UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIAWEI TECHNOLOGY (HK) LTD., JIAWEI TECHNOLOGY (USA) LTD., SHENZHEN JIAWEI PHOTOVOLTAIC LIGHTING CO., LTD., ATICO INTERNATIONAL (ASIA) LTD., ATICO INTERNATIONAL USA, INC., CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN FLORIDA), CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN CHINA), COLEMAN CABLE, LLC, NATURE'S MARK, RITE AID CORP., SMART SOLAR, INC., AND TEST RITE PRODUCTS CORP.
Petitioner,
v.

SIMON NICHOLAS RICHMOND
Patent Owner.

U.S. Patent No. 7,196,477

IPR Case No.: IPR2014-00936

REPLY IN SUPPORT OF PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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I. INTRODUCTION

Petitioner contends its Reply (Paper 48) evidence "directly respond[ed] to arguments that patent owner raised in its response." Opposition (Paper 60, "Opp."), 3. Like federal courts, the Board will decline to "consider new evidence presented at the end of a briefing schedule when the other party no longer has an opportunity to respond." *Corning, Inc. v. DSM IP Assets B.V.*, Case IPR2013-00052, Paper 88 (PTAB 2014) at 13 (refusing to consider data submitted in a reply that was necessary for petitioner to make its case of inherent anticipation).

In its Motion to Exclude, Patent Owner meaningfully discussed arguments that might have triggered Petitioner's reliance on the testimony that Patent Owner now seeks to exclude, namely that Petitioner seeks to admit new evidence to support the construction of "varying colour" (Exs. 1061 – 1063), to support a new construction of the term "exposed" (Exs. 1064 – 1066), and to for the first time show that the level of skill in the art is evidenced by the prior art references and the education level of those working in the field (Exs. 1051 - 1060), including adding qualifications of Dr. Shackle not previously relied upon. Petitioner cannot now in its reply brief seek to fill in the gaps and correct the deficiencies in its purported *prima facie* case for invalidity of the patent claims (Paper 10, "Pet.")—to prove by a preponderance of the evidence that the instituted claims are unpatentable. Admission of such evidence would be manifestly unfair to Patent Owner, who has not had an opportunity to respond to such belated evidence, which reasonably

could have been anticipated and raised in the Petition. For the further reasons stated below, such evidence, including the identified portions of Dr. Ducharme's testimony should be excluded.

II. PETITIONER'S REPLY EVIDENCE EXCEEDS THE PROPER SCOPE OF A REPLY

A. Exhibits 1061 - 1066 Should Be Excluded

Petitioner seeks to improperly rely on Exs. 1061 - 1063 to make its case for its construction of "varying colour," as "a direct response to patent owner's continued argument regarding the claim construction of varying colour." Opp., 6. However, as Petitioner acknowledges, the Board in its Decision chose its own construction of varying colour (see Paper 21 at 8), which for purposes of the IPR proceeding neither party contested (see the Response at 17 and Petitioner's Reply (Paper 48) at 9). Furthermore, at the time of its Response (June 25, 2015), Patent Owner did not know that Petitioner would withdraw reliance on its original construction (Paper 48 filed on August 11, 2015) and adopt the Board's construction. Petitioner cannot now complain that its own exhibits concerning "varying colour" are relevant and admissible when it argued that Patent Owner's argument regarding the construction of "varying colour" in its Response testimony was irrelevant. *See* Petitioner's Motion to Exclude, Paper 55, pgs. 4 – 5. In any event, the briefing here clearly reflects that the parties do not contest the Board's construction for purposes of this proceeding, and the issue is moot.

Similarly, Petitioner now seeks to improperly rely on Exs. 1064 - 1066 to

make its case for construction of the term "exposed." Petitioner chose not to put forth a construction for this term in its Petition. But now, in its Reply (Paper 48 at 21, fn. 2) Petitioner seeks to create a *prima facie* case for invalidity of claims using the term exposed based on a new and never before presented construction. Accordingly, Exs. 1061 – 1066 should be excluded.

B. Exhibits 1051 - 1060 Should Also Be Excluded

Even if admissible over hearsay objections, Exs. 1051 - 1061 should have been part of the *prima facie* case of level of skill offered in the Petition. In his declaration, Dr. Shackle recites that "the level of skill in the art is evidenced by the prior art references" and "the education level of those working in the field." Ex. 1002, para. 35. Patent Owner pointed out (at Response, 9 - 12) that Dr. Shackle did not correctly assess the level of skill in the art. In fact, he did not cite one example of a prior art reference or any education level of a person working in the field, including the education and experience level of those purportedly identified in Exs. 1051 - 1060, in his initial analysis. *See* Ex. 1002, 35 - 37. Furthermore, it should not take Patent Owner calling out the deficiencies in Dr. Shackle's qualifications (at Response, 13) for Petitioner for the first time to assert the same experience Dr. Shackle had as when he wrote his first declaration. There is no evidence that Dr. Shackle relied on this evidence in formulating his opinions of the first declaration, including his initial determination of the level of skill, and its submission now is late and improper.

III. CERTAIN PORTIONS OF DR. DUCHARME'S TESTIMONY SHOULD BE EXCLUDED

Regarding the objectionable testimony regarding Wu's disclosure of a "light sensitive switch" (Ex. 1049, 119: 4-13), Petitioner fails to address that the elicited response should be excluded, because the question asked Dr. Ducharme to divest "Module A of the Wu reference" from its context, and consider it in "isolation" (Ex. 1049, 119:4 – 6), which is why Dr. Ducharme qualified his answer with "[i]f you consider the point between the circuit elements or circuit blocks A and C…" (Ex. 1049, 119:8 – 13). Dr. Ducharme is saying here that if you take Module A *out of Wu* you get a light sensitive switch. It is obvious that Petitioner sought an answer to a *different* question, thus making the question misleading and the answer inadmissible. *See* Reply, 12.

Regarding the purported testimony that Dr. Ducharme "limited his focus to the eternal flame embodiment" (8/3,171: 20 – 25, 172: 1 – 25, 173: 1 – 25, 174: 1 – 16), the first question asked if he "limited" his analysis to Chliwnyj's flame embodiment, and the next questions asked if he "focused" on that embodiment, which not having omitted this testimony, Patent Owner quoted him answering "yes." *See* Mot. Exclude, 9. Dr. Ducharme never said he focused "solely" on one embodiment, which is how Petitioner characterizes this testimony (*see* Reply, 14 and Opp, 12), which makes the questions confusing and misleading, and the answers inadmissible.

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