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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WANGS ALLIANCE CORPORATION D/B/A WAC LIGHTING CO.
Petitioner

v.

PHILIPS LIGHTING HOLDING B.V.
Patent Owner

Inter Partes Review Case No. IPR2015-01292
U.S. Patent No. 6,586,890

PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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Petitioner hereby submits its Reply to Patent Owner's Opposition to Patent Owner's Motion to Exclude Evidence Under 37 C.F.R. §§ 42.62 and 42.64 (Paper 54).

I. EXHIBIT 2010 IS IRRELEVANT AS UNDATED

Exhibit 2010 is undated and, thus, cannot be probative of the understanding of a person of ordinary skill in the art at the time of the invention or for explaining the disclosures in the prior art. Thus, it should be excluded as irrelevant. Patent Owner states that "[t]he date . . . is not relied on by Dr. Zane, and thus, it is not being offered for the truth of the matter asserted." Paper 54, at 4. Patent Owner ignores that the entire purpose of the cited section of Dr. Zane's declaration (Ex. 2006, ¶¶ 63-64, 66-68) is to support the proposition that "The ST Micro Datasheet and Biebl use different and incompatible PWM control mechanisms." *Id.* at 34. Exhibit 2010 is therefore being used to describe the allegedly "incompatible PWM control mechanisms" in the prior art ST Micro Datasheet and Biebl, and thus the date is being relied upon by Dr. Zane in conducting that analysis.

Patent Owner cites *U.S. Postal Service et al. v. Return Mail, Inc.*, CBM2014-00116 (PTAB Oct. 15, 2015) for the proposition that documents can be relevant for "providing background on the technology despite the documents' late date." However, the documents in *U.S. Postal Service* were used to support assertions "with respect to the state of the art and to [the] knowledge of a person of

ordinary skill in the art, and how it evolved." CBM2014-00116, Paper 41, at 30. Here, Exhibit 2010 is not being used to evidence of the evolution of the knowledge of one of ordinary skill in the art (nor can it), but rather to explain the allegedly "different and incompatible PWM control mechanisms" in the prior art. Ex. 2006, at 34. References that have publication dates after the critical date "may be cited to show the state of the art ***at or around the time of invention***." *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00010, 2014 WL 869413, at *21 (PTAB Feb. 24, 2014) (emphasis added). Without being able to date the document "at or around the time of invention," Exhibit 2010 is irrelevant. *Actifio, Inc. v. Delphix Corp.*, IPR2015-00108, 2016 WL 1734063, at *11 (PTAB April 29, 2016). Patent Owner cites no case law for the proposition that an undated document is relevant to explain prior art that is not related to the document itself.

The alleged copyright date of 2001 on Exhibit 2010 is hearsay. *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, 2015 WL 1906730, at *6-8 (PTAB April 23, 2015). Here, as in *Standard Innovation*, the copyright date on Exhibit 2010 is not subject to any hearsay exception. Additionally, the hearsay statement that Exhibit 2010 was published in 2001 has no equivalent circumstantial guarantees of trustworthiness. Patent Owner states without evidence or citation that Texas Instruments acquired Unitrode in 1999 (Paper 52, at 2), but that does not adequately explain why markings from both entities are on the document, or why

the copyright page is a different size from the other pages. As the date on Exhibit 2010 is hearsay not subject to any exception, it should be considered undated and, thus, irrelevant.

II. MR. TINGLER'S TESTIMONY SHOULD BE EXCLUDED

Mr. Tingler's testimony about (1) claims that he did not opine on in his Reply Declaration and (2) the scope and content of his original declaration should be excluded because they are outside the scope of his Reply Declaration. Testimony about claim 23, from which claim 31 depends, is outside the scope of Mr. Tingler's Reply Declaration because he only opined about claim 31 (Patent Owner has not disputed that claim 23 is invalid). Additionally, whether particular testimony related to the combination of Biebl and ST Micro was present in Mr. Tingler's original declaration is outside the scope of his Reply Declaration, and therefore irrelevant, particularly considering that the Rules allow Mr. Tingler to respond to Dr. Zane on reply. 37 C.F.R. § 42.23(b).[1]

Patent Owner argues that the "an objection to scope is a procedural

[1] Patent Owner appears to take its Opposition brief as an opportunity to argue the merits of whether Mr. Tingler presented new arguments/evidence in his Reply Declaration, despite the Board determining that such argument is improper at this juncture. Ex. 2012, 30:3-9. The Board should ignore those arguments.

objection" and, thus, Petitioner cannot seek to exclude Mr. Tingler's testimony in a Motion to Exclude. Paper 54, at 9. The cited case law, however, only holds that a Patent Owner cannot use a Motion to Exclude to argue that Petitioner's expert has added new arguments or evidence to the case in a Reply declaration. *Google, Inc. v. Visual Real Estate, Inc.*, IPR2014-01339, 2016 WL 308801, at *17 (PTAB Jan. 25, 2016); *Microsoft Corp. v. Surfcast, Inc.*, IPR2013-00292, 2014 WL 5337868, at *30 (PTAB Oct. 14, 2014). That is not the present situation, where Mr. Tingler, Petitioner's expert, was questioned at his second deposition about both (1) claims that were not opined upon in his reply declaration and (2) the content of his original declaration, about which he was already deposed. Ex. 2011, 12:11-16:2; 29:22-31:2. The case law cited by Patent Owner does not address the examination of an expert at deposition about issues outside the scope of the declaration.

Thus, Patent Owner cites no authority for the proposition that a motion to exclude based on a scope objection is improper. Patent Owner cites 37 C.F.R. § 42.53—the general provision regarding the taking of depositions—which makes clear at section (d)(5)(ii) that "[f]or cross-examination testimony, the scope of the examination *is limited to the scope of the direct testimony*." (emphasis added). Therefore, Patent Owner's argument that the scope objections cannot support a motion to exclude is improper. Indeed, if an objection cannot be used as a basis to exclude evidence, then it has no effect.

Patent Owner also argues that Petitioner waived its relevance objection by only objecting based on scope. Paper 54, at 11. But the cases it cites do not support its argument. Patent Owner's cited cases merely hold that testimony to which *no objection* had been made cannot be the subject of a motion to exclude. *Apple Inc. v. Achates Ref. Publ'g, Inc.*, IPR2013-00080, 2014 WL 2530788, at *26-27 (PTAB June 2, 2014) ("Achates does not point to ***any objections*** to the lines of questioning . . ."") (emphasis added); *HTC Corp. v. Advanced Audio Devices, LLC*, IPR2015-01157, 2016 WL 287057, at *13 (PTAB Jan. 22, 2016) (denying motion to exclude where motion did not identify any prior objections). Here, Petitioner properly objected to the two lines of questioning as outside the scope of Mr. Tingler's reply declaration, which makes them irrelevant. To hold that no scope objections can be the subject of a motion to exclude would make objections to scope hollow mechanisms. Indeed, given this particular context, the scope objections should effectively be treated as relevance objections. Therefore, Mr. Tingler's testimony should be excluded because the questioning was outside the scope of his reply declaration, and therefore irrelevant.

III. CONCLUSION

For the reasons stated above, the Board should exclude Exhibit 2010 and Mr. Tingler's testimony that was elicited from questioning that was outside the scope of his declaration.

Date: August 5, 2016

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CERTIFICATE OF SERVICE ON PATENT OWNER UNDER 37 C.F.R. §§ 42.6(e)(4) and 42.205(b)

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on August 5, 2016, a complete and entire copy of PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE was served via EMAIL to counsel of record for Patent Owner at the below:

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