

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.

Petitioner

v.

UNILOC LUXEMBOURG S. A.¹

IPR2017-1799

PATENT 8,199,747

**PATENT OWNER REPLY IN SUPPORT OF
ITS MOTION TO EXCLUDE**

¹ The owner of this patent is Uniloc 2017 LLC.

Patent Owner's motion to exclude strictly complies with the requirements of 42.64(c), which states:

A motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the record in order and must explain the objections. The motion may be filed without prior authorization from the Board.

37 C.F.R. § 42.64(c). Consistent with this section, Patent Owner's motion (1) identifies the objections in the record in order and (2) explains the objections. Petitioner's claim that Patent Owner failed to explain the objections is simply false. As explained in the motion, Petitioner spent nearly the entire deposition posing questions outside the scope of Mr. Easttom's declaration. The basis for each objection is that it exceeds the scope of Mr. Easttom's declaration. The meaning of this objection is self-evident – the questions posed by Petitioner exceeded what was discussed in Mr. Easttom's declaration. Any further explanation would require Patent Owner to prove a negative by proving what is *not* in Mr. Easttom's declaration, a fruitless exercise.

Petitioner complains that Patent Owner's motion does not identify where in the record the evidence sought to be excluded was relied upon by Petitioner. Not knowing if Petitioner would attempt to rely on deposition testimony outside the scope of Mr. Easttom's declaration in trial exhibits or any other later-filed documents, Patent Owner timely filed its motion to exclude to preserve its objections. While section 42.64(c) does not, on its face, require a motion to exclude

to identify where in the record the objectionable evidence was relied upon by the opponent (a requirement mentioned only by the practice guide), it *does* require a timely motion to exclude to preserve *any* objection. Under the scheduling order, Patent Owner's deadline to file a motion to exclude was September 28.

The updated practice guide recognizes that the Board generally waits until after the oral hearing, when it reviews the record in its entirety, to decide the merits of any motions to exclude. Consistent with this guideline, Patent Owner does not oppose delaying a decision on its motion to exclude until after all exhibits and documents have been filed. Patent owner requests, however, the right to supplement its motion to exclude in the event Petitioner later attempts to rely on deposition testimony outside the scope of Mr. Easttom's declaration.

Date: October 19, 2018

Respectfully submitted,

By: /s/ Brett A. Mangrum
Brett A. Mangrum
Attorney for Patent Owner
Reg. No. 64,783

Ryan Loveless
Attorney for Patent Owner
Reg. No. 51,970

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), we certify that we served an electronic copy of the foregoing PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.107(a) along with any accompanying exhibits via the Patent Review Processing System (PRPS) to Petitioner's counsel of record at the following address:

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Respectfully submitted,

By: /s/ Brett A. Mangrum

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