

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLLEGE PRODUCTS, INC.,

Petitioner,

v.

INTIRION CORPORATION,

Patent Owner.

Case No. PGR2024-00003

Patent No. 11,674,745

**PATENT OWNER'S MOTION TO EXCLUDE PETITIONER'S EVIDENCE
UNDER 37 C.F.R. § 42.64**

Patent Owner submits this motion pursuant to 37 C.F.R. §§ 42.62 and 42.64(c) and in accordance with Due Date 5 (Paper 11).

Patent Owner respectfully requests exclusion of Exhibits 1004, 1009, 1012, 1022, and 1024, as well as certain paragraphs and appendices of Dr. Hornstein's declarations (Exhibits 1002 and 1023), as described below.

The Federal Rules of Evidence govern the admissibility of evidence in post grant review proceedings. 37 C.F.R. § 42.62. Intirion properly and timely objected to various exhibits. *See* Papers 12, 16, 25, 31. Yet, other than Exhibit 1024 (directed to curing Exhibit 1012's deficiencies but failing to do so), Petitioner has made no attempt to affirm or correct the admissibility of any of the objected-to exhibits. Thus, Exhibits 1004, 1009, 1012, 1022, and 1024, along with the identified paragraphs and appendices of Exhibits 1002 and 1023, should be excluded from consideration in this proceeding.

If the Board does not rely on the challenged evidence in reaching its Final Written Decision, the Board should not dismiss this Motion as moot. Instead, Intirion respectfully requests that the Board rule on the Motion so that Petitioner cannot continue to rely upon the challenged evidence on appeal. Not excluding the challenged evidence would force Intirion to address it again, e.g., on appeal, thereby wasting judicial resources.

I. Dr. Horenstein's Prior Declaration Based On Other Patents (Exhibit 1002) Should Be Excluded.

Exhibit 1002 is the Declaration of Mark N. Horenstein in Support of the Petitions for *Inter partes* Review of U.S. Patent No. 9,791,206 (“’206 Patent”); U.S. Patent No. 10,495,374 (“’374 Patent”); and U.S. Patent No. 11,274,876 (’876 Patent”). It refers throughout to these three patents, which are not challenged in this proceeding, describes art that is not provided or analyzed in this proceeding, and relies on references and documents not submitted in this proceeding. Each category should be excluded. Exhibit 1002 is relied upon or cited in the Petition (Paper 1), Petitioner’s Reply (Paper 30), and the Order Instituting Review (Paper 10).

A. Paragraphs Related To Patents or Documents Not Submitted In this Proceeding.

Many paragraphs¹ of Exhibit 1002 should be excluded because they are not based on sufficient facts or data, do not disclose underlying facts or data, rely on documents and exhibits not before the Patent Trial and Appeal Board, do not sufficiently explain the test or data in accordance with 37 CFR § 42.65(b), are not the product of reliable scientific principles and methods, and/or are otherwise

¹ Relevant paragraphs are: ¶¶ 1-4, 17-18, 23, 27, 43, 48-56, 57-72, 73-76, 77-82, 83-88, 89-92, 93-95, 96-100, 101-103, 117, 118-126, 128, 129-131, 132-133, 136, 140, 141-142, 143-145, 150-153, 154-164, 168-170, 174-175, 176-179, 186-188, 189-191, 192, 207-214, 215-219, 220, 224-226, 227-231, 232-242, 243, 244, 245-246, 247-249, 250-251, 252-253, 255, 259, 260, 261, 262, 264-271, 272, 273, 274-275, 276-277, 278-281, 282, 283, 284-285, 286-287, 288, 289, 290, 291, 295, 296, 298-304, 305-311, 312-320.

irrelevant and should be excluded under Fed. R. Evid. 402 and 403. These paragraphs are inadmissible because they relate to opinions formed regarding the '206 Patent, *not* the '745 Patent. For example, ¶ 48 discusses the specification of the '206 Patent, and further relates to a petition for *inter partes* review relating to the '206 Patent. Neither the '206 Patent nor the petition for *inter partes* review of the '206 Patent have been submitted here; thus, Dr. Horenstein's opinions are irrelevant in that they are based on a non-challenged patent, and untrustworthy in that the complete basis for his opinions (including why or how opinions regarding the '206 Patent could be relevant to the '745 Patent, and the underlying documents supporting his opinions regarding the '206 Patent) are not submitted in full.

