

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc., Google Inc. and Motorola Mobility LLC,

Petitioners,

v.

Arendi S.A.R.L.,

Patent Owner.

Case No. IPR2014-00208

Patent No. 7,917,843

PATENT OWNER ARENDI S.A.R.L.'S

MOTION TO EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R. § 42.64

I. Statement of Relief Requested

Pursuant to 37 C.F.R. §42.64(c), the undersigned, on behalf of Patent Owner Arendi S.A.R.L. (“Arendi” or “Patent Owner”) hereby moves to exclude certain of Petitioners’ submissions in this proceeding.

The Patent Owner moves to exclude Exhibit 1013 – the transcript of the deposition of Petitioners’ expert, Daniel A. Menascé.

II. Statement of Material Fact

1. This case was instituted on June 11, 2014 pursuant to the Decision for the Institution of *Inter Partes* Review.
2. The Petitioners have previously filed a Declaration of Petitioners’ expert, Dr. Daniel A. Menascé, dated December 2, 2013, as Exhibit 1002, which Declaration addressed, among other things, the Domini reference (US patent 6,085,206) as prior art, and the knowledge of one of ordinary skill in the art.
3. The Patent Owner deposed the Petitioners’ expert, Daniel A. Menascé, on August 7, 2014.
4. Prior to the Petitioners’ November 11, 2014 Reply to Patent Owner’s Response, the Petitioners did not take any action to authorize or file a motion to submit supplemental information.

5. In their November 11, 2014 Reply to Patent Owner’s Response, the Petitioners now seek to submit the transcript of Menascé’s deposition as “Exhibit 1013.”

III. Statement of the Reason for the Relief Requested

37 C.F.R. §42.64(c) provides that a motion to exclude “must identify the objections in the record in order and must explain the objections.” The Trial Practice Guide, 77 Fed. Reg. 48756 (August 14, 2012), Section II, Part K, provides that a “motion to exclude must: (a) Identify where in the record the objection originally was made; (b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent; (c) Address objections to exhibits in numerical order; and (d) Explain each objection. 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.”

1. Evidence: Exhibit 1013 – the Transcript of the Menascé Deposition

The Petitioners’ Exhibit 1013 is the transcript of the deposition of the Petitioners’ expert, Daniel A. Menascé, dated August 7, 2014 (herein, the “Menascé Deposition”).

(a) Objection in the record:

The Patent Owner objected to the Petitioners' introduction of Exhibit 1013 (the Menascé Deposition) at page 2 of the Patent Owner Arendi S.A.R.L.'s Objections to Evidence Pursuant to 37 C.F.R. § 43.64, dated November 18, 2014 (Paper 22), which objections were timely served within 5 business days of service of the Petitioners Reply and associated exhibits.

(b) Petitioners' reliance on the evidence:

Neither the Petitioners' Reply, nor any other filing by Petitioners, makes mention of or reference to any testimony in the Menascé Deposition.

(c) Objections to exhibits:

- (i) The Patent Owner objects that the Menascé Deposition is irrelevant.
- (ii) The Patent Owner objects that Petitioners failed to comply with the requirements of 37 C.F.R. §42.123 for the submission of supplemental information as found in the Menascé Deposition.

(d) Explanation of each objection:

(i) The Menascé Deposition is irrelevant

Neither the Petitioners' Reply (except in the Exhibit List on page iii of that Reply), nor any other filing by Petitioners or by Patent Owner, makes mention of or reference to the Menascé Deposition (Exhibit 1013).

Consequently, the Menascé Deposition is not relevant.

(ii) The Petitioners failed to comply with the requirements of 37 C.F.R. §42.123 for the submission of supplemental information as found in Menascé's Deposition

The Menascé Deposition (Exhibit 1013) is not admissible because it contains supplemental information within the meaning of 37 C.F.R. § 42.123, and the Petitioners failed to submit the information in compliance with the rules at 37 C.F.R. § 42.123.

The rules at 37 C.F.R. § 42.123(a) specifies that, “[o]nce a trial has been instituted, a party may submit supplemental information only by requesting authorization to submit a motion to submit supplemental information,” and the rule at 37 C.F.R. § 42.61(a) provides that “Evidence that is not taken, sought, or filed in according with this subpart is not admissible.”

The Menascé Deposition is supplemental information because it has not been previously presented or even mentioned by Petitioners.

The Petitioners have not filed any request for authorization to file a motion to submit the information, and no authorization has been granted by the Board. For at least that reason, the Menascé Deposition (Exhibit 1013) is not admissible, and should be excluded.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.