

Filed on behalf of Intellectual Ventures II LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC.
Petitioner

v.

INTELLECTUAL VENTURES II LLC
Patent Owner

Case IPR2014-00631¹
Patent No. 7,817,914

PATENT OWNER MOTION TO EXCLUDE EVIDENCE

¹ Case IPR2014-00632 has been consolidated with the instant proceeding.

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I. SUMMARY OF ARGUMENT

The Board should exclude inadmissible evidence filed with Petitioner's Reply.

A question asked on cross-examination must not exceed the scope of direct testimony. Petitioner examined Patent Owner's expert, Dr. Alan Bovik, on subjects that were far beyond the scope of Dr. Bovik's direct testimony. Patent Owner's counsel timely objected, and the Board should exclude responses to the questions on cross-examination that were beyond the scope of Dr. Bovik's direct testimony.

New testimony not rebutting arguments made in the Patent Owner's Response is not permitted in a Rebuttal Declaration. Petitioner relies on new arguments found in a so-called Rebuttal Declaration from its expert and on a new exhibit of dictionary definitions. Patent Owner timely objected to this evidence pursuant to 37 C.F.R. § 42.64. Therefore, the Board should exclude the new declaration testimony and exhibit.

II. EXCERPTS FROM DR. BOVIK'S CROSS-EXAMINATION TESTIMONY (EXHIBIT 1018) SHOULD BE EXCLUDED

During the cross-examination of Dr. Bovik, Petitioner's counsel repeatedly asked questions that were outside the scope of Dr. Bovik's direct declaration testimony (Ex. 2006). Patent Owner's counsel timely objected to these questions. Petitioner used this improperly-elicited testimony in both its Reply and its Rebuttal Declaration. The Board should exclude argument based on that testimony because

the rebuttal testimony is outside the scope of the direct testimony of Dr. Bovik's declaration. *See* Fed. R. Evid. 611(b) ("Cross-examination should not go beyond the subject matter of the direct examination"); 37 CFR § 42.53(d)(5)(ii) ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.").

In particular, the following cross-examination testimony (Ex. 1018) upon which Petitioner relies in its Reply and Petitioner's expert relies in the Rebuttal Declaration should be excluded: 38:19 to 39:13, 54:6–18, 71:1 to 84:12, 86:10 to 87:3, 87:20 to 88:10, 90:1 to 96:12, 175:15 to 176:24, 212:20 to 213:3, and 221:16 to 225:20.

A. Dr. Bovik's Cross-Examination Testimony at 71:1 to 73:18, 90:1 to 95:25, and 175:15 to 176:24

Petitioner's Reply argues that Dr. Bovik "admits that some of the disclosed embodiments [of the '914 patent] involve threshold levels that a user could not enter due to their complexity (e.g., for soccer balls, faces, etc.)." Paper 33 at 2–3. Petitioner seeks to support this argument by relying on the following excerpts from the Bovik transcript (Exhibit 1018): 71:9 to 73:3, 89:1 to 94:14, and 175:15 to 176:24. *Id.* at 3. The Rebuttal Declaration of Petitioner's expert relies on pages 71–73, 89–95, and 175–176 of the Bovik transcript as support for a similar argument. *See* Ex. 1016 at 5–6, 26. For the reasons discussed below, the excerpts at 71:1 to

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