B. Paragraphs Unrelated To Dr. Horenstein's Expertise Should Be Excluded.

Dr. Horenstein offered opinions regarding the public availability of the ISDU reference.² Such opinions are not based on his expertise (admittedly to Northeastern or library sciences, *see* ¶¶ 5-16), are not based on personal knowledge, are based on or rely upon hearsay, and are improper lay witness opinion testimony. *See* FRE 602 (requiring personal knowledge when not acting as an expert); 701 (limiting opinion testimony by a lay witness); 702 (describing expert witness testimony where

² Relevant portions of Exhibit 1002 related to ISDU's public availability are: ¶¶ 96-98, 159-161, 168-170, 217, 224-225, 252-253, 261, 262, 274, 279, 290, 296, Appendix B, Appendix C, Appendix D.

proponent demonstrates “expert’s scientific, technical, or other specialized knowledge” will aid the trier of fact); 703 (allowing *expert* to rely on hearsay for matters within expertise); 802 (prohibiting hearsay unless otherwise allowed under Fed. R. Evid.). For example, ¶ 96 opines that ISDU was publicly available as of April 17, 2007. Yet Dr. Horenstein has no personal knowledge of ISDU, and his opinion was based on a review of Northeastern University library documents. As the Board noted, this is improper. Paper 27 at 6 (“Petitioner has provided only a conclusory citation to ISDU itself and the uncorroborated speculative testimony of Dr. Horenstein as to ISDU’s publication on Iris.”).

II. Exhibit 1004 - Original Interim Complaint Filed On June 8, 2022 Is Irrelevant and Uncited.

Exhibit 1004 should be excluded pursuant to FRE 106, 402, and 403. Exhibit 1004 is no longer the operative complaint in the district court litigation. Moreover, Petitioner has not relied upon Ex. 1004 in its Petition, Reply, declarations, or other exhibits. Inclusion in this proceeding is misleading, would cause confusion, and is improper given that Exhibit 1004 is not cited.

III. Exhibit 1009, A Claim Chart Related To Claim 1 of ’876 Patent Is Irrelevant.

Exhibit 1009 should be excluded pursuant to FRE 106, FRE 402 and 403 because it relates to a patent not challenged here, which has claims that are different than the claims in this proceeding. *See* Ex. 1009 (claim chart to the ’876 patent). It is also out of date, as it pre-dates claim construction and updated infringement charts

served in the District Court litigation. Exhibit 1009 is relied upon or cited in the Petition (Paper 1) and the Order Instituting Review (Paper 10). The Board should exclude Exhibit 1009 because it is irrelevant and likely to cause confusion.

IV. Ex. 1012 (ISDU) Should Be Excluded Because ISDU Is Not Prior Art.

Ex. 1012 (ISDU) should be excluded pursuant to FRE 402 and 403 because College Products has not met its burden to show that ISDU is prior art, and thus ISDU has no relevance to this proceeding. ISDU is an undergraduate research paper with a cover page having a date of April 17, 2007. Ex. 1012, 2. Exhibit 1012 is relied upon or cited in the Petition (Paper 1), Petitioner's Reply to the Preliminary Response (Paper 8), and Petitioner's Reply (Paper 30). The entirety of Petitioner's explanation in the Petition regarding the asserted public accessibility of ISDU is reproduced below.

ISDU: Integrated Smoke detector Unit for Commercial Microwave Ovens, Cory Lloyd et. al, Northeastern University ("ISDU") published on April 17, 2007, on "IRis". Ex. 1012. IRis was a "digital archive," indexed on Google and readily accessible worldwide, that allowed Northeastern University researchers, starting in 2006, to publish their work to "promote and preserve their intellectual output" and was a precursor to Northeastern University's more current Digital Repository Service. Ex. 1002 ¶¶[96-98]. Per IRis's publishing practices, ISDU was published and publicly available in Northeastern University's digital archive in 2007. *Id.* ISDU is prior art pursuant to at least 35 U.S.C. §102(a)(1).

Pet. 20.

As the Board has noted, this simply is not credible. Paper 27 at 5-6, 11 (noting speculative and contradicted nature of evidence submitted). First, the date listed on ISDU, April 17, 2007, is insufficient to establish public accessibility, and regardless is contradicted by Ex. 1024 (which also should be excluded, *see* Section VI). A date on a document or paper, alone, is generally not sufficient to show public accessibility. *See Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986) (The Court determining that the date on an advertising mailer was insufficient to show “receipt of the mailer by any of the addressees.”); *see also, e.g., Apple Inc. v. DSS Tech. Management, Inc.*, IPR2015-00373, Paper 8 at 10–11 (PTAB June 25, 2015) (denying institution where “[t]hat stamped date, however, would appear to be a hearsay statement to the extent that it would be offered for its truth”).

