

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2017-00297¹
Patent 7,916,781

PATENT OWNER'S SECOND NOTICE OF OBJECTION TO EVIDENCE

¹ Case IPR2017-00423 has been consolidated with this proceeding.

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner California Institute of Technology (“Caltech”), submits the following objections to Petitioner Apple Inc.’s (“Petitioner”) Exhibits 1053-1055. As required by 37 C.F.R. § 42.62, Patent Owner’s objections below apply the Federal Rules of Evidence (“F.R.E.”).

II. OBJECTIONS

Caltech objects to Ex. 1053, “Relevance of Deposition Questions Summary”; Ex. 1054, “Declaration of Dariush Divsalar”; Ex. 1055, “Transcript of Deposition of Dr. Dariush Divsalar”.

Grounds for Objection: F.R.E. 401 (Test for Relevant Evidence); F.R.E. 402 (General Admissibility of Relevant Evidence); F.R.E. 403 (Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons).

On February 10, 2018, the Board authorized Patent Owner to file a 10-page combined motion to strike and motion for sanctions relating to testimony from Dr. Mitzenmacher and Dr. Divsalar that was elicited from out-of-scope questions. Paper 39. Petitioner was authorized to file a 10-page response. *Id.* The Board also authorized the parties to include a tabular listing “to supplement the parties’ papers and should not be used for substantive argument.” *Id.*

Patent Owner’s tabular listing (Ex. 2037) followed these instructions, identifying the offending lines in Dr. Mitzenmacher and Dr. Divsalar’s deposition

transcripts, and providing a short, neutral description of the subject matter. By contrast, Petitioner put forth extensive substantive argument in its tabular listing. Every row in Petitioner's listing includes substantive arguments regarding why Petitioner believes the identified testimony is relevant. Exhibit 1053 itself labels the descriptive column as "Relevance to [Mitzenmacher/Divsalar] Declaration." Indeed, Petitioner admits that, "[a]s *detailed* in Exhibit 1053, Petitioner's questions were entirely directed to topics addressed and opinions given in Dr. Divsalar's and Dr. Mitzenmacher's declarations." Opp. Motion for Sanctions, Paper 44, p. 2. But *detailed* explanations of relevance are precisely what the Board forbade the parties to include in the tabular listing.

For these reasons, Exhibit 1053 should be excluded for exceeding the relevant scope of the Board's authorization regarding the tabular listing. FRE 401; 402. Exhibit 1053 should also be excluded for prejudicing Caltech because it gave Petitioner essentially nine additional pages of briefing, a significant extension of the 10-page briefs the Board authorized for each party. FRE 403.

Exhibits 1054 and 1055 should also be excluded. These exhibits are the direct and cross-examination testimony of Dr. Divsalar. However, Dr. Divsalar is not a witness in this case, and no party is relying on his testimony for any substantive issue. Neither exhibit is cited in the petitions, Patent Owner's response, or Petitioner's reply. Thus, Exhibits 1054 and 1055 are not relevant.

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FRE 401; FRE 402. Caltech would also be prejudiced if these exhibits were admitted into the record, because it would allow Patent Owner to rely on these exhibits without giving Caltech adequate notice to respond. FRE 403.

III. CONCLUSION

Exhibits 1053-1055 were filed and served on February 27, 2018. These objections are made within five business days of service.

Respectfully submitted,

Date: March 6, 2018

/ Michael T. Rosato /
Michael T. Rosato, Lead Counsel
Reg. No. 52,182

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CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Second Notice of Objection to Evidence was served on this 6th day of March, 2018, on the Petitioner at the electronic service addresses of the Petitioner as follows:

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Respectfully submitted,

Date: March 6, 2018

/ Michael T. Rosato /
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