

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

QUANTUM IMAGING LLC,
Patent Owner.

Case IPR2023-00954
Patent 8,458,028

PATENT OWNER'S MOTION TO EXCLUDE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	EXHIBITS 1017-20 AND 1026-27 MUST BE EXCLUDED.....	1
	A. Exhibit 1020 must be excluded per FRE 401-03	1
	B. Exhibits 1018-19 and 1026 must be excluded	4
	1. Objection under FRE 901	4
	2. Objection under FRE 401-03	5
	3. Objection under FRE 106	7
	4. Objection under FRE 801-02	8
	C. Exhibits 1017 and 1027.....	10
	1. Objection under FRE 106	10
	2. Objection under FRE 401-03 and 37 C.F.R. § 42.104(b)(5).....	13
III.	CERTAIN PARAGRAPHS OF EXHIBITS 1004 AND 1025 MUST BE EXCLUDED.....	13
IV.	CERTAIN PORTIONS OF EXHIBIT 1023 MUST BE EXCLUDED	15
V.	CONCLUSION.....	15

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Ascend Perf. Op. LLC v. Samsung SDI Co.</i> , IPR2020-00349 (July 15, 2021)	12
<i>Barbaro Techs., LLC v. Niantic, Inc.</i> , No. 3:18-cv-02955-RS (N.D. Cal.)	2
<i>Canfield Sci., Inc. v. Quantificare S.A.</i> , IPR2021-01518 (March 9, 2023)	12
<i>Edwards Lifesciences Corp. v. Cardiovalve Ltd.</i> , IPR2021-00383 (July 18, 2022)	12
<i>Sherwin-Williams Co. v. PPG Indus., Inc.</i> , No. 2022-2059, 2024 WL 3534113 (Fed. Cir. July 25, 2024)	6
 Rules	
37 C.F.R. § 42.104	13
37 CFR § 42.63	15
Fed. R. Evid. 106	<i>passim</i>
Fed. R. Evid. 401	<i>passim</i>
Fed. R. Evid. 402	<i>passim</i>
Fed. R. Evid. 403	<i>passim</i>
Fed. R. Evid. 602	15
Fed. R. Evid. 801	8, 9
Fed. R. Evid. 802	8, 9
Fed. R. Evid. 901	4, 5, 14
Fed. R. Evid. 902	4, 14

I. INTRODUCTION

The Board should exclude Exs.1017-20, 1026-27, certain paragraphs of Exs.1004 and 1025, and certain portions of Ex.1023. Petitioner failed to cure any of the deficiencies raised by PO in its objections, (Paper 13; Paper 31) except for a half-attempt regarding Ex.1020 which fails.

II. EXHIBITS 1017-20 AND 1026-27 MUST BE EXCLUDED

A. Exhibit 1020 must be excluded per FRE 401-03

PO timely objected to Ex.1020 under FRE 401-03. Paper 31; *see also* Ex.1023, 147:19-149:6. This exhibit comprises 36 slides bearing Bates numbers BT00014843 through BT00014878. Petitioner advances a two-fold justification for the potential relevance of this exhibit. First, Petitioner argues that Ex.1020 is somehow relevant, for it was “provided by Patent Owner in the litigation.” Reply, 6 n.6. Second, Petitioner and its expert argue that Exhibit 1020 is “in color” and provides “a higher visual quality” than pages 123-131 of the prosecution history (i.e., Ex.1003). Ex.1025 ¶15; *see also* Reply, 6 n.6. Both arguments fail.

First, in the parallel district court case involving the ‘028 Patent and two others, PO has produced thousands of documents. If production in the district court were a basis for relevance, then all of those documents would be potentially relevant to this IPR proceeding. Absurd. Furthermore, Petitioner has not provided any evidence that PO affirmatively linked Ex.1020 to the ‘028 Patent. This, Petitioner

cannot do. Ex.1020 was simply part of a bulk production of documents from *Barbaro Techs., LLC v. Niantic, Inc.*, N.D. Cal., Case No. 3:18-cv-02955-RS, which involved different patents. In the parallel district court case, PO merely turned over each and every document produced in the *Barbaro Techs.* Matter, including Ex.1020, but did not specifically associate any of those documents with the ‘028 Patent or any other patents-in-suit. Notably, a PHOSITA does not have access to this exhibit—what is available to a PHOSITA is whatever can be found in the prosecution history and publicly available extrinsic evidence. Thus, the entirety of Ex.1020 must be excluded under FRE 401-02.

