Paper No. 39
Filed October 10, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) Inc., HTC Corporation, HTC America, Inc.,
Samsung Electronics Co., Ltd., and
Samsung Electronics America, Inc.,

Petitioner,

v.

Evolved Wireless LLC,

Patent Owner.

Case IPR2016-00757[1]
Patent 7,881,236 B2

Before WILLIAM V. SAINDON, PATRICK M. BOUCHER, and TERRENCE W. MCMILLIN, *Administrative Patent Judges*.

OPPOSITION TO PATENT OWNER'S MOTION FOR SUBMISSION OF SUPPLEMENTAL INFORMATION

[1] IPR2016-01345 has been consolidated with this proceeding.

In its motion (Paper 38), Patent Owner ("PO") seeks to enter an excerpted deposition transcript in which Samsung's district court non-infringement expert, Dr. John Villasenor, was questioned on the meaning of the word "if." PO's motion is an eleventh-hour effort to replace a defective declaration submitted together with PO's Response. The Board should deny the motion for two reasons: (1) PO already had an opportunity to submit expert opinion on its "only if" interpretation; and (2) considering Dr. Villasenor's testimony at this late stage would not serve the interests of justice. Each reason provides a separate basis for denying the motion.

I. PO had an opportunity to submit expert opinion on its "only if" interpretation.

PO's motion fails unless it establishes "why the supplemental information reasonably could not have been obtained earlier." *See* 37 C.F.R. § 42.123(b). PO cannot make that showing because it already submitted earlier expert opinion on its "only if" interpretation. Specifically, along with its Response, PO submitted Dr. Cooklev's "declaration" offering his opinion that "if" means "only if." *See* Ex. 2006, Cooklev Decl. As Petitioners' Reply explained, Dr. Cooklev's "declaration" is defective because it: (i) is unsworn, (ii) applies the clear and convincing standard of invalidity, and (iii) compares the preferred embodiment to the prior art. *See* Paper 28, Reply, at 6-7.

Now, *after* the oral hearing, PO seeks to cure this defect through Dr. Villasenor's testimony. As PO confirmed, it offers Dr. Villasenor's testimony for the same reason it offered Dr. Cooklev's unsworn "declaration"—to show "how one of ordinary skill in

the art construes claim term 'if' in the '236 patent." *See* Paper 38, Motion, at 2. The Board should reject PO's eleventh-hour do-over. PO had ample opportunity to submit a proper declaration from Dr. Cooklev—or any other expert—but it failed to do so.

PO argues that it lacked access to *Dr. Villasenor's* opinions (*see id.* at 2), but that is irrelevant. The issue is *not* whether PO could have reasonably obtained earlier expert opinion from somebody who has no connection whatsoever with this IPR. The issue is whether PO could have earlier obtained expert opinion on its "only if" interpretation—and here it plainly did have an opportunity to obtain such opinion from Dr. Cooklev. For this reason, the Board should deny PO's motion.

II. Consideration of Dr. Villasenor's testimony does not serve justice.

The Board should also deny PO's motion because it does not establish that "consideration of the supplemental information would be in the interests-of-justice." *See* 37 C.F.R. § 42.123(b). Considering Dr. Villasenor's testimony would not serve justice because it is irrelevant, prejudicial, and inadmissible hearsay.

A. Dr. Villasenor's testimony is not relevant.

Under 37 C.F.R. § 42.123(b), "supplemental information must be relevant to a claim for with the trial has been instituted." 77 Fed. Reg. at 48707. Dr. Villasenor's testimony is irrelevant here for two reasons. First, extrinsic evidence "cannot be relied on to change the meaning of the claims when that meaning is made clear by those documents." *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995).

PO admits "[t]he patent is clear"—thus conceding that its resort to extrinsic evidence is improper. *See* Paper 22, Response, at 45.

Second, Dr. Villasenor provided his testimony under the *Phillips* standard, not the BRI standard that governs these IPR proceedings. *See PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 734, 740 (Fed. Cir. 2016). PO incorrectly insists the different claims construction standards have "no bearing" here. *Compare* Paper 38, Motion, at 4, *with PPC Broadband*, 815 F.3d a 741 (recognizing that a case can "hinge[] on the claim construction standard applied"). Dr. Villasenor did not analyze or provide an opinion regarding the construction of *any* claim terms under the BRI standard. Ex. 1048 at 313:11-15, errata. *Cf. InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352-54 (Fed. Cir. 2014) (rejecting expert testimony that applied incorrect legal standard and reversing district court). In fact, in his written report, Dr. Villasenor did not provide *any* opinions on claim construction. The scope of his report was limited to non-infringement of certain accused products *based on* PO's arguments made in *this* IPR. Ex. 1048 at 54:11-13, 83:25-84:6, 85:8-11, 85:15-23, 86:6-13. He provided no independent analysis on the question of "if" versus "only if." Ex. 1048 at 313:11-15. *See* 37 CFR § 42.65 ("Expert testimony that does not disclose the underlying facts or data . . . is entitled to little or no weight."). PO employs circular reasoning to suggest this testimony supports its claim construction argument, particularly where the testimony began with Dr. Villasenor's *assumption* that PO's argument is correct.

With misplaced reliance on *Ultratec, Inc. v. CaptionCall, LLC*, 2017 U.S. App. LEXIS 16363, at *10 (Fed. Cir. Aug. 28, 2017), PO incorrectly asserts that Dr. Villasenor's testimony is relevant because it is "conflicting testimony" of how a skilled artisan would interpret the claim term "if." *See* Paper 38, Motion, at 3. In *Ultratec*, an expert offered district court testimony that conflicted with *his own* testimony in a related IPR. *See id.* at *4-5 (The expert's "trial testimony conflicted with written declarations he made in the IPRs."). Dr. Villasenor has not presented any testimony in this IPR, so there is no "conflict" to justify consideration of his district court testimony in this proceeding.

Indeed, Petitioners did not offer *any* expert testimony on the interpretation of "if," and have consistently argued that "if" should be given its plain and ordinary meaning consistent with the intrinsic evidence. *See* Paper 3, Petition, at 16; Paper 28, Reply, at 5. In the Institution Decision, the Board agreed and rejected PO's "only if" interpretation. *See* Paper 12, ID, at 9. Even if the reasoning of *Ultratec* could be extended to cover "conflicting testimony" between two *different* experts—and it cannot—there still is no testimony from any expert in this IPR with which Dr. Villasenor's testimony would conflict.

B. Dr. Villasenor's testimony is inadmissible hearsay.

Dr. Villasenor's testimony meets both prongs of the hearsay rule: (1) his testimony was not taken in this IPR (*i.e.*, it contains statements "not ma[de] while

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