

Filed: December 18, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK INC. and NXP USA, Inc.
Petitioners,

v.

Bell Northern Research, LLC,
Patent Owner.

IPR2023-01414
U.S. Patent 8,416,862
Filing Date: September 28, 2005
Issue Date: April 9, 2013

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ARGUMENT	1
A. Petitioner’s Introduction of the Challenged Exhibits Is Proper and Does Not Violate 37 C.F.R 42.123(b).....	1
B. EX1025 - IEEE 802.11-2016 (excerpts)	4
1. EX1025 is relevant under FRE 401 and 402	4
2. EX1025 is not hearsay or falls under an exception to hearsay under FRE 801 and 802 fail	5
3. EX1025 is authentic and admissible under FRE 901 and 902.....	6
C. EX1026, EX1027, EX1028, and EX1029 – IEEE Exhibits	8
1. The IEEE exhibits are relevant under FRE 401 and 402	8
2. The IEEE exhibits are not hearsay or falls under an exception to hearsay under FRE 801 and 802 fail	8
3. The IEEE exhibits are authentic and admissible under FRE 901	10
D. EX1030 - Supplemental Declaration of Dr. Jonathan Wells	12
E. EX1031 - Deposition of Dr. Cooklev in 337-TA-1367	12
III. CONCLUSION.....	13

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Anacor Pharms., Inc. v. Iancu</i> , 889 F.3d 1372 (Fed. Cir. 2018)	1, 2, 3
<i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359 (Fed. Cir. 2015)	2
<i>Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.</i> , 825 F.3d 1360 (Fed. Cir. 2016)	2
<i>United States v. Turner</i> , 718 F.3d 226 (3d Cir. 2013)	7
Other Authorities	
37 C.F.R 42.123(b)	1
37 C.F.R. § 42.123(b)	1
FRE 401 and 402.....	1, 8
FRE 801	5, 8
FRE 801 through 807	1
FRE 802	5, 8
FRE 803(17).....	5, 9
FRE 807	6, 9
FRE 901	1, 7
FRE 902	1, 6, 10
Rule 401	4
Rule 402	4
Rule 901	<i>passim</i>

EXHIBITS CITED WITHIN

EX1004	U.S. Pat. No. 7,236,748 to Li et al. ("Li-748")
EX1005	U.S. Pub. No. 2008/0108310 to Tong et al. ("Tong")
EX1007	U.S. Pub. No. 2006/0092054 to Li et al. ("Li-054")
EX1009	U.S. Pat. No. 7,710,925 to Poon ("Poon")
EX1024	Deposition Transcript of Todor Cooklev Ph.D.
EX1025	IEEE 802.11-2016 (excerpts)
EX1026	IEEE Standard 802.11, 1999 Ed. (R2003) (excerpts)
EX1027	IEEE Standard 802.11a-1999 supplement to 802.11-1999 (excerpts)
EX1028	Singh, et al., Wwise Proposal: High throughput extension to the 802.11 Standard (2004)
EX1029	Mujtaba, et al., TGn Sync Proposal Technical Specification (2005)
EX1030	Supplemental Declaration of Dr. Jonathan Wells
EX1031	Public Transcript of February 9, 2024 Deposition of Dr. Todor Cooklev in ITC proceeding 337-TA-1367
EX2001	Declaration of Todor Cooklev, Ph.D.
EX2003	Excerpts from IEEE 802.11-2016 standard

I. INTRODUCTION

Petitioner opposes Patent Owner's Motion to Exclude (Paper 32) exhibits EX1025-EX1031 (the "challenged exhibits"), filed on December 11, 2024.

Petitioner files this opposition pursuant to the Board's scheduling order (Paper 12), filed on April 2, 2024. Petitioner's motion misunderstands 37 C.F.R 42.123(b) and ignores Federal Circuit case law allowing and encouraging responsive information to be provided with a Reply. None of Patent Owner's evidentiary objections are valid because the challenged exhibits are relevant under FRE 401 and 402, not hearsay or fall under a hearsay exception under FRE 801 through 807, and are authenticated under FRE 901 and 902.

