad infinitum* into expert declarations, irrespective of the brief itself or an expert's field of expertise. Such bloated declarations would place an undue burden on this Board to parse out and digest. Once entered into the

record, they would also create a confusing and ambiguous record for future courts (including the Federal Circuit on any appeal) to understand what this Board did (and did not) actually consider.

In addition to these policy concerns, nearly half of the Second Declaration—60 of the 117 paragraphs of Exhibit N1-2024—constitutes inadmissible evidence, and should be excluded:

- Fifty-seven (57) paragraphs (¶¶ 227–231, 241–249, 259, 260, 267–291, 298–302, 315, 316, and 327–335) (“Irrelevant Arguments”) are not even cited by Patent Owner in its Reply Brief, and are inadmissible under Federal Rule of Evidence 401;
- Eleven (11) paragraphs (¶¶ 230–232, 242–245, 300, 310, 315, and 335) (“Patent Law Testimony”) consist of improper testimony on United States patent law, and are inadmissible under Federal Rule of Evidence 702 and 37 C.F.R. § 42.65(a);
- Four (4) paragraphs (¶¶ 331–334) (“District Court Litigation Arguments”) consist of testimony on the purported efficient and cost-effective alternatives to district court litigation, and are inadmissible under Federal Rules of Evidence 702 (Patent Owner’s technical expert is not qualified to express an opinion about such topics), 401 (irrelevance, as noted above), and 602 (lack of personal knowledge);

- Paragraph 328 includes speculative testimony regarding what defendants in a prior litigation “focused” or “believed” to be the closest prior art. Under Federal Rule of Evidence 602, it is inadmissible testimony outside the scope of the Patent Owner’s technical expert’s personal knowledge; and
- Paragraph 326 constitutes testimony concerning the purported view of those skilled in the art with respect to the De Nicolo system, and is inadmissible under Federal Rules of Evidence 801 and 802 (hearsay) and 602 (lack of personal knowledge).

Because of Patent Owner’s pattern and practice of using its expert’s declarations as a “dumping grounds” for inadmissible arguments that it could not fit into its five-page reply, for example, Petitioner Avaya Inc. (“Avaya”) moves to exclude the Second Declaration (Exhibit N1-2024) in its entirety pursuant to 37 C.F.R. §42.64(c). Alternatively, Avaya moves to exclude the above-referenced paragraphs. Avaya raised all of the above-listed bases in objections it timely served on Patent Owner on November 21, 2013 (Avaya’s Objections to Evidence, Paper 72).

Because the excessive length of the Second Declaration makes it impossible to address each excludable paragraph individually, Avaya has grouped its arguments in Sections I-IV below based on the above bullet point categories.

I. THE IRRELEVANT ARGUMENTS

The Irrelevant Arguments constitute nearly half of the paragraphs of Exhibit N1-2024. None are cited in the in the body of its Reply Brief or otherwise relied upon by Patent Owner, and each paragraph should be excluded as irrelevant. *See* Fed. R. Evid. 401.

Relevant evidence is evidence “having any tendency to make the existence of any *fact that is of consequence* to the determination of the action more probable or less probable than it would be without the evidence,” and all evidence that is irrelevant is inadmissible. Fed. R. Evid. 401, 402 (emphasis added). In filing its motion to amend and Reply Brief, however, Patent Owner was required to provide a “full statement of the reasons for relief.” 37 C.F.R. § 42.22(a)(2) (specifying contents for motions); 37 C.F.R. § 42.23(a) (requiring replies to “comply with the content requirements for motions”). The Irrelevant Arguments—because they are not cited in the motion to amend or Reply Brief—cannot constitute Patent Owner’s “reasons for relief.” Accordingly, the Irrelevant Arguments fall far short of qualifying as facts “of consequence,” must therefore be irrelevant, and should be excluded.

Certain examples of irrelevant arguments include:

Woodmas. In its Reply Brief, Patent Owner makes only one argument on what Woodmas does or does not disclose—whether it discloses the “determining”

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