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

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

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PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE

As Petitioner's Motion to Exclude (Paper 44) explained, Exhibits 2041, 2042, and 2045—which were not cited by Patent Owner or Petitioner in the briefing of this proceeding—should be excluded. Nothing in Patent Owner's opposition (Paper 45) changes this conclusion.

Patent Owner suggests that Petitioner must explain why it is "permitted to seek relief in the form of a motion to exclude." Paper 45, 3. However, no explanation is needed; no prior authorization is required for motions to exclude, which are different from motions to strike. *See* Scheduling Order (Paper 16), 10 ("Either party may file a motion to exclude evidence (37 C.F.R. § 42.64(c))"). Further, while Petitioner was authorized a sur-sur reply to respond to portions of the sur-reply relying on Exhibits 2043 and 2044 (not subject to this motion), Petitioner could not respond to Exhibits 2041, 2042, and 2045 because Patent Owner never cited to them or Dr. Bederson's testimony about them in its sur-reply. These exhibits should be excluded, at least to preclude new arguments during the hearing.

I. PETITIONER'S MOTION TO EXCLUDE IS PROPER

Patent Owner states that in view of the Trial Practice Guide ("TPG") and *Ascend Performance Operations LLC v. Samsung SDI Co.* (IPR2020-00349) ("*Ascend*"), the relief Petitioner requested in its Motion to Exclude is improper

because it should have been brought via a Motion to Strike. Paper 45, 2-3. Patent Owner conflates the two motions. Motions to Exclude are the correct avenue to address evidence filed (including evidence filed but not cited) with a Patent Owner's sur-reply pursuant to 37 C.F.R. § 42.23(b). *See, e.g.*, *Netflix v. Divx*, IPR2020-00511, Paper 46, 54-56 (PTAB Aug. 13, 2021); *Netflix, Inc. v. DivX, LLC*, IPR2020-00558, Paper 50, 32-36 (PTAB Aug. 23, 2021; *Intel Corp. v. Parkervision, Inc.*, IPR2020-01265, Paper 44, 74-75 (PTAB Jan. 21, 2022); *Hamilton Techs. LLC v. Fleur Tehrani*, IPR2020-01199, Paper 57, 51-54 (PTAB Dec. 28, 2021) (all cases granting Motions to Exclude evidence filed with a Patent Owner's sur-reply pursuant to 37 C.F.R. § 42.23(b)).

II. 37 C.F.R. § 42.23(b) MANDATES EXCLUSION

Patent Owner relies on *Edwards Lifesciences Corp. v. Cardiovalve Ltd.* (IPR2021-00383) ("*Edwards*") and *Ascend* to assert the Board "has not always applied Rule 42.23(b) in the manner suggested by Petitioner" and "has allowed exhibits 'used during cross-examination…for the limited purpose of allowing the Board to understand the context of the cross-examination.'" Paper 45, 3-4. This reliance is misplaced for at least two reasons.

First, unlike in *Edwards and Ascend*, neither Dr. Bederson testimony related to Exhibits 2041, 2042, and 2045, nor the exhibits themselves were ever cited in the sur-reply. *Edwards*, IPR2021-00383, Paper 39, 1; *Ascend*, IPR2020-00349, Paper 38, 10. This is exactly the kind of scenario to which § 42.23(b) applies.

Second, Exhibits 2041, 2042, and 2045 do not provide the Board with understanding of the context of Dr. Bederson's cross examination testimony because during Dr. Bederson's reply deposition, where these exhibits were first introduced by Patent Owner, he testified that he had not seen these exhibits before in this proceeding and was not familiar with them. EX2046, 190:3-12; *see Netflix*, IPR2020-00511, Paper 46, 52–55 (granting motion to exclude, finding exhibits did not provide context as the declarant testified he had not seen them before); *see also Netflix*, IPR2020-00558, Paper 50, 32-36. *Edwards* and *Ascend* are distinguishable because in those proceedings no such testimony regarding the declarant's knowledge of the exhibits at issue was brought to the Board's attention. *Edwards*, Paper 39; *Ascend*, Paper 38, Paper 47. Exhibits 2041, 2042, and 2045 were not reliable to test Dr. Bederson's opinions and, therefore, should be excluded.

III. PETITIONER FACES UNDUE PREJUDICE

Patent Owner states "Petitioner can hardly claim prejudice here" because it was authorized and filed a sur-sur reply to address portions of Patent Owner's sur-reply that relied on Exhibits 2043 and 2044, those of Exhibits 2041-2045 that Patent Owner relied on in its sur-reply. Paper 45, 5; Paper 42, 1-5. But Patent Owner's statement is belied by another part of its opposition, which asserts for the first time in this proceeding that exhibits 2041, 2042, 2045—exhibits Petitioner could not address in its sur-sur reply because they were not relied on by Patent Owner in Patent Owner's sur-reply—are "relevant to claim construction" regarding "disputed claim terms" and reflect on Dr. Bederson.[1] Paper 45, 5-6. By not having the opportunity to

[1] Exhibit 2045, a patent that issued over a year ago listing Dr. Bederson as an inventor, is irrelevant to this proceeding. Patent Owner disingenuously states Dr. Bederson "was unable to respond substantively because he hadn't 'even read the claim'" of the patent. Paper 45, 6; EX2046, 79:18-80:2, 81:9-11. But Dr. Bederson testified that Exhibit 2045 was "not something that I have read in many years and I have not considered this claim in a long time." EX2046, 88:15-19, 90:3-5.

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