

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MPH TECHNOLOGIES OY,  
Patent Owner,

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Case IPR2019-00820  
Patent 7,937,581

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**PATENT OWNER'S OBJECTIONS PURSUANT TO 37 C.F.R. § 42.64(b)(1)**

Pursuant to 37 C.F.R. § 42.64(b)(1) and the Federal Rules of Evidence (“FRE”), Patent Owner MPH Technologies Oy (“Patent Owner”) hereby objects to the evidence presented in the following document submitted by Petitioner Apple Inc. (“Petitioner”).

Nothing in this paper should be construed as an admission that any rights of Patent Owner would have been waived or forfeited had the paper or any objection herein not been filed, or that 37 C.F.R. § 42.64(b) applies to any of the objections herein if § 42.64(b) would not otherwise apply. The objections herein are premised upon § 42.64 potentially being determined to apply to the document in question and are submitted solely to preserve the rights of Patent Owner should § 42.64(b) be determined to apply.

Under 37 C.F.R. § 42.23(b), a reply cannot be used to belatedly submit new contentions, grounds or evidence to make out a prima facie case of unpatentability. A reply may only respond to arguments raised in the corresponding patent owner response. *Id.* The November 2019 Consolidated Trial Practice Guide (“Trial Guide”) states that “Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” Trial Guide, 73.

In accordance with 37 C.F.R. § 42.64, Patent Owner hereby objects to the following evidence referenced in Petitioner’s Reply, Paper 26, filed on April 1,

2020: Exhibit 1022, Declaration of David Goldschlag, Ph.D in Support of Petitioner's Reply to the Patent Owner Response, including the subject matter addressed in pars. 15, 16-25, 20-25, 31-32, 39-40 and 63-67.

Specifically, Patent Owner objects to the evidence as submitted in par. 15 and elsewhere to the effect that allegedly “the combination of Ishiyama and Murakawa teaches the claimed security gateway” because supposedly “Ishiyama’s use of the IPSec protocol would have made it obvious to a POSITA to use a ‘security gateway’ in view of Ishiyama’s disclosure of a ‘correspondent host.’” This testimony violates § 42.23(b) and the Trial Guide because it is new evidence that could have been presented earlier in the original petition for IPR. This testimony is also inadmissible under FRE 403 because its probative value is outweighed by the danger of unfair prejudice and confusion of the issues because, among other things, Patent Owner is not permitted to present expert rebuttal evidence in its sur-reply. See Trial Guide, 73 (“The sur-reply may not be accompanied by new evidence other than deposition transcripts of . . . any reply witness.”).

Patent Owner objects to the evidence as submitted in par. 15 and elsewhere to the effect that allegedly “the combination of Ishiyama and Murakawa teaches the claimed security gateway” because supposedly “Ishiyama’s disclosure of IPSec tunnel mode would have even further made it obvious to a POSITA to modify

Ishiyama's 'correspondent host' to be a 'security gateway'." This testimony violates § 42.23(b) and the Trial Guide because it is new evidence that could have been presented earlier in the original petition for IPR. This testimony is also inadmissible under FRE 403 because its probative value is outweighed by the danger of unfair prejudice and confusion of the issues because, among other things, Patent Owner is not permitted to present expert rebuttal evidence in its sur-reply. See Trial Guide, 73.

Patent Owner objects to the evidence as submitted in pars. 16-25 and elsewhere that it would have allegedly been obvious to a POSITA from Ishiyama's use of IPSec for its correspondent host to be a security gateway because supposedly IPSec only has a finite number of endpoint configurations. These paragraphs also present evidence for a new "obvious to try" theory of obviousness. This testimony violates § 42.23(b) and the Trial Guide because it is new evidence that could have been presented earlier in the original petition for IPR. This testimony is also inadmissible under FRE 403 because its probative value is outweighed by the danger of unfair prejudice and confusion of the issues because, among other things, Patent Owner is not permitted to present expert rebuttal evidence in its sur-reply. See Trial Guide, 73.

Patent Owner further objects to the subject matter of pars. 16-25 on the basis that they form an impermissible new ground(s) of unpatentability set forth in Ex.

2022 and the Reply itself. The Petitioner may not use the reply to present new grounds not found in the petition. *See* 35 U.S.C. § 312(a)(3); *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348, 1356 (2018); 37 CFR § 42.23(b); Trial Guide, 73-74. Pars. 16-25 of Exhibit 1022 assert that IPsec has a finite number of endpoint configurations (e.g., three combinations of network devices and two types of endpoints, a host or a security gateway) by citation to the Frankel reference (Ex. 1008) and the RFC 2401 reference (Ex. 1011). However, Grounds 1-3 in this IPR do not include the Frankel reference or RFC 2401 reference. As presented in the Petition and set forth in the Institution Decision, the instituted Grounds are “(1) claims 1, 2, 4, 6, 7, and 9 under 35 U.S.C. § 103(a) over Ishiyama and Murakawa; (2) claims 3 and 5 under 35 U.S.C. § 103(a) over Ishiyama, Murakawa, and Ahonen; and (3) claim 8 under 35 U.S.C. § 103(a) over Ishiyama, Murakawa, and Forslöw.” Instn., Paper 10, 42. In sum, Petitioner’s evidence constitutes an impermissible new ground including the Frankel and RFC 2401 references.

Patent Owner further objects to the new ground(s) under FRE 403 because the probative value is outweighed by the danger of unfair prejudice and confusion of the issues because, among other things, Patent Owner is not permitted to present expert rebuttal evidence in its sur-reply. *See* Trial Guide, 73.

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