

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 RESPONSE TO PATENT OWNER'S MOTION FOR  
OBSERVATIONS ON CROSS EXAMINATION**

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

Patent Owner's Motion for Observations on Cross Examination of Facebook's Reply Witness Dr. Lavian (Paper No. 38), contains argumentative observations and should be expunged. Nevertheless, Petitioner respectfully submits the following responses.

**a. Response to Observation "a" (purportedly relevant to "any Association between Keys and Invitations in Roseman")**

Petitioner responds that Patent Owner mischaracterizes Dr. Lavian's testimony. In Exhibit 2013, on page 13, lines 17 to 20, Dr. Lavian testified regarding a "hypothetical situation that you may have a key that was not sent to anyone. So it's a key without an invitation." Dr. Lavian further testified on page 13 at lines 21 to 22 that he "need[ed] to investigate and see if this is the situation." Moreover, the testimony cited by Patent Owner is not relevant because the Petition focuses on keys that are actually sent to users. In fact, the page of the Petition Patent Owner cites explains that Roseman "discloses a security mechanism in which users must be invited and have an appropriate 'key' to enter the conference room." (Petition at 11 (bold in original, underlining added).)

**b. Response to Observation "b" (purportedly relevant to "Bob Metcalfe being a Leading Figure with Respect to the Internet")**

Petitioner responds that this observation is improper because it is both argumentative and fails to provide a citation to allegedly relevant arguments made in the record. *See, e.g., Medtronic, Inc. v. Nuvasive, Inc.*, No. IPR2013-00506,

Paper 37 at 3-4 (P.T.A.B. Oct. 15, 2014) (dismissing motion for observations containing argument); *Xilinx, Inc. v. Papst Licensing GMBH & Co., KG*, No. IPR2016-00104, Paper 22 at 9-10 (P.T.A.B. May 3, 2017) (expunging motion for observation where patent owner alleged testimony was relevant but failed to provide a citation to where patent owner's arguments were made in the record). In particular, Patent Owner improperly argues that Dr. Lavian's "testimony is relevant because it provides evidence that a person of ordinary skill in the art would have taken Metcalfe's prediction seriously in 1996." Petitioner further responds that Patent Owner mischaracterizes Dr. Lavian's testimony. In Exhibit 2013, on page 15, lines 8 to 9, Dr. Lavian testified that Bob Metcalfe "was not an expert of Internet traffic." In Exhibit 2013, on page 27, lines 12 to 14, Dr. Lavian further testified that Bob Metcalfe "was respectable in the area of LAN and the cable of Layer 2, not the performance of the Internet."

**c. Response to Observation "c" (purportedly relevant to "Article entitled 'Sage who warned of Net's Collapse eats his words.'")**

Petitioner responds that this observation is improper because it is both argumentative and fails to provide a citation to allegedly relevant arguments made in the record. *See, e.g., Medtronic*, No. IPR2013-00506, Paper 37 at 3-4; *Xilinx*, No. IPR2016-00104, Paper 22 at 9-10. In particular, Patent Owner improperly argues that Dr. Lavian's "testimony is relevant because it shows the degree that Metcalfe's prediction did come true." Petitioner further responds that Patent

Owner mischaracterizes Dr. Lavian's testimony. In Exhibit 2013, on page 24, lines 19, Dr. Lavian testified that he did not know whether alleged outages occurred. Moreover, Dr. Lavian's testimony that Patent Owner cites is not relevant because it provides no support for such outages actually occurring or for Metcalfe's alleged prediction.

**d. Response to Observation "d" (purportedly relevant to "Article entitled 'Bob Metcalfe on What's Wrong with the Internet.')**

Petitioner responds that this observation is improper because it is both argumentative and fails to provide a citation to allegedly relevant arguments made in the record. *See, e.g., Medtronic*, No. IPR2013-00506, Paper 37 at 3-4; *Xilinx*, No. IPR2016-00104, Paper 22 at 9-10. In particular, Patent Owner improperly argues that Dr. Lavian's "testimony is relevant because it shows the part of the basis of Metcalfe's prediction was reasonable." Petitioner further responds that Patent Owner mischaracterizes Dr. Lavian's testimony. In Exhibit 2013, on page 27, line 25, to page 28, line 2, Dr. Lavian testified that he did not think Metcalfe's "fear" was "based on any statistics or information." Moreover, Dr. Lavian's testimony that Patent Owner cites is not relevant because it provides no support for such Metcalfe's alleged "fear" or "prediction" being reasonable.

**e. Response to Observation “e” (purportedly relevant to “Books Authored by Loomis and Korth”)**

Petitioner responds that this observation is improper because it is both argumentative and fails to provide a citation to allegedly relevant arguments made in the record. *See, e.g., Medtronic*, No. IPR2013-00506, Paper 37 at 3-4; *Xilinx*, No. IPR2016-00104, Paper 22 at 9-10. In particular, Patent Owner improperly argues that Dr. Lavian’s “testimony is relevant because it casts doubt on whether more recent books during the relevant year of 1996 by these writers would provide the same information.” Petitioner further responds that Dr. Lavian’s testimony regarding not researching whether there were later editions of the cited books that Patent Owner cites is not relevant and does not “cast doubt” on whether the books’ authors “would provide the same information” in 1996.

**f. Response to Observation “f” (purportedly relevant to “Video Traffic on the Internet in 1996”)**

Petitioner responds that this observation is improper because it is both argumentative and excessively cites testimony spanning numerous pages. *See, e.g., Medtronic*, No. IPR2013-00506, Paper 37 at 3-4; *Xilinx*, No. IPR2016-00104, Paper 22 at 9-10. In particular, Patent Owner attempts to use Dr. Lavian’s testimony to make improper arguments regarding Exhibit 2014, arguing that “Dr. Lavian acknowledged that the article states that multicast video traffic appeared poised to explode a few years before 1997. Dr. Lavian did not dispute that such

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