

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC., META PLATFORMS TECHNOLOGIES, LLC, and
TWISTED PIXEL GAMES, LLC,
Petitioner,

v.

EIGHT KHZ, LLC,
Patent Owner.

IPR2023-01019
Patent 10,368,179 B1

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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TABLE OF AUTHORITIES

Rules	Page(s)
Fed. R. Evid. 106	1, 3, 4, 5
Fed. R. Evid. 403	1, 3, 4, 5
Fed. R. Evid. 702	1, 5

EXHIBIT LIST

Ex.	Description
2001	Defendants' Preliminary Invalidity Contentions
2002	U.S. District Court Order in <i>Eight kHz, LLC v. Meta Platforms, Inc.</i> , No. 6:22-cv-00575-ADA-DTG (W.D. Tex. Jun. 3, 2022), Granting Motion to Extend Scheduling Order Deadlines
2003	Memorandum from Katherine K. Vidal on Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
2004	Lex Machina, Patent Cases (All Judges) Time to Trial, U.S. District Court for the Western District of Texas, September 9, 2023
2005	Lex Machina, Patent Cases (Judge Alan D. Albright) Time to Trial, U.S. District Court for the Western District of Texas, September 9, 2023
2006	Declaration of Dr. Durand R. Begault regarding U.S. Patent Nos. 10,368,179 and 10,448,184 (September 14, 2023) ("Begault")
2007	Curriculum Vitae (CV) of Dr. Durand R. Begault
2008	Defendant's Final Invalidity Contentions, Ex. E-10, October 18, 2023
2009	Defendant's Final Invalidity Contentions, Ex. D-10, October 18, 2023
2010	Defendant's Final Invalidity Contentions, October 18, 2023
2011	Defendant's Final Invalidity Contentions, Ex. F-09, October 18, 2023
2012	Declaration of Dr. Durand R. Begault regarding U.S. Patent Nos. 10,368,179 and 10,448,184 in support of Patent Owner's Response (April 2, 2024) ("Begault Supp.")
2013	Curriculum Vitae (CV) of Dr. Durand R. Begault (updated)
2014	Deposition transcript of Dr. Agnieszka Roginska, taken on February 27, 2024 ("Roginska Depo.")
2015	Excerpt from Merriam Webster's Dictionary, available at https://www.merriam-webster.com/dictionary/environment , accessed March 11, 2024

I. INTRODUCTION

Petitioner's Opposition (Paper 39) fails to sufficiently rebut Patent Owner's (PO's) arguments regarding its Motion to Exclude ("Motion," Paper 38).

Petitioner has not—and cannot—overcome PO's valid objections to Dr. Roginska's unsupported statements by mischaracterizing them as being made "under the guise of the Federal Rules of Evidence and 37 C.F.R. § 42.65(a)" to "circumvent sur-reply page limits." Opposition at 1. As shown in PO's Motion, statements in Dr. Roginska's Declarations (Ex. 1003; Ex. 1146) that PO seeks to exclude rely on cherry-picked portions of the prior art and cherry-picked portions of Dr. Begault's testimony. Thus, these statements fail to include all related parts "that in fairness ought to be considered at the same time" under FRE 106 and should thus be excluded under FRE 403. In addition, statements in Dr. Roginska's Declarations challenged in PO's Motion fail to provide sufficient underlying facts or data upon which the statements contained therein could legitimately be based, violating FRE 702, and are thus prejudicial and should be excluded under FRE 403.

In this Reply, PO addresses specific challenges raised by Petitioner in its Opposition regarding Dr. Roginska's testimony regarding Dr. Begault. On the remaining issues, while PO does not agree with Petitioner's arguments in its Opposition, PO considers these issues fully briefed and, to conserve judicial resources, refers the Board to PO's arguments in its Motion.

II. STATEMENTS BASED ON CHERRY-PICKED PORTIONS OF DR. BEGAULT'S TESTIMONY

Petitioner's attempts to excuse Dr. Roginska's cherry-picked portions of Dr. Begault's testimony fail, and thus these statements should be excluded as shown below.

Petitioner and Dr. Roginska resort to characterizing Dr. Begault's testimony as "contradictory," and improperly conclude that such statements undercut his credibility, but at his deposition, Dr. Begault explained that his definitions of "environment" are consistent when taken in context. In his deposition, Dr. Begault testified at length on this issue, even pointing out that Petitioner's counsel was transposing concepts:

Q: The word "environment," according to your construction, seems to refer to only the physical surroundings, and that seems to be what you're saying, even if the user's also in a virtual environment.

