Filed on behalf of TQ Delta, LLC
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,
v.

TQ DELTA, LLC,
Patent Owner.

Case IPR2016-01466
Patent No. 8,611,404

PATENT OWNER'S MOTION TO EXCLUDE INADMISSIBLE EVIDENCE PURSUANT TO 37 C.F.R. § 42.64

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64, Patent Owner TQ Delta, LLC ("Patent Owner") hereby moves to exclude Petitioner's Exhibit 1012 for lack of admissibility under the Federal Rules of Evidence.[1]

II. EXHIBIT 1012 SHOULD BE EXCLUDED

Exhibit 1012 is a declaration of Petitioner's expert, Dr. Kiaei, that was submitted with Petitioner's Reply (the "Reply Declaration") for this IPR proceeding and for IPR2016-01760 (the subject of which is Patent Owner's U.S. Patent No. 9,094,268). For the reasons discussed below, Ex. 1012 should be excluded under Fed. R. Evid. 402 and 403.

A. Paragraphs 1-3, 8-16, 22, and 25 of Exhibit 1012 Should Be Excluded Because Petitioner's Reply Does Not Cite to Them

The Board should exclude Paragraphs 1-3, 8-16, 22, and 25 of Exhibit 1012 under Fed. R. Evid. 402 and 403. Patent Owner timely objected to Paragraphs 1-3, 8-16, 22, and 25 of Exhibit 1012 on those grounds. *See* Paper 16 at 2.

[1] Patent Owner does not waive its objections to Petitioner's improper new arguments and evidence (identified in Paper No. 22) submitted for the first time on Reply. This motion only addresses inadmissibility under the FRE.

First, Paragraphs 1-3, 8-16, 22, and 25 are not relevant. Petitioner's Reply for this proceeding does not cite to those paragraphs. Therefore, the testimony at those paragraphs is not relevant to the issues in this proceeding and should be excluded pursuant to Fed. R. Evid. 402. *See* Fed. R. Evid. 402 ("Irrelevant evidence is not admissible.").

Moreover, any effort by Petitioner now to explain the relevance of Paragraphs 1-3, 8-16, 22, and 25 to this proceeding would result in confusion, delay, and wasted time. Accordingly, Paragraphs 1-3, 8-16, 22, and 25 of Exhibit 1012 should also be excluded under Fed. R. Evid. 403. *See* Fed. R. Evid. 403 ("The court may exclude relevant evidence if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury, undue delay, wasting time, or needlessly presenting cumulative evidence.").

B. Paragraphs 4-7, 17-21, and 23-24 of Exhibit 1012 Should Be Excluded Because they Constitute New Evidence that is Improperly Introduced in Petitioner's Reply

The Board should exclude Paragraphs 4-7, 17-21, and 23-24 of Exhibit 1012 as irrelevant under Fed. R. Evid. 402 because they constitute new evidence. The testimony in those paragraphs could have – and should have – been presented in Dr. Kiaei's first declaration (Ex. 1003). "A reply may only respond to arguments

raised in the… patent owner response." 37 C.F.R. § 42.23(b). While "replies may rely upon appropriate evidence," "[r]eply evidence… must be responsive and not merely new evidence that could have been presented earlier to support" the petition. *See* 77 Fed. Reg. 48612, 48620 (Comments regarding 37 C.F.R. § 42.23(b)) (emphasis added). Moreover, Paragraphs 4-7, 17-21, and 23-24 should also be excluded under Fed. R. Evid. 403 because their inclusion in this proceeding would result in confusion, delay, and wasted time. *See* Fed. R. Evid. 403. Patent Owner timely objected to Paragraphs 4-7, 17-21, and 23-24 of Exhibit 1012 on those grounds. *See* Paper 16 at 2.

1. Paragraphs 4-7 of Exhibit 1012

Paragraphs 4-7 of Exhibit 1012, on which Petitioner relied at pages 6-7 of its Reply, include new opinions regarding the meaning and scope of the claim term "synchronization signal," a claim term recited in U.S. Pat. No. 8,611,404.[2] In particular, Dr. Kiaei provides new testimony about how the claims "never limit synchronization to any specific type" and that the term "synchronization signal"

[2] They also provide new opinions regarding the claim term "maintaining synchronization with a second transceiver," which is recited in claims of the patent under examination in IPR2016-01760, U.S. Patent No. 9,094,268.

"must be broad enough to include" timing synchronization and frame synchronization. *See* Ex. 1012 at 3-5.

This testimony regarding the scope of "synchronization signal" could have – and should have – been made in Dr. Kiaei's first declaration. Indeed, as the term "synchronization signal" does not appear in the specification, Dr. Kiaei certainly should have anticipated that its construction would require more than the cursory analysis provided in his first declaration. *See* Ex. 1003 at ¶¶ 53-56. Moreover, Patent Owner and its expert have no opportunity to respond to this new testimony from Dr. Kiaei regarding the scope of "synchronization signal."

Therefore, Paragraphs 4-7 of the Reply Declaration should be excluded.

2. Paragraphs 17-18 of Exhibit 1012

Paragraphs 17-18 of Exhibit 1012, on which Petitioner relies at pages 16 and 17 of its Reply, should be excluded because they offer improper new testimony about the teachings of the prior art that was not (but could have been) presented in Dr. Kiaei's first declaration.

At paragraph 17, Dr. Kiaei testifies for the first time that Yamano's "timing signal" is used "to maintain synchronization *by correcting timing errors to avoid re-initialization*." Ex. 1012 at 9-10. Despite spending several pages of his first declaration discussing Yamano and its "timing signal," *see* Ex. 1003 at pp. 26-31,

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