

IPR2023-00341

Petitioner's Motion to Exclude Exhibits

Filed on behalf of Intuit Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner

v.

SAMESURF, INC.,
Patent Owner.

Inter Partes Review No. IPR2023-00341
Patent 9,483,448 B2

PETITIONER'S MOTION TO EXCLUDE EXHIBITS 2005 – 2008

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), Petitioner Intuit Inc. (“Petitioner”) respectfully submits this motion in accordance with Due Date 5 of the Scheduling Order (Paper 14), and hereby requests exclusion of Exhibits 2005-2008.

The table below shows each exhibit or portion thereof for which Petitioner requests exclusion, a description of the exhibit, and the grounds for exclusion.

Exhibit	Description	Grounds for Objection/ Exclusion
2005	Order Denying Defendant's Motion to Dismiss Pursuant to 35 U.S.C. § 101 and Denying Defendant's Request for Oral Argument, entered in <i>Samesurf, Inc. v. Intuit, Inc.</i> , USDC, Southern District of California, Case No. 22-cv-00412-RSH-DDL [Dkt. 27]	FRE 402, 403; 37 C.F.R. § 42.61
2006	Defendant Intuit, Inc.'s Notice of Motion and Motion to Dismiss Pursuant to Rule 12(b)(6), filed on May 23, 2022 in the case titled, <i>Samesurf, Inc. v. Intuit Inc.</i> , USDC, Southern District of California, Case No. 22-cv-00412-LL-KSC [Dkt. 16].	FRE 402, 403
2007	Defendant Intuit, Inc.'s Reply in Support of Its Motion to Dismiss Pursuant to Rule 12(b)(6), filed on June 17, 2022 in the case titled, <i>Samesurf, Inc. v. Intuit Inc.</i> , USDC, Southern District of California, Case No. 22-cv-00412-LL-KSC [Dkt. 22].	FRE 402, 403
2008	Corrected Notice of Allowability for Application No. 14/830,710 (U.S. Patent No. 9,483,448) issued on September 19, 2016.	FRE 402, 403; 37 C.F.R. § 42.23(b)

II. LEGAL STANDARDS

The Federal Rules of Evidence govern the admissibility of evidence and expert testimony in an *inter partes* review. 37 C.F.R. § 42.62(a). Irrelevant evidence is not admissible, and relevant evidence may be excluded “if its probative value is substantially outweighed by a danger of . . . unfair prejudice [or] confusing the issues.” FRE 402, 403.

New arguments or evidence introduced in Sur-reply are inadmissible under 37 C.F.R. § 42.23(b) and thus subject to exclusion. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1366, 1369-70 (Fed. Cir. 2016). The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Consolidated Trial Practice Guide (“Trial Practice Guide”) at 74 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

It is not enough for the Board to find that this Motion is moot if the Board does not rely on the inadmissible evidence in reaching its Final Written Decision. If the exhibit and paragraphs identified herein remain in the record, Petitioner could continue to rely upon them on appeal, and Petitioner would be unfairly forced to address them again.

Accordingly, the Board should exclude the objected-to exhibits for the reasons that follow.

III. COMPLIANCE WITH 37 C.F.R. § 42.64(C)

Petitioner timely objected to Exhibits 2005-2008 by filing Petitioner's Objections to Evidence Submitted with Patent Owner's Response pursuant to 37 C.F.R. § 42.64 on October 4, 2023 (Paper 23) and to Patent Owner's Sur-Reply to Petitioner's Reply filed on February 6, 2024 (Paper 29).¹

IV. EXHIBITS 2005-2007 SHOULD BE EXCLUDED AS IRRELEVANT AND/OR UNFAIRLY PREJUDICIAL OR CONFUSING

Petitioner objected to Exhibits 2005-2007 as irrelevant. Papers 23, 29.

Each of these papers relates to a district court proceeding involving the subject patent, but related to Motion to Dismiss Pursuant to 35 U.S.C. § 101, patentable subject matter, as it relates to the subject patent. Since patentable subject matter is not a ground that can be raised in an IPR, the order is irrelevant.