Second, Petitioner’s statement that Ex.1020 is part of the prosecution history is patently false. Petitioner’s own expert admits that Ex.1020 “includes additional various additional slides (BT00014843-44, BT00014854-78) that are not ... in the prosecution history.” Ex.1025 ¶24. Therefore, these “additional various slides” from Ex.1020 must be excluded, as they do not relate to any issue in this proceeding. Mr. Crane admits that they are not part of the intrinsic record of the ‘028 Patent, and Petitioner has not established their relevance to this proceeding under FRE 401-02.

Third, Petitioner’s assumption that slides BT00014845-53 in Ex.1020 represents a higher quality version of pages 123-131 of the prosecution history (Ex.1003) is solely based on a visual comparison performed by Petitioner’s expert.

Ex.1025, ¶15. When PO's expert was presented with Exhibit 1020 for the first time ever at the deposition, he did not agree:

Given the renderings being completely different from one another, I would never have guessed that. But [] that you're pointing out that some of the pages from the file history match ..., I can see that, except that they're not exactly the same. So that would be another reason why I would not have guessed that, because the green text on Exhibit 1020 does not match the text underneath the figures in whatever this is. 1003? So I'll take your word for it, but never in a million years would I have guessed to be matching to have even tried to match what's in 1003 versus 1020. It just never would have occurred to me[.]

Ex.1023, 156:4-157:6. Even assuming *arguendo* that Petitioner was correct, at best slides BT00014845-53 are duplicative of what is in the prosecution history thus admitting these slides amounts to additional confusion and “needlessly presenting cumulative evidence” under FRE 403.

Fourth, whatever potential probative value slides BT00014845-53 of Ex.1020 may have—which Petitioner describes as providing “color” and “higher visual quality”—is substantially outweighed by the risk of prejudice and confusion that the admission of the entire Ex.1020 may cause, as per FRE 403. As evidenced by Petitioner's expert's declaration, admitting Ex.1020 would create confusion by suggesting that “the POSITA's understanding” of the prosecution history should be guided by the “additional various slides” from Ex.1020 that are not part of the

prosecution history. Ex.1025 ¶24. The admission of Ex.1020 is exceedingly prejudicial as it invites speculation that “Ex. 1020 [is] likely to be the document that the applicant provided to the patent examiner in the October 8, 2008 interview.” *Id.* ¶15.¹ Therefore, the Board should exclude Ex.1020.

B. Exhibits 1018-19 and 1026 must be excluded

1. Objection under FRE 901

PO timely objected to the authenticity of Exs.1018-19 under FRE 901, but Petitioner did not address these objections. Paper 31. Under FRE 901(a), “[t]o satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Since Exs.1018-19 are not self-authenticating under FRE 902, Petitioner was required to provide evidence establishing that these exhibits are as claimed. Petitioner has failed to provide any such authenticating or corroborating

¹ At deposition, Mr. Crane testified that he is not even certain whether this Exhibit was actually provided to the Examiner, undermining his declaration. *See* Ex.2016, 72:22-76:18. This inconsistent testimony and confusion on Mr. Crane’s part is yet another evidence that admitting Exhibit 1020 invites speculation and leads to undue prejudice and substantial confusion.

evidence regarding the authenticity or public availability of these exhibits. Consequently, Exs.1018-19 should be excluded under FRE 901.

If Petitioner intends to rely on the copyright page of Ex.1018 as the “distinctive characteristics of the item” to establish authenticity under FRE 901(b)(4), this attempt must fail. Although Petitioner claims that Exs.1018-19 are Dr. Medvidovic’s textbook, *Dr. Medvidovic, when first encountering these exhibits during his deposition, could not confirm their authenticity and repeatedly noted that they appeared to differ from the textbook he co-authored and is familiar with.* Ex.1023, 82:2-85:11. FRE 901(b)(4) specifies that the “distinctive characteristics of the item” must be assessed “taken together with all the circumstances.” Given that Dr. Medvidovic was not expecting to see Exs.1018-19 during his deposition and expressed doubts about their authenticity when presented with them, Petitioner’s reliance on 901(b)(4) must necessarily fail, and these exhibits should be excluded.

