

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZTE (USA) INC.,

Petitioner,

v.

BELL NORTHERN RESEARCH, LLC,

Patent Owner.

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PTAB Case No. IPR2019-01365

Patent No. 7,039,435

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**PETITIONER'S OBJECTIONS TO PATENT OWNER'S EVIDENCE  
UNDER 37 C.F.R. § 42.64(B)(1)**

Petitioner hereby objects under 37 C.F.R. § 42.64(b)(1) to the following evidence in Bell Northern Research, LLC's ("BNR" or "Patent Owner") Response (Paper 19) filed on May 12, 2020. As required by Rule 42.64, these objections are being filed and served within five (5) business days of service of evidence by Patent Owner on Petitioner.

**I. IDENTIFICATION OF CHALLENGED EVIDENCE AND GROUNDS FOR OBJECTIONS**

**A. Exhibit 2022 - Declaration of Mark Horenstein, Ph.D.**

Petitioner objects to Exhibit 2022 to the extent that Patent Owner has violated its duty to disclose relevant information under 37 C.F.R. § 42.51(b)(1)(iii) that is inconsistent with the positions advanced by its expert, Dr. Horenstein, concurrent with the filing of its Patent Owner's Response. Petitioner discovered that Dr. Horenstein has provided at least sworn testimony in the form of declarations submitted in support of previous IPR petitions that are inconsistent with his current declaration and inconsistent with sworn deposition testimony he gave on January 8, 2020.<sup>1</sup> *See Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267,

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<sup>1</sup> Dr. Horenstein has provided inconsistent testimony in at least the following declarations in prior IPR proceedings: IPR2015-01023, Ex. 1022; IPR2015-00609, Ex. 1008; IPR2015-01928, Ex. 1015; IPR2015-01149, Ex. 1012; IPR2019-01319 Ex. 2053; IPR2019-01320 Ex. 2053.

1272–73 (Fed. Cir. 2017) (finding that inconsistencies in expert testimony bear on the credibility of the expert in an IPR proceeding).

Petitioner further objects to Exhibit 2022 under Federal Rules of Evidence rules 403 and 702. Given Dr. Horenstein’s inconsistent testimony, Exhibit 2022 is unfairly prejudicial, confuses the issues, is misleading, and wastes the Board and parties’ time. Additionally, based on Dr. Horenstein’s inconsistent testimony, Exhibit 2022 is not the product of reliable principles and methods, and Dr. Horenstein has failed to reliably apply principles and methods to the facts of the case.

**B. Exhibit 2025 - Declaration of Chad Hilyard**

Petitioner further objects to Exhibit 2025 under Federal Rules of Evidence rules 401/402, 403, 602, 802, and 1002. Given Mr. Hilyard’s attempts to provide testimony for time periods when he was no longer at LSI, and thus for which he does not have personal knowledge of LSI’s licensing practices or any considerations as to patent licensing or agreements, Exhibit 2025 includes hearsay statements, is irrelevant, unfairly prejudicial, confuses the issues, is misleading, and wastes the Board and parties’ time. Petitioner further objects to Exhibit 2022, Dr. Horenstein’s declaration, and Paper 19, the Patent Owner’s Response, to the extent they rely on the impermissible hearsay and irrelevant statements provided in Mr. Hilyard’s Declaration.

**C. Exhibits 2024, 2027**

Petitioner further objects to the form of Exhibits 2024 and 2027, which were marked AEO and provided in full, instead of in the proper form under PTAB policies relating to documents for which a Motion to Seal or Protective Order may be considered applicable. Petitioner notes that at least Exhibits 2024 and 2027 have been produced in the related district court litigation, in a format that may also serve useful in this proceeding.

**D. Exhibit 2027**

Petitioner further objects to Exhibit 2027 under Federal Rules of Evidence rules 401/402, 403, and 802. It is not clear what Exhibit 2027 purports to represent, and Exhibit 2027 not only appears to be a draft document since it contains mark-ups, but even if taken for the argument for which BNR purports to provide it, Exhibit 2027 particularly constitutes hearsay information/statements, and is irrelevant, unfairly prejudicial, confuses the issues, is misleading, and wastes the Board and parties' time. Petitioner further objects to Exhibit 2022, Dr. Horenstein's declaration, and Paper 19, the Patent Owner's Response, to the extent they rely on the impermissible hearsay and irrelevant information/statements provided in Exhibit 2027.

**E. Exhibit 2028 – “Market Share 4Q17 Update”**

Petitioner further objects to Exhibit 2028 under Federal Rules of Evidence

rules 401/402, 403, 802, and 1002. It is not clear what Exhibit 2028 purports to represent, but even if taken for the arguments for which BNR purports to provide it, Exhibit 2028 then particularly constitutes hearsay information/statements, and is irrelevant, unfairly prejudicial, confuses the issues, is misleading, and wastes the Board and parties' time. Petitioner further objects to Exhibit 2022, Dr. Horenstein's declaration, and Paper 19, the Patent Owner's Response, to the extent they rely on the impermissible hearsay and irrelevant information/statements provided in Exhibit 2028.

## **II. Conclusion**

To the extent that Patent Owner fails to correct the defects identified above, Petitioner reserves the right to file a Motion to Exclude under 37 C.F.R. § 42.64(c).

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