

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 COMBINED MOTION TO STRIKE  
AND MOTION TO EXCLUDE**

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## **I. PRECISE STATEMENT OF RELIEF REQUESTED**

The Board authorized (Ex. 2031) Patent Owner (“Caltech”) to include in its motion to exclude a motion to strike Petitioner’s Exhibits 1064 and 1076, and also portions of Petitioner’s Reply to Patent Owner’s Response (Paper 29, “Pet. Reply”), which raise a new theory of unpatentability contending that the Divsalar reference constitutes prior art under § 102(a). 37 C.F.R. § 42.12(a) & (b).

Caltech also moves to exclude Petitioner’s Exhibits 1001-1004, 1007-1009, 1012, 1013, 1017-1021, 1023, 1030-1036, 1038-1044, 1046-1059, 1060 (¶¶ 13-38 and 40-83), 1061-1063, 1065, and 1066 for failing to meet the admissibility requirements of the Federal Rules of Evidence. 37 C.F.R. § 42.64(c).

## **II. STATEMENT OF REASONS FOR RELIEF REQUESTED**

### **A. Statement of Material Facts**

1. The petition asserts that Divsalar was “published by at least April 30, 1999 and available as prior art under 35 U.S.C. 102(b).” Paper 4 (“Pet.”) p. 2.
2. The petition cites to Exhibit 1064, the declaration of Robin Fradenburgh, in support of the assertion that Divsalar is available as prior art. *Id.*
3. The petition cites no exhibit beyond Ex. 1064 to support the assertion that Divsalar is prior art. *See, generally, Pet.*
4. The petition does not mention 35 U.S.C. § 102(a), much less assert that Divsalar is prior art under § 102(a). *See, generally, Pet.*

5. The petition does not identify any other alleged publication date for Divsalar beyond the assertion that it was “published by at least April 30, 1999.”

*See, generally, Pet.*

6. On June 12, 2015, Caltech requested that Petitioner make Ms. Fradenburgh available for cross-examination. Ex. 2025.

7. Petitioner did not provide Ms. Fradenburgh for cross-examination. Ex. 2026-27.

8. Exhibits 1001-1004, 1007-1009, 1012, 1013, 1017-1021, 1023, 1030, 1032-1036, 1038-1040, 1042-1044, 1046-1056, 1059, 1061-1063, 1065, and 1066, and paragraphs 13-29, 34-38 and 40-83 of Exhibit 1060, are not cited in any of Petitioner’s filings to date in this proceeding.

## **B. Motion to Strike**

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

Exhibit 1064 is a declaration submitted by Ms. Fradenburgh, identified as a librarian at the University of Texas, Austin. Ex. 1064 p. 1. The exhibit is the sole evidence cited in the petition to support the assertion that Divsalar qualifies as § 102(b) prior art. Pet. p. 2. Caltech’s preliminary response explained that the Fradenburgh declaration is insufficient to support Petitioner’s contention that Divsalar constitutes a publicly available prior art printed publication under § 102(b). *See* Paper 13 (“Prelim. Resp.”) pp. 19-23; PO Resp. (Paper 24) pp. 24-27; PO Opp. to Pet. Mot. for Discovery (Paper 28) pp. 4. Petitioner, however, refused to make Ms. Fradenburgh available for cross-examination, thereby failing

to comply with the relevant rules and practice guide governing this proceeding and prejudicing Caltech's ability to produce a complete record for the Board to form an accurate understanding of the testimony. Hence, the Board should strike her declaration.

Caltech's preliminary response notified Petitioner that Caltech disputes the sufficiency of the Fradenburgh declaration on the public accessibility issue. Prelim. Resp. pp. 19-23. After institution, Caltech asked to cross-examine Ms. Fradenburgh to explore this insufficiency. Caltech emailed Petitioner on June 12, 2015 requesting the dates of her availability for cross examination. Ex. 2025. Petitioner did not respond until nearly a month later, when it stated that it could not provide Ms. Fradenburgh and informed Caltech it must seek a subpoena compelling her to appear. Ex. 2026. In response to a follow-up Caltech email inquiring as to the circumstances of her unavailability, Petitioner replied that it had learned "late last week" that she would not appear voluntarily.<sup>1</sup> Ex. 2027. Caltech immediately requested that Petitioner take the necessary steps to make Ms. Fradenburgh available for cross-examination or formally withdraw her testimony. Ex. 2028.

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<sup>1</sup> Ms. Fradenburgh's declaration lacks a statement acknowledging that she may be subject to cross-examination and agreeing to make herself available for the same. Ex. 1064.

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