

Filed on behalf of Intellectual Pixels Limited

By: Douglas R. Wilson
Michelle E. Armond
Joseph Li
Forrest M. McClellan
ARMOND WILSON LLP
4685 MacArthur Court, Suite 390
Newport Beach, CA 92660
Telephone: (949) 932-0778
Email: litigation@armondwilson.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

INTELLECTUAL PIXELS LIMITED,
Patent Owner.

Case No. IPR2021-00237
U.S. Patent No. 10,681,109

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

Pursuant to 37 C.F.R. § 42.64(c) and the Scheduling Order (Paper 14), Patent Owner Intellectual Pixels Limited hereby moves to exclude Petitioner Sony Interactive Entertainment LLC's Exhibits 1024, 1029, and 1030 and portions of Exhibit 1033. Patent Owner timely objected to these exhibits on November 30, 2021. *See* Paper 23 at 1-4.

I. THE BOARD SHOULD EXCLUDE EXHIBIT 1024 UNDER FRE 401-402 AND 901

Exhibit 1024 should be excluded for both lack of relevance and lack of authentication.

First, Exhibit 1024 should be excluded because it is irrelevant and therefore inadmissible. Petitioner filed Exhibit 1024 with its Reply (Paper 22), but neither Petitioner nor its expert cites or relies on Exhibit 1024. Because neither Petitioner nor its expert cites or relies on Exhibit 1024, it is not relevant to any issue in this IPR and should be excluded under FRE 402. *See* Fed. R. Civ. P. 402 (“Irrelevant evidence is not admissible.”); *SK Innovation Co., Ltd. v. Celgard, LLC*, IPR2014-00680, 2015 WL 5722451, at *16 (P.T.A.B. Sept. 25, 2015) (granting motion to exclude “[b]ecause Patent Owner does not explain where it cited [the exhibits] in this proceeding”).

Exhibit 1024 should also be excluded because Petitioner has offered no evidence to show that Exhibit 1024 is what Petitioner appears to claim it is, as required by FRE 901. As explained in Patent Owner's objections, Exhibit 1024 is

not a document but instead appears to be a collection of pictures or images compiled by Petitioner’s counsel from unspecified sources. *See* Paper 23 at 1. Indeed, Petitioner’s exhibit list identifies Exhibit 1024 as simply “Pictures of devices” (Paper 22 at 30), which provides no evidence to establish what the exhibit is. Moreover, Exhibit 1024 “does not bear any statement of publication, let alone an identification of the medium in which it allegedly was published.” *TRW Auto. U.S. LLC v. Magna Elecs. Inc.*, IPR2014-01348, 2016 WL 212791, at *3 (P.T.A.B. Jan. 15, 2016). Exhibit 1024 should be excluded under FRE 901. *Id.* at *2 (excluding exhibit “in its entirety under FRE 901 for lack of authentication”).

II. THE BOARD SHOULD EXCLUDE EXHIBITS 1029 AND 1030 AND PORTIONS OF EXHIBIT 1033 UNDER 37 C.F.R. § 42.23(b)

Exhibits 1029 and 1030 and portions of Exhibit 1033 should be excluded because they constitute improper new evidence or contain improper new argument not permitted with a reply. *See* 37 CFR § 42.23(b); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-00912, 2021 WL 2384365, at *1 (P.T.A.B. June 10, 2021) (“motions to exclude [are] a potential remedy to exclude certain evidence or argument that would exceed the proper scope of a reply”).

A. Exhibits 1029 And 1030 Should Be Excluded Because They Are Improper New Evidence

Exhibits 1029 and 1030 should be excluded because they are improper new evidence that were not “made of record at the institution stage,” were filed “for the

first time with [Petitioner’s] Reply,” and are relied upon by Petitioner “to fill a gap in its prima facie case.” *Dexcom, Inc. v. Waveform Techs., Inc.*, IPR2016-01680, 2018 WL 1137089, at *13 (P.T.A.B. Feb. 28, 2018).

As explained in the Patent Owner Response, “to close th[e] gap” in Petitioner’s Ground II obviousness case, “Petitioner would have to either depart from Chen’s teaching of use of ADSL in residences or supplement Wiltshire’s disclosure with placing clients in residences. Petitioner argued neither, and neither is supported by this record.” Paper 17 at 59. Relying on Exhibits 1029 and 1030, Petitioner attempts to close the gap in its Reply, by asserting that Wiltshire is not “limited to commercial casino establishments” and that Chen is not “limited to residential applications.” Paper 22 at 26. Tellingly, Petitioner relies on the new references to gap-fill for what Chen itself did not disclose. *See id.* (relying on Exhibits 1029 and 1030 to assert that ADSL and DSL can be used in the “business” context). That is improper. *See* 37 CFR § 42.23(b); Consol. Trial Practice Guide (Nov. 2019) at 74 (“It is also improper for a reply to present new evidence ... that could have been presented in a prior filing, for example newly cited prior art references intended to ‘gap-fill’”).

