

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VOIP-PAL.COM, INC.
Patent Owner

Case No. IPR2016-01198
Patent 9,179,005

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE**

Patent Owner challenges two opinions proffered by Petitioner's expert, Dr. Henry Houh. First, Patent Owner disagrees with Dr. Houh's opinion that the Chu '684 prior art reference could be improved by modifying it in accordance with the dialed digit modification teachings of the Chu '366 reference and, separately, the Chen reference (collectively, the "Secondary References"). **Paper 40**, *Motion to Exclude* at 1. Second, Patent Owner disagrees with Dr. Houh's opinion and Petitioner's reliance thereon regarding the meaning of "subscriber" in the Challenged Patent and in the Chu '684 reference. But a mere disagreement with an expert's opinion is not grounds to exclude an exhibit and Voip-Pal cites no authority supporting this position. Indeed, both of these challenges misconstrue the facts and the law, look at individual paragraphs in a vacuum, and are more properly addressed to the weight to be accorded Dr. Houh's opinions, not their admissibility. Because the Board is well-positioned to evaluate Dr. Houh's opinions and accord them the appropriate weight, Patent Owner's motion should be denied.

The remainder of Patent Owner's objections in its Motion to Exclude relate to how Petitioner has characterized the testimony of Patent Owner's own declarants. There, Patent Owner seeks to exclude Apple's arguments and not the evidence itself. As the Board already noted "such content is not proper for a motion to exclude." **Paper 43**, at 3.

a. Excluding Evidence is an Extreme Remedy and Voip-Pal's Motion Should be Denied to Ensure a Complete Record for the Public and for Appellate Review

Patent Owner seeks an extreme remedy—exclusion of evidence that it disagrees with from the formal record in this case. However, well-settled precedent with the Board makes clear that the preferred course of action is “to assign the appropriate weight to be accorded to evidence” instead of excluding the evidence. *See Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00002 (PTAB Jan. 23, 2014 (citing *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”)).

Moreover, because the Board is sitting as a non-jury tribunal with administrative expertise and it is well-positioned to determine and assign appropriate weight to the evidence without resorting to formal exclusion that might later be held reversible error. *See, e.g., SEC v. Guenthner*, 395 F. Supp. 2d 835, 842 n.3 (D. Neb. 2005); *Builders Steel Co. v. Comm’r*, 179 F.2d 377, 379 (8th Cir. 1950). This is why the PTAB generally prefers to determine the appropriate weight to give expert evidence “without resorting to formal exclusion that might later be held reversible error.” *Informatica Corp. v. Protegrity Corp.*, CBM2015-00021, Paper 38 at 52 (PTAB May 31, 2016). Indeed, “[i]n an *inter partes* review, we

regard it as the better course to have a complete record of the evidence to facilitate public access, as well as appellate review.” *Sony Computer Entm’t Am. LLC v. Game Controller Tech. LLC*, IPR2013-00634, Paper 32 at 31 (PTAB Apr. 14, 2015); *see also Gnosis S.p.A. v. S. Alabama Med. Sci. Found.*, IPR2013-00118, Paper 64 at 43 (PTAB June 20, 2014) (citing *Donnelly Garment Co. v. NLRB*, 123 F.2d 215, 224 (8th Cir. 1941) (“If the record on review contains not only all evidence which was clearly admissible, but also all evidence of doubtful admissibility, the court which is called upon to review the case can usually make an end of it, whereas if evidence was excluded which that court regards as having been admissible, a new trial or rehearing cannot be avoided.”)).

Voip-Pal’s objections amount to nothing more than a disagreement with his characterization of the prior art and his ultimate opinion that the prior art obviates each of the Challenged Claims. But Patent Owner’s disagreement is not grounds to exclude Dr. Houh’s opinions, especially in light of the overwhelming precedent against such a draconian remedy.

b. Voip-Pal Provides No Explanation for Why Dr. Houh’s Opinions Violate FRE 701-703 and FRE 401-403

Patent Owner sets forth two main disagreements with Dr. Houh’s opinions. The entirety of these disagreements are set forth in two short paragraphs without any explanation as to how these opinions allegedly violate the FRE. The first

disagreement appears to be that Dr. Houh made an assertion in paragraphs 38 and 43 of his declaration that is “unsupported by any citation to Chu ‘684 or explanation.” **Paper 40**, at 1. Patent Owner then broadly claims that this is “improper testimony under FRE 701-703” and “should also be excluded under FRE 401-403 as irrelevant and misleading.” *Id.* The second disagreement is equally devoid of details claiming that Dr. Houh has a “fundamental misunderstanding of ‘subscriber’ and ‘subscriber-specific dial plan’” and, therefore, “should also be excluded under FRE 401-403 as irrelevant and misleading.” *Id.*

Patent Owner apparently leaves it to Petitioner and the Board to guess why and how FRE 701-703 and FRE 401-403 apply. This guessing game is insufficient under the Board’s guidelines for Motions to Exclude. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) (“A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay)....”). Board precedent also makes clear that merely citing to a series of Federal Rules of Evidence without explanation for how they apply is insufficient. *See Samsung Electronics America, Inc., et al. v. Smartflash LLC*, CBM2014-00190, Paper 47, at 25 (“We also are not persuaded by this argument. Petitioner does not explain, for example, why Rules 701 and 702 apply to the excerpts at issue.”).

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