

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Petitioner

v.

WINDY CITY INNOVATIONS, LLC
Patent Owner

Case No. IPR2016-01155¹
Patent No. 8,694,657

PETITIONER'S OPPOSITION TO MOTION TO EXCLUDE EVIDENCE

¹ Case IPR2017-00622 has been joined with this proceeding.

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Patent Owner's motion to exclude reply testimony of Christopher Schmandt is improper procedurally and unfounded in substance. Scores of Board panels have consistently held that a motion to exclude evidence is not the correct procedure to challenge reply testimony as allegedly exceeding the permitted scope of 37 C.F.R. 42.23(b). For this reason alone, Patent Owner's improper motion should be denied in its entirety. Even if considered, however, the motion rests on faulty grounds. Every portion of testimony to which Patent Owner objects is in fact directly responsive to arguments and opinions newly raised by Patent Owner and its expert, Dr. Carbonell.

I. PATENT OWNER'S MOTION IS IMPROPER

The Board has repeatedly explained that a motion to exclude is not the proper vehicle to complain that arguments and supporting evidence are outside the proper scope of a reply. *See, e.g., Palo Alto Networks, Inc. v. Finjan, Inc.*, No. IPR2016-00151, Paper 51 at 23 (P.T.A.B. Mar. 15, 2017) (“[W]e have stated repeatedly that a motion to exclude is not a vehicle for arguing that Petitioner's arguments and supporting evidence are outside the proper scope of a reply.”); *South-Tek Sys., LLC v. Engineered Corrosion Sols., LLC*, No. IPR2016-00136, Paper 52 at 8 (P.T.A.B. May 10, 2017) (“A motion to strike or a motion to exclude is not the proper mechanism for raising the issue of whether a reply or reply evidence is beyond the proper scope.”); *Canon Inc., et al. v. Papst Licensing GmbH & Co. KG*, No. IPR2016-01211, Paper 25 at 2, (P.T.A.B. Aug. 2, 2017) (“[A] motion to exclude is

not a proper mechanism to present argument that a reply and evidence filed in support of the reply are outside the scope of a proper reply under 37 C.F.R. § 42.23(b)"); *Blackberry Corp. v. Zipit Wireless, Inc.*, No. IPR2014-01508, Paper 49 at 40 (P.T.A.B. Mar. 29, 2016); *Facebook, Inc. et. al v. Software Rights Archive, LLC*, No. IPR2013-00478, Paper 58 at 37-38 (P.T.A.B. Feb. 2, 2015).

A motion to exclude should be directed to the admissibility of evidence under the Federal Rules of Evidence or other law governing the admissibility of evidence, and not issues relating to the timing or scope of that evidence. *Vibrant Media v. Gen. Elec. Co.*, No. IPR2013-00172, Final Written Decision, Paper 50 at 41 (P.T.A.B. July 28, 2014), citing 37 C.F.R. § 42.64(c) and Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767; *Canon*, No. IPR2016-01211, Paper 25 at 2 (Aug. 2, 2017). Tellingly, Patent Owner failed to cite a single supportive authority in its effort to use the rules of evidence to object to the scope of Mr. Schmandt's reply testimony.

Furthermore, Patent Owner's motion should be denied because the Board has found it within its own discretion to determine if any evidence exceeds the proper scope of reply. *See, e.g., Canon*, No. IPR2016-01211, Paper 25 at 2 (Aug. 2, 2017). As the Board has explained, because it sits "as a non-jury tribunal with administrative expertise, [it] is well-positioned to determine and assign appropriate weight to evidence presented." *Liberty Mut. Ins. v. Progressive Casualty Insurance*

Co., No. CBM2012-00002, Paper 66 at 70 (P.T.A.B. Jan. 23, 2014); *see also Sony Computer Entm't Am. LLC v. Game Controller Tech. LLC*, No. IPR2013-00634, Paper 32 at 32 (P.T.A.B. Apr. 14, 2015). As further explained below, each item of Mr. Schmandt's declaration that Patent Owner objects to is properly within the permitted scope of reply testimony.

II. MR. SCHMANDT'S REPLY TESTIMONY IS PROPERLY WITHIN THE SCOPE PERMITTED BY RULE 42.23(B)

A reply may “respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response.” 37 C.F.R. § 42.23(b). All of Mr. Schmandt's reply testimony properly responds to arguments raised in Patent Owner's response, and is also well-grounded in his original testimony

A. Mr. Schmandt's Reply Testimony Regarding the “other programs” Claim Limitations Is Proper

Regarding Exhibit 1100, ¶ 21 at lines 4–17, Patent Owner mischaracterizes the scope of Petitioner's and Mr. Schmandt's original arguments presented with the Petition. Contrary to Patent Owner's myopic view of the Petition, these originally-presented arguments were not limited to “edit, search, lookup commands typed on the controller and executed on the controller computer.” (*See Mot.* at 3; *cf. Pet.* at 20-22.)² Nor was Mr. Schmandt's opening testimony limited to programs operating

² Indeed, it appears that Patent Owner copied Section II-A of its motion from its

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