2. Objection under FRE 401-03

PO has timely objected to Exs.1018-19 and 1026 under FRE 401-02, as having no bearing on any issues in this proceeding. Paper 31. Petitioner and its expert acknowledge that these documents were published seven years after the priority date of the ‘028 Patent. Ex.1025 ¶35; Reply, 10. Consequently, these exhibits are not part of the intrinsic record and do not pertain to how a PHOSITA would have understood the challenged claims based in the context of the intrinsic record as of the priority

date. Accordingly, these later-published documents—that were not accessible to a PHOSITA at the priority date per Mr. Crane’s admission (Ex.2016, 78:1-3; 80:1-6; 80:15-20; 81:6-10; 81:16-20)—do not reflect the knowledge of a PHOSITA at the priority date of the ‘028 Patent. Petitioner has not identified any statements from these exhibits that address the state of the art or the knowledge of a PHOSITA as of the priority date, which is unsurprising as such statements do not exist. They must be excluded under FRE 401-02.

To the extent that Petitioner attempts to infer the knowledge of a PHOSITA in 2002 based on concepts published in 2009, such an approach is speculative. **Given the rapid advancements in the state of the art**, it is highly unlikely that Exs.1018-19 and 1026 would have any significant relevance in determining the knowledge of a PHOSITA in 2002, much like a 2024 textbook can hardly be used to determine the knowledge of a PHOSITA in 2009. As Dr. Medvidovic testified, “[t]hings have changed,” and “[w]e do things differently in software engineering today than ... late 2008.” Ex.1023 95:12-22. Further, any potential minimal relevance is substantially outweighed by the risk of unfair prejudice and substantial confusion between the functionalities of web browsers in 2002 and the more specific “anti-pattern” browsers, (*see* Ex.1023, 136:14-137:9), depicted in these purportedly 2009-published documents. FRE 403; *Sherwin-Williams Co. v. PPG Indus., Inc.*, No. 2022-2059, 2024 WL 3534113, at *6 (Fed. Cir. July 25, 2024) (upholding the district

court's holding that "any potential relevance of the [later-published art] is substantially outweighed by the danger of unfair prejudice and confusion of the issues between the general term 'acrylics' and the more specific term 'acrylic latexes.'").

Moreover, Petitioner claims that these Exhibits are essentially different versions of the same textbook. Reply, 10 n.5. At a minimum, this creates additional confusion and amounts to "needlessly presenting cumulative evidence" under FRE 403. Specifically, for Exhibits 1018 and 1019, Petitioner acknowledges that they correspond to the non-U.S. version of the textbook used during Dr. Medvidovic's deposition. Reply, 10 n.5. Dr. Medvidovic, one of the textbook's co-authors, testified during his deposition that "[i]t's restricted for sale only in India, Bangladesh, Nepal, Pakistan, Sri Lanka, and Bhutan. And I have not seen this version of the book before." Ex.1023, 82:7-20. He also noted that Exs.1018-19 do not appear to be complete versions, with at least 20 pages missing. *Id.*, 83:5-11. He stated clearly, "I can only tell you that I have never seen this edition before and I, quite frankly, don't understand why you didn't obtain an edition that's readily available in this country." *Id.*, at 84:12-20. These Exhibits should be excluded under FRE 403.

3. Objection under FRE 106

PO timely objected to Ex.1026 under FRE 106, and Petitioner failed to cure. Paper 31. Petitioner cherry-picked portions of *Software Architecture: Foundations*,

Theory, and Practice without including related parts that “in fairness ought to be considered at the same time,” as required by FRE 106. For example, and without limitation, Ex.1026 omits significant portions of Chapter 4 of the textbook, which Petitioner repeatedly relies on. *E.g.*, Reply, 10-13. Notably, the introductory pages of Chapter 4 are missing from Ex.1026—these pages provide the framework, definitions, and “fundamental conceptual tools” necessary to fully understand the chapter’s content, including the web browser configurations that Petitioner cites. *Id.* Petitioner’s expert could not rule out the relevance of the omitted parts, because he “was provided a portion of that textbook and asked to form an opinion based upon what I read there.” Ex.2016, 77:11-21. Additionally, the portions of Chapter 4 included in Ex.1026 make repeated references to other chapters of the textbook for context and background information, none of which are included in the Exhibit. This Exhibit must be excluded under FRE 106.

