UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PARUS HOLDINGS, INC.,
Patent Owner.

Case No. IPR2020-00686
U.S. Patent No. 7,076,431

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
STRIKE PORTIONS OF PATENT OWNER'S SUR-REPLY**

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I. Parus's Expert's Supplemental Declaration Is Not New Evidence

Apple's allegation that Exhibit 2027, a two-paragraph declaration, is new evidence that was filed without authorization is unfounded for two reasons, and both reasons demonstrate that it was filed properly. First, Parus filed Mr. Occhiogrosso's declaration in order to rebut new opinions that Dr. Terveen advanced in twenty-nine paragraphs of his supplemental declaration, which contained new opinions and arguments that could have and should have been part of his initial declaration. Second, Mr. Occhiogrosso's supplemental declaration does not contain new opinions as Apple alleges.

A. Exhibit 2027 was filed in response to Dr. Terveen's Supplemental Declaration

Parus filed Mr. Occhiogrosso's two-paragraph supplemental declaration with its Sur-reply. In its Sur-reply, Parus stated that in the event that the Board allowed Dr. Terveen's supplemental declaration, that Parus was including Mr. Occhiogrosso's supplemental declaration to rebut the new opinions and arguments in Dr. Terveen's supplemental declaration.

Without authorization, Apple filed Exhibit 1040, Supplemental Declaration of Loren Terveen, with its Reply to the POR. Parus timely objected to this submission because, among other reasons, Apple did not seek prior authorization,

and because it contained new opinions and theories that Apple could have included in its Petition.[1]

Apple filed the supplemental declaration under the guise of rebutting arguments in the POR, but Dr. Terveen does not rebut any arguments from the POR, and instead includes new opinions and theories that should have been included in the Petition.

For example, in the declaration, Dr. Terveen claims that he had been asked to "respond to certain issues raised by Patent Owner in Patent Owner's Response dated December 23, 2020 ('POR')." (Ex. 1040, ¶ 1). Dr. Terveen's supplemental declaration does not rebut certain issues raised by Patent Owner in its POR. Instead, Dr. Terveen spends the bulk of his supplemental declaration attempting to describe how he thinks speech recognition works, how he thinks it works in Ladd, and how he thinks it is purportedly similar to the disclosures of the '431 Patent. These new arguments and opinions should have been included in the Petition. (*See PTAB's Consolidated Trial Practice Guide (November 2019)* (Nov. 2019 TPG), 73 ("[i]t is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing")).

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[1] Parus intends to file a motion to exclude the declaration at the appropriate deadline.

Interestingly, in Dr. Terveen's twenty-nine paragraph supplemental declaration, in which Apple alleges that he was responding to certain issues raised in the POR, he cites to the POR once, and that is not until paragraph twenty-three. (Ex. 1040). In this singular citation to the POR, Dr. Terveen does not even rebut the section he cites. Instead, Dr. Terveen takes Mr. Occhiogrosso's testimony from his deposition out of context, falsely alleges that Mr. Occhiogrosso explained that this represented Parus's position in regards to the '431 Patent, and then attempts to rebut what Mr. Occhiogrosso testified about in his deposition, and how it is purportedly different than Ladd. This is not a response to certain issues raised in Parus's POR. These are new opinions that should have been included in the Petition. Nothing in Mr. Occhiogrosso's deposition changed the disclosure of Ladd, the '431 Patent, or the state of the art.

Mr. Occhiogrosso rebutted these new opinions with his two-paragraph supplemental declaration. As such, this supplemental declaration did not require prior authorization.

B.   Ex. 2027 does not include new opinions, so Apple is not prejudiced

Ex. 2027 does not include new opinions contrary to Apple's assertions. (Paper 25, 2). Mr. Occhiogrosso's statement that Ladd teaches "speech recognition that directly compares audio inputs, not text, to a vocabulary or grammar in order to

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