

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

LENOVO HOLDING COMPANY, INC.,  
LENOVO (UNITED STATES) INC.,  
MOTOROLA MOBILITY LLC

Petitioners

v.

DODOTS LICENSING SOLUTIONS LLC

Patent Owner

---

Case IPR2019-01279

Patent No. 8,510,407

---

**PETITIONERS' RESPONSE**  
**TO PATENT OWNER'S MOTION TO STRIKE**

The “exceptional remedy” of striking evidence which further demonstrates that the *Berg* reference was a printed publication is not justified in this case. While Patent Owner did not challenge the printed publication status of *Berg* in its Patent Owner response, Patent Owner has nonetheless repeatedly challenged the printed publication status of *Berg* during communications with the Board and in related proceedings. Further, the printed publication status of *Berg* was addressed in the Institution Decision, and the Trial Practice Guide authorizes a petitioner to address such issues. Thus, Petitioners’ submission was proper. And even if Petitioners’ submission were improper, any prejudice resulting from its inclusion would be minimal.

Petitioners’ submission is proper in response to Patent Owner’s arguments regarding *Berg*. In *Hulu*, the Board held “if the patent owner challenges a reference’s status as a printed publication, a petitioner may submit a supporting declaration with its reply to further support its argument that a reference qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovs., LLC*, IPR2018-01039, Paper 29 at 15 (PTAB Dec. 20, 2019) (precedential) at 15. *Hulu* is not limited to a challenge presented in a Patent Owner response. In this case, Patent Owner did not challenge the printed publication status of *Berg* in its Patent Owner response (*see generally* Paper 18) and so the argument should be deemed waived. *See* Paper 8, 7 (“Patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”). Nonetheless, Patent Owner has attempted to raise the issue multiple times here and in a

related proceeding. *First*, during the July 21, 2020 telephone conference with the Board, Patent Owner indicated it planned to depose Catherine Vassilkova, whose declaration (Ex. 1017) supporting the public accessibility of *Berg* had previously been submitted. *Second*, during the August 31, 2020 telephone conference, Patent Owner again argued that Petitioner had not established *Berg* as a printed publication. *Third*, Patent Owner challenged the publication status of *Berg* in a related proceeding. *See*, IPR2019-00988, Paper 15, at 12. Thus, Petitioners’ additional evidence regarding this issue is responsive to Patent Owner’s arguments and properly before the Board.

Petitioners’ submission is also proper in response to the Board’s Institution Decision. The Trial Practice Guide states, “[t]he Board will permit the petitioner, in its reply brief, to address issues discussed in the institution decision.” Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 (“Consolidated TPG”), 73. Here, in its Institution Decision, the Board preliminarily found “based on the indicia on the face of *Berg*, and in light of the additional evidence cited by Petitioner, that there is a reasonable likelihood that *Berg* qualifies as a printed publication.” IPR2019-01278, Paper 7, 9 (citing *Hulu* at 13, 17–18.). *Hulu* notes that Petitioner faces a higher standard to prevail in a final written decision than the “reasonable likelihood” standard at institution. *Id.* at 13. Thus Petitioners’ submission is a proper response to the Board’s findings in its Institution Decision regarding *Berg*.

Finally, the Trial Practice Guide warns that striking a portion of a party's brief is "an exceptional remedy that the Board expects will be granted rarely." Consolidated TPG, 80. "In most cases, the Board is capable of identifying . . . and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply." *Id.* In this case, any potential prejudice to Patent Owner is minimal, and so the "exceptional remedy" of striking Petitioner's Reply should be rejected.

Petitioner demonstrated in its petition that *Berg* qualifies as a printed publication, relying on indicia on the face of the *Berg* reference as well as the unchallenged testimony of the author, Cliff Berg. *See* Paper 2 at 9. And Patent Owner did not challenge the publication status of *Berg* in its Patent Owner response, thereby waiving this argument. Thus, the additional evidence cannot prejudice Patent Owner. Further, any potential prejudice to Patent Owner based on the Vassilkova Declaration, can be cured by deposing Ms. Vassilkova. Patent Owner has also suggested that it is prejudiced by testimony of its own expert, Dr. Sacerdoti, acknowledging his awareness of the journal in which the *Berg* article was published, Dr. Dobb's Journal. *See* Paper 21 at 13 citing Ex. 1019 (Sacerdoti Deposition) at 78:10-21. In his declaration, Dr. Sacerdoti testified regarding Berg; his knowledge regarding the article and the journal in which it appeared is unquestionably relevant, within the scope of his direct testimony, and thus proper reply evidence.

For the foregoing reasons, Patent Owner's motion to strike should be denied in its entirety.

Dated: September 4, 2020

Respectfully submitted,

By: /s/ John C. Alemanni  
John C. Alemanni (Reg. No. 47,384)  
Lead Counsel for Petitioner

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.