

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,  
Patent Owner.

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Case IPR2015-00059  
Patent 7,916,781

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**PATENT OWNER'S REPLY IN SUPPORT OF COMBINED MOTION  
TO STRIKE AND MOTION TO EXCLUDE**

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Patent Owner (“Caltech”) hereby replies to Petitioner’s Opposition to Patent Owner’s Combined Motion to Strike and Motion to Exclude (“Opp.,” Paper 35) and respectfully requests the Board grant its Combined Motion to Strike and Motion to Exclude (“Motion,” Paper 32).<sup>1</sup>

## **I. MOTION TO STRIKE**

### **A. Exhibit 1064 (Fradenburgh Declaration)**

Regarding the Fradenburgh declaration, Petitioner makes two arguments: (1) that Caltech waived its motion by not formally serving notices of objection to evidence; and (2) that the burden was on Caltech to request a subpoena to compel Ms. Fradenburgh’s deposition. Both arguments fail.

Petitioner’s waiver theory is based on a misapprehension of the nature of the request. Petitioner argues that Caltech never served or filed a “formal objection” to Ex. 1064 as an evidentiary matter (Opp. pp. 1, 3-4) but the rules only require objections for a motion to exclude. § 42.64. The motion to strike Ex. 1064 is not advanced under the Federal Rules of Evidence; instead it relies on the requirements of 35 U.S.C. § 311(b) and on Petitioner’s violation of well-established requirements for declarants. § 42.12(a)-(b).

Caltech’s criticisms of the Fradenburgh declaration have been clear from the beginning. Caltech discussed the declaration’s deficiencies in its preliminary

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<sup>1</sup> Petitioner includes extensive argument at pp. 15-17 of its brief regarding the statement of material facts in circumvention of the page limit restrictions.

response, timely requested a deposition for cross-examination, formally requested Petitioner withdraw the testimony when cross-examination was refused, discussed Petitioner's failure to provide its declarant for cross-examination in the Patent Owner response, and raised the issue again when Petitioner sought additional discovery to remedy the deficiencies in its evidence. Motion pp. 2-4; *see also, e.g.*, PO Response (Paper 24) p. 29. Caltech also timely requested authorization for its motion to strike five weeks before the deadline for the motion to exclude. Ex. 2031. Petitioner's failure to provide Ms. Fradenburgh for deposition was a clear violation of the rules and the declaration should be stricken.

Regarding Petitioner's argument that Caltech must seek a subpoena, the plain language of the Trial Practice Guide as well as numerous Board decisions make clear that the proponent of declaration testimony must make the declarant available for cross. Petitioner relies on a heading in the Trial Practice Guide rather than its substantive text, which plainly states that it relates to "[t]he burden *and* expense of producing a witness." 77 Fed. Reg. 48761; *cf. Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 256 (2004) (a caption does not limit the plain meaning of an authority's text).

The numerous cases cited in Caltech's motion confirm that the burden and responsibility is on the party relying on the direct testimony. Indeed, the Board has already explained that "it was not Petitioner's burden to ... compel cross-examination testimony of a witness that Patent Owner asks us to consider." *FLIR Sys., Inc. v. Leak Surveys, Inc.*, IPR2014-00411, Paper 113 pp. 15-16 (2015).

The sole case cited by Petitioner, *Marvell*, does not compel a different conclusion. There, the patent owner elected to seek a subpoena compelling testimony of a witness it desired to cross-examine, and the petitioner did not oppose. *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, IPR2014-00553, Paper 28 (2015). Nothing in *Marvell* contradicts the overwhelming precedent requiring the proponent to produce the witness for cross-examination.

**B. Petitioner’s New § 102(a) Theory**

The rules require Petitioner to identify the “specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based.”

§ 42.104(b)(2). The theory specifically identified and relied upon in the petition was 35 U.S.C. § 102(b).

Petitioner argues that § 102(b) prior art must necessarily satisfy § 102(a) as well. Opp. p. 9. But Petitioner presupposes that it has established Divsalar qualifies as § 102(b) prior art, which it has not. The only reason Petitioner raised its new § 102(a) theory in its reply is to present an alternative to the § 102(b) assertion in the petition, should the § 102(b) theory properly be rejected. Petitioner failed to show Divsalar qualifies as § 102(b) prior art, and untimely and belatedly attempts to shift its theory at this late stage to § 102(a)—without even identifying a specific alleged publication date.

Petitioner cannot point to a single statement or citation in the petition providing notice of a § 102(a) ground. Opp. pp. 9-10. The expert testimony cited on page 7 of the petition addresses the purported content of Divsalar, not its

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