4. Objection under FRE 801-02

PO timely objected to Exs.1018-19 and 1026 for containing inadmissible hearsay statements not covered by an exception. Paper 31. Petitioner and its expert rely on the following non-exhaustive list of hearsay statements (in bold) within these

Exhibits for the purported truth of the matter asserted. These exhibits must be excluded under FRE 801-02.²

- “Medvidovic’s web browsers ... are executed locally according to Dr. Medvidovic’s textbook: ‘**all the game logic moves to the client machines, freeing the server’s computing resources.**’” Reply, 13; Ex.1025 ¶38. Petitioner relies on the purported truth of the matter asserted in the hearsay statement to conclude that the browsers are game applications that are executed locally, (Reply 13), and accessible at the user’s device, (Reply 14-15), because all the game logic ***in fact*** moves to the client machines.
- “In a first example, highlighted in red above, ‘**one client Web browser downloads code-on-demand in the form of a Lunar Lander game applet via HTTP.**’” Reply, 12; Ex.1025 ¶37. Petitioner relies on the purported truth of the matter asserted in the hearsay statement to conclude that the browsers are game applications, because the web browser ***in fact*** downloads code-on-demand in the form of a Lunar Lander game applet via HTTP.
- “The Pro version of Lunar Lander is ‘**identical to Lunar Lander Demo but missing the Demo Reminder and System Clock components.**’ ... [T]able 15-

² By discussing these examples, PO does not adopt Petitioner’s reasoning, mischaracterization, and conclusions.

1 shows that the demo version of the software includes all components and connectors of the pro version (e.g., game logic), along with additional components to enforce the demo’s time limits.” Reply, 29; Ex.1025 ¶40. Petitioner relies on the purported truth of the matter asserted in the hearsay statement to conclude that the Pro and Demo versions are *in fact* identical, except for the time limits.

C. Exhibits 1017 and 1027

1. Objection under FRE 106

PO timely objected to Ex.1017 under FRE 106, (Paper 31), as Petitioner cherry-picked portions of the *Microsoft Computer Dictionary, Fifth Edition* without including all relevant sections that “in fairness ought to be considered at the same time.” FRE 106. Many entries in Ex.1017 reference other terms within the dictionary for a complete understanding.

For example, and without limitation, on page 31 of Ex.1017, the term “application” is defined as “a program,” but Petitioner did not include the entry for “program,” which is essential for understanding the definition in context. Petitioner first raised the definition of “application” in its Reply, and together with its expert, has repeatedly relied upon this definition. Reply, 9-10, 25; Ex.1025 ¶¶9-10, 28, 38. PO is prejudiced if Ex.1017 is admitted without the related entries. FRE 106.

Similarly, on page 562 of Ex.1017, the term “Web address” is defined by referring back to the definition of “URL,” yet the page containing the definition of “URL” is omitted. Given that the presence of a URL in the evidence relied upon by Petitioner (i.e., Ex.1003 123-24) is a contested issue, (Sur-Reply, 8-9; Ex.2016, 53:3-58:1), this omission significantly prejudices PO. PO can offer many examples similar to these. Further, throughout Ex.1017, introductory signals such as “see also,” “acronym,” and “also called” are used, but the exhibit does not include the “Introduction” section that explains the meaning assigned to these signals in the dictionary, which is crucial for the understanding of a PHOSITA and the Board.