Exhibits 1029 and 1030 “should be excluded from evidence and ... the corresponding portions of the Reply [*i.e.*, Paper 22 at 26] should not be considered.” *Dexcom*, 2018 WL 1137089, at *13.

B. Portions Of Exhibit 1033 Should Be Excluded Because It Contains Improper New Arguments

Portions of Exhibit 1033, Dr. Fuchs’ supplemental declaration, should be excluded because it contains improper new arguments. Specifically, paragraph 79 of Exhibit 1033 includes an entirely new theory of invalidity in violation of 37 C.F.R. § 42.23(b).

First, Dr. Fuchs opines that “Wiltshire discloses a system with only one client” and that “[t]hus, it is immaterial whether ADSL could support more than one concurrent MPEG video stream.” EX1033 ¶ 79. But the Petition and Dr. Fuchs’ original declaration specifically relied on Wiltshire’s disclosure of a plurality of clients. *See, e.g.*, Paper 3 at 20-21 (for claim 1, relying on Wiltshire’s Figure 1A and disclosure that “Computer gaming system 100 includes ... a ***plurality of remote client/terminal computers 120***” (emphasis added)); EX1002 ¶ 60 (same); Paper 3 at 61 (for claim 2, explaining that “Wiltshire describes using a communication pathway between the server and ***clients***” (emphasis added)); EX1002 ¶ 197 (same). Patent Owner, in responding to Petitioner’s theory, made clear that “with a bandwidth requirement of 1.3 Mb/s for an MPEG video stream, Chen disclosed that ADSL’s downstream bandwidth can provide only ***one*** MPEG video stream on a single pair of copper wires. ... Petitioner’s assertion that Chen’s ADSL was well-suited for Wiltshire’s commercial system is thus refuted by its own expert.” Paper 17 at 61-62. Seeking to evade the conflict in its Petition theory and its own

expert testimony, Petitioner now submits a new expert declaration with a new theory in reply that changes both its Petition theory and its expert's testimony. For example, in reply, Dr. Fuchs now relies for the first time on Wiltshire's claim 1, which recites "one or more client/terminal computers." EX1033 ¶ 79. But a reply is not the time to offer new invalidity theories. *See* Consol. Trial Practice Guide (Nov. 2019) at 74 ("Respond,' in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing.").

Second, Dr. Fuchs newly opines in the alternative that a "given application in Wiltshire need not consume the entire 1.3 Mbps bandwidth." EX1033 ¶ 79. But Dr. Fuchs opined in his original declaration that "an MPEG stream may require rates of *at least* 1.3 megabits per second." EX1002 ¶ 200 (emphasis added); *see also* Paper 3 at 63-64 (citing EX1006, 5); EX2010, 70:10-72:15. That was the theory upon which the Board instituted this IPR. *See* Paper 13 at 44-45 ("Dr. Fuchs further testifies that a [POSITA] would have understood that sending compressed updated images from Wiltshire's server to the client requires higher bandwidth of *at least* 1.3 Megabits per second when an MPEG stream is used." (emphasis added)).

None of these arguments were raised or mentioned in the Petition, nor are they proper reply arguments under 37 C.F.R. § 42.23(b). *See* Consol. Trial Practice Guide (Nov. 2019) at 74 ("Respond,' in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the

positions taken in a prior filing.”). Paragraph 79 of Exhibit 1033 “should be excluded from evidence and ... the corresponding portions of the Reply [*i.e.*, Paper 22 at 27] should not be considered.” *Dexcom*, 2018 WL 1137089, at *13.

III. CONCLUSION

For at least the reasons stated above, Patent Owner respectfully requests that the Board exclude Exhibits 1024, 1029, and 1030 and portions of Exhibit 1033.

ARMOND WILSON LLP

Dated: February 18, 2022

By: /Douglas R. Wilson/

Douglas R. Wilson (Reg. No. 54,542)

Michelle E. Armond (Reg. No. 53,954)

Joseph Li (Reg. No. 74,998)

Forrest M. McClellan (Reg. No. 76,553)

Attorneys for Intellectual Pixels Limited

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing **PATENT OWNER’S MOTION TO EXCLUDE EVIDENCE** is being served electronically on February 18, 2022 to the following lead and back-up counsel for Petitioner to the following email addresses:

Joseph F. Haag
joseph.haag@wilmerhale.com

Daniel V. Williams
daniel.williams@wilmerhale.com

James M. Dowd
james.dowd@wilmerhale.com

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Attorneys for Intellectual Pixels Limited