

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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. (SHIEN LUEN FLORIDA),  
CHIEN LUEN INDUSTRIES CO., LTD., INC. (SHIEN 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.

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Case No. IPR2014-00938  
Patent 7,429,827

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

## I. INTRODUCTION

Patent Owner's Motion to Exclude Evidence ("Motion") should be denied. Patent owner argues (i) that certain exhibits should be struck because they are belated, (ii) that other exhibits violate the Federal Rules of Evidence, and (iii) that certain portions of the cross-examination of its expert (Dr. Ducharme) should be excluded because the questions allegedly were misleading, argumentative, ambiguous, and/or compound. Patent owner is incorrect.

First, the allegedly belated exhibits are not belated, but were provided in direct reply to arguments that patent owner raised in its response, which is permitted. Second, none of petitioner's exhibits violate the Federal Rules of Evidence (*e.g.*, the use of dictionaries to provide meanings to claim terms is common); and is warranted in petitioner's reply because patent owner attempted to reargue the construction of "varying colour" and "accessible" in its response. Third, contrary to patent owner's position, petitioner's questions were fair, and the questions were understood by Dr. Ducharme. That patent owner does not like the answers that its expert provided is not reason to exclude them. And, in any event, the Board can judge the probative value of the testimony. It should not be excluded.

## II. ARGUMENT

### A. Petitioner's Exhibits Are Timely And Provided In Direct Response to Patent Owner's Response.

It is well understood that “[a] reply may only respond to arguments raised in the corresponding opposition.” 37 C.F.R. § 42.23; Office Patent Trial Practice Guide, 77 Fed. Reg. at 48767. Stated differently, even if the reply relies on new evidence or expands on arguments, this cannot establish impropriety of such evidence or the inadmissibility of the evidence under the Federal Rules of Evidence. See Case CBM2013-00009, paper 68 at 43 (Feb. 11, 2014). Thus, “[t]he very nature of a reply is to respond to the opposition, which in this case is the Patent Owner Response.” *Microsoft Corp. v. SurfCast, Inc.*, 2014 WL 5337868, at \*30 (Oct. 14, 2014); see 37 C.F.R. § 42.23(b). As such, where patent owner raised issues for the first time in its patent owner response, the petitioner may address those issues in its reply. See *St. Jude Med., Cardiology Div., Inc., v. Board of Regents of Univ. of Mich.*, 2014 WL 1783276, at \*20 (May 1, 2014). (“A petitioner is not expected to anticipate, in its petition, every counterargument a patent owner might make in response.”).

Here, patent owner argues that paragraphs 26-27, 35-38, 50, and 69 of the Declaration of Peter Shackle (Ex. 1047) (“Shackle II”) provided in reply to patent owner’s response are belated. Patent owner also argues that exhibits 1048-1057 (LinkedIn and Atlas Profiles), exhibits 1058-1062 (dictionary definitions and

thesaurus), and exhibit 1063 (Ducharme expert report from earlier case against IDC) are untimely. This testimony and the accompanying exhibits should be permitted, however, because they directly respond to arguments that patent owner raised in its Response.

**1. Patent Owner's Failure to Meaningfully Discuss the Arguments in its Response that Triggered the Allegedly Belated Testimony and Exhibits is a Basis for Denial.**

Patent owner's motion should be denied at the outset because patent owner does not even discuss the arguments it made in its response that led to the allegedly improper evidence being included in the Reply. *See* CBM2013-00009, paper 68 at 43–44 (“[Movant’s] motion does not, however, contain any meaningful discussion of the arguments [Movant] has made in its patent owner response, which reasonably might have triggered [Petitioner’s] reliance on the testimony [Movant] now seeks to exclude. Without such an analysis, [Movant] has not shown that the reply declarations . . . and documentary evidence . . ., exceed the proper scope of reply evidence.”) (citations omitted). Specifically, patent owner does not discuss that paragraphs 26-27 of Shackle II and exhibits 1048-1057 are in direct response to patent owner’s contention that petitioner assessed the level of skill in the art too high and the evidence provided by patent owner. *See generally* PO Resp., Paper No. 34 at 10-14; Duchm. Decl., Ex. 2021 at ¶¶ 51-58. Similarly, paragraphs 20, 35-38 of Shackle II are in direct response to patent owner’s allegations that Dr.

Shackle is not qualified to testify. *See* PO Resp., Paper 34 at 14-15, Duchm. Decl., Ex. 2021 at ¶¶ 32-34, 36. And exhibits 1058-1063 and ¶¶ 50 and 69 of Shackle II are in response to patent owner’s attempt to reargue the construction of “varying colour,” and to construe “accessible” for the first time, in its response. *See* PO Resp., Paper No. 34 at 20-21; Duchm. Decl., Ex. 2021 at ¶¶ 74-77. Patent owner’s failure to even identify these arguments that led to petitioner’s expert’s testimony and exhibits alone justifies denying patent owner’s motion.

## **2. Petitioner’s Evidence in Reply to Patent Owner’s Challenge to the Level of Skill in the Art is Timely.**

Patent owner submitted evidence that the prior art allegedly indicated a level of skill lower than the level of skill in the art proposed by petitioner. This evidence took the form of citing to the level of education of the named inventors of certain patents. *See* PO Resp., Paper 34 at 12-14; *see generally* Duchm. Decl., Ex. 2021 at ¶¶ 51-56 and specifically at ¶¶ 57-58. Dr. Ducharme further states he is “aware that only a handful of the inventors of the prior art patents in this case are electrical engineers.” Duchm. Decl., Ex. 2021 at ¶ 52.

Dr. Shackle’s paragraphs 26-27 and exhibits 1048-1057 provide testimony and evidence that educational level of many of the named inventors of the prior art patents of record is at least a Bachelor’s degree (as petitioner contends) or in many cases greater. This testimony and evidence thus directly rebuts an argument raised by the patent owner for the first time in its response and should be permitted.

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