

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

UNILOC LUXEMBOURG, S.A.
Patent Owner

IPR2018-00294
PATENT 6,736,759

**PATENT OWNER MOTION TO EXCLUDE
PURSUANT TO 37 C.F.R. § 42.120**

Patent Owner moves pursuant to 37 CFR §§ 42.53(d)(4)(ii) and 42.64(c) to exclude portions of the deposition transcript of William C. Easttom, II, filed as Exhibit 1027. Under Section 42.64(c):

A motion to exclude evidence must be filed to preserve any objection. The motion must [1] identify the objections in the record in order and must [2] explain the objections. The motion may be filed without prior authorization from the Board.

See 37 C.F.R. § 42.64(c). Further, according to the Trial Practice Guide, “[a] motion to exclude evidence must: ... [3] [i]dentify where in the record the evidence sought to be excluded was relied upon by an opponent.” Trial Practice Guide, 77 Fed. Reg. 48,756, 47,867.

Petitioner’s Reply to Patent Owner’s Response (Paper 12) relies on several excerpts from the cross examination of Dr. Easttom (EX1027) that exceed the proper scope of cross-examination testimony allowed under Section 42.53(d)(4)(ii), which limits the scope of cross-examination testimony to “the scope of direct testimony.” Because such testimony was not “taken, sought, or filed” in accordance with Subpart A of Section 42, it is inadmissible and should be excluded from Petitioner’s briefs, motions and exhibits.

Inadmissible evidence in the order it appears in the transcript:

First, Petitioner’s Reply relies on EX1027 at **24:16-25:11**. *See* Paper 12 at 8. This testimony exceeds the scope of Dr. Easttom’s direct testimony and is therefore inadmissible under Section 42.53(d)(4)(ii). Patent Owner preserved this objection

by objecting to scope during Dr. Easttom's cross examination. *See* EX1027 at 24:21-22. This excerpt of Dr. Easttom's testimony should, therefore, be excluded from Petitioner's briefs, motions and exhibits.

Second, Petitioner's Reply relies on EX1027 at **26:2-15**. *See* Paper 12 at 7. This testimony exceeds the scope of Dr. Easttom's direct testimony and is therefore inadmissible under Section 42.53(d)(4)(ii). Patent Owner preserved this objection by objecting to scope during Dr. Easttom's cross examination. *See* EX1027 at 26:4-5. This excerpt of Dr. Easttom's testimony should, therefore, be excluded from Petitioner's briefs, motions and exhibits.

Third, Petitioner's Reply relies on EX1027 at **58:22-60:4**. *See* Paper 12 at 7. This testimony exceeds the scope of Dr. Easttom's direct testimony and is therefore inadmissible under Section 42.53(d)(4)(ii). Patent Owner preserved this objection by objecting to scope during Dr. Easttom's cross examination. *See* EX1027 at 58:24-25. This excerpt of Dr. Easttom's testimony should, therefore, be excluded from Petitioner's briefs, motions and exhibits.

Fourth, Petitioner's Reply relies on EX1027 at **86:25-87:11**. *See* Paper 12 at 17. This testimony exceeds the scope of Dr. Easttom's direct testimony and is therefore inadmissible under Section 42.53(d)(4)(ii). Patent Owner preserved this objection by objecting to scope during Dr. Easttom's cross examination. *See*

EX1027 at 87:4. This excerpt of Dr. Easttom's testimony should, therefore, be excluded from Petitioner's briefs, motions and exhibits.

Date: January 3, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that the foregoing was served on the Petitioner's counselors of record
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