

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALEO NORTH AMERICA, INC., VALEO S.A., VALEO GMBH,
VALEO SCHALTER UND SENSOREN GMBH,
AND CONNAUGHT ELECTRONICS LTD.,

Petitioner,

v.

MAGNA ELECTRONICS, INC.,

Patent Owner.

Case IPR2015-01410¹
Patent 8,643,724 B2

PETITIONERS' OBJECTIONS UNDER 37 C.F.R. § 42.64
TO EVIDENCE SUBMITTED BY PATENT OWNER

¹ Case IPR2015-01414 has been consolidated with this proceeding.

Pursuant to 37 C.F.R. § 42.64(b)(1), Petitioners object to the admissibility of the following exhibits filed by Patent Owner as follows:

Paper 14: Patent Owner Response

Petitioners object to Patent Owner’s response to the extent that it relies upon or incorporates inadmissible exhibits or declaration testimony to which Petitioners object herein.

Petitioners object to Patent Owner’s response as impermissibly incorporating materials from other documents and exhibits by reference. 37 C.F.R. § 42.6(a)(3). Petitioners further objects to Patent Owner’s Response as exceeding the page limit set forth in 37 C.F.R. § 42.24 (b) to the extent the improperly incorporated materials are counted toward the sixty-page limit for the Patent Owner Response. 37 C.F.R. § 42.24(a)(1). In particular, the Trial Practice Guide explains that “[c]laim charts submitted as part of a petition, motion, patent owner preliminary response, patent owner response, opposition, or reply count towards applicable page limits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48764 (Aug. 14, 2012). Patent Owner’s Response, however, improperly incorporates forty-three pages of claim charts from Ex. 2001, entitled “Magna’s Constructive Reduction to Practice Claim Chart.” Patent Owner further improperly incorporate by reference arguments and discussion from Exhibit 2004, the Declaration of Dr. Ralph Etienne-Cummings. (*See, e.g.*, Paper 14 at 6-7, 9, 17, 31.)

Exhibit 2001 Magna's Constructive Reduction to Practice Chart

Petitioners object to Exhibit 2001 to the extent it is being used to circumvent the page limits for Patent Owner's Response, as set forth in 37 C.F.R. § 42.24 (b). In particular, "[c]laim charts submitted as part of a petition, motion, patent owner preliminary response, patent owner response, opposition, or reply count towards applicable page limits." Office Patent Trial Practice Guide, 77 Fed. Reg. 48764 (Aug. 14, 2012).

Petitioners further object to Exhibit 2001 as being not relevant under FED. R. EVID. 401 and inadmissible under FED. R. EVID. 402. In particular, Exhibit 2001 fails to demonstrate the claimed subject matter of any challenged claim in this proceeding is entitled to an earlier priority date.

Exhibit 2004: Expert Declaration of Dr. Ralph Etienne-Cummings with Appendix A – CV of Dr. Ralph Etienne-Cummings

Petitioners object to Exhibit 2004 under FED. R. EVID. 402 and 702. Dr. Ralph Etienne-Cummings, the witness offering declaration testimony, (a) lacks the knowledge, skill, experience, training, or education to testify as an expert in a manner that is helpful to the Board; (b) provides opinions that are not based on sufficient facts or data; (c) has not applied reliable principles and methods; and (d) has not reliably applied such principles and methods to the facts of the case. For example, Dr. Etienne's opinion regarding the priority date of U.S. Patent 8,643,724 is not supported by any independent study or analysis. Instead, Dr. Etienne-

Cummings merely acts as a conduit for conclusory assertions in Exhibit 2001, entitled “Magna’s Constructive Reduction to Practice Claim Chart.”

Petitioners further object to Exhibit 2004 under FED. R. EVID. 703. The witness offering declaration testimony does not base his opinion on facts or data that he has been made aware of or personally observed and the witness fails to demonstrate that such facts or data would be reasonably relied upon by experts in the particular field.

Further, Petitioners object to Exhibit 2004 to the extent portions of Exhibit 2004 are improperly incorporated by reference into Patent Owner’s Response (Paper 14) in violation of 37 C.F.R. § 42.6(a)(3). *See e.g.* Ex. 2004 at ¶¶ 54- 100.

Dated: March 15, 2016

Respectfully submitted,

/s/ Russell E. Levine, P.C.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document was served on March 15, 2016, via email by agreement of the parties directed to counsel of record for the Patent Owner at the following:

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Date: March 15, 2016

Respectfully submitted,

/s/ Russell E. Levine, P.C.

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