

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HESAI TECHNOLOGY CO. LTD.,
Petitioner

v.

OUSTER, INC.
Patent Owner

Case No. IPR2023-01456
Patent No. 11,178,381

**PATENT OWNER'S OBJECTIONS TO EVIDENCE
FILED WITH THE PETITION**

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner Ouster, Inc. (“Patent Owner”) hereby objects to Petitioner’s Hesai Technology Co. Ltd. (“Petitioner”) exhibits submitted with Petition for *Inter Partes* Review (Paper 2) as indicated below, as well as any reference thereto or reliance thereon, without limitation.

Exhibit Number and Description	Objections
Ex. 1003 - Declaration of Dr. James F. Shanley	<p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 702/703 (Unreliable expert testimony): The exhibit contains statements and opinions that are not admissible under FRE 702 or 703. For example, the exhibit fails to identify facts or data supporting the witness’s conclusory testimony, and that testimony thus is not based on sufficient facts or data. Further, the testimony is not the product of reliable principles and methods, and the witness fails to reliably apply the principles and methods of the facts of the case.</p> <p>The exhibit contains opinions for which the factual bases have not been disclosed, including numerous broad and/or conclusory statements made without analysis or sufficient citation to evidence or explanation. <i>See also</i> Consolidated Trial Practice Guide, November 2019, at 36 (“Expert testimony, however, cannot take the place of a disclosure in a prior art reference,</p>

	<p>when that disclosure is required as part of the unpatentability analysis.”).</p> <p>The exhibit fails to reliably apply the correct legal standard to the facts of the case. For example, the witness fails to explain the differences between the claims and the prior art. <i>Graham v. John Deere Co.</i>, 383 U.S. 1, 17-18 (1966) (requiring that the obviousness analysis consider “differences between the claimed subject matter and the prior art.”).</p> <p>The exhibit may contain statements that are not Dr. Shanley’s opinion, as large portions of the declaration are nearly identical to the Petition itself.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p> <p>37 CFR § 42.6(a)(3): The declaration is excessively long and thereby attempts to circumvent the rule against incorporation by reference by providing analysis beyond the scope of the Petition. Further, numerous portions of the declaration are improperly incorporated by reference into the petition, e.g., Petition at 19, 32, 37, 39, 43-47, 49, 50, 52, 53, 56-59, 69, 75, 78, 80 <i>passim</i> (improperly incorporating ranges of paragraphs from Ex. 1003).</p>
<p>Ex. 1013 - U.S. Patent App. Pub. No. 2014/0211194 (“Pacala”)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice,</p>

	<p>confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.</p> <p>35 USC § 312; 37 CFR § 42.104: The exhibit is both relied on by the Petition (at 26) as disclosing limitations of claim 1 for Ground 1A but also not relied upon as a part of that Ground. Petitioner’s use of the exhibit in this manner violates 35 U.S. Code § 312(a)(3) since it ensures Ground 1A is not set forth with the required particularity and multiplies the proceedings. <i>See also</i> 37 CFR § 42.104 (requiring “a statement of the precise relief requested for each claim challenged” including “the patents or printed publications relied upon for each ground. . . . The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon. . . . The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
<p>Ex. 1014 - Lee <i>et al.</i>, “Accuracy-Power Controllable LiDAR Sensor System with 3D Object Recognition for Autonomous Vehicle,” in <i>Sensors</i>, Vol. 20, Iss. 19 (Oct. 2020)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p>

	<p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p>
<p>Ex. 1019 - Marino <i>et al.</i>, <i>A compact 3D imaging laser radar system using Geiger-mode APD arrays: system and measurements</i>, MIT Lincoln Lab (2003)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p> <p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p>
<p>Ex. 1023 - Matsubara <i>et al.</i>, <i>Development of Next Generation LiDAR</i>, R&D Review of Toyota CRDL (2012)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p>

	<p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p>
<p>Ex. 1024 - U.S. Patent No. 7,969,558 (“Hall”)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
<p>Ex. 1025 - U.S. Patent No. 10,199,801 (“Li”)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>35 USC § 312; 37 CFR § 42.104: The exhibit is both relied on by the Petition (at 75) as disclosing limitations of claim 13 for Ground</p>

