UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., HTC CORPORATION, HTC AMERICA, INC., MICROSOFT CORPORATION, MICROSOFT MOBILE OY, MICROSOFT MOBILE, INC., SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., AND ZTE (USA) INC.,

Petitioners

v.

EVOLVED WIRELESS LLC,

Patent Owner.

Cases IPR2016-00757, IPR2016-01228, IPR2016-01229, IPR2016-01345

Patent 7,881,236 B2

PATENT OWNER'S MOTION FOR SUBMISSION OF SUPPLEMENTAL INFORMATION UNDER 37 C.F.R. § 42.123(b)

Patent Owner Evolved Wireless, LLC submits this motion for submission of supplemental information to the above-captioned *Inter Partes* Reviews of U.S. Patent No. 7,811,236 pursuant to 37 C.F.R. § 42.123(b).

I. The supplemental information was not reasonably available to Patent Owner prior filing its Patent Owner Responses in the proceedings.

The transcript of Samsung's expert, Dr. Villasenor, was not available until Sept. 12, 2017. As such, it was not reasonably available when Patent Owner submitted its Patent Owner Responses in these proceedings. In the pending district court litigation, opposition expert reports were due on June 26, 2017, which is when Samsung served the report for Dr. Villasenor. Ex. 2012. Dr. Villasenor's deposition was timely conducted on Aug. 25, 2017, wherein he provided, for the first time, his opinions regarding claim construction of the '236 Patent. Ex. 2011. Patent Owner received the final transcript on Sept. 12, 2017.

At Dr. Villasenor's deposition, counsel for Samsung designated the deposition transcript confidential under the district court protective order. Immediately upon receiving the final transcript on September 12, Patent Owner requested that Samsung consent that the excerpted pages of Dr. Villasenor's transcript included only public information. Samsung waited until September 22 to inform Patent Owner that the excerpts of Dr. Villasenor's testimony that Patent Owner sought to supplemental were not confidential.

On Sept. 25, Patent Owner informed Petitioners of its request for a conference call with the Board to seek authorization to file this Motion. Upon receipt of Petitioners' objections, Patent Owner submitted its request via email on September 27 requesting the teleconference with the Board.

Patent owner was fully diligent in seeking discovery and promptly requested authorization from the Board to submit supplemental information. Due to the scheduling order of the district court litigation, Patent Owner could not have obtained a transcript of Dr. Villasenor's deposition testimony prior to September 12. *Ultratec, Inc. v. CaptionCall, LLC*, 2017 U.S. App. LEXIS 16363 at *10 (Fed. Cir. Aug. 28, 2017). As such, this information was not available to Patent Owner when it submitted its final response to the Board in these proceedings.

II. Consideration of the supplemental information is in the interests-of-justice.

A. The supplemental information is highly relevant to the central issue of claim construction present in all proceedings.

The proposed deposition testimony of Dr. Villasenor demonstrates how one of ordinary skill in the art construes claim term "if" in the '236 patent. All Petitioners have raised this claim construction issue in the pending IPRs. *See* IPR2016-00757, Paper 1 at 16-19, Paper 28 at 3-8; IPR2016-01345, Paper 1 at

17-20, Paper 28 at 3-8; IPR2016-01228, Paper 2 at 17-21, Paper 16 at 3-20; IPR2016-01229, Paper 15-18, Paper 16 at 3-20.

Indeed, it was a significant issue presented at both oral arguments related to the '236 Patent. In Apple and Microsoft's demonstrative exhibits submitted for oral hearing of IPR2016-01228 and IPR2016-01229, 51 of 67 slides directly related to the issue of claim construction in light of prior art, with 20 slides devoted entirely to the interpretation of "if." Petitioners ZTE, HTC and Samsung in IPR2016-00757 and IPR2016-01345 similarly emphasized the issue of claim construction in light of prior art by having 24 of 36 slides relate to the issue of claim construction; and ten slides interpreting "if."

Dr. Villasenor's interpretation of the term "if" is probative of a key issue raised by all petitioners. Expert testimony may be received as extrinsic evidence by the court at its discretion to better reach a correct conclusion as to the true meaning of a disputed term. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995). Indeed, Apple and Microsoft rely on expert testimony for in support of their positions on claim construction. IPR2016-01228, 1229, Ex. 1003. The fact that other petitioners did not rely on expert testimony does not preclude the Board from receiving this evidence, especially when these Petitioners are suggesting that the intrinsic record is not clear as to the proper construction by offering alternative constructions. Nevertheless, Samsung is

under a duty of candor to present such evidence to the Board, such that its lack of expert testimony with its petition does not preclude entry of this evidence into the record. 37 C.F.R. § 42.11. At a minimum, the supplemental evidence must be included in the record for IPR2016-01345.

The Federal Circuit recently reversed a PTAB decision to exclude contradictory testimony that was sought to be introduced pursuant to 37 C.F.R. 42.123(b). *Ultratec, Inc.*, 2017 U.S. App. LEXIS 16363 at *11-12. In *Ultratec*, the Federal Circuit noted that conflicting testimony would be highly relevant to the Board's analysis. *Id*. at *11. Dr. Villasenor's deposition testimony is inconsistent with position taken by Samsung and the other Petitioners in these IPR proceedings as to this claim construction issue. Thus, consideration of this supplemental information is in the interests-of-justice.

B. The different claim construction standards has no bearing on the relevance of this testimony.

During the teleconference, Petitioners' argued that the testimony is irrelevant because the expert was applying a different claim construction standard. That argument is without merit. Petitioners have never advanced that the claim construction of "if" is different under broadest reasonable interpretation as compared to the *Philips* standard. Indeed, Petitioners have advanced the same construction here and in the district court litigation.

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