

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sipnet EU S.R.O.,

Petitioner

v.

Straight Path IP Group, Inc.,

Patent Owner

Case No. IPR2013-00246

U.S. Patent No. 6,108,704

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE UNDER 37 C.F.R. 42.64(c)

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INTRODUCTION

Patent Owner premises its motion to exclude on faulty legal arguments and incomplete and/or inaccurate characterizations of the evidence in the record. Patent Owner apparently concedes that WINS (Ex. 1004) has been properly authenticated and is not hearsay, and instead argues for exclusion of WINS because it “cannot be considered prior art.” Patent Owner’s exclusion arguments are faulty. First of all, WINS on its face states “For Distribution Only With a New PC” and lists the 1994 date, which is before the critical date. Moreover, Patent Owner has failed to challenge the authenticity of WINS or produce any evidence whatsoever tending to show that the 1994 date printed on WINS is not the date of its first public availability. On the other hand, Petitioner has produced multiple exhibits and testimony all corroborating the fact the WINS was publicly available in 1994 and, is therefore valid prior art.

Patent Owner’s attack on various sections in Antonov Declaration is also without merit because Mr. Antonov’s testimony is not limited to anticipation and because the Motion to Exclude is not a proper vehicle for challenging the scope of the evidence submitted with the Reply. Finally, the remaining Patent Owner’s exclusion requests should likewise be rejected. Patent Owner’s motion to exclude should therefore be denied in its entirety.

ARGUMENT

A. WINS Should Not Be Excluded

WINS clearly meets the Federal Circuit's requirements for a printed publication to qualify as prior art. In *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986) the Federal Circuit concluded that "a single cataloged thesis in one university library" constitutes "sufficient accessibility to those interested in the art exercising reasonable diligence." *Id.* at 900. Thereafter, *Constant v. Advanced Micro-Devices, Inc.* explained that "[a]ccessibility goes to the issue of whether interested members of the relevant public could obtain the information if they wanted to." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988). Therefore, "[i]f accessibility is proved, there is no requirement to show that particular members of the public actually received the information." *Id.*

WINS on its face carries a 1994 copyright date and conspicuously states "For Distribution Only With a New PC". This itself is evidence of WINS' public availability before the critical date. In fact, the Board has a long practice of admitting publications, such as WINS, in other proceedings and relying solely on their copyright or posting date as the date of publication. See, e.g., *Ex parte*

Broyles, Appeal 2009-010197, 2012 WL 359584, at * 2-4 (BPAI Jan. 30, 2012) (affirming examiner's reliance on copyright date as date of publication); Ex parte Molander, Appeal 2008-2589, 2009 WL 726751, at *5 (BPAI Mar. 17, 2009) (affirming examiner's admission of and reliance on prior art reference as being publically available on the date imbedded in reference's URL).

Second, Patent Owner has failed to introduce any evidence that calls into question the public availability date of WINS, as printed on WINS itself, as well as the numerous corroborating declarations and exhibits produced by Petitioner. Thus, the fact that WINS on its face carries the evidence of the 1994 publication date, which has not been contradicted by any contrary evidence of the Patent Owner, compels the conclusion that WINS should not be excluded for this reason alone.

Third, to the extent that Patent Owner argues that such evidence is not sufficient to establish the public availability of WINS before the critical date, sufficiency of the evidence is not a ground for a motion to exclude, see 77 Fed. Reg. 48767. This provides an additional reason for refusing to exclude WINS.

Fourth, Petitioner has produced a declaration of Yuri Kolesnikov, a computer industry veteran who testified that in the fall of 1994 he observed

multiple server packages that included a printed copy of the Windows TCP/IP Guide, which is exactly identical to WINS with exactly the same copyright notice. The Federal Circuit's reasoning and conclusions in two recent cases is instructive on this point. In *In re Enhanced Security Research, LLC*, No. 13-1114 (Fed. Cir. Jan. 13, 2014), under similar factual circumstances, Federal Circuit held that even "relatively obscure documents qualify as prior art so long as the public has a means of accessing them." *Id.* at 13 (*citing In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986)), and proceeded to conclude that the subject reference qualified as a prior art. The same conclusion was reached by the Federal Circuit in *Suffolk Technologies, LLC v. Aol Inc.* 13-1392 (Fed. Cir. May 27, 2014). In the present case, the public availability of WINS before the critical date is established by the 1994 date on WINS itself, as well as corroborating declarations and exhibits produced by Petitioner. Therefore, there is substantial evidence that WINS qualifies as a prior art and the request to exclude this reference should be denied.

