UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAWASAKI RAIL CAR, INC.
Petitioner,

v.

SCOTT BLAIR,
Patent Owner.

Case No. IPR2017-00117

Patent No. 6,700,602

Issue Date: March 2, 2004

Title: Subway TV Media System

PETITIONER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), Petitioner Kawasaki Rail Car, Inc. moves to exclude an inadmissible four-page exhibit (Ex. 2006-325-328, marked as PO-8 ("PO-8")) that Patent Owner attempted to introduce for the first time on November 28, 2017 at the deposition of Petitioner's expert, Lowell Malo. In addition to objections made at the deposition relating to that particular line of questioning (Ex. 2006-99, at 88:3-4), Petitioner, on November 29, 2017, timely served Patent Owner via email with objections to the admissibility of PO-8 pursuant to § 42.64(b)(1). Ex. 1029. Patent Owner's new exhibit (PO-8) is an attempt to introduce new evidence that Patent Owner failed to raise in its Patent Owner Response by using Mr. Malo's deposition as a vehicle to circumvent the Board's rules.

As explained below, the exhibit should be excluded because Patent Owner failed to disclose it in a timely manner, because it goes beyond the scope of direct testimony in Petitioner's expert's reply declaration, and also on relevance, authenticity and hearsay grounds.

II. ARGUMENT

A. PO-8 Should Be Excluded Because It Was Not Timely Disclosed and Goes Beyond the Scope of the Direct Testimony Set Forth in the Supplemental Declaration of Lowell Malo

PO-8 should be excluded because it is untimely under the Board's rules. Patent Owner did not submit this exhibit in support of its Patent Owner's

Preliminary Response (Paper No. 6) or Patent Owner Response (Paper No. 13). Patent Owner instead attempted to introduce it during the deposition of Petitioner's expert, and now attempts to move this exhibit into evidence through a post-reply deposition of Mr. Malo and observations on cross-examination regarding that deposition. This is improper.

According to 37 C.F.R. § 42.53(5)(ii), the scope of cross-examination testimony "is limited to the scope of the direct testimony." For cross-examination testimony relating to a reply witness, the scope of the examination is limited to the scope of the direct testimony of the reply witness, which is the witness's declaration submitted in support of the reply.

In this regard, the Office Trial Practice Guide has recognized two discovery periods for a patent owner. The first discovery period begins after the institution decision but ends before the patent owner files its response. Office Trial Practice Guide, 77 Fed. Reg. 48757-8 (Aug. 14, 2012). In cases where patent owner is not seeking to amend the claims, the second discovery period takes place after the petitioner's reply to the patent owner's response. *Id*. Patent owner can cross-examine a reply witness in the second discovery period, but any such cross-examination testimony can be called to the Board's attention only by filing a motion for observation. *Id*. at 78767-8. Moreover, the scope of any such observation is limited to the testimony concerning petitioner's reply to the patent

owner's response. *Respironics, Inc. v. Zoll Medical Corp.*, IPR2013-00322, Paper 26 at 4 (PTAB May 7, 2014). "It is improper to introduce issues into the proceeding that could have been presented during the first discovery period after Petitioner's Reply has been filed." *American Express Co. v. MetaSearch Systems, LLC*, CBM2014-00001, Paper. No. 70 at 27-28 (PTAB Mar. 13, 2015) (citing *Respironics*, at 4). Otherwise, Patent Owner may improperly "defer deposing [the witness] until after filing the Patent Owner Response in an attempt to introduce new issues into the proceeding after Patent Owner's response period and after first discovery period had concluded." *Respironics*, at 4. This is precisely what Patent Owner has done here.

Both the Petition and the original supporting declaration of Petitioner's expert, Lowell Malo (Ex. 1014), identified the prior art and the proposed regulations from the Federal Railroad Administration ("FRA"), as well as other information, as material that would have been known to one of ordinary skill in the art at the time of the alleged invention. In its Preliminary Response filed on February 6, 2017 (Paper No. 6) and Patent Owner Response filed on August 7, 2017 (Paper No. 13), and the accompanying declarations of Patent Owner's expert, Jack Long (Exs. 2002 and 2004), Patent Owner never raised ventilation or fire safety as an issue to be addressed in this proceeding. Patent Owner also chose not to take the deposition of Petitioner's expert with respect to his original declaration

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.