

IPR2024-00343

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED
Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Case: IPR2024-00343
U.S. Patent No. 7,594,052

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION**

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Patent Owner seeks to submit deposition testimony from a different expert in a different IPR concerning a different patent and different references, about an issue that the expert testified he had not analyzed or provided opinions on. For the reasons discussed below, including that such testimony is not relevant and not in the interests of justice, Patent Owner's Motion to Submit Supplemental Information (Paper 45) should be denied.

I. LEGAL FRAMEWORK

"A party seeking to submit supplemental information more than one month after the date the trial is instituted, . . . must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice." 37 C.F.R. § 42.123(b). This rule also does not preclude the Board from considering additional criteria or exercising its discretion to deny motions. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 443, 446-47 (Fed. Cir. 2015).

II. ARGUMENT

A. The Expert in the -00338 IPR Did Not Analyze or Offer Opinions Regarding the Subjects at Issue In This IPR and Consideration of the Transcript Is Not in the Interests of Justice

Patent Owner seeks to submit the transcript from the deposition of a different expert (Dr. Todd Mowry) in a different IPR (IPR2024-00338, "the -00338 IPR") concerning a different patent from a different family (U.S. Patent No. 7,373,449, the "'449 patent"), different invalidity references, and different disputed

claim construction issues. Patent Owner has failed to demonstrate how consideration of the transcript is in the interest of justice or even relevant to any claim or claim construction in this proceeding. *See PNC Bank N.A. v. United Services Auto. Assoc.*, IPR2021-01077, Paper 73 at 81-83 (P.T.A.B. Jan. 20, 2023) (denying a motion under Rule 42.123(b) for failing to show the relevance of the supplemental information).

In the Institution Decision for this IPR, the Board did not adopt either party's construction of the claim term "interconnect means," and instead preliminarily construed "interconnect means" to be a means-plus-function limitation and determined that the corresponding structure is a "network." Paper 11, 42. The Board requested specific briefing from the parties, and stated that its preliminary construction "does not resolve the issue of whether Weber discloses the recited interconnect means." *Id.* at 43. The Board further stated that "to the extent Patent Owner's proposed construction remains relevant at trial... further discussion and evidence of what a 'hop' entails and whether the cited portions of Weber disclose the requisite hops would be helpful." *Id.*

The -00338 IPR, the source of the deposition transcript Patent Owner seeks to now introduce in this IPR, does not concern any of these issues. The -00338 IPR does not concern the construction of "interconnect means," as the claims of the '449 patent at issue in that IPR do not use that term. The -00338 IPR also does

not concern a claim construction dispute regarding the term “network” or “hop.” The -00338 IPR also does not concern the Weber reference, as Weber is not the basis of any invalidity ground in that IPR. Moreover, the expert in the -00338 IPR did not analyze any of the issues that the Patent Owner’s motion cites as “relevant” to this IPR and did not offer opinions regarding them. To the contrary, the expert in the -00338 IPR consistently testified that he had ***not*** analyzed or offered opinions on those issues (e.g., the bounds of the term “hop” and the transmission of packets). ***Over twenty times***, the expert clarified that the scope of his testimony and declaration was limited to an obviousness analysis of the ’449 patent.

Patent Owner contends that the fact that the expert in the -00338 IPR did not analyze or offer opinions on the issues Patent Owner argues are “relevant” to this IPR should go to the weight of the testimony, not whether it should be submitted. Paper 45, 3-4. But that is not in the interests of justice. It is not in the interests of justice to consider deposition testimony from a different expert in a different IPR that does not involve the disputed patent or the disputed claim term, particularly where the expert was not testifying about the same prior art or the same claim term and repeatedly made clear that he had not analyzed or offered opinions regarding the issues the Patent Owner now identifies as “relevant” to this IPR.

Patent Owner also argues that “[i]t would be unfair for Petitioner to be able to rely on portions of [the expert’s] testimony it believes to be helpful in the [-

00338 IPR], while blocking Patent Owner from introducing other portions of his testimony that undermine Petitioner’s positions in this IPR.” Paper 45, 2. Not so. Patent Owner attempted to elicit testimony in the -00338 IPR on issues that are not relevant to that IPR and that the expert had not analyzed or offered opinions on, and the expert in the -00338 IPR repeatedly and expressly made clear that he had not analyzed or offered any opinions on those issues. There is nothing “unfair” about Patent Owner relying in the -00338 IPR on other portions of the expert’s testimony that concern issues he *had* analyzed and did offer opinions on in that IPR.

Patent Owner finally argues that the ’449 patent (at issue in the -00338 IPR) and the ’052 patent (at issue in this IPR) have the same named inventors and priority dates that are only two years apart, and that in district court litigation the parties agreed that claim terms should be construed the same across the patents. Paper 45, 4. But that does not show that consideration of the transcript from the -00338 IPR is in the interest of justice. The ’449 patent is not a family member of the ’052 patent, it does not use the claim term “interconnect means,” and in the IPR concerning the ’449 patent (the -00338 IPR) there is no disputed issue regarding the meaning of the term “interconnect means” nor what Weber discloses (indeed Weber is not even an exhibit in that IPR).

The Board should reject Patent Owner’s attempt to elicit and introduce deposition testimony from a different expert in a different proceeding concerning a different patent and different prior art, regarding subjects not at issue in that different proceeding, over the expert’s express statements that he had not analyzed or offered opinions on those issues. Consideration of such testimony does not serve the interests of justice under Rule 123(b).

B. The Testimony from the -00338 IPR Is Also Hearsay, and Patent Owner Has Not Even Attempted to Identify a Non-Hearsay Purpose

In addition to not being in the interests of justice, the deposition testimony would constitute hearsay. Patent Owner has not even attempted to identify how it would be admissible or to identify a non-hearsay purpose. Instead Patent Owner just argues that any hearsay objection is “premature.” But it is not in the interest of justice to allow submission of testimony regarding an issue that the expert had not analyzed or offered opinions on, without even an attempt by the proponent to show how that testimony could be admissible.

III. CONCLUSION

For the above reasons, Patent Owner’s Motion to Submit Supplemental Evidence should be denied.

Respectfully submitted,

Dated: November 26, 2024

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and the agreement of the parties, the undersigned certifies that on November 26, 2024, a true and correct copy of the foregoing document was served via electronic mail upon the following:

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