

Filed on behalf of Petitioners by:

Paper No. ____

Adam R. Wichman, Reg. No. 43,988

Richard F. Giunta, Reg. No. 36,149

WOLF, GREENFIELD & SACKS, P.C.

600 Atlantic Avenue

Boston, MA 02210

(617) 646-8000 Phone

(617) 646-8646 Fax

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB USA, INC. AND GEOTAB, INC.,
Petitioners,

v.

OMEGA PATENTS, LLC,
Patent Owner.

Case No. IPR2023-00504

Patent No. 8,032,278

**PETITIONERS' REPLY IN SUPPORT OF
MOTION TO EXCLUDE EXHIBITS 2004-2006
AND PORTIONS OF EXHIBITS 2010 AND 2014**

TABLE OF CONTENTS¹

I.	There Is No “Secondary Consideration” Hearsay Exception.....	1
II.	None Of The Deposition Testimony Is Admissible Under Rule 803(3).....	3
	A. PO’s New Rationale Is Inconsistent With Its Trial Papers.	3
	B. No Testimony Qualifies As A Then-Existing State Of Mind.	4
III.	Tregillis and McAlexander Parrot the Hearsay Without Analysis and Identified Portions are Inadmissible Under Rules 702, 703 And 802.....	5

¹ Emphasis is added throughout unless otherwise indicated.

TABLE OF AUTHORITIES

CASES

<i>HTC Corp. v. Tech. Props. Ltd.</i> , No. 5:08-cv-00882-PSG, 2013 U.S. Dist. LEXIS 129263 (N.D. Cal. Sep. 6, 2013)	2
<i>Hynix Semiconductors Inc. v. Rambus Inc.</i> , No. C-00-20905-RMW, 2009 WL 112834 (N.D. Cal. Jan. 16, 2009)	2
<i>Infinity Canopy, Inc. v. Import FenceDirect, Inc.</i> , No. CV 19-08427-AB, 2022 WL 1591702 (C.D. Cal. Mar. 17, 2022)	2
<i>United States v. Cohen</i> , 631 F.2d 1223 (5th Cir. 1980)	3
<i>United States v. Naiden</i> , 424 F.3d 718 (8th Cir. 2005)	5
<i>United States v. Rivera-Hernandez</i> , 497 F.3d 71 (1st Cir. 2007)	5
<i>United States v. Samaniego</i> , 345 F.3d 1280 (11th Cir. 2003)	3, 4

REGULATIONS

37 C.F.R. §42.51(b)(1)(ii)	1
----------------------------------	---

RULES

Fed. R. Evid. 801(c)(2)	4
Fed. R. Evid. 803(3)	1, 3, 4, 5
Fed. R. Evid. 804(b)	1
Fed. R. Evid. 807	1

OTHER AUTHORITIES

Consolidated Trial Practice Guide (Nov. 2019)	1
---	---

Patent Owner (“PO”) does not meaningfully dispute that EX2004-EX2006 are hearsay and fails to meet its burden to justify an exception. PO makes no showing that the witnesses were unavailable so no Rule 804(b) exception applies. PO makes no showing to justify the residual exception under Rule 807. PO’s reliance on a “then-existing state of mind” exception under Rule 803(3) fails. The deposition testimony in EX2004-EX2006, and the way PO relies on it, contradict PO’s argument that the testimony provides “state of mind” under Rule 803(3).

In an IPR, “parties will... have opportunities to cross-examine any opposing declarants[.]” Trial Practice Guide, 49; *see also* 37 C.F.R. §42.51(b)(1)(ii) (“Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.”). By relying on the hearsay testimony in EX2004-EX2006, PO deprived Petitioners of the opportunity to cross-examine Chen, Hergesheimer, and Hall and develop testimonial evidence contradicting PO’s secondary consideration arguments.

EX2004-EX2006 are hearsay. No exception applies. They are inadmissible, as is the conclusory expert testimony that parrots the hearsay without analysis.

I. There Is No “Secondary Consideration” Hearsay Exception.

None of PO’s unpublished cases support PO’s contention that EX2004-EX2006 are admissible under an alleged blanket exception to the prohibition on

hearsay when the evidence is offered in an attempt to prove “secondary considerations.” Paper 38 (“Opp.”) at 3-4.

PO’s cases concern certain out of court statements—publications offered to show industry praise—used for the non-hearsay purpose of showing that the industry praise existed, rather than for the hearsay purpose of proving the truth of the matters asserted in the publications. *See Hynix Semiconductor v. Rambus*, No. C-00-20905-RMW, 2009 WL 112834, *14 (N.D. Cal. Jan. 16, 2009) (IEEE award showed industry praise); *HTC v. Tech. Props.*, No. 5:08-cv-00882-PSG, 2013 U.S. Dist. LEXIS 129263, *16 (N.D. Cal. Sep. 6, 2013) (article showed industry acclaim). In *Infinity Canopy v. Import FenceDirect*, No. CV 19-08427-AB, 2022 WL 1591702, *5, *5 n.2 (C.D. Cal. Mar. 17, 2022), the court overruled objections to a declaration stating the patent owner’s products had “been featured in several consumer magazines” because the evidence “could be relevant to... commercial success... and not for the truth of the matters asserted in those publications.”

