

U.S. Patent No. 10,621,228  
Patent Owner's Response to Motion to Exclude  
IPR2021-01413

Paper No. \_\_\_\_

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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UNIFIED PATENTS, LLC  
Petitioner

v.

MEMORYWEB, LLC  
Patent Owner

Patent No. 10,621,228

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*Inter Partes* Review No. IPR2021-01413

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**PATENT OWNER'S OPPOSITION TO  
MOTION TO EXCLUDE EVIDENCE**

MemoryWeb, LLC ("Patent Owner") submits this Response to Petitioner's Motion to Exclude (Paper 44) filed by Unified Patents, LLC ("Petitioner" or "Unified").

## **I. Factual Background**

Petitioner seeks to exclude Exhibits 2041, 2042, and 2045. Exhibits 2041 and 2042 show Cambridge English Dictionary entries for the terms "responsive," and "caus[ing]." Both terms are recited in limitations 1[b] and 1[l] of the '228 patent, which are subject to claim construction disputes. *See e.g.*, Paper 35, 2 – 8. Exhibit 2045 is a copy of U.S. Patent No. 11,061,524, a patent issued to Petitioner's expert, Dr. Benjamin B. Bederson. EX2046, 80:4-9

Patent Owner introduced and cross-examined Dr. Bederson regarding each of the contested exhibits to test the opinions of Dr. Bederson's Second declaration (EX1038) submitted with Petitioner's Reply. *See e.g.* EX2046, 52:7-25, 59:7-20, 79:18-80:2. While Patent Owner's Sur-Reply does not explicitly cite to the contested exhibits or offer them as substantive evidence, they were marked at Dr. Bederson's deposition and provide context for the testimony reflected in the transcript. *Id.* Thus, Patent Owner submitted them with the Sur-Reply.

On October 17, 2022, Petitioner emailed the Board seeking leave to move to strike each of Exhibits 2041-2045 and portions of the Sur-Reply or, alternatively,

file a sur-sur reply. EX1040, 1-2. The Board declined to authorize a motion to strike and authorized a sur-sur-reply instead. *Id.* Pursuant to the Board's authorization, Petitioner filed a sur-sur-reply. *See* Paper 42. Petitioner's sur-sur-reply addressed Exhibit 2043 (providing Dictionary.com entries for the term "caus[ing]") and Exhibit 2044 (a demonstrative depicting different types of views). Paper 42, 1-5.<sup>1</sup> Having failed to receive authorization to move to strike the contested exhibits, Petitioner now makes a second attempt in the form of a motion to exclude.

## **II. Petitioner Has Not Met Its Burden**

The party moving to exclude bears the burden of proving "that it is entitled to the requested relief." *See* 37 C.F.R. § 42.20(c). Petitioner has not met its burden here.

### **A. Petitioner's Motion to Exclude Is Improper**

Having already tried (and failed) to receive authorization to move to strike the contested exhibits, it is improper for Petitioner to seek equivalent relief in the form of a motion to exclude here. *See* EX1040. Petitioner's Motion primarily alleges a procedural violation of 37 C.F.R. § 42.23(b) based on Patent Owner allegedly

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<sup>1</sup> While the Board's authorization expressly referenced "Exhibits 2041-2045" Petitioner declined to address Exhibits 2041, 2042, and 2045 in the sur-sur-reply.

providing “new evidence.” Paper 44, 1-4. The Consolidated Trial Practice Guide instructs parties to address alleged procedural violations of this nature by requesting “authorization to file a motion to strike.” Consolidated Trial Practice Guide, 80; *see Ascend Performance Operations LLC v. Samsung SDI Co.*, IPR2020-00349, Paper 53, 12 (July 15, 2021) (“We agree ... [that] objections to the late-filed exhibits should have been brought as a motion to strike, instead of a motion to exclude”).

As instructed by the Consolidated Trial Practice Guide, Petitioner sought authorization to move to strike. EX1040, 1-2. Petitioner's email request identified each of “Exhibits 2041-2045” and asserted the same violation of “37 C.F.R. 42.23(b)” alleged in the Motion to Exclude. *Id.*, 2; Paper 44, 1-4. After considering Petitioner's request, the Board declined to authorize a motion to strike. Instead, the Board authorized a sur-sur reply, which Petitioner prepared and filed. EX1040, 1; *see* Paper 42. Petitioner's Motion to Exclude does not explain why Petitioner should be permitted to seek relief in the form of a motion to exclude, when authorization to move to strike the same exhibits has already been denied.

**B. 37 C.F.R. § 42.23(b) Does Not Mandate Exclusion**

Petitioner claims the contested exhibits are subject to a “blanket prohibition” under Rule 42.23(b) because they are “not deposition transcripts.” Paper 44, 2. The Board, however, has not always applied Rule 42.23(b) in the manner suggested by

Petitioner. For example, the Board has allowed exhibits “used during cross-examination . . . for the limited purpose of allowing the Board to understand the context of the cross-examination.” *See e.g. Edwards Lifesciences Corp. v. Cardiovalve Ltd.*, No. IPR2021-00383, 2022 WL 2812478, Paper 60 at 87 (July 18, 2022) (“allowing exhibits to be used in this manner merely allows them to be used as an adjunct to reading and understanding the deposition transcript”); *see also Ascend*, IPR2020-00349, Paper 53 at 12 (“if exhibits are introduced during a deposition for the purposes of testing the witness’ testimony, a party should be able to submit those exhibits with the transcript, so the Board has the full context available in order to evaluate the testimony”).

Petitioner filed the contested exhibits for this same “limited purpose” here. *Edwards*, No. IPR2021-00383, Paper 60 at 87. For this reason, *Intel Corp. v. Parkervision, Inc.*, relied on by Petitioner, is inapplicable. IPR2020-01265, Paper 44, 74 (Jan. 21, 2022). In *Intel Corp.*, the disputed exhibit was “used by Patent Owner to raise new arguments” also excluded by the Board. *Id.*; Paper 44, 2. These circumstances are not present here. *Netflix v. Divx*, and *Hamilton Technologies LLC v. Tehrani*, also cited by Petitioner, similarly concern exhibits substantively relied on in sur-reply briefs. IPR2020-00511, Paper 46, 54-55 (Aug. 13, 2021); No. IPR2020-01199, Paper 57, 53 (Dec. 28, 2021); Paper 44, 2. Further, none of

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