

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner

v.

Telefonaktiebolaget L M Ericsson
Patent Owner.

IPR2024-00728

U.S. Patent 7,151,430

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

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Patent Trial and Appeal Board
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I. Introduction.

Patent Owner's ("PO") Motion to Exclude ("Motion," Paper 28) fails to cite a single rule of evidence on which the Motion is allegedly based. Instead, PO relies on *Hulu, LLC v. Sound View Innovations* to argue that Petitioner is prohibited from submitting "new" evidence with a reply in support of unpatentability. PO's motion is both procedurally improper for lack of evidentiary basis and misreads *Hulu's* holding.

As PO admits in its Motion, "new" evidence may be submitted with a reply if it is responsive to the Patent Owner Response ("POR") or Institution Decision ("ID"). (Motion, 1, 4, 5.) The evidence PO seeks to exclude, paragraphs 6-36 of INTEL-1043, the Supplemental Declaration of Dr. Manos Tentzeris (the "Simulation Evidence"), is directly responsive to (1) the Board's invitation to develop the record regarding what a POSITA would have understood regarding the EM fields emanating from Taniguchi's antennas and the motivation to combine Taniguchi and Rostoker (ID, 19, 20); and (2) PO's arguments in the POR. Furthermore, contrary to PO's argument that it is prejudiced by the Simulation Evidence, PO had sufficient opportunity to respond. PO chose not to depose Petitioner's expert on the Simulation Evidence and did not seek leave to submit its own supplemental declaration responding to the Simulation Evidence.

Because PO fails to identify an evidentiary basis for exclusion and because the Simulation Evidence is properly responsive to the POR and the ID, the Motion to Exclude should be denied.

II. The Board Should Not Exclude the Simulation Evidence

A. Legal Standard

On a motion to exclude, the moving party has the burden of proof to establish it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Motions to exclude must be based on evidentiary objections; a “motion to exclude evidence filed for the purpose of striking or excluding an opponent’s brief and/or evidence that a party believes goes beyond what is permitted under 37 CFR §42.23 is improper.” *Palo Alto Networks, Inc. v. Finjan Inc.*, IPR2015-01979, Paper 62 at 66 (P.T.A.B. Mar. 15, 2017) (“allegation that evidence does not comply with 37 CFR §42.23 is not a sufficient reason under the Federal Rules of Evidence for making an objection and requesting exclusion of such evidence”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (“Consolidated Trial Practice Guide”) at 79 (Nov. 2019) (motion to exclude should not “address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply”). Indeed, the Board has “stated repeatedly that a motion to exclude is not a vehicle for arguing that Petitioner’s arguments and supporting evidence are outside the proper scope of a reply.” *Id.*; *see also F5 Networks, Inc. v. Radware, Ltd.*, IPR2017-00124, Paper 48 at

68 (P.T.A.B. Apr. 23, 2018) (“motion to exclude should be directed to the admissibility of evidence”).

A petitioner may introduce new evidence with its reply to respond to PO’s arguments, respond to the Institution Decision, or provide evidence supporting how a POSITA would understand the prior art. *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380–82 (Fed. Cir. 2018) (explaining petitioner “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”); Consolidated Trial Practice Guide at 73. While it is true that “[a] reply may only respond to arguments raised in [*inter alia*] the ... **patent owner response**, or **decision on institution**” (37 C.F.R. § 42.23(b)), a party is “not barred from elaborating on their arguments on issues previously raised.” *Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019). And while a petitioner may not introduce new evidence in support of its prima facie case of unpatentability, “[e]vidence admitted in rebuttal to respond to the patent owner’s criticisms will commonly confirm the prima facie case. That does not make it necessary to the prima facie case.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015).

PO has the ability to address evidence presented in a petitioner’s reply. For example, if a petitioner submits a new expert declaration with its reply, PO may cross-examine the expert or request authorization to file a responsive supplemental declaration of its own. *Id.* at 1081–82; Consolidated Trial Practice Guide at 73; *see also Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023) (criticizing PO for failing to seek leave to submit a supplemental expert declaration to respond to petitioner’s supplemental expert declaration, submitted in response to PO’s arguments made in the POR). There is “no blanket prohibition against the introduction of new evidence ... as long as the opposing party is given notice of the evidence and an opportunity to respond to it.” *Id.* at 1380. Finally, a PO could seek authorization to file a motion to strike new evidence. *See Aylo Freesites Ltd et al v. Dish Technologies LLC*, IPR2024-000462, Paper 60, at 85, n.19 (P.T.A.B. April 14, 2025) (noting “certain aspects of Petitioner’s motion to exclude would be characterized more precisely as a motion to strike” and citing Consolidated Trial Practice Guide at 80, explaining motion to strike appropriate where a brief “raises new issues, is accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply”).