Finally, Patent Owner's contention that the Yuri Guide is substantially different from WINS and, therefore, fails to support the public availability of WINS is also without merit. Patent Owner's repeated assertion that there are

over 10,000 differences between WINS and Yuri Guide is highly misleading. The relationship between WINS and the Yuri Guide and the process of comparing the two documents is clearly set forth in the Declaration of Leslie Ehrlich, and a visual inspection of the two documents in conjunction with Ms. Ehrlich's Declaration and deposition testimony readily explain the differences: they arose from technical optical character recognition (OCR) errors that occurred during the scanning and OCR processing of the Yuri Guide, the presence of the metadata in the CD-ROM version, as well as the absence of the page numbers in the CD-ROM. Ex. 1018, Ehrlich Declaration and Ex. 2044, Ehrlich Dep. at 11:15-12:10, 16:14-24, 19:3-20:10, 21:8-22:24. On the other hand, Patent Owner has failed to point to any differences whatsoever that are material to the Petitioner's invalidity arguments or to assert that any disclosure relied upon by the Petitioner in its invalidity position is missing from the Yuri Guide. Thus, for purposes of this proceeding, the Yuri Guide is substantially identical to WINS and, therefore, clearly establishes the public availability of WINS before the critical date. Ex. 1004, WINS.

For the foregoing reasons, Patent Owner's request to exclude WINS should be denied.

B. The Antonov Declaration Should Not Be Excluded

Patent Owner's attack on the Antonov Declaration rests on two flawed premises. First, that Antonov, whose declaration was provided as that of a technical expert, is not permitted to employ his technical knowledge in testifying as to technical matters in this proceeding. Second, that Antonov's technical testimony and accompanying conclusions would foreclose any ability by Patent Owner to challenge such testimony or conclusions.

Patent Owner attempts to argue for the exclusion of Antonov's Declaration on the ground that Antonov's prior experience with WINS product is not part of the record. Petitioner notes that according to Patent Owner's argument, the Declaration of Patent Owner's own expert must also be excluded, as it states (Ex. 1023 ¶ 12):

12. My opinions are also based upon my education, training, research, knowledge, and experience in this technical field.

Clearly, Patent Owner's expert's "education, training, research, knowledge, and experience in this technical field" are not part of the record in this proceeding just as with the prior experience of any expert.

This argument of course lacks any plausible merit. Antonov is a technical and not a legal expert who was retained for his technical knowledge of the state of the art. It is well known that the Patent and Trademark Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827, 1830] (Fed. Cir. 2004). Therefore, Antonov’s prior technical experience in the field is critical to his ability to determine the scope of the claim language “as it would be interpreted by one of ordinary skill in the art.”

Secondly, any specific conclusions contained in Antonov’s Declaration regarding invalidity of the claims clearly set forth the basis for such conclusions., Patent Owner therefore can challenge any specific conclusions or the basis therefor on a case-by-case basis rather than unjustifiably attempt to exclude the entire Antonov Declaration because expert’s prior experience is “not part of the record”.

With respect to Patent Owner’s argument that specific paragraphs of Antonov’s Declaration are not supported by required references or do not include

necessary citations or claim charts, Petitioner submits that this is not a ground for exclusion of the Antonov's Declaration. The deficiencies alleged by the Patent Owner at best may reflect on the weight accorded any specific expert conclusions, and can be substantively addressed by Patent Owner on a case-by-case basis. 77 Fed. Reg. 48767.

Therefore, for all the foregoing reasons, the Antonov Declaration should not be excluded.

C. Petitioner's Other Evidence Relating to Contentions Should Not Be Excluded

Patent Owner proceeds to request exclusion of Section IX-X of Antonov's Declaration (Ex. 1023) on a ground that they relate to anticipation of the claims 33-37. This request must be again denied. Section IX of Antonov's Declaration is entitled "Dynamic Process Addresses: Not a Limitation" and makes no reference to anticipation at all. Thus, Petitioner is at a loss as to the reasons for Patent Owner's request, which appears to be entirely lacking any merit with respect to this Section.

Section X is entitled "Dynamic Addressing of Processing Units" and contains much explanation of the underlying technical concepts as well as the teachings of the '704 patent related thereto. The term anticipation appears in

only a couple of places within this large section and appears to have been used by Mr. Antonov loosely to refer to a teaching of a specific feature. The mere presence of a loosely used term is not a ground to exclude an otherwise relevant section containing extensive technical explanation.

Patent Owner selectively provides Mr. Antonov's deposition testimony in support of its position. However, Mr. Antonov, in the remainder of the very same deposition answer provided by Patent Owner, went on to state that he was somewhat confused by the legalese:

[Q.] Your declaration -- your opinions in this declaration are limited to an opinion that the claims at issue are anticipated by the prior art, is that correct?

