

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Twilio Inc.  
Petitioner

v.

TeleSign Corporation  
Patent Owner

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*Inter Partes* Review No. IPR2016-01688  
Patent No. 9,300,792

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**PATENT OWNER'S MOTION TO EXCLUDE UNDER 37 C.F.R. § 42.64(c)**

Patent Owner moves the Board to exclude the testimony of Dr. Seth Nielson relied upon in Petitioner's Reply at page 10, which cites to EX 1035 at 18:15-9:5. That testimony was improperly elicited at deposition because it is beyond the scope of Dr. Nielson's declaration. The line of question begins in EX 1035 at 17:5-7, where counsel seeks a claim-construction position from Dr. Nielson regarding the term "actions" and continues therefrom.

5 Q And what is the construction of  
6 "actions" that you used when analyzing Claim 1  
7 of the '792 patent?  
8 MR. DYKAL: Objection, beyond the  
9 scope.

Counsel for TeleSign timely objected during the deposition to the line of questioning. EX. 1035 at 17:8-9 (above); see also, e.g., 27:6-13 (below).

6 Q Now, as we turn to the nonclaim  
7 portion of the '792 patent -- I'm going to walk  
8 you through the individual portions, and I would  
9 like you to identify any disclosure that gives  
10 examples of an action.  
11 MR. DYKAL: I object to this line of  
12 questioning as beyond the scope of the  
13 deposition.

Out of an abundance of caution, TeleSign also filed an objection with the Board. Paper 19.

Dr. Nielson's declaration (EX 2008) does not offer an opinion on the claim construction of the term "actions" (or variations thereof). Thus, testimony related to such is outside the scope of Dr. Nielson's Declaration. 37 CFR 24.53(d)(5)(ii) ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony."). Patent Owner requests that the Board exclude EX 1035 at 18:15-9-5 as cited in Petitioner's Reply (and commensurately avoid considering any corresponding argument related to it).

The lines of questioning drew numerous scope objections. Petitioner has not yet expressly relied on all of the lines of questioning to which Patent Owner's counsel objected during Dr. Nielson's Declaration. But if Twilio later refers to any such evidence, and the Board finds that it is outside the scope of Dr. Nielson's declaration, Patent Owner moves the Board to exclude such testimony and disregard the points it is intended to support.

Dated: September 26, 2017

Respectfully submitted,

By: /ELENA K. MCFARLAND/

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 26, 2017, a copy of the foregoing was served by electronic mail (or is being served by electronic mail simultaneously with its filing on even date) on the persons listed below at their corresponding addresses, which includes all counsel of record.

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