

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

DODOTS LICENSING SOLUTIONS LLC

Patent Owner

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Case IPR2019-01278, IPR2019-01279  
Patent Nos. 8,020,083, 8,510,407

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**PETITIONER'S MOTION TO STRIKE  
SUR-REPLY AND IMPROPER SUR-REPLY EVIDENCE**

Pursuant to the Board’s September 29, 2020 Order (Paper 30), Petitioner moves to strike Patent Owner’s Sur-Replies and the accompanying belatedly-presented declaration (Ex. 2007).

The Sur-Replies’ reliance on a new declaration is prohibited by the rules, is not proper as late-submitted supplemental information, and would be prejudicial to the Petitioner; the Sur-Replies should therefore be stricken. *First*, the rules governing these proceedings *expressly* and *absolutely* prohibit Patent Owner from submitting this new evidence with its Sur-Reply: A “sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” *PTAB Consolidated Trial Practice Guide, November 2019* (“CTPG”), at 73.<sup>1</sup> Exhibit 2007 is not a deposition transcript but rather a self-described “supplemental” declaration of Dr. Earl Sacerdoti. Dr. Sacerdoti previously submitted testimony regarding claim construction and the prior art in support of Patent Owner’s Response. *See* Ex. 2004. Now—nearly five months later, and on the eve of oral argument—Patent Owner attempts to supplement Dr. Sacerdoti’s testimony with an additional 10-page declaration on the same topics. *See* Ex. 2007. This new testimony is expressly precluded by the carefully crafted framework for these proceedings, as discussed above. CTPG, at 73. Thus, Patent Owner’s Sur-Replies relying on Exhibit 2007 should

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<sup>1</sup> Patent Owner raised *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064 (Fed. Cir. 2015) during the telephone conference. *Belden* is inapplicable here as it addresses the case where “petitioner submits a new expert declaration with its Reply.” *Id.* at 1081.

be stricken. CTPG, at 73; *see also id.* at 74 (“While replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.”).

*Second*, should Patent Owner argue Ex. 2007 is late-submitted supplemental information under 37 CFR § 42.123(b), Patent Owner cannot meet its burden to show: (1) the evidence could not have been obtained earlier, and (2) consideration of it would be in the interests of justice. Dr. Sacerdoti’s supplemental declaration could have been submitted earlier with Patent Owner’s Response. Specifically, his supplemental declaration addresses the disputed claim term “Networked Information Monitor Template.” Ex. 2007, ¶¶ 2–15. For context, claim 1 of the ’083 Patent recites the “first networked information monitor template comprises...*instructions* configured (i) to cause...” various actions and further recites “one or more processors...*execute* the first networked information monitor template.” IPR2019-01278, Ex. 1001 at 47:60-65, 48:3-6. Petitioner asserts that the term “NIM template” must include templates that are in executable form as explicitly recited in claim 1 but may include templates in other forms, such as text. IPR2019-01278, Petition (Paper 2) at 24-25, 49. In contrast, Patent Owner, relying on Dr. Sacerdoti’s original declaration, asserts the NIM Template cannot be an executable. IPR2019-01278, Patent Owner Response (Paper 20) at 7. In his new declaration Dr. Sacerdoti provides additional testimony regarding this disputed construction despite having *already* provided extensive testimony on this issue in his original declaration (Ex. 2004, ¶¶ 37–65) and during cross and redirect examination

(See, e.g., Ex. 1019, p. 78-80). Thus, Patent Owner cannot demonstrate that this new testimony could not have been submitted earlier.

Further, Patent Owner cannot satisfy its burden to show that consideration of this new evidence is in the interests of justice. Dr. Sacerdoti's supplemental declaration is improper legal argument under the guise of expert testimony, and he misapplies the law of lexicography in any event. "In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves." *Interactive Gift Exp., Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001). Dr. Sacerdoti ignores the claims, beginning instead with the proposition that a "NIM Template" cannot be executable and arguing the specification *could* support that construction. However, unless the specification "clearly, deliberately, and precisely" spells out how a claim term is to be used, the plain and ordinary meaning controls. *Merck & Co., Inc. v. Teva Pharm. USA, Inc.*, 395 F.3d 1364, 1379 (Fed. Cir. 2005). "To act as its own lexicographer, a patentee must clearly set forth a definition of the disputed claim term other than its plain and ordinary meaning" and must "clearly express an intent to redefine the term." *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012) (quotations omitted).

Dr. Sacerdoti ignores this standard. Claim 1 recites executing a NIM Template. During deposition, Dr. Sacerdoti admitted that "execute" has a plain and ordinary meaning. Ex. 1019 at 59:5-7. He argues that the challenged patents disclose a single embodiment of NIM Template and therefore the term "execute" should be ignored. But

the Federal Circuit “has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004). Further, Dr. Sacerdoti notes that various terms in the specification are, in fact, ambiguous and thus fail to define the disputed term. For example, in paragraph 4, he argues the specification could support a narrow construction of NIM Template that would exclude an executable, but in that same paragraph admits that “a blob data type ***may in general contain*** executable code.” Likewise, in paragraph 14, he notes that the term “‘module’ ***is not limited*** to executable code.” These admittedly ambiguous statements in the specification cannot alter the claim’s requirement that the NIM template be “execute[d]” as that term is understood to one of ordinary skill in the art.

*Third*, Patent Owner’s failure to submit Dr. Sacerdoti’s ***full*** testimony with its Patent Owner’s Response in spite of knowing that the rules strictly prohibit introducing such evidence now prejudices Petitioner. Patent Owner’s concealment and delay of this evidence leaves Petitioner with no ability to cross examine Dr. Sacerdoti on his new testimony or otherwise respond to this new evidence prior to the oral argument. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1373 (Fed. Cir. 2019) (“[T]he Board may not rely on a basis for a decision unless the party adversely affected by such reliance had notice of the basis and an adequate opportunity to address it.”).

Patent Owner’s Sur-Replies and belatedly submitted evidence should be stricken.

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