UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, INC.
Petitioner
v.

INTELLECTUAL VENTURES II, LLC
Patent Owner
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U.S. Patent No. 6,968,459
IPR2016-01404

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PETITIONER'S REPLY TO PATENT OWNER'S
OBSERVATIONS ON CROSS-EXAMINATION OF DR. PAUL FRANZON

Patent Owner's Observations (Paper 30) regarding the Cross-Examination of Dr. Paul Franzon, filed September 18, 2017, should be dismissed because they are overly argumentative, selectively cite the record to mischaracterize the record and mislead the Board, and fail to identify where its arguments were previously presented in the record.[1] Petitioner responds to each of Patent Owner's Observations individually below.

I.   Response to Observation No. 1.

In Observation No. 1, Patent Owner makes false statements. For example, Patent Owner's claims that Dr. Franzon's testimony "directly contradicts [his] 'Supplemental' Declaration" and that Dr. Franzon has made "repeated contradictions" are simply untrue, as explained below. The Observation should be dismissed.

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[1] *See Medtronic, Inc. v. NuVasive, Inc.*, IPR2013-00506, -00507, -00508, Paper No. 37 at 2-3 (P.T.A.B., Oct. 15, 2014) ("An observation is not an opportunity to raise new issues, to re-argue issues, or to pursue objections . . . In considering whether a motion for observation . . . is improper, the entire motion . . . may be dismissed or not considered if there is even one excessively long or argumentative observation . . .").

Further, Patent Owner selectively cites and mischaracterizes the record to support its false claims. For example, Patent Owner cites a portion of Dr. Franzon's deposition testimony in which he responded that "[the term password string in Bensimon] is referring to either the write protection password or read-write protection password." EX-2008, 51:13-15. Patent Owner claims that this portion of Dr. Franzon's testimony "directly contradicts" his Supplemental Declaration at ¶ 24. Patent Owner then cites to only the portion of the Supplemental Declaration at ¶ 24 where Dr. Franzon declared that his "understanding is that Bensimon does not disclose the type of 'password string' the Password-Disable commend sends to the storage device using the disable command." Patent Owner's fabrication is false. For example, Patent Owner fails to mention that Dr. Franzon continued his explanation regarding the "password string" during his second deposition and testified that: "To me [Bensimon] is **not saying** whether [the password string is] the write protection password or read-write password. To me it can be either." EX-2008, 51:23-52:1 (emphasis added). Thus, Dr. Franzon's statement that "Bensimon does not disclose the type of password string" in his Supplemental Declaration at ¶ 24 **does not** directly contradict his second deposition testimony, in which he stated that "[Bensimon] is not saying whether [the password string is] the write protection password or read-write password." EX-2008, 51:23-25. Despite claiming "repeated contradictions" in Dr.

Franzon's testimony, Patent Owner cannot cite even a single one. Therefore, Patent Owner's Observation No. 1 is improper and should be dismissed.

II.   Response to Observation No. 2

Patent Owner's Observation No. 2 is improper and should be dismissed. Patent Owner again makes false statements. For example, Patent Owner's assertions that Dr. Franzon "repeatedly refused to answer the question" and that he has "shifting and inconsistent positions" are not true. Dr. Franzon, in fact, repeatedly answered Patent Owner's questions throughout the second deposition. *See*, e.g,, EX-2008, 58:14-20 ("To me . . . someone of ordinary skill in the art reading Bensimon, would [understand that] the host computer in Bensimon does block access to the storage device.").

Further, Patent Owner again selectively cites and mischaracterizes the record to fit its own narrative. For example, to support its false claim that "Dr. Franzon agrees that Bensimon does not explicitly disclose what happens when an error condition is set," Patent Owner cites merely the portion of Dr. Franzon's deposition transcript where he stated that "Bensimon doesn't give further detail on what happens to the error conditions set." EX-2008, 51:9-11. Patent Owner, however, fails to fully explain to the Board the context from which its selective citations were pulled. Dr. Franzon had been explaining that: (1) "Bensimon does explicitly disclose that write commands are not sent under the control of the

computer under certain conditions," EX-2008, 55:5-8, (2) "[the host computer of Bensimon] is not sending the write command to the device if . . . the host systems is password aware," *id.*, 55:20-22, and (3) "Bensimon does explicitly disclose that the host system will block . . . off access to the storage device [when an error condition is set]," *id.*, 57:3-12. When further questioned regarding Bensimon's error condition, Dr. Franzon explained that "someone of ordinary skill in the art reading Bensimon, would read that . . . the host computer in Bensimon does block access to the storage device." EX-2008, 58:14-59:4. Thus, Dr. Franzon does not, in fact, agree that "Bensimon does not explicitly disclose what happens when an error condition is set," as Patent Owner would have the Board believe. Because Patent Owner's assertions are false, Observation No. 2 should be rejected.

Furthermore, Patent Owner's assertion that Dr. Franzon's second deposition testimony "contradicts Dr. Franzon's opinion at ¶ 30 of his Supplemental Declaration that Bensimon teaches that 'write commands' are disabled when an 'error condition' is set" is also false. There is no contradiction between his deposition testimony and his Supplemental Declaration. Just as Dr. Franzon explained that in ¶ 30 of his Supplemental Declaration, Dr. Franzon made clear again during his second deposition that Bensimon does teach that "write commands" are disabled when an "error condition" is set. EX-2008, 55:5-8, 55:20-22, and 57:3-12. Thus, Dr. Franzon's testimony during his second deposition is

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