

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

DH INTERNATIONAL LTD.,

Patent Owner.

Case No. IPR2024-01322

U.S. Patent No. 9,022,294

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

I. Introduction

Patent Owner's Motion to Exclude ("Mot.") arguments overwhelmingly relate to the sufficiency of the evidence and not the admissibility of the evidence. These arguments are not properly raised in a motion to exclude under the Board's Trial Practice Guide. Notwithstanding Patent Owner's improper use of a motion to exclude, Petitioner maintains that 1) Mr. Lipoff's testimony is provided from the perspective of a POSITA, 2) the parties' agreed level of ordinary skill does not require Bluetooth expertise, 3) Petitioner's means-plus-function claim constructions were properly raised under the Board's regulations, and 4) any purportedly uncited portions of Mr. Lipoff's Declarations are relevant. Accordingly, Petitioner requests that the Board deny Patent Owner's Motion.

II. Mr. Lipoff Qualifies as a POSITA; His Opinions Are Rendered from that Vantage, Consistent with *Kyocera*; Bluetooth Expertise Is Irrelevant to the Agreed POSITA Definition

Patent Owner agreed to Petitioner's definition of a POSITA (POR, 4) and does not dispute—and therefore has waived the ability to challenge—that Mr. Lipoff qualifies as one. Patent Owner nevertheless attempts to categorically exclude both of Mr. Lipoff's Declarations (Ex. 1003 and Ex. 1014) for lack of relevancy because, according to Patent Owner, they are based on his own knowledge. Mot. 3-4. Patent Owner further contends that Mr. Lipoff's Reply Declaration (Ex. 1014) is not relevant and lacks probative value because Mr.

Lipoff is purportedly not a Bluetooth expert. Mot. 4-5. Patent Owner's arguments should be rejected because Mr. Lipoff's opinions are properly rendered from the appropriate perspective of a POSITA and are relevant to the issues in this case.

A. Mr. Lipoff's Opinions Are Based on His Perspective as a POSITA

Patent Owner argues that Mr. Lipoff's opinions are based on his knowledge and professional judgment *guided by* the understanding of a POSITA rather than *from* the vantage point of a POSITA. Mot. 3-4. As an initial matter, Patent Owner's argument fails to articulate any legally or factually material distinction between being "guided by" and "from the vantage point" of a POSITA. But more importantly, Patent Owner is wrong that Mr. Lipoff's opinions are not from the vantage point of a POSITA. Tellingly, Patent Owner did not and cannot identify any particular statement or opinion presented by Mr. Lipoff that is not provided *from* the vantage point of a POSITA. Instead, Patent Owner draws its conclusion from two sentences of Mr. Lipoff's Opening Declaration (Ex. 1003) that read:

All of the opinions contained in this declaration are based on the documents I reviewed and my knowledge and professional judgment. My opinions have also been guided by my understanding of how a POSITA would have understood the claims of the '294 Patent at the time of the earliest claimed priority date.

Ex. 1003, ¶26. This statement explains the materials Mr. Lipoff considered when forming his opinions, not the perspective from which Mr. Lipoff delivered his opinions. Moreover, Patent Owner’s argument assumes that being “guided by” and “from the vantage point” of a POSITA are mutually exclusive. But such an assumption defies logic; an opinion proffered from the vantage point of a POSITA is most certainly also guided by the knowledge and understanding of a POSITA. Regardless, Mr. Lipoff expressly stated that he was “informed that an obviousness determination must be made from the perspective of a POSITA” (*Id.* ¶46) and that he “applied [that standard] in forming [his] opinions.” *Id.* ¶33, *see also id.* ¶¶33-35, 38-52. Mr. Lipoff also expressly stated that “claims 1-20 of the ’294 Patent would have been obvious to a POSITA based on the following grounds....” *Id.* ¶80. Patent Owner ignores these and other statements that directly confirm that Mr. Lipoff’s testimony was rendered from the perspective of a POSITA.

The only support Patent Owner proffers for its argument is from *Kyocera Senco Ind. Tools, Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1376-77 (Fed. Cir. 2022), which supports Petitioner’s position here. Mot. 4. Patent Owner quotes *Kyocera* for the proposition that “to be qualified to offer expert testimony on issues from the vantage point of an ordinarily skilled artisan in a patent case, an expert must at a minimum possess ordinary skill in the art.” *Kyocera*, 22 F.4th at 1376-77;

Mot. 4. Patent Owner does not challenge that Mr. Lipoff qualifies as a POSITA.