B. Argument

PO’s motion is procedurally improper as it fails to raise any evidentiary objection related to the admissibility of evidence. Instead, PO relies exclusively on

Hulu to argue that new evidence may not be submitted after the Petition is filed to make out a case of unpatentability. (Motion, 5.) But *Hulu* also does not provide a basis for a motion to exclude. *See Consolidated Trial Practice Guide* at 79. This alone is sufficient reason for the Board to deny the motion.

Even if the motion were procedurally proper, however, the evidence PO seeks to exclude was properly submitted as it is directly responsive to (1) the Board's request that the parties develop the record regarding the fields produced by Taniguchi's antennas/inductors; and (2) PO's arguments in the POR. In addition, PO fails to show any legitimate prejudice it would suffer if the evidence is not excluded. PO had an opportunity to depose Dr. Tentzeris on the alleged new evidence and chose not to do so. PO also could have sought leave to submit a supplemental expert declaration responding to the evidence and failed to do so.

1. The Motion to Exclude is Procedurally Improper.

PO's Motion should be denied as improper because it does not cite a single rule of evidence as a basis for excluding the Simulation Evidence. *Palo Alto Networks*, IPR2015-01979, Paper 62 at 66; *F5 Networks*, IPR2017-00124, Paper 48 at 68. PO's sole basis for requesting exclusion is *Hulu*'s unremarkable holding that a petitioner may not submit new evidence "to make out a prima facie case of unpatentability." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper

29 at 7 (PTAB 2019) (Precedential). *Hulu* does not provide an evidentiary basis to support a motion to exclude.¹

Regardless, even if the Board entertains PO's procedurally improper motion, *Hulu* does not support exclusion here. *Hulu* holds, as PO acknowledges (Motion, 5), that a petitioner may submit new evidence in response to arguments raised by a patent owner and in support of its reply. *Hulu*, IPR2018-01039, Paper 29 at 7; *see also* Consolidated Trial Practice Guide at 73 (party permitted to "submit rebuttal evidence in support of its reply"). As demonstrated below, the Simulation Evidence is directly responsive to the Board's request to the parties to develop the record and PO's arguments in the POR.

2. The Simulation Evidence Is Responsive to the Institution Decision.

In the Institution Decision, the Board invited the parties to develop the record "regarding what a person of ordinary skill would have understood regarding

¹ In *Hulu*, after denying institution, the Board granted Petitioner's request for rehearing on the issue of whether Petitioner's Dougherty reference qualified as prior art. *Id.* at 2. Petitioner submitted additional evidence that the reference was a printed publication after filing the Petition. *Id.* at 4. Patent Owner argued, in opposing the request for rehearing, that Petitioner's "new" evidence should not be considered because it was not submitted with the Petition. *Id.* 11.

the characteristics of the EM fields emanating from Taniguchi’s loop structures.” (ID, 19.) The Simulation Evidence is directly responsive to that invitation. *See* Consolidated Trial Practice Guide at 73 (petitioner permitted “to address issues discussed in the institution decision” and “submit rebuttal evidence in support of its reply”); *Anacor Pharms.*, 889 F.3d at 1380–82 (Fed. Cir. 2018) (petitioner “may introduce new evidence after the petition stage if the evidence ... is used to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness”). Specifically, the Simulation Evidence illustrates the magnetic fields produced by various conducting structures, including the type of rectangular and eight-shaped loop structures disclosed by Taniguchi. (INTEL-1043, ¶¶6-36.)

The Board also invited the parties to develop the record “regarding whether a person of ordinary skill would have had reason to combine the teachings of Taniguchi and Rostoker.” (ID, 20.) The Simulation Evidence is directly responsive to that invitation as it demonstrates that a POSITA would have understood the physics of antennas/inductors is the same whether those antennas/inductors are formed on a printed circuit board or a semiconductor die. (INTEL-1043, ¶¶26-30.)

3. The Simulation Evidence is Responsive to PO's Arguments and Properly Elaborates on Arguments Presented in the Petition.

The Simulation Evidence illustrates what a POSITA would understand about the magnetic fields produced by Taniguchi's inductors/antennas and is specifically responsive to at least the following arguments in the POR:

- “Taniguchi’s antenna 1 does not have a reduced magnetic field at antenna 2. Antenna 1 has a strong magnetic field at antenna 2.” (POR, 17. *See* INTEL-1043, ¶¶6-30.)
- PO’s conclusory arguments that a POSITA would not have looked to PCB art in designing inductors for use in ICs. (POR, 32, 46-47, 55, 56, 65. *See* INTEL-1043, ¶¶26-30.)
- “Taniguchi fails to show cancellation of the magnetic field emanating from the first antenna 1 at a predetermined distance away from the first antenna.” (POR, 42. *See* INTEL-1043, ¶¶6-30.)
- “Taniguchi does not teach the spacing between the ends of the antenna conductor 102 at feeding point 111 in Figure 8B minimizes the magnetic field contributions from the terminals.” (POR, 43, 51. *See* INTEL-1043, ¶¶31-36.)

