UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYDRITE CHEMICAL CO.,
Petitioner,

v.

SOLENIS TECHNOLOGIES, L.P.,
Patent Owner.

Case IPR2015-01592
Patent 8,962,059

PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE PURSUANT TO 37 C.F.R. § 42.64(C)

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Contrary to Petitioner's assertions, Patent Owner's Motion to Exclude ("Motion") is consistent with the Board's Order of July 27, 2016 (Paper 24). That order not only authorized the filing of a list of new issues raised in Petitioner's Reply, but reminded the parties that they may also file Motions to Exclude that address admissibility of any evidence for which an objection was timely filed (Paper 24 at 3). Patent Owner subsequently filed its motion to exclude based on the objections that it had lodged in Paper 22. As stated in a Board decision cited by Petitioner, "[a] motion to exclude can be based on ... evidence presented contrary to the applicable rules (37 C.F.R. § 42.62(a) and 37 C.F.R. § 42.61(a) ('[e]vidence that is not taken, sought, or filed in accordance with ... [Subpart 42] is not admissible.')" (IPR2014-01555, Paper 50 at 72). Accordingly, Patent Owner's Motion was proper.

I. Petitioner's Reliance on New Evidence to Cure Deficiencies in Its Petition Is Improper and Prejudicial to Patent Owner

Although Petitioner contends that "nothing" in its Reply is necessary to establish its *prima facie* case of obviousness, that clearly is not true. Indeed, as explained in the Motion, Petitioner improperly submitted new evidence on reply to cure deficiencies in the Petition that Patent Owner had identified in its Response. *See* IPR2013-00424, Paper 50 at 21 (PTAB Jan. 12, 2015) ("A Reply affords the Petitioner an opportunity to refute arguments and evidence advanced by Patent Owner, not an opportunity to cure deficiencies in its Petition.").

In an attempt to downplay the prejudice to Patent Owner that would result

from admission of the new evidence, Petitioner notes that Patent Owner had the opportunity to submit observations on cross-examination. Petitioner, however, ignores the fact that observations on cross-examination are limited in scope and, significantly, do not allow for the submission of rebuttal argument or evidence. As the Board recently recognized, new evidence and argument in a Reply is improper "because, as the Federal Circuit instructed…the agency 'must allow 'a party…to submit rebuttal evidence…as may be required for a full and true disclosure of the facts.'" IPR2013-00440, Paper 49 at 9 (PTAB Aug. 22, 2016). No such opportunity for rebuttal evidence is available to Patent Owner here. Accordingly, Petitioner's new evidence should be excluded.

II. Petitioner Has Failed to Overcome the Objections to Exs. 1022 and 1029

A. Exhibit 1029 ("Jacobsen")

Petitioner's opposition trivializes and renders meaningless the Federal Rules of Evidence ("FRE"). In particular, FRE 901 requires that the proponent produce evidence sufficient to support a finding that an item is what the proponent claims it is. For example, "[w]hen offering a printout of a webpage into evidence to prove the website's contents, the proponent of the evidence must authenticate the information from the website itself, not merely the printout." IPR2014-00148, Paper 41 at 10 (PTAB April 23, 2015).

Petitioner fails to meet this standard. Instead, Petitioner only alleges that

because the Jacobsen webpage bears "The Jacobsen" trade inscription, it is self-authenticating under FRE 902(7). But Jacobsen is not an inscription, sign, tag, or label – it is a printout of a web page. "Printouts from a web site do not bear the indicia of reliability demanded…under FRE 902. To be authenticated, some statement or affidavit from someone with knowledge is required." *In re Homestore.com, Inc. Securities Litigation*, 347 F. Supp. 2d 769, 782-83 (C.D. Cal. 2004), *see also* IPR2014-00148, Paper 41 at 10. Following Petitioner's logic, any webpage containing a trademark should be found authentic, even if the trademark had been inserted fraudulently by someone other than the trademark's owner, thus rendering FRE 901 meaningless. *See Victaulic Co. v. Tieman*, 499 F.3d 227, 236 (3d Cir. 2007).

Petitioner erroneously relies upon the decision in IPR2013-00534, Paper No. 81 at 24, in an attempt to support its self-authentication position. The facts in that case differed in that the petitioner did not rely solely upon the fact that the document at issue bore a Duke University trade inscription, but submitted an affidavit of the person who obtained a copy of the original document detailing how it was obtained.

Similarly without merit is Petitioner's assertion that Jacobsen does not contain hearsay. Petitioner's Reply offers Jacobsen for the truth of the matter asserted, not as "evidence of what it describes to an ordinary artisan." Notably, Petitioner's expert, Dr. Rockstraw, does not even consider Jacobsen in his analysis, let alone explain

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