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Filed on behalf of

Patent Owner Intellectual Ventures II LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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INTERNATIONAL BUSINESS MACHINES CORP.,

Petitioner

v.

INTELLECTUAL VENTURES II LLC

Patent Owner.

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Case No. IPR2014-00587

U.S. Patent 6,826,694

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**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO  
LIMIT SCOPE OF CROSS-EXAMINATION OF  
DR. STEVEN M. BELLOVIN**

**I. THE BOARD CONSIDERED AND REJECTED IBM'S IDENTICAL MOTION IN A CO-PENDING IPR BETWEEN THE PARTIES**

On May 15, 2014, IBM raised the identical issue of whether to limit cross-examination to the instituted grounds in a co-pending IPR between the same parties, and the panel *denied* IBM's motion. *IBM v. Intellectual Ventures II LLC*, IPR2014-00180, Paper 13, at 2; Ex. 1026 at 23-24.

<b>This IPR</b>	<b>IPR2014-00180</b>
<p><b>1. Motion to Limit Scope of Cross-Examination</b></p> <p>IBM seeks authorization from the Board to file a motion to limit IV's crossexamination of IBM's declarant, Dr. Steven M. Bellovin, to the instituted ground of invalidity—contained in the Board's Decision re Institution of <i>Inter Partes</i> Review (Paper 13)—based on the combination of Hughes and Abraham.</p>	<p><b>1. Motion to Limit Scope of Cross-Examination</b></p> <p>IBM seeks authorization from the Board to file a motion to limit IV's crossexamination of IBM's declarant, Dr. Çetin Kaya Koç, to the instituted grounds of invalidity—contained in the Board's Decision re Institution of <i>Inter Partes</i> Review (Paper 10)—based on the combination of Matsuzaki, Dworkin, Tenca, and the knowledge of one having ordinary skill in the art.</p>

Alternatively, IBM requests the Board to provide guidance to the Parties on the appropriate scope of cross-examination of Dr. Bellovin.	Alternatively, IBM requests the Board to provide guidance to the Parties on the appropriate scope of cross-examination of Dr. Koç.
<b>Status: Pending</b>	<b>Status: Denied</b>

At a minimum, while this previous decision is not binding, candor counsels that this panel be informed of the previous decision and its underlying rationale.

IBM’s motion actually cites to IPR2014-00180 for purported *support*, taking out of context the Board’s comment that “the cross-examination in our proceedings is typically limited to the grounds that we have instituted on.” Paper 22 at 3, citing IPR2014-00180, Ex. 1026 at 23:15-20. But when read in context, the Panel was not stating that the *Board* limits cross-examination beyond Rule 42.53(d)(5)(ii), but rather that cross-examiners typically focus their questioning on the instituted grounds. Indeed, in a well-reasoned decision, the Board *denied* IBM’s motion:

As to whether the patent owner can ask questions concerning grounds that are not instituted, I will caution that the cross-examination in our proceedings is typically limited to the grounds that we have instituted on. That’s all the guidance that we can provide at this time as to whether questions of credibility may become relevant based on those redundant grounds. **Those need to be addressed at the time the question is made.**

In view, of course—the parties can, of course, deal with the objection and try to seek a compromise at that time. . . .

So at this time, **Motions 1 [to limit cross-examination] and 2 are denied** without prejudice, of course.

IPR2014-00180, Ex. 1026 at 23:15-24:10 (emphasis added).

Thus, by ignoring the Board’s previous decision, IBM is merely trying to get a second bite at the apple, seeking to create inconsistency in the Board’s precedent.

## **II. CROSS-EXAMINATION IS GENERALLY PERMITTED ON THE ENTIRE SCOPE OF DIRECT TESTIMONY**

By rule, cross-examination is “limited to the scope of the direct testimony.” 37 C.F.R. § 42.53(d)(5)(ii). No compelling reason exists here to further limit this scope, and several general decisions of the Board have not done so. *See Micron Tech., Inc. v. Bd. of Trustees of the Univ. of Ill.*, IPR2013-00005, Paper 22 at 3; *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, IPR2013-00128, Paper 34 at 5; *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, IPR2013-00266, Paper 27, at 3-4 (different patent at issue than IPR2013-00128); *Kyocera Corp. v. Softview LLC*, IPR2013-00007, Paper 18 at 4. For example, the panel in *Micron* declined to limit cross-examination beyond the rule, explaining that portions of expert testimony not related to the instituted grounds “may be relevant to the state of the prior art or the credibility of the most pertinent portions of the testimony.” IPR2013-00005, Paper 22 at 3. IV cited the *Micron* case during the October 16<sup>th</sup> conference call (Ex. 1024 at 15), but IBM’s motion ignores it. Similarly, in *IBS*,

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the Board “decline[d] to further limit the cross-examination testimony beyond [the] limitation” in the rule, although not all grounds were instituted. IPR2013-00128, Paper 34 at 5. *Kyocera* likewise held that “Petitioner should make [declarant] available for cross-examination on *all* direct testimony” despite instituting only on some grounds. IPR2013-00007, Paper 18 at 4 (emphasis added); Paper 11 at 38.

IBM’s motion suggests that there are several different decisions that support its position by citing to five IPRs; but these IPRs *all* relate to the *same* consolidated proceeding. Paper 22 at 2-3 (citing *ZTE Corp. v. Conteguard Holdings, Inc.*, IPR2013-00136, Paper 27 at 3; IPR2013-00133, Paper 30 at 2-3; IPR2013-00137, Paper 33 at 2-3; IPR2013-00138, Paper 34 at 2-3; IPR2013-00139, Paper 32 at 2-3.). In particular, the parties in each of these IPRs agreed to consolidate depositions. *See id.* This agreement to consolidate depositions, presumably to avoid five days of cross-examination, was likely a factor considered by the Board in further limiting the scope of cross-examination. No such consolidation has been stipulated to in this proceeding. Thus, there is no reason to further limit cross-examination beyond the limits of Rule 42.53(d)(5)(ii).

### **III. THE ENTIRE DECLARATION IS PART OF THE RECORD AND IS THEREFORE SUBJECT TO CROSS-EXAMINATION**

IBM mistakenly asserts that the declaration testimony and exhibits that IBM seeks to circumscribe are not part of the record, referring to IV’s objections and setting up IBM’s own straw man: “[I]f these paragraphs and exhibits are excluded,

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