

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC
Petitioner

v.

MEMORYWEB, LLC
Patent Owner

Case No. IPR2021-01413
Patent 10,621,228

PETITIONER'S MOTION TO EXCLUDE

In accordance with 37 C.F.R. § 42.64(c), Petitioner Unified Patents, LLC (“Petitioner”) respectfully moves to exclude Exhibits 2041, 2042, and 2045. Petitioner timely objected to these exhibits in its objections to evidence filed October 18, 2022,¹ within five business days of service of the evidence. Paper 38.

I. EXHIBITS 2041, 2042, AND 2045 WERE FILED IN VIOLATION OF 37 C.F.R. § 42.23(b) AND SHOULD BE EXCLUDED

37 C.F.R. § 42.23(b) is clear: “[a] sur-reply may only respond to arguments raised in the corresponding reply and **may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.**”² 37 C.F.R. § 42.23(b); *see also Consolidated Trial Practice Guide*, 73 (“[t]he sur-reply **may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness**”). The Board has

¹ Petitioner objected to Exhibits 2041, 2042, and 2045 under 37 C.F.R. § 42.23(b) in its filed objections to evidence, as well as during Dr. Bederson’s reply deposition when they were introduced by Patent Owner. *See* Paper 38, 1; *see, e.g.*, EX2046, 52:7-25, 59:7-20, 79:18-80:2.

² Bolding indicates emphasis added unless otherwise noted.

explained that “Rule 42.23(b) provides a blanket prohibition on the patentee filing new exhibits (other than deposition transcripts of the cross-examination of any reply witness) with a sur-reply.” *See, e.g., Netflix v. Divx*, IPR2020-00511, Paper 46, 54 (PTAB Aug. 13, 2021); *Intel Corp. v. Parkervision, Inc.*, IPR2020-01265, Paper 44, 74 (PTAB Jan. 21, 2022); *Hamilton Techs. LLC v. Fleur Tehrani*, IPR2020-01199, Paper 57, 51-54 (PTAB Dec. 28, 2021).

Patent Owner filed Exhibits 2041, 2042, and 2045³ with its Sur-Reply (Paper 35) on October 11, 2022.⁴ These exhibits are not deposition transcripts. Therefore, Exhibits 2041, 2042, and 2045 must be excluded under 37 C.F.R. § 42.23(b).

³ Patent Owner introduced Exhibits 2041, 2042, and 2045 for the first time during the reply deposition of Dr. Bederson. EX2046, 52:7-25, 59:7-20, 79:18-80:2. Patent Owner’s use of these exhibits during this deposition was improper under 37 C.F.R. § 42.53 (d)(5)(ii) as it exceeded the scope of the direct testimony in Dr. Bederson’s reply declaration (EX1038).

⁴ Patent Owner also filed Exhibits 2043 and 2044 with its Sur-Reply, which Petitioner Objected to. Paper 38. Per the Board’s authorization, Petitioner filed a Sur-Sur Reply

To the extent Patent Owner argues Exhibits 2041, 2042, and 2045 are admissible in the interests of justice because they constitute deposition evidence that provide context for Dr. Bederson's testimony, this argument fails. Patent Owner does not rely on Exhibits 2041, 2042, or 2045, or Dr. Bederson's testimony regarding these exhibits, in its Sur-Reply (or any of its other papers). Moreover, Patent Owner introduced Exhibits 2041, 2042, and 2045 for the first-time during Dr. Bederson's reply deposition and did not serve them to Petitioner in advance of the deposition. EX2046, 52:7-25, 59:7-20, 79:18-80:2.⁵ Dr. Bederson testified during that deposition that he had not seen these exhibits before in this proceeding and was not familiar with them. *Id.*, 190:3-12. Exhibits 2041, 2042, and 2045 therefore do not provide context for Dr. Bederson's testimony and are not reliable to test his

addressing the portions of Patent Owner's Sur-Reply that relied on these exhibits. Paper 42. Therefore, these exhibits are not subject to this Motion.

⁵ Patent Owner introduced these exhibits at such a late stage of the proceeding even though it could have introduced them earlier, such as with its Patent Owner Response or during Dr. Bederson's first deposition, but chose not to.

opinions, and should be excluded; the interests of justice do not necessitate otherwise. *See Netflix*, IPR2020-00511, Paper 46, 52–55 (Board granting motion to exclude exhibits introduced during reply deposition and filed by patent owner with its Sur-Reply, finding that since the exhibits did not provide context for deposition testimony as the declarant testified he had not seen the exhibits before, the interests of justice did not weigh in favor of maintaining the exhibits); *see also Netflix, Inc. v. DivX, LLC*, IPR2020-00558, Paper 50, 32-36 (PTAB Aug. 23, 2021) (Board granting motion to exclude exhibit introduced during reply deposition and filed by patent owner with its Sur-Reply, finding that since the exhibit did not provide context for deposition testimony as the declarant testified he had not prepared for the deposition using the newly introduced exhibit, the interests of justice did not weigh in favor of maintaining the exhibit).

II. EXHIBITS 2041, 2042, AND 2045 SHOULD BE EXCLUDED UNDER THE FEDERAL RULES OF EVIDENCE (“FRE”) 401-403

The FRE apply to this proceeding. *See* 37 C.F.R. § 42.62. The Board may exercise its discretion to exclude evidence entirely, or alternatively, may decline to consider evidence. *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 79, 3 (PTAB Aug. 9, 2013). According to FRE 401

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