Petitioner has provided no persuasive evidence that ISDU was “published on April 17, 2007, on ‘IRis.’” Pet. 20. The April 2007 date may simply be the date the undergraduate authors wrote or turned in their paper. *See Apple Inc. v. DSS Tech. Management, Inc.*, IPR2015-00373, Paper No. 8 at 10-11 (PTAB June 25, 2015) (denying institution where “[t]hat stamped date, however, would appear to be a hearsay statement to the extent that it would be offered for its truth”). There is no evidence that ISDU was published or publicly accessible on April 17, 2007 (or on any date for that matter). Pet. 20. Dr. Horenstein states that “ISDU indicates its date of publication as April 17, 2007 and indicates on its face that it was published on

‘IRis.’” Ex. 1002 ¶ 96. But Dr. Horenstein is not an expert in public availability of library documents at Northeastern University, has no personal knowledge of the pre-critical date availability of ISDU, and does not explain how or why the date on the face page of the paper indicates publication or public accessibility. The documents Dr. Horenstein relies upon relating to the IRis system notably *do not discuss ISDU*. Further, as discussed below, Exhibit 1024 cannot be used to remedy ISDU’s public availability problem, at least because Exhibit 1024 is *also* not based on personal knowledge, and lacks trustworthiness.

In short, ISDU should be excluded as irrelevant because there has been no showing that it is relevant to this proceeding (*i.e.*, was publicly available).

V. Exhibit 1023, Dr. Horenstein’s Declaration, Is Largely Inadmissible.

Exhibit 1023 is Dr. Horenstein’s declaration in this matter. Dr. Horenstein’s abnormal declaration has many issues. First, Dr. Horenstein’s declaration improperly adopts a prior declaration whole-sale, Exhibit 1002, which was submitted in relation to *other* patents that are not challenged here and are not identical to the patents challenged here. Dr. Horenstein’s new declaration, Exhibit 1023, also relies upon appendices that were not submitted and, again, upon the premise that ISDU is prior art (it is not). Exhibit 1023 is relied upon or cited in the Petition (Paper 1), the Order Instituting Review (Paper 10), and Petitioner’s Reply (Paper 30). Dr. Horenstein’s declaration should be excluded as described below.

A. Paragraphs Incorporating the Prior Declaration Should Be Excluded.

Paragraphs 1, 4, 6, 7, 8, 10, 15, 19, 37, 38, 39, 48, 53, 58, 62, 65, 66, 72, 74-75, 80, 81, 94, 95, 105, 120, 124, 127, 131, 136, 156-157, 167, 174, 191-196, 199, 202-209, 214-215, 217-219, 223, 225-227, 230-231, 248-249, 251, 253-256, and notes 5, 6, and 8 incorporate either the entirety of Ex. 1002 or (typically) numerous paragraphs or portions of Ex. 1002 at a time. These paragraphs are not based on sufficient facts or data, do not disclose underlying facts or data, rely on documents and exhibits not before the Patent Trial and Appeal Board, do not sufficiently explain the test or data in accordance with 42.65(b), and are not the product of reliable scientific principles and methods. This whole-sale incorporation of paragraphs from a declaration covering *different patents* (patents that were not submitted in this proceeding), and which included different obviousness grounds, should be excluded under Fed. R. Evid. 402, 403, and 801. As but one example, ¶ 69 of Exhibit 12 cross-cites to ¶ 61 of Exhibit 1002, which itself cites Exhibit 1013, “prior art reference[] Ueda.” Ueda is not submitted here, and is not an exhibit in *this* proceeding. *See also* Ex. 1023 ¶ 206 and n.8 (citing Ex. 1002 ¶ 169, which discusses and cites to Ueda). Petitioner’s incorporation-by-reference practice further runs afoul of 37 C.F.R. § 42.6 (a)(3), which explicitly provides “Arguments must not be incorporated by reference from one document into another document.” (emphasis added).

Moreover, because the extensive cross-referencing should be excluded, each of those paragraphs suffers from an additional flaw: they should be excluded under 37 C.F.R. § 42.65(a) as unsupported by underlying facts or opinion identified in Exhibit 1023 itself.

B. Paragraphs Referencing Appendix F, G, and H Should Be Excluded.

Dr. Horenstein's declaration references Appendices F, G, and H. *See* Exhibit 1023 at 3 and ¶ 131. These appendices were not submitted, even with Dr. Horenstein's initial declaration. Intirion provided objections that identified Petitioner's failure to submit these appendices. *See* Paper 12 at 3 (noting "Appendix F; Appendix G; Appendix H discuss things that have not been made available for inspection"). Petitioner made no attempt to produce these appendices thereafter. Thus, references to these appendices (as well as ¶ 131, which is based on the alleged appendices G and H) should be excluded. 37 C.F.R. §§ 42.51(c); *see also* Fed. R. Evid. 106.

