

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC

Petitioner

- vs. -

CARRUM TECHNOLOGIES, LLC

Patent Owner

IPR2019-00481

U.S. Patent 7,925,416

PETITIONER'S MOTION TO STRIKE

PATENT OWNER'S SUR-REPLY

Petitioner submits this Motion to Strike Patent Owner's Sur-Reply ("PO Sur-Reply," Paper 20) and the second Declaration of Gregory Shaver, Ph.D. ("Second Shaver Declaration," Ex. 2010) pursuant to the Board's e-mail authorization. *See* Ex. 1025. The PO Sur-Reply and Second Shaver Declaration violate the Trial Practice Guide's prohibition of new evidence with a sur-reply. The appropriate remedy is to strike the offending papers and request a corrected sur-reply.

I. The PO Sur-Reply and the Second Shaver Declaration Fail to Comply with the Trial Practice Guide

A. The Sur-Reply Improperly Introduces New Evidence

The August 2018 update to the Trial Practice Guide ("TPG") changed the Board's procedures from authorizing observations on cross-examination testimony to authorizing a sur-reply to a petitioner's reply. *See* 2018 Revised TPG at 14; *see also* Consolidated TPG (Nov. 2019) at 73–74.¹ This change was accompanied by a clear directive: "[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." *Id.*

In disregard of the TPG, the PO Sur-Reply was accompanied by new evidence: the Second Shaver Declaration. Worse, the PO Sur-Reply extensively relied on the impermissible Second Shaver Declaration. *See, e.g.* PO Sur-Reply at 3–8, 10–11, 13–14, 21–24.

¹ Further citations herein are to the Consolidated TPG.

There is no excuse for doing so. The August 2018 update to the Trial Practice Guide issued *before* the Petition was filed. Lead counsel for Patent Owner is an experienced practitioner. *See* Ex. 2008, ¶ 8. And Patent Owner's back-up counsel, in his motion for *pro hac vice* admission, attested that he "read and will comply with the Office Patent Trial Practice Guide" including the guidance on sur-replies and new evidence. Ex. 2008, ¶ 6; Paper 12.

Nor did Patent Owner seek permission from the Board to submit its new evidence (e.g., by authorization for a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(b)). Even if it had, it would have also needed to demonstrate that the new evidence deserved consideration in the interests of justice. As demonstrated below, justice would not be served by allowing this new evidence.

B. The Sur-Reply Improperly Raises New Issues

Notwithstanding the clear violation of the new evidence prohibition, the PO Sur-Reply also improperly raises at least 3 new issues. *See* Consolidated TPG at 74.

First, Patent Owner, citing the Second Shaver Declaration, seeks to now explicitly construe the claim phrase "position in the turn," even though it did not advocate for a specific meaning to that phrase in its Patent Owner Response. *See* PO Sur-Reply at 10–11 (*citing* Ex. 2010, ¶¶ 21–23).

Second, Patent Owner now seeks to clarify Dr. Shaver's earlier testimony and its reliance thereon. At pages 7–8 of the PO Sur-Reply, Patent Owner argues that

its “use of ‘i.e.’ ... shows that the entry, vertex, and exit of a turn are non-limiting examples,” and cites the Second Shaver Declaration in support of this belated redefinition of the Latin expression *id est*, which stands for “that is,” not “for example.” PO Sur-Reply at 7–8 (*citing* Ex. 2010, ¶¶ 19–20). But this argument is not responsive to anything in Petitioner's Reply; thus, it plainly raises a new issue.

Third, with respect to Ground 2, Patent Owner (again citing new evidence) now appears to argue inoperability of *Fukada*, alleging that using *Fukada*'s method “would frequently incorrectly determine the vehicle's path”—no such argument was ever presented before. PO Sur-Reply at 23 (*citing* Ex. 2010, ¶ 37).

II. Striking the PO Sur-Reply and Exhibit 2010 and Requiring a Corrected Sur-Reply is the Appropriate Remedy

The TPG and the Board's previous treatment of similar issues confirm that striking the PO Sur-Reply and Second Shaver Declaration, and requiring a corrected sur-reply with no new argument or evidence, is the appropriate remedy. For example, the TPG states a “sur-reply that raises a new issue or *belatedly presents evidence may not be considered*.” Consolidated TPG at 74 (emphasis added). Even more strongly, while the TPG notes that the Board is “capable of identifying new issues or belatedly presented evidence,” the TPG acknowledges that “whether an issue is new *or evidence is belatedly presented may be beyond dispute*” and notes that in some instances, striking a brief or evidence may be appropriate. *Id.* at 80–81 (emphasis added). Petitioner respectfully submits that there can be no dispute that

the Second Shaver Declaration is belatedly presented. In the face of the TPG's prohibition on new evidence with a sur-reply, Patent Owner filed new evidence with its sur-reply. The proper remedy is explicitly provided for and appropriate here.

Recently, a panel of the Board held that a patent owner's submission of new evidence with its sur-reply, which included a second declaration of its expert witness, was improper and did not comply with the TPG. *See 33Across, Inc. v. Leftsnrights, Inc. d/b/a Liqwid*, IPR2018-01480, Paper 36 (PTAB Oct. 1, 2019). In view of the improper filing, the Board expunged the sur-reply and new evidence, and ordered the patent owner to file a corrected sur-reply with no new arguments and no citation to new evidence. *Id.* at 3. Petitioner respectfully submits that the remedy in *33Across* is equally appropriate here. Such a remedy suitably imposes the burden on curing Patent Owner's violation on Patent Owner itself.