II. ARGUMENT

A. Petitioner's Introduction of the Challenged Exhibits Is Proper and Does Not Violate 37 C.F.R 42.123(b)

37 C.F.R. § 42.123(b) does not, as Patent Owner argues, prohibit evidence and arguments made by Petitioner in response to Patent Owner's Response. "There is [] no blanket prohibition against the introduction of new evidence during an inter partes review proceeding." *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380 (Fed. Cir. 2018). Rather, "the introduction of new evidence in the course of the trial is to be expected in inter partes review trial proceedings and, as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible under the APA." *Id.*

(quoting *Genzyme Therapeutic Prods. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016)). A “petitioner in an inter partes review proceeding may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner, or if it is used to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.” *Id.* (quotations omitted) (Citing *Genzyme*, 825 F.3d at 1369 (quoting *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015))).

Like in *Anacor*, Petitioner introduced the challenged exhibits for legitimate purposes and with sufficient notice to Patent Owner. The exhibits were offered in response to arguments made in Patent Owner's Response regarding either claim construction (EX1030 and EX1031) or secondary considerations (EX1025-1030), including to demonstrate the knowledge of one of skill in the art related to these two issues. Dr. Cooklev explained that “[i]ndustry standards—such as the 802.11 standards—often reflect the accepted practices and solutions to common problems within a particular field” that would be known to one of ordinary skill. EX2001 at ¶¶ 26, 146. Despite this, Dr. Cooklev admitted he did not consider the contents of these prior standards in his analysis (EX1024, 35:1-5, 38:1-9, 41:2-14, 45:10-16, 47:18-48:1) and later testified that one of ordinary skill in the art would not have

been aware of them. *See* EX1024, 34:9-20. Thus, these exhibits are directly responsive to the credibility of Dr. Cooklev's testimony.

Patent Owner had ample time and opportunity to understand and respond to Petitioner's use of these documents. EX1025 includes identical cover pages and content as those produced in Patent Owner's EX2003 (*Compare* EX1025 at 1, 121, 122, 123 to EX2003 at 2, 2542, 2548, and 2580, respectively). EX1025 also provides additional relevant material from the same document that was omitted from Patent Owner's excerpts. Patent Owner's expert was cross-examined regarding EX1026-1029, and Petitioner's Reply discussed the challenged exhibits and Dr. Cooklev's responses. *See* Paper 27 (Reply) at 23. Patent Owner chose not to depose Dr. Wells regarding his supplemental declaration (EX1030) or any other challenged exhibit. Patent Owner then filed its Sur-Reply discussing the challenged exhibits and Petitioner's arguments at length. *See* Paper 29 (PO Sur-Reply) at 12-14, 14-18.

Like in *Anacor*, the challenged exhibits come as no surprise to Patent Owner. *See Anacor*, 889 F.3d at 1381 (finding no surprise where exhibits were "introduced by the petitioner during the deposition of [Patent Owner's] experts and [were] then referred to in the petitioner's reply" and were "offered in direct response to [arguments made by Patent Owner and their expert]"). Nor has Patent Owner claimed as much.

B. EX1025 - IEEE 802.11-2016 (excerpts)

1. EX1025 is relevant under FRE 401 and 402

Patent Owner's relevancy objections focus solely on whether the document "was publicly available . . . prior to the critical date." Motion to Exclude at 2. But whether EX1025 predates the '862 patent has no bearing on its relevancy in this matter because Petitioner does not rely on EX1025 as invalidating prior art. Petitioner cited to EX1025 when discussing the level of ordinary skill in the art pertinent to the issues of claim construction and secondary considerations.

EX1025 is also relevant to evaluating the credibility of Dr. Cooklev's testimony. Dr. Cooklev asserted that the '862 patent is "highly relevant to the 802.11ac" standard because it "adopted estimating a channel response based upon a received preamble sequence." EX2001 at ¶ 147. Patent Owner also acknowledged that the 802.11 standard is an industry standard maintained by the IEEE and describes the practices and solutions known to those in the field at the time. Paper 24 (POR) at 56. Dr. Cooklev agreed that determining the Level of Ordinary Skill in the Art includes considering factors such as "the type of problems encountered in the art [and] the prior solutions to those problems found in the prior art references." EX2001 at ¶ 26. And the prior art references within the Petition identify the IEEE 802.11 standards as background knowledge. *See* EX1030 at ¶ 38; EX1004, 1:61-2:5, EX1007, [0112], EX1009, 1:63-2:4, EX1005, [0186]. Thus, the

IEEE standards, including EX1025, are essential to understanding the scope of knowledge that skilled artisans would bring to bear in understanding the '862 patent and related issues.