Patent Owner argues in its Sur-reply that Petitioner's articulation of the abstract idea it argued in district court should be considered in claim construction in this proceeding, despite the term argued by Patent Owner therein ("simultaneous interactions") not being present in the claims. Paper 28. Since this term is not recited in the claims, the discussion thereof in Exhibits 2005-2007 – in the context of patentable subject matter – is both irrelevant and "its probative value is substantially

¹ Petitioner also filed, with the Board's authorization, a Motion to Strike Exhibits 2006-2008 on February 14, 2024 (Paper 31).

outweighed by a danger of . . . unfair prejudice [or] confusing the issues.” *See* FRE 402, 403. Accordingly, Exhibits 2005-2007 should be excluded.

If these portions are not excluded and Petitioner relies on them in their demonstratives or otherwise at the hearing, they would be considered new evidence. *See St. Jude Med., Cardiology Div., Inc. v. Bd. of Regents Univ. of Mich.*, IPR2013-00041, Paper 65 at 2-3 (P.T.A.B. Jan. 27, 2014) (demonstratives may not present new arguments nor “evidence that, although it is in the record, was never specifically discussed in any paper”).

V. EXHIBITS 2006-2008 SHOULD BE EXCLUDED AS BEYOND THE SCOPE OF A PROPER SUR-REPLY

Petitioner objected to Exhibits 2006-2008 as prejudicial, misleading, confusing, and/or a waste of time under FRE 403 and improper under new evidence 37 C.F.R. § 42.23(b). Paper 29. Petitioner also filed, with the Board's permission, a Motion to Strike Exhibits 2006-2008 on February 14, 2024 due to each being improper new evidence in a Sur-reply. Paper 31.

37 C.F.R. § 42.23(b) states that “a sur-reply may only respond to arguments raised in the corresponding reply and *may not be accompanied by new evidence* other than deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23(b) (emphasis added). None of Exhibits 2006-2008 are deposition transcripts. Nor were Exhibits 2006-2008 of record before Patent Owner submitted them with its Sur-reply, which is what defines exhibits as new evidence. *Satco*

Products, Inc. v. Seoul Semiconductor Co., Ltd., IPR2020- 00836, Paper 45 at 76 (P.T.A.B. Oct. 22, 2021) (exhibits considered new evidence because they were not of record prior to Patent Owner filing them with its Sur-reply), cited at Paper 31 (Motion to Strike), 3-4. Thus, Exhibits 2006-2008 should be excluded as improper under 37 C.F.R. § 42.23(b).

In addition, Exhibit 2008 should be excluded for an additional reason: as wasting time and needlessly presenting cumulative evidence. FRE 403. Patent Owner has ***admitted*** that Exhibit 2008 is cumulative of a portion of Exhibit 1002. *See* Paper 32 (Opposition to Motion to Strike), 1. Patent Owner provided no explanation of why it submitted Exhibit 2008 as a new exhibit instead of citing to Ex. 1002. Thus, Exhibit 2008 should be excluded as wasting time and needlessly presenting cumulative evidence. FRE 403.

Should the Board deny the Motion to Strike Exhibits 2006-2008, it should exclude Exhibits 2006-2008 for the above reasons.

Furthermore, if these exhibits are not excluded and Petitioner relies on them in its demonstratives or otherwise at the hearing, they would be improper new evidence. *See St. Jude Med.*, IPR2013-00041, Paper 65 at 2-3.

VI. CONCLUSION

For the reasons presented above, Exhibits 2005-2008 fail to comply with the Federal Rules of Evidence and 37 C.F.R. § 42.23(b) and should be excluded.

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Dated: March 6, 2024

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Attorneys for Petitioner

Intuit Inc.

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 6, 2024, I caused a true and correct copy of the foregoing PETITIONER'S MOTION TO EXCLUDE EXHIBITS 2005-2008 to be electronically served on Petitioner's lead and backup counsel at the following addresses:

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