

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEALS BOARD

BROSE NORTH AMERICA, INC.
and
BROSE FAHRZEUGTEILE GMBH & CO. KG, HALLSTADT,
Petitioners

v.

UUSI, LLC
Patent Owner

Case No. IPR2014-00416
Patent No. 8,217,612

**OPPOSITION TO PATENT OWNER UUSI, LLC'S MOTION TO
EXCLUDE PETITIONER'S EVIDENCE UNDER 37 C.F.R. § 42.64**

Patent Owner UUSI, LLC's ("UUSI") Motion to Exclude Petitioner's Evidence Under 37 C.F.R § 42.64 (the "Motion") should be denied. The request to exclude a textbook that Petitioners' expert discussed during his deposition lacks support in the law and is without merit.

UUSI's Motion asks the Board to exclude an excerpt of a textbook by Clarence deSilva entitled "Control Sensors and Actuators" (Ex. 1062), a complete color copy of the same textbook (Ex. 1063), and pages 185–193 and lines 15–18 of page 198 of the transcript of the deposition of Dr. MacCarley (Ex. 2004) during

which the deSilva textbook was discussed. Mot. at 2. UUSI also seeks to exclude “any reliance by Petitioner on these pages of this deposition testimony and/or deSilva textbook in Petitioner’s expert Declarations, briefs and argumentation.”

Id.

A. The deSilva Textbook Was Submitted To Complete The Record Of Dr. MacCarley’s Deposition

As more fully explained in Petitioners’ Opposition to UUSI’s Motion To Exclude Evidence in related proceeding IPR2014-00417, the deSilva book became pertinent when Petitioners’ expert Dr. Art MacCarley raised it at his deposition, which was conducted for purposes of both this proceeding and IPR2014-00417. Ex. 2004 at 185:3–191:4. Dr. MacCarley pointed to the deSilva textbook to, among other things, support his knowledge of the state of the art in 1989 and to refute an argument made by UUSI in its Preliminary Response in the IPR2014-00417 proceeding. *Id.* at 185:3–186:5, 188:21–191:4. After UUSI abandoned the argument made in its Preliminary Response, Petitioners did not cite the deSilva textbook (Exs. 1062 and 1063) or Dr. MacCarley’s deposition (Ex. 2004) in its Reply. Nor was the textbook cited in Dr. MacCarley’s Reply Declaration. *See* Ex. 1053.

Petitioners filed copies of the textbook (Exs. 1062 and 1063) with their Reply because, as of that time, UUSI had not filed the complete record of Dr.

MacCarley's deposition. *See* 37 C.F.R. § 42.53(f)(7) (requiring that deposition testimony "be filed by proponent as an exhibit").

B. UUSI's Argument That deSilva Raises A "New Issue" Is Not The Proper Subject Of A Motion To Exclude And UUSI States No Other Basis For Exclusion

UUSI contends that the deSilva textbook exhibits and related deposition testimony from Dr. MacCarley are "improper" on the grounds that a "reply that raises a new issue or belatedly presents evidence will not be considered and may be returned." Mot. at 3. As an initial matter, this request is not a proper use of a motion to exclude, as it is not grounded in any evidentiary rule or basis. "Motions to exclude are for *evidentiary* objections previously made on the record," and are "not a proper vehicle for use by a party to raise the issue of a reply exceeding the proper scope." *Honeywell Int'l Inc. v. Int'l Controls and Measurements Corp.*, IPR2014-00219, Paper 38 at 2 (Jan. 5, 2015) (expunging improper motion to exclude) (emphasis added).

Additionally, Petitioners did not cite Exhibits 1062, 1063, or 2004 in their Reply, nor did Dr. MacCarley cite them in his Reply Declaration. UUSI neither cites nor has any valid basis for seeking to exclude exhibits merely because they were used at Dr. MacCarley's deposition and submitted to complete the record as to his testimony. UUSI's requests to exclude Exhibits 1062 and 1063, the identified portions of Exhibit 2004, and "any reliance by Petitioner on these pages

of this deposition testimony and/or deSilva textbook” should be denied as failing to meet any applicable standard for exclusion, or as moot.

Date: April 9, 2015

Respectfully submitted,

/s/ Craig D. Leavell

Craig Leavell (Reg. No. 48505)

Luke L. Dauchot, P.C. (*pro hac vice*)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing OPPOSITION TO PATENT OWNER UUSI, LLC'S MOTION TO EXCLUDE PETITIONER'S EVIDENCE UNDER 37 C.F.R. § 42.64 was served on April 9, 2015 via electronic mail upon the following:

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