

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

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Case IPR2016-01159<sup>1</sup>  
U.S. Patent No. 8,694,657

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**PETITIONER'S OPPOSITION TO MOTION TO EXCLUDE**

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<sup>1</sup> Case IPR2017-00659 has been joined with this proceeding.

Petitioner Facebook, Inc. respectfully submits this Opposition to Patent Owner Windy City Innovations LLC's Motion to Exclude (Paper No. 39 ("Motion")).

## I. INTRODUCTION

Patent Owner's Motion seeks to have excluded certain portions of the Second Declaration of Tal Lavian, Ph.D. (Ex. 1021) 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." (Mot. at 1.) Patent Owner's Motion should be denied in its entirety.

First, a motion to exclude is not the proper vehicle for a complaint about arguments and supporting evidence being outside the proper scope of a reply. Second, even if the Board were to consider the substance of the Motion, the challenged portions of Dr. Lavian's declaration are clearly within the proper scope of a reply and otherwise admissible, and Patent Owner falls far short of meeting its burden of establishing inadmissibility.<sup>2</sup>

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<sup>2</sup> The Motion also fails to "identify the objections in the record" as required by 37 C.F.R. § 42.64(c).

## II. PATENT OWNER'S MOTION SHOULD BE DENIED BECAUSE IT IS PROCEDURALLY IMPROPER

A proper 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 to 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 Inc. v. Papst Licensing GmbH & Co. KG*, No. IPR2016-01211, Paper 24 at 2 (P.T.A.B. Aug. 2, 2017).

The Board has repeatedly explained that a motion to exclude is not the proper vehicle for a complaint about arguments and supporting evidence being outside the proper scope of a reply. *See 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*, No. IPR2016-01211, Paper 24 at 2 (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) (denying motion to exclude); *Facebook, Inc. v. Software Rights Archive, LLC*, No. IPR2013-00478, Paper 58 at 37-38 (P.T.A.B. Feb. 2, 2015) (denying motion to exclude).

Here, Patent Owner's Motion is based entirely on the complaint that Dr. Lavian's second declaration exceeded the proper scope of a reply. In particular, Patent Owner argues:

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.

(Mot. at 1.) Accordingly, the Motion should be denied.

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 Ins. 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 Dr. Lavian’s declaration that Patent Owner objects to is properly within the permitted scope of reply testimony.

### **III. PATENT OWNER’S MOTION SHOULD BE DENIED BECAUSE THE CHALLENGED EVIDENCE IS PROPER REPLY EVIDENCE**

Even if the Board considers the substance of the Motion, the challenged portions of Dr. Lavian’s declaration are properly within the scope of a reply and otherwise admissible, as explained below.

#### **A. Dr. Lavian Reply Declaration re “Other Programs” (Ex. 1021, ¶ 54, lines 1-17)**

Patent Owner’s Motion first complains that Dr. Lavian offers new arguments regarding the “other programs” limitation of the claims. (Mot. at 2.) But as the objected-to portion makes clear, Dr. Lavian was directly responding to Dr. Carbonell’s argument that “nowhere is there a teaching in Roseman that more than one program associated with the conference room accesses the database.” Dr.

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