Further, the Simulation Evidence does not support any new arguments or theories of unpatentability. Rather, the Simulation Evidence merely elaborates on the arguments presented in the Petition. That is, the Simulation Evidence ***confirms***

Petitioner’s prima facie case of unpatentability, but *is not necessary* to make out a prima facie case. *Hulu* IPR2018-01039, Paper 29 at 7-8; *Belden*, 805 F.3d at 1079. PO argues that the Petition “failed to show Taniguchi would reduce magnetic coupling if its antennas were laterally offset,” and thus the Simulation Evidence is not responsive to PO’s arguments, but rather “purports to fill an evidentiary gap missing in the Petition.” (Motion, 5-6.) As an initial matter, PO’s interpretation of the claims to require a “lateral offset” is incorrect for the reasons explained in Petitioner’s Reply. (Reply (Paper 19), 13-14.) Further, not only did PO fail to demonstrate that “lateral offset” is required, the ID correctly found that Petitioner established a prima facie case “that Taniguchi teaches that its loop structures are spaced apart by a predetermined distance ... and ... Taniguchi recognizes suppression of the remote EM field.” (ID, 19.) In other words, the Simulation Evidence is not needed to meet Petitioner’s burden to make out a prima facie case of obviousness. *Belden*, 805 F.3d at 1079 (“Evidence admitted in rebuttal to respond to the patent owner’s criticisms will commonly confirm the prima facie case. That does not make it necessary to the prima facie case.”).

Specifically, the Simulation Evidence elaborates on at least the following arguments presented in the Petition:

- Taniguchi discloses the “reduced far field” limitations. (Petition, 14-18. See INTEL-1043, ¶¶ 6-30.)

- Taniguchi discloses “minimizing magnetic field contributions” of the terminals. (Petition, 28-30. *See* INTEL-1043, ¶¶31-36.)
- Taniguchi discloses the “reduced electromagnetic coupling” limitations. (Petition, 31-35, 42-43. *See* INTEL-1043, ¶¶ 6-30.)
- Motivation to combine PCB and IC art. (Petition, 54-60, 71-74. *See* INTEL-1043, ¶¶26-30.)

The Simulation Evidence is properly responsive to PO’s arguments and merely elaborates on arguments presented in the Petition and, therefore, should not be excluded.

4. PO Has Not Established Prejudice.

Even if PO had raised a proper evidentiary basis for exclusion (it has not), and even if PO could establish that the Simulation Evidence is not properly responsive to PO’s arguments and the Board’s invitation (it could not), PO has not shown that it has or will suffer any prejudice if the Simulation Evidence is not excluded. In fact, PO’s complaint that it did not have an opportunity to respond is not a recognizable evidentiary objection. It is also incorrect. PO had an opportunity to depose Dr. Tentzeris on the Simulation Evidence and chose not to. *See* Consolidated Trial Practice Guide at 70; *Belden*, 805 F.3d at 1081. PO also could have sought leave to file a supplemental declaration responding to the Simulation Evidence, but chose not to. *See Axonics*, 75 F.4th at 1384 (Fed. Cir. 2023). Accordingly, any

alleged prejudice of PO's own making is not a basis for exclusion.

PO's conclusory argument that Petitioner would suffer no prejudice from exclusion of the Simulation Evidence lacks any basis in law and is factually incorrect. Petitioner is entitled to respond to PO's arguments as well as the Board's invitation to develop the record. *See Consolidated Trial Practice Guide* at 73; *Anacor Pharms.*, 889 F.3d at 1380–82. If the Simulation Evidence is excluded, Petitioner will be prejudiced because it will not be afforded that opportunity. Further, PO's citations to 35 U.S.C. §311(b) and *Qualcomm* are misplaced (Motion, 6). Petitioner is not using the Simulation Evidence as “the ‘basis’ of a ground for inter partes review,” *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1374 (Fed. Cir. 2022), but rather as support for what a POSITA would understand about the EM fields produced by Taniguchi's antennas/inductors and to rebut PO's arguments that a POSITA would not be motivated to combine PCB art with IC art—which are all issues that the Petition addressed with evidence from the prior art and Dr. Tentzeris's initial declaration (*see* Section II.B.3.)

III. Conclusion.

None of PO's arguments justify exclusion of paragraphs 6-36 of INTEL-1043. PO's Motion to Exclude should be denied.

Date: June 24, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on June 24, 2025, a copy of the foregoing Petitioner's Opposition to Patent Owner's Motion to Exclude was served via email on the following attorneys for the Patent Owner:

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