

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIPNET EU S.R.O.  
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.  
Patent Owner.

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Case IPR2013-00246  
Patent 6,108,704

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Before KALYAN K. DESHPANDE, THOMAS L. GIANNETTI, and  
TRENTON A. WARD, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

ORDER  
Motion to Exclude

## I. PATENT OWNER'S MOTION TO EXCLUDE

On June 6, 2014, Patent Owner filed a motion to exclude the following:

- (1) The WINS<sup>1</sup> reference;
- (2) Sections B, E, and F of the Declaration of Vadim Antonov (Ex. 1023);  
and
- (3) Several miscellaneous exhibits (Exs. 1005 and 1017-1021).

Paper 45 (“Mot. to Exclude”). Petitioner filed an Opposition (Paper 48, “Opp.”). For the reasons discussed below, the motion is *denied*.

The party moving to exclude evidence bears the burden of proof to establish that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence. *See* 37 C.F.R. §§ 42.20(c), 42.62(a).

The rules governing *inter partes* review set forth the proper procedure for objecting to, and moving to exclude, evidence when appropriate. When a party objects to evidence that was submitted during a preliminary proceeding, such an objection must be served within ten business days of the institution of trial. *See* 37 C.F.R. § 42.64(b)(1). Once a trial has been instituted, an objection must be served within five business days. *See id.* The objection to the evidence must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence. *Id.* This process allows the party relying on the evidence to which an objection is served timely the opportunity to correct, by serving supplemental evidence within ten business days of the service of the objection. *See* 37 C.F.R. §§ 42.64(b)(1), 42.64(b)(2). If, upon receiving the supplemental evidence, the opposing party is still of the opinion that the evidence

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<sup>1</sup> WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1004) (“WINS”).

is inadmissible, the opposing party may file a motion to exclude such evidence. 37 C.F.R. § 42.64(c).

*A. The WINS Reference (Ex. 1004)*

Patent Owner argues that WINS should be excluded because Petitioner has failed to establish that WINS was publicly available. Mot. to Exclude 2-6. Patent Owner alleges that the witness on whom Petitioner relies, Mr. Yuri Kolesnikov (*see* Ex. 1017), could not confirm that WINS was publicly available. Petitioner contends that Petitioner has submitted declarations, including that of Mr. Yuri Kolesnikov, to corroborate the public availability of WINS. Opp. 5-6.

We are not persuaded by Patent Owner that Petitioner has not established WINS was publicly available. Petitioner has provided declarations of Mr. Yuri Kolesnikov (Ex. 1017) and Ms. Leslie Ehrlich (Ex. 1018) to establish the public availability of WINS. Opp. 5–7. Mr. Kolesnikov testifies that he saw several Microsoft Windows NT 3.5 Server packages that included a print copy of WINS. Ex. 1017 ¶ 7. Mr. Kolesnikov further testifies that he purchased Windows NT 3.5 Server, which included a CD version (Ex. 1019) of the WINS reference. *Id.* ¶¶ 8–10. Patent Owner argues that Mr. Kolesnikov could not confirm whether he had previously seen WINS. Mot. to Exclude 5. We are persuaded, however, that Mr. Kolesnikov had previously seen WINS and the CD version because Mr. Kolesnikov testifies he recalls seeing printed copies of WINS during installations he did for clients in 1994, and is certain that it was 1994 because he had switched jobs in 1995. Ex. 2043, 29:1–10, 32:21–22.

Additionally, Ms. Ehrlich testifies that WINS and the CD version are substantially similar, noting differences in the glossaries and formatting only. Ex. 1018 ¶ 6. Patent Owner argues that Petitioner has relied on Ms. Ehrlich’s testimony to establish WINS was publicly available and Ms. Ehrlich has no

personal knowledge of whether WINS was ever published or made publicly available. Mot. to Exclude 4–5. We are not persuaded by this argument because Petitioner only relies on Ms. Ehrlich’s testimony to establish that WINS and the CD version are substantially similar. Opp. 7 (citing Ex. 1018; Ex. 2044, 11:15–12:10, 16:14–24, 19:3–20:10, 21:8–22:24).

Therefore, we conclude that Petitioner has established that WINS was publicly available based on Mr. Kolesnikov’s testimony that he had seen WINS and had possession of a CD version of WINS in 1994 and Ms. Ehrlich’s testimony that WINS and the CD version are substantially similar, with differences only in the glossaries and formatting. For the foregoing reasons, we deny Patent Owner’s motion to exclude WINS.

*B. The Declaration of Mr. Vadim Antonov (Ex. 1023), Sections B, E, and F of Paper 33 (Petitioner’s Reply to Patent Owner’s Response), and Several Miscellaneous Exhibits (Exs. 1005 and 1017-1021)*

Patent Owner’s Motion to Exclude seeks to exclude the Declaration of Mr. Vadim Antonov (Ex. 1023), sections B, E, and F of Paper 33 (Petitioner’s Reply to Patent Owner’s Response), and several miscellaneous exhibits (Exs. 1005 and 1017-1021). Mot. to Exclude 6-14. We are not persuaded by Patent Owner’s motion for the following reasons.

Patent Owner argues that Mr. Antonov’s declaration should be excluded because Mr. Antonov “based his opinions on software products and multiple technical documents not of record.” Mot. to Exclude 7. We are not persuaded by this argument that the declaration should be excluded. This argument goes towards the weight of the evidence rather than its admissibility. It is within the Board’s discretion to assign the appropriate weight to be accorded to evidence. *See, e.g., In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he

Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”).

Patent Owner further argues that sections B, E, and F of Paper 33 (Petitioner’s Reply to Patent Owner’s Response) should be excluded because Petitioner’s Reply references Mr. Antonov’s declaration in entirety for certain arguments. Mot. to Exclude 12-13. Patent Owner argues, for example, that section E states “NetBIOS RFC 1001 clearly states: ‘An application, representing a resource, registers one or more names that it wishes to use’ (Ex. 1003, p.378). Mr. Antonov’s Declaration, Exhibit 1023, Section VIII explains this in detail.” Mot. to Exclude 12 (quoting Paper 33, 11). Patent Owner additionally argues that section F of Paper 33 similarly incorporates section IX of the Antonov declaration and there are sections of the Antonov declaration not relied upon in Paper 33. Mot. to Exclude 12–13. Patent Owner does not provide any explanation as to why section B should be excluded. We are not persuaded by this argument because Patent Owner fails to explain why these portions of Paper 33 should be excluded. A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact. Office Patent Trial Practice Guide, 77 Fed. Reg. 48765, 48767 (Aug. 14, 2012). We are unable to discern from Patent Owner’s argument a sufficient explanation to why sections B, E, and F of Paper 33 should be excluded.

Patent Owner also argues that Exhibits 1017 and 1018, the declarations of Mr. Kolesnikov and Ms. Ehrlich, respectively, should be excluded. Mot. to Exclude 14. Patent Owner generally alleges that these declarations do not discuss the prior art of record. *Id.* As discussed above, however, Petitioner relies on these declarations to establish that WINS was publicly available, not to discuss the prior art. Furthermore, Patent Owner does not provide sufficient explanation as to why

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