

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION¹,

Petitioners,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

PTAB Case No. IPR2021-00375
Patent No. 8,265,096 B2

**PATENT OWNER'S REPLY IN SUPPORT OF ITS
MOTION TO EXCLUDE**

¹ ZyXEL Communications Corporation was joined as a Petitioner in this proceeding based on a petition and motion for joinder filed in IPR2021-00734, which were granted.

Patent Owner UNMRI respectfully submits this Reply to Petitioners' Response ("Response") to Patent Owner's Motion to Exclude EX1002 (Declaration of Dr. S. Roy).

I. TIMELINE

The below timeline demonstrates the reasonableness of Patent Owner's objections:

- Dec. 28, 2020 – Petitioners file EX1002, Patent Owner has no reason to believe anything therein is objectionable;
- July 19, 2021 – Institution Decision issues;
- Nov. 18, 2021 – Patent Owner requested Petitioners to make Dr. Roy available for deposition in the week of Nov. 29 – Dec. 3;
- Nov. 22, 2021 – Petitioners respond but offers Dr. Roy's deposition only on the last day before Dec. 7, 2021, Patent Owner's deadline for the Patent Owner's Response and Motion to Amend;
- Dec. 6, 2021 – Deposition of Dr. Roy; Patent Owner discovers that Dr. Roy did not perform the requisite analysis required by Fed. R. Evid. 702(d) but does not have the supporting evidence – the transcript;
- Dec. 7, 2021 – Patent Owner Response (Paper 28) and Motion to Amend (Paper 27) filed, including objections to EX1002 “[t]he technical aspects of the Roy declaration (EX1002) should be discounted in their entirety because they do not reflect the work of Dr. Roy. . . . Patent Owner intends to request authorization from the Board to file a motion to strike the technical aspects of the Roy declaration in their entirety.” (Paper 28 at 34); Patent Owner files EX2014 (Roy rough transcript); due to Petitioners' delay of the Roy deposition, Patent Owner was forced to at first rely on the rough transcript;
- Dec. 14, 2021 – Petitioners object to EX2014 (Roy rough transcript);

- Dec. 16, 2021 – Patent Owner receives final Roy Depo transcript and files objections to evidence (Paper 31) with citations to the final transcript and identifying to the objections raised to EX1002 in Paper 28;
- Dec. 20, 2021 – Patent Owner files the Roy final transcript as EX2015; and
- May 4, 2022 – Patent Owner files its Motion to Exclude (Paper 55) referring to its objections to EX1002 raised both in its Patent Owner’s Response (Paper 28) and Objections to Evidence (Paper 31).

II. PATENT OWNER’S OBJECTIONS WERE TIMELY.

First, Petitioners argue that “UNM was required to file any objection to Dr. Roy’s Petition Declaration no later than July 27, 2021.” Response at 3. However, Patent Owner had no objection to EX1002 on its face. The objection is based not on the analysis itself, but on the fact that Dr. Roy simply signed off on the work of another expert, and so became a mere mouthpiece for another non-testifying expert in violation of Fed. R. Evid. 702(d). Patent Owner, therefore, did not become aware of the evidentiary problem with EX1002 until the deposition of Dr. Roy, which, due to Petitioners’ delay, did not take place until Dec. 6, 2021.

Petitioners’ citation to *GoPro, Inc. v. Contour IP Holdings LLC*, IPR2015-01080, Paper 55 at 7 (PTAB Oct. 26, 2016), *vacated on other grounds*, 888 F.3d 1170 (Fed. Cir. 2018) is inapposite. It concerns objections to exhibits where the Board rejected that a declaration authenticating the exhibit affected the timing of proper objections. Unlike *GoPro*, Patent Owner, in this instance, had no grounds

for an objection at all until Dr. Roy explicitly misrepresented and mischaracterized his work on the substance of EX1002. Similarly inapposite is Petitioners' citation to *Apple Inc. v. Achates Reference Publishing, Inc.*, IPR2013-00080, Paper 90 (PTAB June 2, 2014). There, the Board rejected the argument that "the bases of the objections arose when [Apple] failed to update Mr. Schneier's declaration as part of its Reply." Apple at 49. That is not the issue here.

Pursuant to 37 C.F.R. § 42.64(b)(1), "[o]nce a trial has been instituted, any objection must be filed within five business days of service of evidence to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence." Only one day after the Dec. 6, 2021 deposition of Dr. Roy, Patent Owner filed its evidentiary objections. Paper 28 at 34 ("[t]he technical aspects of the Roy declaration (EX1002) should be discounted in their entirety because they do not reflect the work of Dr. Roy. . . . Patent Owner intends to request authorization from the Board to file a motion to strike the technical aspects of the Roy declaration in their entirety.") Despite forcing Patent Owner to rely on the rough transcript by its delay of the deposition, Petitioners objected to the rough transcript as evidence. Patent Owner then renewed its objections on Dec. 16, 2021, the same day that it received the final transcript. Finally, Patent Owner's Motion to Exclude (Paper 55)

refers to the same evidentiary objection. Patent Owner has met the requirements of 37 C.F.R. § 42.64.

III. PATENT OWNER’S MOTION IDENTIFIED THE OBJECTIONS.

Patent Owner’s Motion to Exclude (Paper 51) referenced the exact objections raised in Paper 28 (filed Dec. 7, 2021) and detailed further in Paper 31 (filed on Dec. 16, 2021). Patent Owner has met the requirements of 37 C.F.R. § 42.64.

IV. THE JOINDER REQUIREMENTS ARE IRRELEVANT

Petitioners argue that Patent Owner’s objections relate to “the substantive similarity of Dr. Roy’s Petition Declaration to a declaration submitted by Dr. Robert Akl” and that “Petitioners hid the substantive similarity of Dr. Roy’s Petition Declaration to Dr. Akl’s.” This is wrong. Patent Owner objects to Dr. Roy’s misrepresentation of having authored the report himself. Roy Depo (EX2015), taken Dec. 6, 2021 at 60:2-61:10 (testifying that he “wrote” various sections of the report bearing his signature.) This is exacerbated further by the fact that the report does not include the report of Dr. Akl in its otherwise exhaustive list of “Materials Relied Upon.” EX1002 at 10–12. Dr. Roy, in fact, *made no mention of the Akl Report whatsoever*, until specifically asked about it. And even then, he only said he considered it and briefly read it before writing his own report. Roy Depo (EX2015), taken Dec. 6, 2021, at 110:14-111:17 (“I had once taken a quick look at the Ackel [sic] declaration, but thereafter, I focused on [my] drafts”).

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