

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LSI CORPORATION and AVAGO TECHNOLOGIES U.S., INC.
Petitioners,

v.

REGENTS OF THE UNIVERSITY OF MINNESOTA
Patent Owner.

Case No. 2017IPR-01068
U.S. Patent 5,859,601

PETITIONERS' OBJECTIONS TO PATENT OWNER'S EVIDENCE

Under 37 C.F.R. § 42.64(b)(1), LSI Corporation and Avago Technologies U.S., Inc. (collectively “Petitioners”) hereby object to the evidence submitted with Patent Owner’s Response to Petition filed July 14, 2020, in response to the Board’s Decision of April 21, 2020 (Paper 35) that instituted the trial for *Inter Partes* Review of U.S. Patent No. 5,859,601 (“’601 Patent”). The objections are timely filed and served within five business days of service of the evidence.

Petitioners object to **Exhibit 2007** (April 13, 2008 Soljanin Decl. in *Regents of the University of Minnesota v. LSI Corporation et al.*, Case No. 18-cv-00821-EJD-NMC, Dkt. 204-4 (N.D. Cal.)).

First, Ex. 2007 as cited is irrelevant because indefiniteness is not at issue in this IPR. *See, e.g.*, Patent Owner response at 2 (“[S]he rendered herself incapable of opining on anticipation of the Challenged Claims by asserting, in sworn testimony in connection with the related district court proceeding, that five terms in the Challenged Claims were indefinite. Ex. 2007, ¶¶ 37-59.”) (footnote omitted); *see also id.* at 30-31 (citing Ex. 2007, Section VII and arguing that Dr. Soljanin’s April 13, 2008 Declaration (Ex. 2007) as to indefiniteness “essentially disqualifies here from opining that she finds those same claim elements in the prior art[.]”). Thus, the portions of Exhibit 2007 cited by Patent Owner should be excluded under Federal Rules of Evidence (“FRE”) 402 and 403.

Second, Exhibit 2007 is inadmissible hearsay and should be excluded under FRE 801 and 802. Further, the content of Exhibit 2007 cited by Patent Owner does not qualify for any exception under FRE 803.

Third, Patent Owner uses Exhibit 2007 to make untimely and waived objections to Prof. Solanin's direct testimony (Ex. 1010). *See, e.g.*, Patent Owner Response at 2, 30-34 (citing Exhibits 2007 and 2008 as basis for disqualifying Prof. Soljanin's direct testimony in this IPR). Patent Owner waived any such objections, which were due within ten business days of the institution of the trial. *See* 37 C.F.R. § 42.64(b)(1) ("Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of trial."). Thus, Exhibit 2007 should also be excluded under 37 C.F.R. § 42.64(b)(1) to the extent it is being offered by Patent Owner to make untimely objections to Prof. Soljanin's direct testimony.

Petitioners object to **Exhibit 2008** (May 9, 2018 Soljain Dep. Tr, in *Regents of the University of Minnesota v. LSI Corporation et al.*, Case No. 18-cv-00821-EJD-NMC, Dkt. 204-4 (N.D. Cal.)).

First, Ex. 2008 is irrelevant because indefiniteness is not at issue in this IPR. *See, e.g.*, Patent Owner response at 2 ("[S]he rendered herself incapable of opining on anticipation of the Challenged Claims by asserting, in sworn testimony in

connection with the related district court proceeding, that five terms in the Challenged Claims were indefinite. Ex. 2007, ¶¶ 37-59.”) (footnote omitted); *see also id.* at 30-31 (citing Ex. 2007, Section VII and arguing that Dr. Soljanin’s Declaration as to indefiniteness “essentially disqualifies here from opining that she finds those same claim elements in the prior art[.]”). Thus, the portions of Exhibit 2008 cited by Patent Owner relating to indefiniteness in the litigation underlying this IPR should be excluded under FRE 402 and 403.

Second, Exhibit 2008 is inadmissible hearsay and should be excluded under FRE 801 and 802. Further, the content of Exhibit 2008 cited by Patent Owner does not qualify for any exception under FRE 803.

Third, Patent Owner uses Exhibit 2008 to make untimely and waived objections to Prof. Soljanin’s direct testimony (Ex. 1010). *See, e.g.*, Patent Owner Response at 30 (“UMN deposed her in May 2018 on her Litigation Declaration (Ex. 2008) ... Her testimony shows that her opinions in support of Petitioners’ challenges are unreliable and not credible.”); *see also id.* at 30-34 (citing Exhibits 2007 and 2008 as basis for disqualifying Prof. Soljanin’s direct testimony in this IPR). Patent Owner waived any such objections, which were due within ten business days of the institution of the trial. *See* 37 C.F.R. § 42.64(b)(1) (“Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of trial.”). Thus, Exhibit 2008 should

also be excluded under 37 C.F.R. § 42.64(b)(1) to the extent it is being offered by Patent Owner to make untimely objections to Prof. Soljanin's direct testimony.

Petitioners object to **Exhibit 2011** (June 12, 2020 Soljanin Dep. Tr. in IPR2017-01068).

First, the portions of Ex. 2011 containing discussion of Ex. 2017 or 2018 should be excluded for all of the same reasons that Exs. 2017 and 2018 should themselves be excluded. As explained above, Exs. 2017 and 2018 should be excluded under FRE 402, 403, 801, 802, and 37 C.F.R. § 42.64(b)(1).

Second, the portions of Exhibit 2011 that contain discussion of 2017 or 2018 should be excluded as outside the scope of Prof. Soljanin's direct testimony (Ex. 1011). *See* 37 C.F.R. § 42.53(d)(5)(ii) ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.").

Petitioners object to **Exhibit 2027** (Excerpts from K. Ashar, *Magnetic Disk Drive Technology*, IEEE Press, 1997). Ex. 2027 is not relevant to claim construction at least because it was published after the alleged priority date for the '601 patent. Thus, Ex. 2027 should be excluded under FRE 402 and 403.

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