

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. 7,429,827

IPR Case No.: IPR2014-00938

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

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I. INTRODUCTION

Petitioner contends its Reply (Paper 50) evidence “directly respond[ed] to arguments that patent owner raised in its response.” Opposition (Paper 62, “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 (Paper 54, “Mot. 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. 1058 – 1060), to support a new construction of the term “accessible” (Exs. 1061 – 1062), to submit a new argument and for the first time to show “the substitution of different LEDs (e.g., green and blue) in Chliwnyj would just result in a differently colored flame” (see Ex. 1047, ¶69 (citing Ex. 1065) and 71), and 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. 1048 - 1057), including adding qualifications of Dr. Shackle not previously relied upon (see Ex. 1047 (¶¶ 26, 27)). 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 13, “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 1058 – 1060 Should Be Excluded

Petitioner seeks to improperly rely on Exs. 1058 - 1060 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 20 at 8 - 9), which for purposes of the IPR proceeding neither party contested (see the Response (Paper 34) at 18 and Petitioner's Reply (Paper 50) 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 56, 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. 1061 - 1062 to make its case for construction of the term “accessible.” Petitioner chose not to put forth a construction for this term in its Petition. But now, in its Reply (Paper 50 at Page 11) Petitioner seeks to create a *prima facie* case for invalidity of the patent claims using the term “accessible,” based on a new and never before presented construction. Accordingly, Exs. 1061 – 1066 should be excluded.

B. Exhibit 1065 Should Be Excluded

Petitioner submits a new argument (Ex. 1047, ¶71) that “the substitution of different LEDs (e.g., green and blue) in Chliwnyj would just result in a differently colored flame” and uses Ex. 1065 and the testimony of Dr. Ducharme to support it. *See* Ex. 1047, ¶69 (citing Ex. 1065). These arguments reasonably, including Ex. 1065, could have been brought in the Petition in anticipation of Patent Owner contending that even if a person of ordinary skill could substitute a red, blue, and green LED of Lau into the flame simulation device of Chliwnyj to produce any color, that person would not have done so because it would have rendered Chliwnyj inoperable for its intended purpose—a flame simulation. *See, e.g.,* Response, 36 – 37. In other words, Ex. 1065, and the related testimony, should be excluded because Petitioner failed from the onset to show that the asserted

combination would have a reasonable expectation of success, and only tried to fix that deficiency in its Reply.

C. Exhibits 1048 - 1057 Should Also Be Excluded

Even if admissible over hearsay objections, Exs. 1048 - 1057 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, 10 - 14) 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. 1048 - 1057, 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, 14 - 15) 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 Dr. Ducharme’s purported testimony regarding Chliwnyj’s “simple user interface” (Ex. 1046, 133: 14 – 25, 134: 1 – 12, 135, 3 – 10),

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