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On behalf of **VIZIO, Inc.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner

v.

POLARIS POWERLED TECHNOLOGIES, LLC
Patent Owner

IPR2024-00073
Patent No. 7,843,148

PETITIONER'S MOTION TO STRIKE

Pursuant to 37 C.F.R. §§ 42.20, 42.23(b), and the Board’s authorization in the Board’s October 28, 2024 email, Petitioner VIZIO, Inc. hereby moves to strike (1) an exhibit introduced during the October 7, 2024 deposition of Petitioner’s expert Dr. Zane and attached to the transcript (EX2011) and (2) two sentences in Patent Owner’s Sur-Reply that present a new merits argument about that new exhibit.

I. DEPOSITION EXHIBIT 1 IS IMPERMISSIBLE

The Board’s rules provide that “[a] sur-reply may only respond to arguments raised in the corresponding reply and 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). That rule “provides a blanket prohibition on a patentee filing exhibits with a sur-reply.” *Netflix, Inc. v. DivX, LLC*, IPR2020-00511, Paper 46 at 54 (PTAB Aug. 13, 2021) (“*Netflix*”). Patent Owner attempted to circumvent that blanket prohibition by introducing a dictionary excerpt for the word “strobe” during the deposition of Petitioner’s expert Dr. Zane and then attaching that excerpt to the transcript as “Deposition Exhibit 1.” EX2011, 76-79 (“Deposition Exhibit 1”), 29:10-30:9 (introducing Deposition Exhibit 1). In *Netflix*, the Board rejected a similar attempt by a patentee to circumvent the prohibition on new sur-reply evidence. *Netflix* at 52-56 (excluding exhibits introduced during deposition of reply witness as violating Rule 42.23(b)).

During the parties' meet-and-confer, Patent Owner cited *Ascend Performance Materials v. Samsung* to contend that the Board permits exhibits in a deposition transcript submitted with a sur-reply so that the Board has the full context available for evaluating the witness's testimony. But in *Ascend*, the Board permitted deposition exhibits that were introduced "for the purposes of testing the witness' testimony" and considered them *only* for the purpose of evaluating that testimony, "*not as evidence supporting the party's arguments on the merits.*" *Ascend Performance Materials Operations LLC v. Samsung SDI Co., LTD.*, IPR2020-00349, Paper 53 at 12 (PTAB July 15, 2021) ("*Ascend*") (emphasis added). The Board did not agree that "*any* exhibit made of record during a deposition may be submitted with a sur-reply, because such a rule would give parties the incentive to raise completely new evidence during a deposition, and then introduce that evidence into the record with a sur-reply, depriving the opposing party the opportunity to fully address that evidence." *Id.* (emphasis in original). That is what happened here.

Patent Owner did not introduce Deposition Exhibit 1 to test Dr. Zane's testimony. The term "strobe signal" never appeared in any of the parties' papers or expert declarations before Dr. Zane's deposition. During deposition, Patent Owner questioned Dr. Zane whether he had heard of a "strobe signal." EX2011, 27:14-28:12. Dr. Zane repeatedly testified that he did not recall that term. *Id.* After Dr. Zane testified he did not recall the term, Patent Owner introduced a dictionary

excerpt as Deposition Exhibit 1 and read its contents into the record. *Id.*, 28:14-33:9.

Dr. Zane repeatedly testified again that he did not recall hearing the term “strobe” as used in the context described in the dictionary. *Id.*

Deposition Exhibit 1 provides no context for Dr. Zane’s testimony because he repeatedly testified that he did not recall the term “strobe signal.” *Netflix* at 55 (“We disagree that the exhibits provide context for [the expert’s] deposition testimony because [the expert] repeatedly testified that he had not seen the exhibits.”).

After reading Deposition Exhibit 1 into the record, Patent Owner then relied on this exhibit in its sur-reply to present a new merits argument that a shift signal does not necessarily have to be a clock signal because it could be a “strobe signal.” Sur-Reply, 16 (citing EX2011, 27:14-33:9). Petitioner has no opportunity to rebut. Thus, striking Deposition Exhibit 1 is appropriate just as the Board excluded similar deposition exhibits in *Netflix*.¹

II. THE SUR-REPLY PRESENTED A NEW “STROBE” ARGUMENT

Petitioner also moves to strike two sentences on page 16 of the Sur-Reply that presented the new “strobe signal” argument. Specifically, Patent Owner argued on page 16, lines 4-7:

¹ *Netflix* involved a motion to exclude, but the proper procedural vehicle would have been a motion to strike. *See Ascend* at 12; Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), 80-81.

“But a ‘shift signal’ does not necessarily have to be a clock signal from a connected clock. *Id.*, 17:13-20:12 (testifying it depends on ‘context’), 27:14-33:9 (strobe signal). That a shift or strobe or clock signal can be used means that a clock is not inherent.”

Sur-Reply, 16. That is precisely the type of new argument that Rule 42.23(b) was intended to prohibit. Dr. Zane never testified that a strobe signal could be a shift signal. The only purported support for Patent Owner’s new argument is the dictionary definition that its counsel read into the deposition transcript.

Patent Owner has been aware since the outset of this proceeding of Petitioner’s assertion that a clock was inherent in Thomas’s shift register. Pet., 34-35. Patent Owner could have presented its “strobe signal” argument in its Patent Owner Response, but did not. Because Patent Owner’s “strobe signal” argument “clearly relies on a new theory not included in prior briefing” and Petitioner has no further opportunity to respond, “striking the portion of the brief containing that theory may be appropriate.” CTPG, 81.

III. CONCLUSION

Petitioner respectfully requests that the Board strike:

1. Pages 76-79 of Exhibit 2011 (Deposition Exhibit 1); and
2. Page 16, lines 4-7 of the Sur-Reply.

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VIZIO, Inc. v. Polaris PowerLED Technologies, LLC

Dated: October 30, 2024 By: / Daniel C. Kiang /

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of this **PETITIONER'S MOTION TO STRIKE** was served by email on the Patent Owner at the following email addresses:

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Dated: October 30, 2024 By: / Daniel C. Kiang /
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