

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

UNILOC LUXEMBOURG S.A.
Patent Owner

Case No. IPR2018-00884
Patent No. 8,539,552

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. INTRODUCTION

Having declined to depose Petitioner's expert, Patent Owner's Response is largely a rehash of the arguments presented in its Preliminary Response (POPR). Because Patent Owner presents no new evidence or arguments that support the Board modifying its preliminary findings at institution, the Board should again reject Patent Owner's contentions and cancel the Challenged Claims.

II. ARGUMENT

A. **The Board Correctly Concluded That Kalmanek's SETUP Message is Intercepted by the Gate Controller.**

Patent Owner's primary argument, repeated throughout its Preliminary Response ("POPR") and Response, is that Kalmanek's SETUP message is not "intercepted" by the Gate Controller ("GC") because the message is intentionally sent to the GC. *See Paper 11, Response* at iv-xii (arguing "'intercepting' a message cannot include being the intended, targeted recipient of that message"). At institution, this Board properly rejected Patent Owner's overly narrow view of "intercepting," concluding Kalmanek's SETUP message is "passed through, or intercepted by, the gate controllers" and ultimately delivered to "the terminating telephone interface unit"—the intended recipient of the message. **Paper 8, Institution Decision ("ID")** at 17. Patent Owner's continued insistence that intercepting must be surreptitious is inconsistent with the intrinsic record and should again be rejected.

i. An intercepting device need not be an unintended “third party” as Patent Owner insists

Relying solely on two paragraphs from Dr. Easttom's original declaration submitted with the POPR, Patent Owner proclaims that “a POSITA would understand that the device that is *intercepting* a message would be a third party to the intended recipients of that message.” **Paper 11**, *Response* at vi. Because Patent Owner did not permit cross examination of its expert, Dr. Easttom's opinions should be accorded no weight. But, even if the Board were to consider the two paragraphs from Dr. Easttom's declaration, they are entirely conclusory and in conflict with the intrinsic record.

a) Dr. Easttom was not made available for cross examination—his declaration and any reliance thereon should be accorded no weight

Having submitted a declaration relied upon by Patent Owner in its Response, the rules of discovery explicitly allow Petitioner to cross-examine Dr. Easttom. *See* 37 C.F.R. 42.51(b)(1)(ii); 37 C.F.R. 42.53(b)(2). And, the Board has made clear: “[a]s a guiding principle of *routine discovery*, as defined by our Rules, if a party proffers a witness's testimony, that party **must** make that witness available for cross-examination by the other party.” *HTC Corp. v. NFC Technology, LLC*, IPR2014-01198, Paper 41, at 3 (PTAB Nov. 6, 2015) (emphasis added on “must”). The Board may exercise its authority to strike a declaration when the declarant is not made available for cross-examination. *See id* at 4. Further, “little to no weight is given to

testimony of declarants who are not subject to cross-examination, even if the testimony is not excluded as hearsay.” *The Mangrove Partners Master Fund, LTD, et al., v. VirnetX Inc.*, IPR2015-01047, Paper 52 at 2 (PTAB Apr. 15, 2016); *see also Kolmes v. World Fibers Corp.* 107 F.3d 1534, 1542 (Fed. Cir. 1997) (holding that evidence was properly disregarded since no opportunity to cross-examine declarant). Here, Petitioner was not afforded an opportunity to cross examine Dr. Easttom and his declaration should be given no weight.

Petitioner informed Patent Owner that it intended to depose Dr. Easttom on February 5, 2019. **Ex. 1011**, 2-5-2019 *Email from Hart*. In response, Patent Owner stressed the narrowness of its reliance on Dr. Easttom and agreed to strike his declaration, rather than offer him for cross examination. **Ex. 1012**, 2-7-2019 *Email from Mangrum* (“Uniloc believes a cross examination of Dr. Easttom is a waste of the parties’ time and resources. **If you still disagree, Uniloc would not oppose a motion to strike Dr. Easttom’s declaration.**”) (emphasis added). Petitioner agreed that striking Dr. Easttom’s declaration was a suitable alternative to cross examination and requested leave to file an unopposed motion to strike. **Ex. 1013**, 2-21-2019 *Email from Hart to Board*. On Feb. 25, 2019, the Board denied this request as premature, noting “Petitioner can explain why the Board should give no weight to Mr. Easttom,” “[i]n the event that Patent Owner does not make Mr. Easttom available for cross-examination.” **Paper 12**, *Order* at 2.

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