A. Yes, that is correct. But -- yeah, that is substantially correct, plus I wanted to state that the differences between anticipated art and what is described in patent are mostly in -- are terminological and not substantial, and that is obvious.

So maybe I'm confusing the legal issue of obvious.

Ex. 2045, Antonov Dep. At 32:11-22. Thus, for the the foregoing reasons, Section IX-X of Antonov's Declaration should not be excluded.

Patent Owner's next argument that Sections VIII-X of the Antonov Declaration should be excluded because they allegedly present new arguments or exceed the scope of the Petitioner's arguments in the Reply should also be rejected. It is well known to practitioners before this Board that a "motion to exclude evidence is not intended as the vehicle for use by a party to raise the issue of a reply exceeding the proper scope of a reply, or reply evidence exceeding the proper scope of reply evidence, in the sense of going beyond what reasonably can be deemed as responding to an opposition," see IPR2013-00346, Paper No. 19 at 3 (January 2, 2014). Here, Patent Owner attempts to make the exact use of the Motion to Exclude that has been expressly prohibited by the Board. For this reason, Patent Owner's request to exclude Sections VIII-X of the Antonov's Declaration should also be rejected.

Finally, Patent Owner's request to exclude the Yuri Guide should also be denied. Patent Owner bases this request on the same faulty notion that the Yuri Guide has over 10,000 differences from WINS. However, as explained above, the Yuri Guide is in all relevant aspects, the same as WINS. Differences arise from OCR errors, CD-ROM metadata and page numbering. Thus, the Yuri Guide is clearly relevant at least to establishing the public availability of WINS.

For this reason, the Yuri Guide is not outside the scope of this proceeding and should not be excluded.

D. Exhibits 1005 and 1020-21 Should Not Be Excluded

With respect to Exhibits 1005 and 1020-21, Patent Owner has failed to provide any specific arguments that would support the exclusion of those exhibits. Patent Owner simply states that the aforesaid exhibits should be excluded because they are irrelevant and unreliable.

Contrary to Patent Owner's argument, electronic data and Internet-based documents are not necessarily inherently untrustworthy or inadmissible. Electronic publications distributed across the Internet are the modern-day libraries relied upon by persons skilled in the art. In fact, the Board has a long practice of admitting such publications in other proceedings and relying on their copyright or posting date as the date of publication. See, e.g., *Ex parte Broyles*, Appeal 2009-010197, 2012 WL 359584, at * 2-4 (BPAI Jan. 30, 2012) (affirming examiner's reliance on copyright date as date of publication); *Ex parte Molander*, Appeal 2008-2589, 2009 WL 726751, at *5 (BPAI Mar. 17, 2009) (affirming examiner's admission of and reliance on prior art reference as being publically

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available on the date imbedded in reference's URL). Therefore, Exhibits 1005 and 1020-21 should not be excluded.

CONCLUSION

For these reasons, Patent Owner's Motion to Exclude should be denied in its entirety.

Respectfully Submitted,

Dated: June 20, 2014

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE UNDER 37 C.F.R. 42.64(c) was served, by agreement of the parties, by electronic mail on counsel for the Patent Owner on June 20, 2014 as follows:

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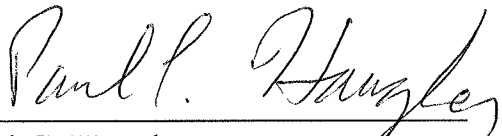
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of

PETITIONER'S LIST OF ISSUES FOR ORAL ARGUMENT

PURSUANT TO 37 C.F.R. §42.70

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE UNDER 37 C.F.R. 42.64(c)

PETITIONER'S RESPONSE TO PATENT OWNER'S OBSERVATION
ON CROSS-EXAMINATION OF PETITIONER'S DECLARANT
LESLIE EHRLICH

PETITIONER'S RESPONSE TO PATENT OWNER'S OBSERVATION
ON CROSS-EXAMINATION OF PETITIONER'S DECLARANT
YURI KOLESNIKOV

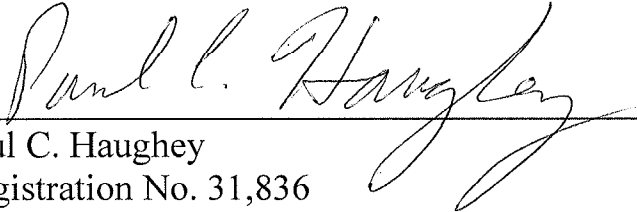
PETITIONER'S RESPONSE TO PATENT OWNER'S OBSERVATION
ON CROSS-EXAMINATION OF PETITIONER'S DECLARANT
VADIM ANTONOV

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have been served, by agreement of the parties, by electronic mail on counsel for
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