PO also notes that during the July 1 deposition of Mr. Crane, deposition Ex.2015³ was introduced, containing excerpts from the *Microsoft Computer*

³ On July 8, 2024, PO emailed the Board seeking authorization to file “rebuttal exhibits” with its Sur-Reply in response to new arguments and evidence presented by Petitioner in their Reply. The Board denied this request, stating that PO was not permitted “to file evidence with its Sur-Reply.” Consequently, PO submitted its Sur-Reply without including any rebuttal exhibits or arguments based on them. The originally filed Sur-Reply included Ex.2015, not as rebuttal evidence, but “only for the limited purpose of allowing the Board to understand the context of the cross-examination” of Mr. Crane. *Edwards Lifesciences Corp. v. Cardiovalve Ltd.*,

Dictionary, Fifth Edition that PO believes should be considered alongside Exhibit 1017. However, Ex.2015 was removed from the proceeding as per the Board's August 5 email. With Ex.2015 removed, Ex.1017 should also be excluded, especially since Petitioner had the opportunity to cure PO's objections under FRE 106 but chose not to do so.

Similarly, PO timely objected to Ex.1027 under FRE 106, and Petitioner failed to cure. Paper 31. Petitioner cherry-picked portions of the *Merriam-Webster's Collegiate Dictionary, 10th Ed.* and failed to include all related parts "that in fairness ought to be considered at the same time." For example, on page 335 of Ex.1027, which Petitioner cites, there is an entry for the word "disseminate." Petitioner relies on the second proposed definition, arguing that "disseminate" must mean "disperse

IPR2021-00383, Paper 60, 87 (July 18, 2022); *Ascend Perf. Op. LLC v. Samsung SDI Co.*, IPR2020-00349, Paper 53, 11-13 (July 15, 2021) (same); *Canfield Sci., Inc. v. Quantificare S.A.*, IPR2021-01518, Paper 61, 44 n.20 (March 9, 2023) (same). However, due to the Board's July 8 email, PO requested permission to file a Corrected Sur-Reply, removing Ex.2015. By "rebuttal exhibits," PO was referring to a plurality of exhibits intended for substantive arguments to counter new arguments introduced in the Reply. On August 14, PO sought the Board's authorization to list via email its intended rebuttal exhibits for appellate purposes.

throughout.” Reply, 22; Ex.1025 ¶48. However, Ex.1027 does not include page 334 of the Merriam-Webster’s Collegiate Dictionary, 10th Ed., where the word “disperse” is actually defined. As a result, PO is prejudiced if Ex.1027 is admitted. FRE 106.

2. Objection under FRE 401-03 and 37 C.F.R. § 42.104(b)(5)

PO timely objected to portions of Exs.1017 and 1027 that were not explicitly relied upon in any of the Papers in this proceeding. Paper 31. Thus, PO moves to exclude any portions of this Exhibits that were not explicitly and clearly relied upon by Petitioner, its expert, or PO per 37 C.F.R. § 42.104(b)(5). These portions include, without limitation, pages 46, 154, 177, 181, 183, 216, 239, 300, 376, 409, 478, and 544. These pages were not relied on by any of the parties in this proceeding, and thus are irrelevant under FRE 401-02, because they lack relevance and fail to support a patentability challenge. To the extent these pages may be relevant, their probative value is substantially outweighed by a danger of prejudice and confusion pursuant to FRE 403.

III. CERTAIN PARAGRAPHS OF EXHIBITS 1004 AND 1025 MUST BE EXCLUDED

PO timely objected to paragraphs 1-8, 11-14, 17, 20-25, 27-28, 30, 33-34, 39-40, 42, and 44 of Ex.1025, for they are not cited to or relied upon by any Paper in violation of 37 C.F.R. § 42.104(b)(5). Paper 31. These are irrelevant under FRE 401-

02, because they fail to support a patentability challenge as they are not relied upon by nay party. To the extent they may be relevant, their probative value is substantially outweighed by a danger of prejudice and confusion per FRE 403.

PO timely objected to paragraphs 11-32 of Ex.1025 under FRE 403. Paper 31. The analysis in these paragraphs is based on Ex.1020, which must be excluded for the reasons discussed in §II.A. Notably, paragraph 15 contains substantially prejudicial speculation that “Ex. 1020 to likely be the document that the applicant provided to the patent examiner in the October 8, 2008 interview.” Further, paragraphs 24 admits that Ex.1020 “includes additional various additional slides” that are not in the prosecution history, rendering this testimony irrelevant.

