Paper No. ___
Filed: March 5, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Cases IPR2017-00219
Patent 7,116,710

PATENT OWNER'S MOTION TO EXCLUDE

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I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c) and the Federal Rules of Evidence, Caltech respectfully moves to exclude Exhibits 1212, 1213, 1216, 1219, 1229-1249, 1253, 1255, 1257-1261, 1265, 1267, 1268 and portions of Exhibits 1262 and 1264. The Federal Rules of Evidence apply to *inter partes* proceedings. 37 C.F.R. § 42.62; *LKQ Corp. v. Clearlamp, LLC*, IPR2013-00020, Paper 17, at 3 (Mar. 5, 2013).

These exhibits are part of a larger pattern of Petitioner's contravention of Board rules. Having recognized that the petition's arguments and evidence cannot sustain a finding of unpatentability, Petitioner has engaged in an improper rehabilitation campaign with new arguments, new evidence, and testimony elicited from out-of-scope questions. Several of these issues have already been briefed in Petitioner's motion for sanctions. Paper 49. But the Federal Rules of Evidence and the Board's Trial Practice rules forbid Petitioner's "shifting-sands" approach. The new exhibits must be excluded because they largely lack relevance to any instituted ground, and they are unduly prejudicial to Caltech because Caltech lacks any meaningful opportunity respond to the new evidence. FRE 401; 402; 403.

II. ARGUMENT

A. Exhibits 1244-1249, 1257-1261, 1265, and 1268 should be excluded for being new evidence used to support new arguments

Exhibits 1244-1249, 1257-1261, 1265, and 1268 were not submitted until

after Caltech had filed its Patent Owner Response. To the extent those exhibits were cited in Petitioner's reply, they were cited in support of arguments that were not made in the petition and were therefore improper to raise for the first time in Petitioner's reply. 37 CFR §42.23(b); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge*, 821 F. 3d 1359, 1370 (Fed. Cir. 2016). As such, they are not relevant to the instituted grounds of review. FRE 401; FRE 402.

Exhibits 1244-1249 and 1257-1260 are various diagrams, including Tanner graphs, that were admittedly created by Petitioner's lawyers (*see, e.g.*, Ex. 1246, 415:14-18) and purport to depict the prior art. These exhibits were first introduced in the depositions of Dr. Mitzenmacher (Exs. 1244-1249) and Dr. Divsalar (Exs. 1257-1260), and have no relevance to the witnesses' direct testimony. The questions relating to these exhibits were largely attempts to authenticate the exhibits so that Petitioner could rely on them in its reply to support new arguments. For example, Petitioner relies on Exhibit 1246 for the argument that it illustrates a "POSA's reasonable expectation of success." Reply 10. But the petition *never* discusses reasonable expectation of success (much less a POSA's reasonable expectation of success with respect to the graph depicted in Exhibit 1246), and so the evidence lacks relevance to any of the instituted grounds. Petitioner could have, and *should have*, introduced Exhibit 1046 in its petition if it wanted to rely on the document with respect to necessary aspects of an obviousness challenge.

Exhibit 1261 is a 2005 paper by Dr. Divsalar, *et al*. Not being prior art, this paper has zero relevance to any issues in this case. Petitioner's reply relies on this exhibit to argue that it is inconsistent with Dr. Divsalar's declaration (though does not identify which section of his declaration). Reply 11-12. But whatever Dr. Divsalar may have said in his 2005 paper has no relevance to his testimony regarding what he knew *at the time of the patent*.

Exhibit 1268 is purportedly a "[s]imulation of Regular and Irregular Divsalar Codes" conducted by Dr. Frey. Petitioner relies on this exhibit to show its proposed modification to Divsalar "would not have been difficult" and "would have had a reasonable expectation of success." Reply 10. As explained above, the petition never argued that any proposed modification would have had a reasonable expectation of success, and there is simply no reason why such evidence or arguments could not have been made in the petition. In addition, the simulation purports to test a Divsalar repeat-5 code that has been modified to repeat some bits 3 times and some bits 7 times. The petition never presented such a proposed modification—instead, Petitioner proposed that a Tanner graph in inventor Khandekar's thesis (which is not prior art) be modified such that "instead of both information bits being repeated three times, one of the information bits is repeated *four* times, while the other information bit is repeated *twice*." Pet. 40 (emphasis in original). Thus, the new simulation data must be excluded as it is a completely

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