

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK INC.

Petitioner

v.

WINDY CITY INNOVATIONS, LLC

Patent Owner

U.S. Pat. No. 8,694,657

Issue Date: April 8, 2014

Title: REAL TIME COMMUNICATIONS SYSTEM

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**PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE**

Case No. IPR2016-01159<sup>1</sup>

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<sup>1</sup> Case No. IPR2017-00659 has been joined with this proceeding.

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## **I. Introduction**

Pursuant to the Board's scheduling order<sup>2</sup> (Paper No. 8), Patent Owner Windy City Innovations LLC respectfully submits this motion to exclude Petitioner Facebook Inc.'s evidence.

## **II. Ex. 1021, Second Declaration of Tal Lavian, Ph.D.**

Certain portions of the reply declaration of Dr. Tal Lavian (Ex. 1021) should also be excluded because the declaration includes evidence that exceeds the propose scope of a petitioner's reply. FRE 401, 402, 403, and 37 C.F.R. § 42.23(b). Pursuant to 37 C.F.R. § 42.23(b), certain portions of the reply declaration should be excluded because they contain citations, references, and arguments provided for the first time in the reply and they go beyond the permissible scope of a reply. These certain portions are not responsive to Patent Owner's response and could have been presented in the Petition. Accordingly, Petitioner's late inclusion of these certain portions are prejudicial to Patent Owner because Patent Owner would have addressed these new citations, references, and arguments in its preliminary response and/or response. Moreover, these certain portions should be deemed attempted gamesmanship as Petitioner uses the Board institution decision and Patent Owner's responses to perfect their arguments impermissibly by changing the scope of the challenged grounds. The following

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<sup>2</sup> Due Date 4 remains unaffected by the filing of the parties' scheduling stipulations and the Board's revised scheduling order in this case.

paragraphs contain examples of certain portions that should be excluded. Patent Owner also respectfully requests that the Board exclude any other sections that impermissibly change the scope of Petitioner's challenges and/or are not responsive to the Patent Owner's response.

**a. The new “other programs” arguments and supporting citations should be excluded from evidence.**

Regarding Exhibit 1021, ¶ 54 at lines 1–17, Petitioner presents new arguments which exceed the scope of the petition, and are irrelevant, confusing, and misleading with respect to the instituted grounds authorized for trial. Additionally, this section amounts to an attempt to construe the “other programs” limitation with new argument not previously presented in the petition. Indeed, Petitioner did not provide a construction for “other programs” and any attempt to do so now would be improper. 37 CFR 42.104(b)(3). None of Petitioner’s new arguments are related to this original argument in the petition. Accordingly, the Board should exclude this narrowly tailored section from evidence.

Regarding Exhibit 1021, ¶ 54 at lines 1–17, Petitioner presents new arguments to allege the disclosure of the “other programs” limitations in the Roseman reference. Petitioner supports its new arguments with new citations which are absent, and lack suggestion, from the petition. Particularly, Petitioner attempts to support its new arguments alleging the disclosure of “other programs”

at ¶ 54 at lines 17–22 with citations to Roseman at 12:1-5 and 12:9-10 and discussion of Windows and Macintosh client software alternatives. Petitioner’s new arguments amount to a drastic departure from its narrowly-tailored arguments in the Petition, which are merely directed to “other programs” being the computer programs associated with the various meeting or conference rooms maintained on the host computer. Ex. 1002 at ¶ 73 . None of Petitioner’s new arguments are related to this original argument in the petition. Accordingly, these narrowly tailored sections of the reply declaration should be excluded from evidence.

**b. The new “channels” arguments and supporting citations should be excluded from evidence**

Regarding Exhibit 1021, ¶ 74 at lines 1–6, Petitioner presents new arguments which exceed the scope of the petition, and are irrelevant, confusing, and misleading with respect to the instituted grounds authorized for trial. Additionally, this section amounts to an attempt to construe the “channel” limitation with new argument not previously presented in the petition. Indeed, None of Petitioner’s new arguments are related to this original argument in the petition. Accordingly, the Board should exclude this narrowly tailored section from evidence.

Regarding Exhibit 1021, ¶ 74 at lines 1–6, Petitioner presents new arguments to allege the disclosure of the “channel” limitation in the Roseman

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