PO timely objected to paragraphs 33-42 of Ex.1025 under FRE 403. Paper 31. The testimony in these paragraphs is based on analysis of Ex.1018, which is an unauthenticated book not recognized by its purported co-author as explained §II.B. That said, Reply relies on Ex.1026 for arguments on pages 10-15, 29. Juxtaposing testimony based on unauthenticated Ex.1018 with arguments made in Reply based on Ex.1026 is substantially confusing and prejudicial under FRE 403. Furthermore, for the reasons discussed §II.B.4, testimony in these paragraphs contains inadmissible hearsay.

PO timely objected to paragraphs 66-68 and 70-72 of Ex.1004 under FRE 901-902 as there has not been a sufficient foundation laid for the admission of the

evidence alleged to support the statements and images appearing in these paragraphs. Paper 13. Petitioner failed to submit witness testimony or evidence to demonstrate that the evidence cited in these paragraphs is authentic, and it is not self-authenticating. Mr. Crane has no personal knowledge under FRE 602 of the evidence's creation, authorship, or any other required foundational aspect of this evidence. Specifically, the evidence relying on the citation to https://macromedia.fandom.com/wiki/Macromedia_Shockwave_Player in paragraphs 70-72 of Ex.1004 is not authenticated nor is there any foundation for admission of this evidence, which has not been properly submitted in the form of an exhibit, as required under 37 C.F.R. § 42.63.

IV. CERTAIN PORTIONS OF EXHIBIT 1023 MUST BE EXCLUDED

During Dr. Medvidovic's deposition, PO timely and repeatedly objected to testimony being taken based on Exs.1018-20. *See e.g.*, Ex.1023, 81:3-15; 86:13-87:7; 147:19-148:9. PO moves to exclude testimony taken based on these Exhibits.

V. CONCLUSION

For the preceding reasons, the Board should exclude Exs.1017-20, 1026-27, certain paragraphs of Exs.1004 and 1025, and certain portions of Ex.1023.

Date: August 19, 2024

Respectfully submitted,

/Erick Robinson/

Erick Robinson, Esq. (Reg. No. 51,354)

Jayne Partridge (Reg. No. 39,011)

Patrick M. Dunn (Reg. No. 70,474)

Homayoon Rafatijo (Reg. No. 80,870)

BOCHNER PLLC

24 Greenway Plaza, Suite 1800

Houston, TX 77046

Tel: (646) 971-0685

Fax: (646) 343-9672

Marc Brockhaus (Reg. No. 40,923)

Douglas Sorocco (Reg. No. 43,145)

DUNLAP CODING

609 W. Sheridan Avenue

Oklahoma City, OK 73102

mbrockhaus@dunlapcoding.com

dsorocco@dunlapcoding.com

Tel: (405) 607-8610

Attorneys for Quantum Imaging LLC

CERTIFICATE OF SERVICE

I hereby certify that on August 19, 2024, I caused a true and correct copy of the foregoing Patent Owner's Motion to Exclude to be served via electronic mail to Sony-Quantum-IPR@mofo.com upon the following attorneys of record for the Petitioner:

Alex S. Yap (Reg. No. 60,609)
MORRISON & FOERSTER LLP
707 Wilshire Boulevard, Suite 6000
Los Angeles, CA 90017-3543
Tel: (213) 892-5200
Fax: (213) 892-5454
Email: AYap@mofo.com

Bryan Blumenkopf (Reg. No. 73,282)
MORRISON & FOERSTER LLP
707 Wilshire Boulevard, Suite 6000
Los Angeles, CA 90017-3543
Tel: (213) 892-5200
Fax: (213) 892-5454
Email: BBlumen@mofo.com

Mehran Arjomand (Reg. No. 48,231)
MORRISON & FOERSTER LLP
707 Wilshire Boulevard, Suite 6000
Los Angeles, CA 90017-3543
Tel: (213) 892-5200
Fax: (213) 892-5454
Email: MArjomand@mofo.com

Date: August 19, 2024

Respectfully submitted,

/Erick Robinson/

Erick Robinson, Esq. (Reg. No. 51,354)

BOCHNER PLLC

24 Greenway Plaza, Suite 1800

Houston, TX 77046

Tel: (646) 971-0685

Fax: (646) 343-9672

Attorneys for Quantum Imaging LLC