Accordingly, the Board should not exclude his Declarations.

B. Specialized Bluetooth Expertise Is Immaterial to the Agreed Level of Ordinary Skill

Patent Owner next wrongly contends that Mr. Lipoff's Reply Declaration should be excluded because "Mr. Lipoff is not a Bluetooth Expert." Mot. 4-5.

Patent Owner's argument, however, ignores the Parties' agreed level of ordinary skill, which does not require expertise in Bluetooth. Paper 10, 9-10; POR, 4

("Patent Owner agrees with the Petitioner on the level of ordinary skill in the art.").

Despite agreeing with Petitioner, Patent Owner also confusingly offered a similar level of ordinary skill, substantively adding only a year of required experience but in the broader field of "wireless communication between devices." POR, 4. The distinctions between the two definitions are immaterial to Patent Owner's current argument, as neither definition requires specific expertise in Bluetooth and Mr.

Lipoff qualifies as a POSITA under both.

Petitioner's Level of Ordinary Skill	Patent Owner's Level of Ordinary Skill
A person of ordinary skill in the art ("POSITA") at the time of the alleged invention of the '294 patent would have had at least a bachelor's degree in electrical engineering, or a related	A person with ordinary skill in the relevant art at the time of invention - April 14, 2003 - would have a bachelor's degree in electrical engineering or a similar discipline and

Petitioner's Level of Ordinary Skill	Patent Owner's Level of Ordinary Skill
field, and at least two years of experience in design, development, and/or testing of network-enabled consumer devices, and familiarity with payment cards, or the equivalent, with additional education substituting for experience and vice versa. Pet. 2.	at least three years of relevant industry or research experience in wireless communication between devices. This definition is approximate, and more education may substitute for industry experience or vice versa. POR, 4.

Indeed, Mr. Lipoff stated that “[a]t the time of the alleged invention, I would have exceeded the level of ordinary skill in the art and I am qualified to testify to what one of ordinary skill in the art would have known at that time.” Ex. 1003, ¶58. As such, there is no basis to exclude Mr. Lipoff’s testimony related to Bluetooth.

Patent Owner’s arguments are an improper attempt to exclude Mr. Lipoff’s testimony based on the sufficiency of his testimony and cannot be a ground to exclude his testimony. For example, Patent Owner states that “Mr. Lipoff did not consider the Bluetooth specification in the Petition, and Petitioner did not submit it as an exhibit, even though it was incorporated into the Mooney reference” Mot. 5. This argument is not about the “relevancy” or “probative value” of Mr. Lipoff’s testimony as Patent Owner contends (Mot. 5) but the sufficiency of the testimony. Indeed, Patent Owner does not attempt to exclude all of Mr. Lipoff’s testimony about Bluetooth, only his Reply Declaration (and Petitioner’s reliance on it) that

addressed Patent Owner's flawed reading of its own exhibit (Ex. 2003). *See* Ex. 1014, ¶¶44-55, 84; Reply, 11-18, 30. Because Mr. Lipoff's testimony is responsive to Patent Owner's arguments, it is relevant and probative to this case. Challenging the sufficiency of Mr. Lipoff's testimony is an improper use of a motion to exclude. *See* Consolidated Trial Practice Guide, 79 ("A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact.").

Patent Owner further fails to meet its burden of proof to exclude Mr. Lipoff's testimony or portions of Petitioner's Reply that rely on the testimony. Patent Owner purports that "Mr. Lipoff's Bluetooth comments and assertions in Exh. 1014 lack[] relevance ... and [sic] for having unsupported opinion testimony lacking sufficient probative value" But Patent Owner does not provide any rationale as to why Mr. Lipoff's testimony lacks relevancy or sufficient probative value under the Federal Rules of Evidence. Accordingly, Mr. Lipoff's testimony or Petitioner's Reply that rely on the testimony should not be excluded.