Patent Owner may instead argue, as the TPG notes, that striking the sur-reply is an "exceptional remedy" that may not be warranted. Consolidated TPG at 80. It is the appropriate remedy here, however, as addressing the new evidence and theories at this late stage would prejudice Petitioner. Potential alternative solutions would be insufficient, as such resolutions would instead levy the burden of Patent Owner's violations on Petitioner and the Board, and would not cure the harm of Patent Owner's transparent defiance of the Board's procedures. For example, adequately addressing Patent Owner's new evidence and theories in supplemental

briefing (e.g., a sur-sur-reply) would require Petitioner to expend attorneys' fees and court reporter fees for cross-examination of Dr. Shaver, expert witness fees for a potential third declaration and cross-examination of Petitioner's own expert witness, attorneys' fees for drafting the additional brief, and potentially more, in the interests of preserving Petitioner's due process rights. Further, additional briefing would require the Board's resources to review the new papers, and could potentially require adjustment to the Scheduling Order, given that the oral hearing is scheduled to be held less than two months from this Motion's filing. This solution would thus impose burdens on both Petitioner and the Board, neither of whom were responsible for the violation. *See also Trane U.S. Inc. v. Semco, LLC*, IPR2018-00514, Paper 36 at 8 (PTAB Apr. 17, 2019) (granting a motion to strike and stating: "we cannot overlook a party's blatant disregard of our rules and practice when doing so would unfairly prejudice another party, unduly burden the Board's review of the evidence, and impact the efficiency of our decision-making.") Patent Owner, on the other hand, would experience little or no impact from its transgression, which would condone similar action in the future by others.

Thus, because the PO Sur-Reply and Second Shaver Declaration contravene the TPG, and because the TPG explicitly states that striking such offending papers is proper, Petitioner respectfully requests that these papers be stricken and expunged, and that Patent Owner be ordered to file a corrected sur-reply.

Respectfully submitted,

March 2, 2020

/Raghav Bajaj/
Raghav Bajaj, Reg. No. 66,630
Counsel for Petitioner
HAYNES AND BOONE, LLP

PETITIONER'S EXHIBIT LIST

EX1001	U.S. Patent 7,925,416 to Perisho, Jr. et al.
EX1002	Prosecution File History of U.S. Patent 7,925,416 (“416 PH”)
EX1003	Prosecution File History of U.S. Patent 7,512,475 (“475 PH”)
EX1004	U.S. Patent 5,508,929 to Harada (“ <i>Harada</i> ”)
EX1005	U.S. Patent 6,675,094 to Russell et al. (“ <i>Russell</i> ”)
EX1006	Certified Translation of Japanese Patent Application JP0536000A to Mazda (“ <i>Mazda</i> ”)
EX1007	U.S. Patent 5,627,756 to Fukada et al. (“ <i>Fukada</i> ”)
EX1008	Declaration of Scott Andrews
EX1009	Complaint, <i>Carrum Technologies, LLC v. BMW of North America, LLC et al.</i> , 1:18-cv-01645 (D. Del. Oct. 23, 2018)
EX1010	Complaint, <i>Carrum Technologies, LLC v. FCA US LLC</i> , 1:18-cv-01646 (D. Del. Oct. 23, 2018)
EX1011	Complaint, <i>Carrum Technologies, LLC v. Ford Motor Company</i> , 1:18-cv-01647 (D. Del. Oct. 23, 2018)
EX1012	U.S. Patent 6,902,021 to Kikuchi et al. (“ <i>Kikuchi</i> ”)
EX1013	U.S. Patent 6,233,515 to Engelman et al. (“ <i>Engelman</i> ”)
EX1014	U.S. Patent 7,260,465 to Waldis et al. (“ <i>Waldis</i> ”)
EX1015	Unified Patents Voluntary Interrogatories
EX1016	U.S. Patent 2,804,160 to Rashid (“ <i>Rashid</i> ”)
EX1017	U.S. Patent 2,127,454 to Wolfe et al. (“ <i>Wolfe</i> ”)
EX1018	U.S. Patent 4,156,874 to Kopis (“ <i>Kopis</i> ”)
EX1019	U.S. Patent 5,014,200 to Chunderlik (“ <i>Chunderlik</i> ”)
EX1020	U.S. Patent 6,751,547 to Khosla (“ <i>Khosla</i> ”)
EX1021	<i>Physics, Part I</i> , Robert Resnick and David Halliday (1966) (excerpts)
EX1022	Transcript of Deposition of Dr. Greg Shaver
EX1023	Reply Declaration of Scott Andrews
EX1024	Research Advances in Intelligent Collision Avoidance and Adaptive Cruise Control, <i>Vahidi et al.</i> , IEEE Transactions on Intelligent Transportation Systems, Vol. 4, No. 3, Sept. 2003
EX1025	E-mail from Andrew Kellogg dated February 24, 2020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Unified Patents, LLC
Petitioner

§ Petition for *Inter Partes* Review
§
§ IPR2019-00481
§ U.S. Patent No. 7,925,416
§

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service March 2, 2020

Manner of service Electronic Service by E-Mail

Documents served Petitioner's Motion to Strike Patent Owner's Sur-Reply Exhibit 1025

Persons served Sarah E. Spires
Paul J. Skiermont
Skiermont Derby LLP
sspires@skiermontderby.com;
pskiermont@skiermontderby.com

/Raghav Bajaj/
Raghav Bajaj
Counsel for Petitioner
Registration No. 66,630