

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. (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.

Case No. IPR2014-00938

Patent 7,429,827

**PETITIONER'S REPLY TO PATENT OWNER'S
RESPONSE TO PETITIONER'S MOTION TO EXCLUDE CERTAIN
EVIDENCE OF RECORD**

I. Introduction.

Petitioner respectfully submits this Reply to Patent Owner’s Response to Petitioner’s Motion to Exclude (“Response to Pet. Mot. to Exclude”). For the reasons discussed below and those provided in petitioner’s Motion to Exclude (“Motion”), the PTAB should exclude Exhibits 2042, 2050, 2052, 2054, and 2062. The PTAB should also exclude Dr. Shackle’s deposition testimony regarding claim terms “varying color” and “exposed”/“exposed switch” (and paragraphs 110-119 of Dr. Ducharme’s declaration), and Dr. Shackle’s testimony regarding “retrospective” review.

II. Because Patent Owner “[R]eserves its [R]ight to [A]ppeal” the Denial of its Motion to Terminate, Petitioner’s Motion to Exclude Exhibits 2042, 2050, 2052, 2054, and 2062 is not Moot.

Patent Owner argues that Petitioner’s Motion to Exclude exhibits 2042, 2050, 2052, 2054, and 2062 is moot because the Board denied Patent Owner’s motion. Patent Owner, however, purports to “reserve[] its right to appeal the decision of the Board.” Response to Pet. Mot. to Exclude, Paper No. 59 at 1. This reservation indicates that Patent Owner may attempt to appeal this rejection. Petitioner’s Motion, therefore, is not moot. Because Patent Owner fails to argue that the exhibits are not hearsay, or make any other argument justifying their admissibility, Petitioner respectfully requests these exhibits be excluded.

III. The Testimony Regarding the Ambiguous Claim Term “Varying” Should Be Excluded.

Patent Owner argues that (i) Petitioner’s objections were not timely, and (ii) the issue is moot as both sides are using the Board’s construction.

First, Petitioner timely objected. During the deposition of Dr. Shackle, Petitioner objected to this line of questioning column/line 58:20, 68:13, 69:3, 69:15, 69:20, 70:7; same objection at 70:13, 70:20, etcetera. Patent owner’s line of questioning was misleading and confusing because Patent owner failed to define which construction of the term “varying” or “varying colour” was being used. *See* Motion at 5.¹

Patent owner also argues that because both parties are now applying the Board’s construction of “varying colour” the issue is moot. Patent owner, however, appears to be continuing to argue for an alternative definition of “varying colour.” The testimony, therefore, is not moot. Even if Patent owner now accepts the Board’s definition, the testimony should still be excluded under FRE 402 and 403 because it is not relevant, and the potential for confusion and thus unfair

¹ Petitioner acknowledges that the referenced exhibit number (2023) is in error, it should be Ex. 2022 at Motion, page 5, line 4. Petitioner requests the following testimony be excluded from Ex. 2022 at 57:23- 65:5, 68:4-79:24, and 167:16-183:19.

prejudice to Petitioner would be high when compared to the probative value of zero.

IV. The Testimony Regarding the Improper and Abstract Hypothetical Regarding “Exposed Switch” Should Be Excluded.

Patent owner argues that Petitioner’s counsel’s purported failure to properly object and/or failure to explain his form objections somehow justifies patent owner’s counsel’s hypothetical. Patent owner is incorrect.

First, petitioner’s counsel objected multiple time to patent owner’s counsel’s vague and abstract hypothetical. *See generally* Motion, at 5 indicating objections; Ex. 2022 at 99:1-100:20; 106:16; 108:22; 109:9; 110:1, 110:12, 110:17, 111:20, and 114:19. Petitioner’s counsel concisely captured the issue with his objection at 100:15-20, which pertained to the entire line of questioning regarding the switch testimony.

Second, patent owner’s discussion of the testimony in its Response is further evidence that questioning was improper. Patent owner argues that the questions were not misleading because patent owner’s counsel offered “clarifying questions” after objections and/or further qualified the questions. *See* Response to Pet. Mot. to Exclude, Paper No. 59 at 5-6. That counsel needed to offer clarifying questions is strong evidence that the original questions were improper. Further, the clarifying questions themselves were often the subject of an objection. *Id.* at 5-6 and *see e.g.*, Ex. 2022 at 108:22 and 109:9, 110:1, 110:7, and 110:12. Petitioner,

therefore, moves to exclude testimony in Shackle Depo., Ex. 2022 at 99:1-115:12, Patent Owner’s Response, Paper 31 at 40-42, and Ex. 2021, Ducharme Decl. at ¶¶ 110-118 because the hypothetical relating to the “exposed switch” was improper and abstract.

V. The Testimony Regarding “Retrospective Review” Should Be Excluded.

Patent owner improperly argues that the testimony should be permitted because petitioner did not object and that Patent owner’s hindsight inference is justified based on the testimony. Patent owner is wrong.

First, petitioner’s counsel objected to the question regarding “retrospective analysis” at page Ex. 2023 at page 278, line 15. Patent owner’s counsel then re-asked a similar question to which Petitioner’s counsel objected. Petitioner’s counsel then stated “[g]o ahead. I’m sorry” as he had interrupted and patent owner’s counsel then asked a similar question with “retrospective review.” *Id.* 278:22-25. The “objection to form” from the previously asked question was believed to be still in effect as the same vague “retrospective” term was being used.

Second, patent owner attempts to convert Dr. Shackle’s answer into improper hindsight should be excluded because it is not supported by Dr. Shackle’s testimony. As stated in Petitioner’s Motion, Dr. Shackle thought his response to the “retrospective review” question meant that he obtained the prior art, studied it, and provided an opinion. Patent owner characterization of this analysis as

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