III. Petitioner's Claim Construction Positions Under § 112, ¶6 Were Proper

Petitioner's claim constructions under § 112, ¶6 were properly provided under the appropriate rule (37 C.F.R. § 42.104(b)(3)) and are relevant to this proceeding. Mot. 1-2. As an initial matter, Patent Owner is wrong that 37 C.F.R. § 42.100(b) requires that "Petitioner has the burden of establishing that either the

claim needs to be construed under 35 U.S.C. § 112, sixth paragraph (pre-AIA) or plain meaning.” Mot. 2. Rule 42.100(b) sets forth no such burden, rather it provides that “[i]n an *inter partes* review proceeding, a claim of a patent ... shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning” Petitioner’s construction abides by this rule. Moreover, Patent Owner’s mistaken burden-based rationale to exclude Petitioner’s constructions relates to *the sufficiency* or pleadings, rather than *the relevancy* and should be denied. *See Consolidated Trial Practice Guide*, 79.

Petitioner’s identification of three terms for potential means-plus-function claim construction was proper under 37 C.F.R. § 42.104(b)(3). Rule 104(b)(3) recites that petitioners must identify “[h]ow the challenged claim is to be construed,” and when the claim contains means-plus-function language, “the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” 37 C.F.R. § 42.104(b)(3). This is exactly what Petitioner did when it provided the Board with constructions for “data conveyance switching element,” “control device,” and “data exchange device.” Pet. 6-8. Petitioner’s use of “[t]o the extent” before these terms merely provides the Board with the ability to decide

whether to apply the proffered means-plus-function construction or to decide that no construction of these terms is needed to resolve the controversy, consistent with Board practice. Pet. 5. Petitioner's claim constructions were properly presented, comply with the controlling Rules, and are relevant this proceeding as terms the Board may need to construe to resolve the disputes before it.

IV. Uncited Portions of Mr. Lipoff's Declarations Should Not Be Excluded

Patent Owner moves to exclude paragraphs 1-52, 58-61, 63, 65, 69-71, 76, 79-80, 89, 113, 127, and 194 of Mr. Lipoff's Declaration (Ex. 1003) and paragraphs 1-26, 28-31, 36-40, 57-83 and 85-89 of Mr. Lipoff's Reply Declaration (Ex. 1014) because they are uncited in the Petition and Petitioner's Reply.

Mot. 2-3.

Regardless of whether the paragraphs of Mr. Lipoff's declarations are cited, Patent Owner fails to establish that the paragraphs are inadmissible or that the proper remedy would be exclusion from the record. First, Patent Owner does not explain why these paragraphs are irrelevant under the Federal Rule of Evidence's relevancy test. As such, Patent Owner's argument should be rejected because it does not meet its burden of proof as the moving party. *See* 37 C.F.R. § 42.20(c). Without an explanation as to the relevancy of these paragraphs, the Board would be forced to undergo the burdensome task of reviewing each paragraph without any guidance. Second, the Board has repeatedly found that merely being uncited is

not a sufficient reason to exclude paragraphs of an expert declaration. *See, e.g., LONGi Green Energy Technology Co., Ltd. v. Hanwha Global Asset Corp.*, IPR2019-01072, Paper 38, 8-10 (PTAB Dec. 3, 2020); *Amerigen Pharm. Ltd. v. Janssen Oncology, Inc.*, IPR2016-00286, Paper 86 at 45-46 (PTAB Jan. 17, 2018) (“We are unaware of any legal basis for striking uncited paragraphs of an expert declaration.”). Patent Owner does not provide the Board with any reason to depart from this long standing practice, and thus, the Board should not exclude the requested paragraphs of Mr. Lipoff’s Declarations.

Patent Owner further argues that reliance on these paragraphs “would raise new matter.” Mot. 3. Patent Owner’s argument is premature and improper because it does not relate to the admissibility of the evidence (*see* Consolidate Trial Practice Guide, 79 (“Nor should a motion to exclude address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply”), and thus, the Board should not exclude the requested paragraphs of Mr. Lipoff’s Declarations.

V. Conclusion

Petitioner respectfully requests that Patent Owner’s Motion be denied.

Dated: December 1, 2025

Respectfully submitted,

/ Erika H. Arner /
Erika H. Arner, Lead Counsel
Reg. No. 57,540

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PETITIONER'S
OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE** was served electronically via email on December 1, 2025, in its entirety on the following:

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