Filed: March 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,

Patent Owner.

Case IPR2017-00219

U.S. Patent No. 7,116,710

PETITIONER'S OPPOSITION TO

PATENT OWNER'S MOTION TO EXCLUDE

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I. Introduction

Caltech's motion to exclude is yet another attempt by Caltech to distract from the invalidity of the claims and avoid the Board's consideration of the merits.

First, a motion to exclude is not the appropriate vehicle for objecting to the scope of reply evidence. As the Board has "stated repeatedly":

> a motion to exclude is not a vehicle for arguing that Petitioner's arguments and supporting evidence are outside the proper scope of a reply. A motion to exclude evidence for the purpose of striking or excluding an opponent's brief and/or evidence that a party believes goes beyond what is permitted under 37 CFR § 42.23 is improper. An allegation that evidence does not comply with 37 CFR § 42.23 is not a sufficient reason under the Federal Rules of Evidence for making an objection and requesting exclusion of such evidence.

Palo Alto Networks, Inc. v. Finjan, Inc., IPR2015-01979, Paper No. 62 at 66 (Mar. 15, 2017) (internal footnote citing five other cases to this effect omitted.).

Caltech's brief merely rehashes arguments related to the scope of evidence that it already made in its motion for sanctions (paper 49). Even if it were proper for Caltech to raise these arguments again here (and it is not), Caltech's motion should still be denied because the challenged exhibits were properly submitted in support of the Petition (paper 5) and in response to arguments made by Caltech in its POR (paper 34). Petitioner has raised no new arguments, and instead Caltech continues to mischaracterize legitimate rebuttals of its positions as "out of scope"

(apparently out of a hope to avoid addressing their merits).

Second, Caltech's repeated assertions of prejudice are baseless. Caltech has knowingly elected not to use evidentiary tools at its disposal, including choosing not to cross-examine Petitioner's experts. In addition, the Board has already generously accommodated Caltech by granting it leave to file a sur-reply and raise its allegations that deposition questions exceeded the scope of direct testimony through a motion for sanctions.

II. Argument

A. Exs. 1244-1249, 1257-1261, 1262, 1264, 1265, and 1268: Caltech's Argument That These Are "New Evidence" For "New Arguments" Should Be Rejected

Caltech argues that portions of the deposition transcripts of Dr. Mitzenmacher (Ex. 1262) and Dr. Divsalar (Ex. 1264) as well as Exs. 1244-1249, 1257-1261, 1265, and 1268 should be excluded under 35 CFR §42.23(b) because the evidence "has no relevance to the witnesses' direct testimony" and because the deposition questions were "beyond the scope of witness's direct testimony."[1]

[1] Caltech cites *Intelligent Bio-Systems, Inc. v. Illumina Cambridge* as purported support for its exclusion argument. 821 F.3d 1359, 1370 (Fed. Cir. 2016). However, Bio-Systems Inc. involved an actual shift in the petitioner's theory of obviousness from using a reference as-is to modifying that reference. *Id*. at 1366

Caltech is mistaken.

First, Caltech's challenge should be rejected because it is an improper attempt to challenge the scope of Petitioner's evidence. *Palo Alto Networks, Inc.*, IPR2015-01979, Paper No. 62 at 66 (Mar. 15, 2017).

Second, as explained in Petitioner's Opposition to Patent Owner's Motion for Sanctions, the questions raised during the cross-examinations of Dr. Mitzenmacher (Ex. 1262) and Dr. Divsalar (Ex. 1264) were properly raised in rebuttal of statements and opinions proffered by Caltech's experts in declaration testimony and in support of arguments made in the Petition. *See* Paper 51; Ex. 1274 (identifying the relevance for each challenged line of questioning).

For the same reasons, as discussed below, the exhibits used to cross-examine and rebut the declaration testimony of Caltech's experts (including Exs. 1244-1249, 1257-1260, and 1268) as well as Dr. Frey's declaration regarding these exhibits (Ex. 1265) are also properly in the record. *See Vibrant Media, Inc. v.*

("[T]he Reply presents new issues by changing the unpatentability rationale from express reliance on Zavgorodny's deprotecting conditions, to asserting that those conditions would have been obvious to modify.") (citation omitted). Caltech can identify no analogous situation in the present case because no new arguments and no new theories of invalidity have been presented.

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