

Filed on behalf of UUSI, LLC
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UUSI, LLC
Patent Owner

Case IPR2014-00417
Patent 7,579,802

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

Pursuant to 37 C.F.R. §42.64 Patent Owner UUSI, LLC moves to exclude certain of Petitioner's submissions in this proceeding. First, Patent Owner moves to exclude Petitioner's Exhibit Nos. 1054, 1055, 1057, 1058, which are all dictionary definitions. Second, Patent Owner moves to exclude the associated Claim 1 and 14 portions of Petitioner's Exhibit 1063, the Reply Declaration of Petitioner, relying on the dictionary definitions noted above, as well as any reliance by Petitioner on these portions of Exhibit 1063. Third, Patent Owner moves to exclude Petitioner's Exhibit No. 1065, excerpts of textbook entitled "Control Sensors and Actuators" by Clarence W. deSilva. Fourth, Patent Owner moves to exclude Petitioner's Exhibit No. 1066, which is a color and more complete copy of the same deSilva textbook. Fifth, Patent Owner moves to exclude pages 185-193 and page 198 (lines 15-18) of the deposition transcript of Petitioner's alleged expert witness C. Art MacCarley of Patent Owner's Exhibit 2004, as well as any reliance by Petitioner on these pages of this deposition testimony and/or deSilva textbook in Petitioner's expert Declarations, briefs and argumentation.

I. Prior Notice of Objections

Patent Owner served its Objections to Petitioner's Exhibits 1054, 1055, 1057, 1058, 1065 and 1066, and the portions of Exhibit 1063 relying thereon, on February 12, 2015. Patent Owner also objected to Petitioner's use of these deSilva textbook exhibits in its redirect deposition questioning as shown on page 185, lines

12-15, of the MacCarley deposition transcript (Patent Owner's Exhibit 2004).

These Objections are based on the dictionary definitions and associated portions of the MacCarley Reply Declaration being irrelevant, and the deSilva textbook exhibits and the MacCarley deposition testimony regarding such, as not being timely submitted and being not responsive to Patent Owner's Response.

II. Legal Standards

Under Federal Rules of Evidence, Rule 401, evidence is relevant if (i) it has any tendency to make a fact more or less probable than it would be with the evidence and (ii) the fact is of consequence in determining the action. The noted dictionary definition exhibits, and by relying thereupon, the Claim 1 and 14 portions of MacCarley's Reply Declaration fail to meet Rule 401.

The submission of new evidence that (i) is necessary to make out a *prima facie* case of unpatentability of an original claim has been submitted with a reply or (ii) could have been presented in a prior filing indicates that a new issue has been improperly raised in the reply. See Office Patent Trial Practice Guide, 77 Fed. Reg. 157, 48767 (Aug. 14, 2012). “[A] reply that raises a new issue or belatedly presents evidence will not be considered and may be returned” as “[t]he Board will not attempt to sort proper from improper portions of the reply.” *Id.* Petitioner's use of its Exhibits 1065 and 1066, as well as the noted redirect testimony by Petitioner of its alleged expert MacCarley regarding same, are therefore improper.

III. Non-Prior Art Dictionary Definitions

Petitioner's Exhibit Nos. 1054, 1055, 1057 and 1058 are all dictionary definitions. These all were published in 1994 or 1995, and without the publication months being known. But, the priority filing date for U.S. Patent No. 7,579,802 ("802 Patent"), which is the subject of the present IPR, is April 22, 1992. All of the claims in dispute are entitled to the 1992 priority date. These dictionaries were published well after the priority filing date. Therefore, these dictionaries are not prior art and do not inform us as to what a person of ordinary skill in the art would have known on or before April 22, 1992.

Additionally, Petitioner's alleged expert witness, C. Arthur MacCarley, heavily relied upon Petitioner's Exhibits 1054, 1055, 1057 and 1058 in forming his opinions in his voluminous Reply Declaration of Petitioner's Exhibit No. 1063. See Petitioner's Exhibit 1063, paragraph nos. 36 and 116, by way of example but not limitation (Exhibit 1063, pages 20 and 83, respectively). These dictionary definitions are being used to support MacCarley's opinions regarding Claims 1 and 14 of the '802 patent.

The dictionary definition Exhibits 1054, 1055, 1057 and 1058 are irrelevant under FRE Rule 401. Since the Claim 1 and Claim 14 opinions in MacCarley's Reply Declaration so heavily rely upon these irrelevant dictionary

definitions, those entire portions of Exhibit 1063 are equally irrelevant (and may even fail under the Daubert factors and FRE Rule 702).

IV. deSilva Book Exhibits

Petitioner's introduction of the deSilva textbook exhibits and associated redirect testimony were not included in its initial Petition brief nor in the exhibits associated therewith. Nevertheless, Petitioner realized that its *prima facie* case had certain weaknesses which it attempted to backfill during Petitioner's redirect deposition questions of MacCarley. It is noteworthy that MacCarley's deposition was conducted before Patent Owner filed its Response brief and associated exhibits, therefore Petitioner's premature use of these exhibits and deposition testimony were not responsive to Patent Owner's Response.

V. Conclusion

The Board should exclude Petitioner's Exhibits 1054, 1055, 1057, 1058 and all sections of MacCarley's Reply Declaration of Exhibit 1063 pertaining to Claims 1 and 14, and any reliance by Petitioner on same. Furthermore, the Board

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