Paper No. 35
Filed: January 4, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUGHES NETWORK SYSTEMS, LLC and
HUGHES COMMUNICATIONS, INC.,

Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,

Patent Owner.

IPR2015-00059 (Patent 7,916,781)

PETITIONER'S OPPOSITION TO PATENT OWNER'S COMBINED MOTION TO STRIKE AND MOTION TO EXCLUDE

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I. PRELIMINARY STATEMENT

Patent Owner has presented no evidence to rebut Petitioner's showing that Divsalar qualifies as prior art. It has carefully avoided arguing that Divsalar is not prior art to the '781 Patent. Indeed, Patent Owner could not make such an argument, as its own inventors conceded that Divsalar was prior art during *ex parte* prosecution and in other public statements. Therefore, Patent Owner's motion to strike evidence and argument regarding the prior art status of Divsalar is a waste of both the parties' and the Board's resources.

As to Patent Owner's challenge to the Declaration of Ms. Fradenburg, an employee of the University of Texas Library, its motion to strike is both untimely and meritless. First, Patent Owner never served formal objections to Ms. Fradenburgh's declaration, nor did it otherwise raise with the Board a motion to strike her testimony during the discovery period in this Trial—when Petitioner would have had an opportunity to compel her deposition, if the Board had concluded that such action was necessary. Second, Petitioner properly followed the procedure established by the Board in *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, IPR2014-00553, Paper 28 (PTAB April 8, 2015) for the deposition of a librarian who is unwilling to appear for deposition voluntarily. In particular, Petitioner attempted to secure her voluntary attendance, then proposed to Patent Owner that her deposition be compelled via subpoena.

Accordingly, Patent Owner's motion should be denied.

Second, Patent Owner's motion to strike what it calls a "New Theory of Unpatentability" of anticipation over Divsalar as § 102(a) art is misguided. The Petition characterized Ground 1 as follows: "Claims 1 and 2 are anticipated under 35 U.S.C. § 102 by Divsalar." (Pet., Paper 4 at 13.) Similarly, the Trial was Instituted on the following Ground: "claims 1 and 2 as anticipated by Divsalar" (Institution Decision, Paper 18 at 16). Nothing in the Petition nor the Institution Decision limits Ground 1 to anticipation under § 102(b), as Patent Owner suggests.

Third, Patent Owner seeks to strike the testimony of Timothy Jezek, which refutes Patent Owner's speculative allegations that each real party-at-issue was not named in the Petition. Submission of rebuttal evidence with Petitioner's reply is both permitted and customary. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1078 (Fed. Cir. 2015) (upholding Board's refusal to strike reply evidence that was "in fair reply" to Patent Owner's contentions); 37 C.F.R. § 42.23(b). Notably, Patent Owner could have cross-examined Mr. Jezek and submitted observations on that cross-examination. It could also have requested a sur-reply to submit additional argument, if it believed that was necessary. Instead, Patent Owner chose to do nothing. Having shown no basis to strike this evidence, Patent Owner's motion should be denied.

Finally, Patent Owner moves to exclude forty-five exhibits as "irrelevant and

unfairly prejudicial". Patent Owner's motion does not explain how these exhibits, which include the file histories of various parent and child patents in the same family as the '781 Patent and several prior art references discussed extensively in the petition, petitioner's reply, and petitioner's supporting declarations, could be irrelevant or unfairly prejudicial. Accordingly, Patent Owner fails to carry its burden as to this motion.

II. PATENT OWNER'S MOTION TO STRIKE

A. Patent Owner's Motion to Strike the University of Texas Librarian's Declaration Is Waived and Lacks Merit.

Patent Owner has waived this issue. The first time Patent Owner formally raised this issue in a filing was in its Patent Owner Response, where it argued that "Petitioner should . . . be precluded from relying on" the Fradenburgh Declaration. Paper 24 at 21, 27-29. Prior to that, the parties had exchanged emails regarding the deposition of Ms. Fradenburgh. As those emails show, Petitioner followed the procedure established by the Board in *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, IPR2014-00553, Paper 28 (PTAB April 8, 2015). Specifically, Petitioner attempted to obtain the voluntary appearance of Ms. Fradenburgh. When it was unable to do so, Petitioner suggested to Patent Owner that if a deposition was necessary (which seemed unlikely given the apparent lack of a dispute over Divsalar's availability as prior art), Patent Owner could subpoena Ms. Fradenburgh. Patent Owner made no attempt to move forward with that subpoena

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