	<p>2A but also not relied upon as a part of that Ground. Petitioner’s use of the exhibit in this manner violates 35 U.S. Code § 312(a)(3) since it ensures Ground 2A is not set forth with the required particularity and multiplies the proceedings. <i>See also</i> 37 CFR § 42.104 (requiring “a statement of the precise relief requested for each claim challenged” including “the patents or printed publications relied upon for each ground. . . . The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon. . . . The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
<p>Ex. 1026 - Joint Claim Construction Chart from ITC Inv. No. 337-TA-1363</p>	<p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
<p>Ex. 1030 - German Pat No. DE 10 2004 014 041 B4 (“Spies-041”)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p>

	<p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
<p>Ex. 1031 - Certified English Translation of DE 10 2004 014 041 B4 (“Spies-041”)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>35 USC § 312; 37 CFR § 42.104: The exhibit is both relied on by the Petition (at 26) as disclosing limitations of claim 1 for Ground 1A but also not relied upon as a part of that Ground. Petitioner’s use of the exhibit in this manner violates 35 U.S. Code § 312(a)(3) since it ensures Ground 1A is not set forth with the required particularity and multiplies the proceedings. <i>See also</i> 37 CFR § 42.104 (requiring “a statement of the precise relief requested for each claim challenged” including “the patents or printed publications relied upon for each ground. . . . The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon. . . . The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific</p>

	portions of the evidence that support the challenge.”).
Ex. 1032 - German Pat. No. DE 101 53 977 B4 (“Spies-977”)	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
Ex. 1033 - Certified English Translation of DE 101 53 977 B4 (“Spies- 977”)	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>35 USC § 312; 37 CFR § 42.104: The exhibit is both relied on by the Petition (at 26) as disclosing limitations of claim 1 for Ground 1A but also not relied upon as a part of that</p>

	<p>Ground. Petitioner’s use of the exhibit in this manner violates 35 U.S. Code § 312(a)(3) since it ensures Ground 1A is not set forth with the required particularity and multiplies the proceedings. <i>See also</i> 37 CFR § 42.104 (requiring “a statement of the precise relief requested for each claim challenged” including “the patents or printed publications relied upon for each ground. . . . The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon. . . . The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
<p>Ex. 1034 - Donati, Silvano, Photodetectors: Devices, Circuits and Applications, Chapter 6, 2d Ed., The Institute of Electrical and Electronics Engineers, Inc. (2021, John Wiley & Sons, Inc.)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p> <p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p> <p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no</p>

	weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).
Ex. 1035 - <i>Performance Analysis of Next-Generation LADAR for Manufacturing, Construction, and Mobility</i> , National Institute of Standards and Technology (2004)	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p> <p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p> <p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
Ex. 1036 - U.S. Patent No. 8,742,325 (“Droz”)	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose probative value to any ground upon which trial was instituted is substantially</p>

	<p>outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.</p> <p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>
<p>Ex. 1037 - <i>Report to Congress: DARPA Prize Authority</i> (2006)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p> <p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p>
<p>Ex. 1038 - Hall et al., <i>Team DAD Technical Paper</i>, DARPA Grand Challenge (2005)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose probative value to any ground upon which trial was instituted is substantially</p>

	<p>outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p> <p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p>
<p>Ex. 1039 - McManamon, <i>Field Guide to LiDAR</i>, SPIE Field Guides, Vol. FG36 (2015)</p>	<p>FRE 402: The exhibit includes information that is not relevant to any ground upon which trial was instituted.</p> <p>FRE 403: The exhibit includes information whose 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.</p> <p>FRE 802: The exhibit and statements included therein are inadmissible hearsay.</p> <p>FRE 901: Petitioner has not produced evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.</p> <p>35 USC § 312; 37 CFR § 42.104: Petitioner does not cite this reference or otherwise explain its relevance in the Petition. <i>See also</i> 37 CFR § 42.104 (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).</p>

Dated: April 15, 2024

Respectfully submitted,

COOLEY LLP
ATTN: Patent Group
1299 Pennsylvania Avenue NW
Suite 700
Washington, DC 20004
Tel: (202) 728-7055
Fax: (202) 842-7899

/Phillip Morton/
Phillip Morton
Reg. No. 57,835
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PATENT OWNER'S OBJECTIONS TO EVIDENCE FILED WITH THE PETITION** are being served via electronic mail the 15th day of April 2024, on Petitioner by serving the Petitioner's counsel of record in this proceeding as follows:

Michael T. Hawkins
Craig A. Deutsch
Yao Wang
FISH & RICHARDSON PC
IPR56432-0093IP2@fr.com
PTABInbound@fr.com

DATED: April 15, 2024

/Phillip Morton/

Phillip Morton
Reg. No. 57,835