

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner

v.

BT AMERICAS INC.,
Patent Owner

Case No. IPR2023-00889
U.S. Patent No. 7,895,641

**PETITIONER’S OBJECTIONS TO PATENT OWNER’S EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64(b)(1)**

Mail Stop “PATENT BOARD”
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.64(b)(1), Petitioner Palo Alto Networks, Inc.

(“Petitioner”) objects under the Federal Rules of Evidence (“F.R.E.”) to the admissibility of Exhibits 2021–2028, which Patent Owner filed with its Sur-Reply.

Petitioner timely objects under 37 C.F.R. § 42.64(b)(1) within five business days of service of evidence to which the objection is directed.

I. EXHIBIT 2021

Petitioner objects to Exhibit 2021 under F.R.E. 401, 402, and 403 for including information that is irrelevant or because its probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.

Petitioner also objects to Exhibit 2021 as violating 37 C.F.R. § 42.23(b) because a sur-reply “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); *see also* Consolidated Trial Practice Guide at pp. 73–75 (“While replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered”).

Petitioner further objects to Exhibit 2021 under 37 C.F.R. § 42.63(d) for failing to include a proper exhibit label.

II. EXHIBITS 2023–2028

Petitioner objects to Exhibits 2023–2028 under F.R.E. 401, 402, and 403 for including information that is irrelevant or because their probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.

Petitioner also objects to Exhibits 2023–2028 as impermissible hearsay under F.R.E. 801 and 802 to the extent these exhibits are offered for the truth of the matters asserted. Patent Owner has not identified any applicable exception or exclusion to the rule against hearsay that applies to these exhibits.

Petitioner further objects to Exhibits 2023–2028 under F.R.E. 901 because Patent Owner has not presented evidence sufficient to support a finding that the documents in question are what Patent Owner claims them to be. There is no evidence that the documents are self-authenticating under F.R.E. 902.

Petitioner further objects to Exhibits 2023–2028 as violating 37 C.F.R. § 42.23(b) because a sur-reply “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); *see also* Consolidated Trial Practice Guide at pp. 73–75 (“While replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered”).

Petitioner further objects to Exhibits 2023–2028 under 37 C.F.R. § 42.63(d)

for failing to include a proper exhibit label.

III. EXHIBIT 2022 – SUPPLEMENTAL DECLARATION OF WENKE LEE IN SUPPORT OF PATENT OWNER’S SUR-REPLY

Petitioner objects to Exhibit 2022, including at least ¶¶ 7–40, as improper expert testimony under F.R.E. 702 and 703 because there has not been an adequate showing that Mr. Lee’s testimony is based on sufficient facts or data, is the product of reliable principles or methods, or that the testimony will help the Board understand the evidence or determine a fact in issue.

Petitioner also objects to Exhibit 2022 to the extent Exhibit 2022 relies on Exhibits 2021 and 2023–2028 for the same reasons as provided above, and/or because Exhibits 2021 and 2023–2028 are not qualified to be the basis for an expert opinion under F.R.E. 703. Therefore, these portions of Exhibit 2022 are inadmissible under F.R.E. 702 and F.R.E. 703.

Petitioner further objects to Exhibit 2022 under F.R.E. 401, 402, and 403 for including information that is irrelevant or because its probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.

Petitioner further objects to Exhibit 2022 as impermissible hearsay under F.R.E. 801 and 802 to the extent this exhibit is offered for the truth of the matters

asserted. For example, Petitioner has not been afforded an opportunity to cross-examine Mr. Lee on the testimony presented in Exhibit 2022. Patent Owner has not identified any applicable exception or exclusion to the rule against hearsay that applies to this exhibit.

Petitioner further objects to Exhibit 2022 as violating 37 C.F.R. § 42.23(b) because a sur-reply “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); *see also* Consolidated Trial Practice Guide at pp. 73–75 (“While replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered”).

Respectfully submitted,
STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jonathan Tuminaro/

Jonathan Tuminaro (Reg. No. 61,327)
Michael D. Specht (Reg. No. 54,463)
Daniel S. Block (Reg. No. 68,395)
Steven M. Pappas (Reg. No. 73,904)
Attorneys for Petitioner Palo Alto Networks, Inc.

Date: July 1, 2024

1101 K Street, N.W., 10th Floor
Washington, D.C. 20005-3934
(202) 371-2600

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PETITIONER'S
OBJECTIONS TO PATENT OWNER'S EVIDENCE PURSUANT TO 37
C.F.R. § 42.64(b)(1)** was served electronically via e-mail on July 1, 2024, in its
entirety on the following counsel for Patent Owner:

Nolan M. Goldberg (Lead Counsel) NGoldbergPTABMatters@proskauer.com
Baldassare Vinti (Back-up Counsel) BVinti@proskauer.com
Jonathan A. Roberts (Back-up Counsel) jr@nixonvan.com
Raymond Y. Mah (Back-up Counsel) rym@nixonvan.com
Joseph A. Rhoa (Back-up Counsel) jar@nixonvan.com
PROSKAUER ROSE LLP
NIXON & VANDERHYE P.C.

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jonathan Tuminaro/

Jonathan Tuminaro
Registration No. 61,327
Attorney for Petitioner Palo Alto Networks, Inc.

Date: July 1, 2024

1101 K Street, N.W., 10th Floor
Washington, D.C. 20005-3934
(202) 371-2600