Is that correct?

A: No. You completely transposed the concepts.

The user, themselves, is in a physical environment because a user cannot be -- you know, when I say "user," I'm talking about a human being. So a physical person

that's perceiving either a virtual world or a real world, right? So, when we say the world "environment," and we're talking about the physical surroundings in which a user operates, that refers to the reality of the fact that humans are operating in some sort of real environment. They can't be -- only in the virtual world can we imagine them to be somewhere else, or can the user imagine themselves to be somewhere else. But, ultimately, there's a user in physical space. So you see a transposed concept.

Ex. 1147, 124:5-125:6 (internal objection omitted). Thus, paragraphs 17, 18, 23, 29, and 30 of Ex. 1146 should be excluded under FRE 403 because they fail to include all related parts “that in fairness ought to be considered at the same time” under FRE 106.

In addition, Petitioner admits that Dr. Roginska misquoted Dr. Begault’s testimony in paragraph 52 of Ex. 1146: “Although Dr. Begault asserts that [***sic*—neither**] Sauk alone or ‘in combination with Osman and Clement disclose a method’ ..., he does not address the disclosures and arguments from my first declaration.” Ex. 1146 ¶ 52 (citing Ex. 2012 ¶¶ 100-102).” Opposition at 4-5 (emphasis added). Petitioner does not provide any justification for this error, which is prejudicial, and thus paragraph 52 should be excluded under FRE 403.

Regarding paragraph 68, Petitioner's assertion that "of the 16 paragraphs of his declaration PO cites, none map passages of Tables I and II as providing support from the claims" is belied by Dr. Begault's declaration. *See, e.g.*, Ex. 2012, ¶30 (under heading "The '179 and '184 Patents Disclose Transitions Between Different Types of Environments", stating "[t]he types of environmental transitions addressed in the specification sections of the '179 and '184 Patents include both a transition in the physical environment of the user (either caused by movement of the user, or a change in the circumstances or conditions of things within the physical environment of the user) as well as transitions in the 3D virtual environment heard and seen by the user."); *see also id.*, ¶¶48-62. Thus, paragraph 68 should be excluded under FRE 403 because it fails to include all related parts "that in fairness ought to be considered at the same time" under FRE 106.

Regarding paragraph 77, Petitioner's attempts to explain Dr. Roginska's assertion that Dr. Begault testified an alert "cannot be inherent" fail. Dr. Begault never testified that the disclosure of an alert cannot be inherent. Dr. Begault testified that "[i]n the ways that are described in my declaration, I believe that those would be effective alerts of changes to binaural sound." Ex. 1147, 87:12-14. Thus, Dr. Roginska's statement implying that Dr. Begault testified that the disclosure "cannot be inherent" clearly mischaracterizes Dr. Begault's testimony and should be

excluded under FRE 403 because it fails to include all related parts “that in fairness ought to be considered at the same time” under FRE 106.

Finally, regarding paragraph 99, contrary to Petitioner’s assertion, Pedrotti and Donner (Ex. 1180 and Ex. 1150) are not relied upon in the Grounds of the Petition. *See* Paper 2 (listing Grounds, which do not include Pedrotti or Donner). Dr. Roginska’s statement that “[i]ndeed, POSAs knew before the time of the alleged inventions that HMDs could independently determine position and orientation information and when a user is leaving an environment using cameras, light-emitting trackers, inertial sensors ... and any type of tracker ...” citing Pedrotti and Donner is baseless because both Pedrotti and Donner rely on external components to determine the position and orientation of the headset, as established in PO’s Motion. Motion at 14. Dr. Roginska does not provide any other evidence to support her statement and thus, it should be excluded under FRE 702 and 403.

III. CONCLUSION

For the reasons stated in PO’s Motion and this Reply, the challenged evidence—paragraphs 30, 111-15, 175, 183, 251, 267, 312, and 313 of Exhibit 1003 and paragraphs 17, 18, 23, 29, 30, 36-39, 41, 47, 52, 68, 77, 81, 85, 99, 100, and 107 of Exhibit 1146—does not meet the threshold for admissibility and should be excluded from the record.

Date: August 28, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §42.6(e), the undersigned hereby certifies that the above-captioned Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Exclude was served via electronic mail, as authorized by Petitioner's Mandatory Notices, on August 28, 2024 at the following email correspondence addresses of record:

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