PO’s cases do not stand for the proposition that “when evidence that may arguably qualify as hearsay is offered for the ***purpose of supporting secondary considerations*** it is admissible.” Opp., 3. They stand only for the basic proposition that an out of court statement may be admissible when offered for a non-hearsay purpose rather than to prove the truth of the matter asserted. PO does not rely on the deposition testimony in EX2004-EX2006 to prove that there was industry

praise, or for any purpose other than to prove the truth of the matters asserted therein. This evidence is classic hearsay. Nothing in PO's cases suggest it is admissible because the testimony relates to alleged secondary considerations.

II. None Of The Deposition Testimony Is Admissible Under Rule 803(3).

Rule 803(3) provides a narrow hearsay exception for “[a] statement of the declarant’s *then-existing state of mind* (such as motive, intent, or plan)[.]” Rule 803(3) *excludes* “a statement of *memory or belief to prove the fact remembered or believed*[.]” Rule 803(3). “[T]he state-of-mind exception *does not permit*... the [hearsay] declarant’s statements *as to why* he held the particular state of mind, *or what he might have believed that would have induced* the state of mind.... [T]he *purpose of the exclusion from Rule 803(3) admissibility is to narrowly limit* those *admissible statements to declarations of condition*—‘I’m scared’—*and not belief*—‘I’m scared *because [someone] threatened me.*’” *United States v. Samaniego*, 345 F.3d 1280, 1282 (11th Cir. 2003) (cleaned up); *United States v. Cohen*, 631 F.2d 1223, 1225 (5th Cir. 1980). None of the cited testimony in EX2004-EX2006 qualifies for the Rule 803(3) exception.

A. PO’s New Rationale Is Inconsistent With Its Trial Papers.

The POR and Sur-reply cite EX2004-EX2006 for the truth of the matters asserted. Paper 37 (“Br.”) at 3-6; *see, e.g.*, POR at 47, citing EX2004-EX2006 as “testimony... admitting to copying.” There is no “copying” state of mind.

PO's reliance on EX2004-EX2006 in the trial papers flatly contradicts PO's argument that the deposition testimony is used for the deponent's "state of mind."

B. No Testimony Qualifies As A Then-Existing State Of Mind.

Contrary to PO's characterizations (Opp. at 2-5), none of the cited testimony concerns state of mind such as motive, intent, or plan. Chen's testimony at EX2004, 26:11-20 (cited Opp. at 2) concerns the facts of a licensing deal. He did not testify he was "scared" a deal might fall through—or anything of the sort. Hergesheimer and Hall likewise testified to facts—in PO's words "perception" (Opp. at 4-5)—not "state of mind." PO cites no case supporting its characterization of the fact testimony in EX2004-EX2006 as "state of mind" under Rule 803(3). PO's characterizations would erase any distinction between "state of mind" testimony and any other testimony offered under Rule 801(c)(2)

PO mischaracterizes EX2005 testimony as providing Hergesheimer's "beliefs." Opp. at 2 (Hergesheimer "explained his 'belief'," "offered his impression," "believed products... were of limited value[.]"). This is also not motive, intent, or plan. Even if PO's mischaracterizations of Hergesheimer's testimony were correct (they are not), Rule 803(3) would *exclude* such "beliefs" testimony. Rule 803(3); *Samaniego*, 345 F.3d at 1282 (Rule 803(3) allows "statements *of condition*" not "*belief*"). Nor does PO show that any testimony concerned a state of mind contemporaneous with described events. *United States v.*

Rivera-Hernandez, 497 F.3d 71, 81 (1st Cir. 2007) (Rule 803(3) requires “substantial *contemporaneity of event and statement*”); *United States v. Naiden*, 424 F.3d 718, 722 (8th Cir. 2005) (“*statement must be “contemporaneous with the declarant’s ‘then-existing’ state of mind*”). Rule 803(3) does not apply.

III. Tregillis and McAlexander Parrot the Hearsay Without Analysis and Identified Portions are Inadmissible Under Rules 702, 703 And 802.

The conclusory Tregillis and McAlexander testimony identified in Paper 37 parrots the hearsay testimony in EX2004-EX2006 without analysis. *See Br.* at 12-14. PO does not meaningfully refute this. PO cites passages in Tregillis (EX2014, ¶¶5-6, 21, 25-27, 35-36) as purportedly showing “analysis” of hearsay “rather than simply conveying the testimony itself.” *Opp.* at 5-7. Those passages in EX2014 ***do not cite*** the hearsay testimony and ***are not the subject of the motion to exclude***, which challenges EX2014, ¶¶38-41 and 43-44. *See Br.*, 1 and 12-14. The POR also ***does not cite*** EX2014, ¶¶5-6, 21, 25-27, meaning PO’s non-obviousness arguments do not rely upon this Tregillis testimony.

In short, EX2014, ¶¶38-41 and 43-44 parrot the hearsay without analysis and should be excluded. *See Br.*, 12-14.

Respectfully submitted,
Geotab USA, Inc. and Geotab, Inc.

Date: April 17, 2024

By: /Adam R. Wichman/
Adam R. Wichman, Reg. No. 43,988
WOLF, GREENFIELD & SACKS, P.C

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on April 17, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Patent Owner, upon the following:

Ryan T. Santurri
Christopher F. Regan
David S. Carus

rsanturri@allendyer.com
cregan@allendyer.com
dcarus@allendyer.com
dkimler@allendyer.com

Date: April 17, 2024

/MacAulay Rush/
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.