

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHARP CORPORATION, SHARP ELECTRONICS CORPORATION, and
SHARP ELECTRONICS MANUFACTURING
COMPANY OF AMERICA, INC.,
Petitioner,

v.

SURPASS TECH INNOVATION LLC,
Patent Owner.

Case IPR2015-00021
Patent No. 7,202,843 B2

PETITIONER'S MOTION TO EXCLUDE EVIDENCE

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c) and the Scheduling Order attached to the Board's April 9, 2015 Order (Paper No. 16), as modified by the parties' Joint Stipulation to Modify the Scheduling Order (Paper No. 23), Sharp Corporation, Sharp Electronics Corporation, and Sharp Electronics Manufacturing Company of America, Inc. (collectively, "Sharp" or "Petitioner") hereby move to exclude certain evidence submitted and relied upon by Patent Owner Surpass Tech Innovation LLC. ("Surpass" or "Patent Owner"). Petitioner identifies the specific evidence to be excluded below by Exhibit number, and where appropriate, by paragraph number. Petitioner also identifies the basis for exclusion. Petitioner has timely objected to these exhibits.

II. ARGUMENT

The admissibility of exhibits submitted in a PTAB proceeding is governed by the Federal Rules of Evidence ("F.R.E."). 37 C.F.R. § 42.62(a) ("the Federal Rules of Evidence shall apply to a proceeding"); Trial Practice Guide, 77 Fed. Reg. at 48,758 ("Admissibility of evidence is generally governed by the Federal Rules of Evidence"). Patent Owner, as the proponent, carries the burden of establishing the admissibility of the challenged evidence.

A. Paragraphs 14, 18-23 and 28-30 of Mr. Bohannon’s Declaration Are Improper and Untimely Claim Amendments

Paragraphs 14, 18-23 and 28-30 of Mr. Bohannon’s Declaration (Ex. 2005) should be excluded from the record as an improper and untimely attempt to amend the claims in violation of 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. Petitioner has raised this issue in its timely filed Objections (*see* Paper No. 21, Paragraph 2 of Specific Objections), as well as in Petitioner’s Reply (*see* Paper No. 24, Petitioner’s Reply at 12-13).¹

In its Response, Patent Owner asserted for the first time that the concept of “overdriving” should be added to Claim 4, even though Claim 4 does not recite this element.² Specifically, Patent Owner argued that “claim 4’s phrase ‘applying the data impulses to the liquid crystal device of one of the pixels ... to control a transmission rate of the liquid crystal device of the pixel’” should be construed as

¹ Petitioner objected to Paragraphs 25, 27 and 32-35 on the same ground. However, Surpass has not cited or otherwise relied upon these Paragraphs. Thus, these Paragraphs are not admissible. *See CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 118 at 2-3 (PTAB Oct. 23, 2013).

² Patent Owner’s Preliminary Response did not offer any claim constructions, and the Board’s decision instituting trial found no need to construe any the claims. (Paper No. 10, 5).

“applying two or more *overdriven* data impulses in order to control a transmission rate of the liquid crystal device, or overdriving.” (See Paper No. 20, Response at 25-26) (emphasis added).

While Patent Owner offers this new argument under the guise of claim construction, it is actually an improper and untimely claim amendment. In this regard, Claim 4 does not refer to overdriving; rather, this concept is only referred to in Claim 1. Patent Owner’s attempt to shoe horn this limitation into Claim 4 is nothing more than an improper attempt to bypass the Rules governing claim amendments in IPR proceedings. The relevant Rules and Scheduling Order in this proceeding required Patent Owner to, among other things, confer with the Board and Petitioner regarding the proposed amendment by May 28, 2015. (37 C.F.R. § 42.121(a); *see also* Paper No. 16, 2-3 (“[I]f Patent Owner determines that it will file a motion to amend, Patent Owner must arrange a conference call no later than two weeks prior to DUE DATE 1 with the Board and opposing counsel to discuss the proposed motion to amend.”)). Patent Owner would have then been required to file a motion to amend (separate from Patent Owner’s Response) that complied with the requirements of 37 C.F.R. § 42.121(a)-(b). In such a motion to amend, Patent Owner would have had to show a “patentable distinction over the prior art of record and also prior art known to the patent owner.” *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 at 7 (PTAB June 11, 2013).

Patent Owner failed to take any of these required steps, and instead sought to introduce the claim amendment through Mr. Bohannon's declaration testimony. This simply is not the proper procedure for amending claims, and as such, Paragraphs 14, 18-23 and 28-30 of Mr. Bohannon's Declaration (Ex. 2005) should be excluded from the record under 35 U.S.C. § 316(d), 37 C.F.R. § 42.121. *See also Idle Free Systems*, IPR2012-00027, Paper 26 at 7.

B. Paragraphs 14, 18-23 and 28-30 of Mr. Bohannon's Declaration Are Irrelevant

In addition to including improper claim amendments, Paragraphs 14, 18-23 and 28-30 of Mr. Bohannon's Declaration (Ex. 2005) should also be excluded from the record under F.R.E. 402, 701, 702 and 703 because they are irrelevant to any issue in this proceeding. Petitioner has raised this issue in its timely filed Objections (*see* Paper No. 21, Paragraph 3 of Specific Objections), as well as in Petitioner's Reply (*see* Paper No. 24, Petitioner's Reply at 14-25).³

As discussed above, these paragraphs relate solely to the legally irrelevant "overdriving" technique. However, none of the claims-at-issue in this proceeding refers to the "overdriving" technique. Significantly, Mr. Bohannon admitted during the cross-examination that the support for his discussion of the

³ Petitioner objected to Paragraphs 25, 27 and 32-35 on the same grounds.

However, as discussed in Footnote 1, these Paragraphs are inadmissible.

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