2. EX1025 is not hearsay or falls under an exception to hearsay under FRE 801 and 802 fail

EX1025 is not offered for the truth of the matter, but rather to demonstrate the credibility of Dr. Cooklev's testimony by providing a more complete record of the 802.11-2016 standard on which he and Patent Owner rely. *See* EX2003 and EX1025.

EX1025 is admissible under the exception provided by FRE 803(17), which provides that items such as "lists, directories, or other compilations that are generally relied on by the public or by persons in particular occupations" are not excluded by the rule against hearsay. Fed. R. Evid. 803(17). In similar matters, other Boards have found that the information published within an IEEE document "falls under an exception to the hearsay rule as lists, etc., generally relied on by the public or by persons in particular occupations [under] Fed. R. Evid. 803(17)." IPR2014-00527, Paper 41 at 11. The "IEEE is a well-known, reputable compiler and publisher of scientific and technical publications, and . . . members in the scientific and technical communities who both publish and engage in research rely on the information" these documents contain. *Id.*

EX1025 is also admissible under FRE 807's "residual exception." The document's numerous references to the IEEE, its 802.11 Working Group, and other verifiable and public information regarding the standard provide sufficient guarantees of trustworthiness after considering the totality of the circumstances. Further, EX1025 is more probative at least regarding the issue of whether Patent Owner and its expert are correctly characterizing the teachings of the standard than any other evidence Petitioner could have obtained via reasonable efforts.

3. EX1025 is authentic and admissible under FRE 901 and 902

EX1025 is self-authenticating under FRE 902(b) and/or authenticated under at least 901(b)(4).

FRE 902(b) provides that a document bearing an "inscription, sign, tag, or label purporting to have been affixed in the course of business and indicating origin, ownership, or control," is self-authenticating and admissible. Here, EX1025 bears the IEEE trademark as well as other trappings and notations indicating the IEEE as the origin and controller of this document. *See* EX1025 at 1. The document also identifies its ownership of the copyrights and trademarks within the document and provides legal disclaimers and notices applicable to its distribution. *See id.* at 3-4. For at least these reasons, EX1025 is a self-authenticating document and is admissible.

EX 1025 is authenticated under Rule 901(b)(4). The standard for admissibility under FRE 901(a) is “slight,” which is clearly met by the contents of the exhibit and further supported by circumstantial evidence. *See United States v. Turner*, 718 F.3d 226, 232 (3d Cir. 2013) (“The standard for authenticating evidence is ‘slight,’”). Patent Owner does not identify anything within the document that brings its authenticity into question. Nor does Patent Owner dispute the origination, control, or public availability of the document. Patent Owner's complaint rests on the fact that the exhibit comprises excerpts of the underlying documents, rendering it “not reliable” and incapable of authentication. Patent Owner cites no rule or case law that supports such a blanket prohibition. Nor would it, since Patent Owner also submitted a strikingly similar exhibit comprising only excerpts and without any external authenticating evidence. *See* EX2003.

Authentication may be established by distinctive characteristics and the like, such as the documents' “appearance, contents, substance, internal patterns, or other distinctive characteristics of the item, taken together with all the circumstances.” FRE 901(b)(4). EX1025 bears the IEEE logo, copyright, and ISBN numbers. EX1025, 1, 3; *see also id.* 3-123 (footer reading “Copyright © 2016 IEEE. All rights reserved”). The second page identifies the document as “[p]repared by the 802.11 Working Group” and approved by the IEEE Standards Board. *Id.* at 2. Pages 4 through 6 lists a variety of disclaimers and notices from the IEEE. *Id.* at 4-

6. Pages 7-10 list members of the 802.11 Working Group. Pages 14 through 75 provide a table of contents for the over 2,500-page document. Thus, EX1025 is authenticated under FRE 901(b)(4) based on the totality of the circumstances.

