UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,

Patent Owner

Case IPR2017-00728

U.S. Patent No. 7,421,032

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 42). 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 32). Petitioner has raised no new arguments, and instead Caltech continues to mischaracterize legitimate rebuttals of its positions as "out of scope."

Second, Caltech's repeated assertions of prejudice are baseless. Caltech has knowingly elected not to use evidentiary tools at its disposal, seeking now to exclude testimony rather than cross-examining 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, 1265, 1268, 1271, 1272, 2038, and 2039: 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. 2038) and Dr. Divsalar (Ex. 2039) as well as Exs. 1244-1249, 1257-1261, 1265, 1268, 1271, and 1272 should be excluded under 35 CFR §42.23(b) because the exhibits are "not relevant" [1] and because the deposition

[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, *Intelligent Bio-Systems Inc*. involved an actual shift in the petitioner's

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