C. Paragraphs Referencing Smith's "Typographical Error" Should Be Excluded.

Through Dr. Horenstein (including through his cross-reference to his prior declaration), Petitioner reads in a separate, unreferenced "Figaro" product into Smith. *See* ¶ 205 and n. 8; *see also* Ex. 1002 ¶¶ 167-169. But Figaro 816 has not been shown to be prior art, and is not supported by evidence in the record to be the

type of product CP states it is. CP has offered no witness with knowledge regarding the alleged Figaro product or its availability. This is improper under Fed. R. Evid. 402 and 403 because neither Petitioner nor Dr. Horenstein have shown the Figaro 816 to be relevant to this proceeding—indeed, it is not mentioned *at all* in the Smith reference, despite Petitioner’s contentions otherwise. Moreover, Dr. Horenstein’s assumption that Smith contains a typographical error is no more than conclusory, unsupported speculation, and should be disregarded. *See K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1365 (Fed. Cir. 2014); Trial Practice Guide at 36.

D. Paragraphs Opining On ISDU Should Be Excluded.

Dr. Horenstein’s declaration still opines on ISDU. *See* ¶ 76, 82, 106-112, 129, 130-131, 135-136, 173, 203-204, 215-216, 224-225, 253, 256, and 261-262. For the reasons stated in Section IV, ISDU is not prior art, and thus these paragraphs should be excluded.

VI. Exhibit 1024 – The Northeastern Email Is Irrelevant and Untrustworthy.

Exhibit 1024 is improper and should be excluded because College Products seeks to introduce an exhibit that (1) explicitly relies on an unproduced and excerpted email; (2) is an incomplete email chain; (3) is an email sent by a person lacking personal knowledge of the subject; (4) is hearsay; (5) is not, and is unable to be, supported by a declaration; and (6) improperly provides unqualified expert testimony. Exhibit 1024 is uncited in the Petition or the Reply.

In an April 30, 2024, email, Petitioner’s counsel inquired with a Northeastern University employee (Ms. Sweeney) as to “when [ISDU] was first published and when it was available in the IRis system.” Ex. 1024, 7.

Ms. Sweeney stated the following:

- We migrated away from the IRis system in 2015, so unfortunately ***I cannot confirm the exact date the paper was made available to the public***
- ***This was a few years before my time at Northeastern***, so I can’t say for certain that was the reason! But, ***I can tell you that the paper was not available in IRis before December 2009.***
- [Northeastern] did not keep any technical or administrative metadata in the migration, so ***I have no documentation that would indicate whether or not the file was public*** (and therefore indexed by Google and other major search engines) or private during the time it was in IRis [*i.e.*, until 2015].
- It’s been nearly 10 years since I worked in materials with IRis, so ***my memory of the workflows are quite fuzzy!***

(Ex. 1024 at 5 (emphasis added)). Despite being “the Head of Digital Production Services at Northeastern Library,” Ms. Sweeney admits she has no personal knowledge and the events occurred before her time. She also admits any guesses are based on a “fuzzy” memory as it has been nearly 10 years since the IRis system was discontinued.

Petitioner argues that Ms. Sweeney “has provided information indicating the public availability of ISDU via IRis, a database that Northeastern maintained, by” November 2013. Mot. 2. This is inaccurate. In fact, Ms. Sweeney *speculated* that the data showing 24 downloads in a month were public downloads. See Ex. 1024, 5 (Ms. Sweeney stating that “[t]here would be no reason for library staff to download the

ISDU paper 24 times in a month, as indicated in the email, so I feel pretty confident saying that the file was public in IRis by December 2013.”). And speculation by a lay witness is disallowed under the Federal Rules where not based upon personal knowledge. Fed. R. Evid. 602, 701. Exhibit 1024 should be excluded in full because it is irrelevant, unreliable, *not* based on personal knowledge, and improperly provides (unsupported) expert testimony. *See* Fed. R. Evid. 402, 403, 601, 801.

Dated: December 17, 2024

/R. Scott Johnson/

R. Scott Johnson

Reg. No. 45,792

*Counsel for Patent Owner Intirion
Corporation*

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(a)(1)(i), the undersigned hereby certifies that the foregoing Patent Owner's Motion to Exclude Petitioner's Evidence Under 37 C.F.R. § 42.64 contains 2,850 words, as measured by the word-processing system used to prepare this paper, and is under 15 pages.

Dated: December 17, 2024

/R. Scott Johnson/

R. Scott Johnson
Reg. No. 45,792

*Counsel for Patent Owner Intirion
Corporation*

CERTIFICATE OF SERVICE

Per agreement of the parties and pursuant to 37 C.F.R. ¶ 42.105(b), the undersigned certifies that a copy of this Patent Owner's Motion to Exclude Petitioner's Evidence Under 37 C.F.R. § 42.64 was served on December 17, 2024, by email on the following:

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