C. EX1026, EX1027, EX1028, and EX1029 – IEEE Exhibits

1. The IEEE exhibits are relevant under FRE 401 and 402

Patent Owner's objection incorrectly asserts that each of EX1026, EX1027, EX1028, and EX1029 ("the IEEE exhibits") "has not been asserted . . . to establish the knowledge of a POSITA." Motion to Exclude at 4, 7, 9, 11-12. Petitioner's Reply cites to the IEEE exhibits to challenge the credibility of Dr. Cooklev's opinions regarding secondary considerations by showing that he failed to consider the previous 802.11 standards that would inform the scope of knowledge of a person of ordinary skill. Paper 27 (Reply) at 23; *see also* EX1030, ¶ 76-79. The IEEE exhibits provide additional relevant information regarding the credibility of Dr. Cooklev's assertions that the 802.11ac standard was the first standard to introduce certain functionality, such as using a preamble sequence to send data.

2. The IEEE exhibits are not hearsay or falls under an exception to hearsay under FRE 801 and 802 fail

The IEEE Exhibits are not offered for the truth of the matter, but rather to demonstrate the credibility of Dr. Cooklev's testimony, including whether he analyzed the documents Patent Owner contends are relevant to understanding the scope of secondary considerations. Dr. Cooklev simultaneously argues that these

documents inform the knowledge of one of ordinary skill at the time while denying that a person of ordinary skill would have been aware of the same documents. *See* Paper 24 (POR) at 56 (explaining that the 802.11 standard describes the practices and solutions known to those in the field at the time); EX2001 at ¶ 26 (explaining that one of skill would understand existing problems and known solutions); *but see* EX1024, 34:9-20 (claiming that a person of ordinary skill would not be familiar with the prior standards). These documents are offered to show that the information contained within them was available and known to a person of ordinary skill.

The IEEE exhibits are admissible under the exception provided by FRE 803(17) at least because the IEEE is a known and reputable publisher of materials relied on by persons in the field. *See* IPR20214-00527, Paper 41 at 11; *see supra*, B.2. The IEEE exhibits bear headers, footers, notices, and other information and trappings identifying the documents as originating from and controlled by the IEEE, as discussed in detail below regarding authentication. *See infra*, Section C.3.

The IEEE exhibits are also admissible under FRE 807's "residual exception" at least because the documents' numerous references to the IEEE, its 802.11 Working Group, and other independently verifiable and public information regarding the standard provide sufficient guarantees of trustworthiness after considering the totality of the circumstances. Further, the IEEE exhibits are more

probative at least regarding the issue of whether Patent Owner and its expert are correctly characterizing the teachings of the 802.11 standards and the knowledge and information available to one of ordinary skill in the art than any other evidence Petitioner could have obtained via reasonable efforts.

3. The IEEE exhibits are authentic and admissible under FRE 901

The IEEE exhibits are self-authenticating under FRE 902(b). EX1026 bears headers, footers, notices, disclaimers, and other notations indicating the IEEE as the origin and controller of this document. *See generally* EX1026. For at least these reasons, EX1026 is a self-authenticating document and is admissible.

The IEEE exhibits are authenticated under at least 901(b)(4). Patent Owner's objections rest on the fact that the IEEE exhibits comprise excerpts of the underlying document. But Patent Owner does not identify any rule excluding the introduction of excerpts of a document, particularly when the excerpts themselves may be authenticated and provide the relevant information. Nor would it, since Patent Owner also produced excerpts of documents without any additional authenticating information. *See* EX2003 ("Excerpts from IEEE 802.11-2016 standard")

A document's authenticity may be established by distinctive characteristics and the like, taken together with all the circumstances. FRE 901(b)(4). Here, each

of the IEEE exhibits bears numerous distinct characteristics that, when considered in their totality, demonstrate the item is what it is claimed to be.

Exhibit 1026 bears a copyright notation and reservation of rights in a footer. EX1026 at 2-90 ("Copyright © 1999 IEEE. All rights reserved"). The second page identifies a variety of disclaimers and notices from the IEEE. *Id.* at 2. Pages 5-8 list members of the 802.11 Working Group. Pages 9 thru 14 provide a table of contents for the over 500-page document.

Exhibit 1027 bears a copyright notation and reservation of rights in a footer. EX1027 1, 3-53 ("Copyright © 1999 IEEE. All rights reserved"). The second page identifies a variety of disclaimers and notices from the IEEE. *Id.* at 2. Pages 6-7 list members of the 802.11 Working Group. Page 8 provides a table of contents for the over 50-page document.

Exhibit 1028 bears a header indicating it as an IEEE document. EX1028 at 1 ("IEEE 11-04-0886-00-000n"). Page 2 lists contributing members to the proposal. Pages 3 thru 9 provide a table of contents for the over 60-page document.

Exhibit 1029 bears a header indicating it as an IEEE document. EX1029 at 1 ("IEEE 802.11-04/0889r3"). Page 2 lists contributing members to the proposal. Pages 5 thru 7 provide a table of contents for the over 130-page document.

Thus, the IEEE exhibits are authenticated under FRE 901(b)(4) based on the totality of the circumstances.

D. EX1030 - Supplemental Declaration of Dr. Jonathan Wells

Patent Owner objects to the caption on Dr. Well's supplemental declaration but ignores the substance of its contents. EX1030 provides testimony responsive to the issues and arguments raised in Patent Owner's Response as well as the declaration and deposition testimony of Dr. Cooklev. Patent Owner has not identified any opinions or statements within EX1030 that are not responsive to Patent Owner's Response.

EX1030 does not incorporate inadmissible hearsay at least because EX1026-1029 are not hearsay and/or fall under an exception to the hearsay exclusion, as discussed above. *See supra* Section C.2. Specifically, Dr. Cooklev refers to the IEEE exhibits to demonstrate the knowledge and information that was publicly available to one of ordinary skill in the art at the time when considering the issue of secondary considerations and whether the alleged commercial success may be attributed to the '862 patent versus solutions that were already known.

E. EX1031 - Deposition of Dr. Cooklev in 337-TA-1367

Petitioner incorrectly states that "Petitioner has not relied on [EX1031] for any fact that is of consequence in determining this action." Motion to Exclude at 15. Dr. Cooklev has advanced a proposed claim construction in this proceeding that deviates from his prior statements. Paper 27 (Reply) at 6-7. The testimony given by Dr. Cooklev in EX1031 is directed to the same patent and claim term at

issue in this proceeding and contradicts the construction he now asserts.

Determining claim construction, including comparing contradictory statements by Patent Owner's expert, "is of consequence in determining this action." Further, assessing the credibility (and consistency) of Dr. Cooklev's claim construction opinions has direct implications on this case and others, particularly when different constructions are offered in different venues depending on whether he is addressing the issue of infringement or validity.

III. CONCLUSION

Accordingly, for the reasons provided above, all of the challenged exhibits are both authenticated and admissible and Patent Owner's Motion should be denied.

Date: December 18, 2024

Respectfully submitted,

/s/ Brian Erickson
Reg. No. 48,895
DLA Piper LLP (US)
303 Colorado Street, Suite 3000
Austin, Texas 78701-4653
Phone: + 1 512 457 7000
Fax: + 1 512 721 2263
Brian.erickson@us.dlapiper.com

Attorney for Petitioner, NXP USA Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE EVIDENCE** was served on December 18, 2024, via email, to counsel
of record for Patent Owner at the following:

Jason M. Shapiro
Timothy Devlin
Devlin Law Firm LLC
1526 Gilpine Ave.
Wilmington, DE 19806
jshashipro@devlinlawfirm.com
tdevlin@devlinlawfirm.com
BNR-MEDIATEK-IPR@devlinlawfirm.com

Date: December 18, 2024

/s/ Brian Erickson
Brian Erickson
Reg. No. 48,895
DLA Piper LLP (US)
303 Colorado Street, Suite 3000
Austin, TX 78701
Phone: 512-457-7059
Fax: 512-721-2263
Brian.Erickson@us.dlapiper.com

Counsel for Petitioner NXP USA, Inc.