

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLLEGE PRODUCTS, INC.
Petitioner,

v.

INTIRION CORPORATION
Patent Owner

Case PGR2024-00003
Patent No. 11,674,745

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

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,674,745 (“Patent”)
1002	Expert Declaration
1003	Prosecution File History, U.S. Patent No. 11,674,745
1004	Original Intirion Complaint Filed on June 8, 2022.
1005-1007	RESERVED
1008	U.S. Application No. 14/262,290 (“the ’290 Application”), published as U.S. Publication 2014/0251982.
1009	Exemplary embodiment Claim chart 1 sent by Intirion related to U.S. Patent No. 11,274,876
1010	RESERVED
1011	U.S. Application No. 12/317,632 (“the ’632 Application”) published as U.S. Publication U.S. Pub. 2009/0188911 (“Emma”)
1012	“ISDU: Integrated Smoke detector Unit for Commercial Microwave Ovens”, Cory Lloyd <i>et. al</i> , Northeastern University (2007). (“ISDU”)
1013	RESERVED
1014	U.S. Patent No. 4,496,817 to Smith (“Smith”)
1015	U.S. Patent No. 8,446,048 to Butt (“Butt”)
1016	Redline Comparison between 290 and Emma
1017-1019	RESERVED
1020	U.S. Application No. 13/094,747 (“the ’747 Application”) published as U.S. Publication U.S. Pub. 2012/0276763A1 (“Quezada”)
1021	Scheduling Order for <i>Intirion Corporation v. College Products, Inc.</i> , 5:23-cv-04023-KEM, Dkt. 75.
1022	Amended Complaint filed by Intirion Corporation, 5:23-cv-04023-KEM, Dkt. 62.

Exhibit No.	Description
1023	Supplemental Expert Declaration related to the 11,674,745 Petition
1024	Email correspondence between counsel for Petitioner and Northeastern University
1025	Claim construction order from <i>Intirion Corporation v. College Products, Inc.</i> , No. 5:23-cv-04023-CJW-KEM (N.D. Iowa May 31, 2024)
1026	Email from the Board, dated August 12, 2024, authorizing Petitioner to file the district court's <i>Markman</i> Order as an exhibit
1027	Deposition Transcript of Emad Y. Tanbour, Ph.D, dated September 13, 2024, and Errata Sheet

Petitioner submits this opposition to Patent Owner's Motion to Exclude Petitioner's Evidence under 37 C.F.R. § 42.64 ("Motion").

Patent Owner mischaracterizes the declarations submitted by Petitioner's expert Dr. Horenstein. It then asks this Board to exclude wholesale almost the entirety of those declarations, without providing any valid reason for doing so, or in several instances, no reason at all. It also asks this Board prematurely weigh evidence, assess credibility, and make merits determinations. Patent Owner's Motion is baseless, improper, highly prejudicial, and clearly intended to hinder Petitioner's ability to assert its invalidity challenges. The Motion should be denied.

Ex. 1002

Patent Owner asks the Board to exclude Dr. Horenstein's original declaration because Dr. Horenstein provides opinions about patents not challenged in this proceeding and about the publication of ISDU. Motion at 3-5. Neither of Patent Owner's requests have merit.

By way of background, Petitioner submitted in this proceeding two declarations. Exhibit 1002 is a declaration submitted by Petitioner's expert Dr. Horenstein ("Original Declaration") in prior *inter partes* review proceedings challenging U.S. Patent Nos. 9,791,206 ("the '206 Patent"), 10,495,374 ("the '374 Patent"), and 11,274,876 ("the '876 Patent") (collectively, the "Related Patents"). U.S. Patent No. 11,674,745 ("the '745 Patent") at issue in this proceeding is a

continuation-in-part of the '206 and '374 Patents and a continuation of the '876 Patent. Ex. 1001 at (63). As such, it discloses the same subject matter as the Related Patents plus additional new matter. Dr. Horenstein's opinions in the Original Declaration include the field of art, level of skill in the art, understanding of legal standards, claim construction, technology background, understanding of the disclosures in the Related Patents, understanding of prior art references, etc. *See, e.g.*, Ex. 1002, ¶¶20-67, 93-117, 126. All topics that equally apply to the '745 Patent at issue here. Thus, Dr. Horenstein's opinions in his Original Declaration are undeniably relevant in this proceeding.

In addition, Dr. Horenstein submitted a supplemental declaration in this proceeding ("Supplemental Declaration") that includes opinions specific to the new matter in the '745 Patent and the invalidity challenges to the '745 Patent claims. As it is a Supplemental Declaration, it necessarily incorporates his opinions from the Original Declaration. The Petition cites to *both* the Original Declaration and Supplemental Declaration for support. *See, e.g.*, Petition at 8-11.

Patent Owner argues that certain paragraphs¹ in the Original Declaration are

¹ Those paragraphs include ¶¶ 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.

inadmissible because they include opinions about the '206 Patent. Motion at 3-4. That is a mischaracterization. While some of the identified paragraphs include opinions about the Related Patents, several of the paragraphs Patent Owner seeks to exclude include, for example, opinions about Dr. Horenstein's bases for opinions (*see, e.g.*, Ex. 1002, ¶18), understanding of the law (*see, e.g., id.*, ¶¶23, 27, 43, 94), the field of art and the level of skill in the art (*see, e.g., id.*, ¶¶48-53), technology background (*see, e.g., id.*, ¶¶53-63), the prior art, including ISDU, a prior art reference in this proceeding, and disclosure of the same or similar limitations in both the '745 Patent and the Related Patents (*see, e.g., id.*, ¶¶64-67, 93, 95-100, 103, 129-131, 136, 141-42, 150-53), and claim construction (*see, e.g., id.*, ¶¶117, 126). As discussed above, those topics and Dr. Horenstein's opinions on them are relevant. As for the paragraphs discussing the Related Patents, the Board may decide how much weight, if any, to give them in the final written decision. A motion to exclude is not the proper vehicle for addressing the weight evidence should be given. Board's Consolidated Trial Practice Guide ("TPG") at 79. Thus, Patent Owner's argument to exclude the paragraphs of the Original Declaration that are identified in footnote 1 of the Motion is meritless and should be rejected.

Patent Owner also claims that Dr. Horenstein "offered opinions regarding the public availability of the ISDU reference." Motion at 4 (citing Ex. 1002, ¶¶ 96-98, 159-161, 168-170, 217, 224-225, 252-253, 261, 262, 274, 279, 290, 296, Appendix

B, Appendix C, Appendix D). That is not true. Dr. Horenstein did not offer an expert opinion that ISDU was published on April 17, 2007. Rather, he reviewed ISDU and the Northeastern University library information and documents, and based on those materials, he understood ISDU was published before the '745 Patent's priority date. Ex. 1002, ¶¶96-97. In other words, he assumed ISDU was prior art for purposes of his invalidity analysis. *See id.* As a person of ordinary skill in the art, he then offered expert testimony about why the challenged claims are invalid in view of ISDU when combined with the other prior art references identified in the Petition. *See, e.g.,* Ex. 1023, ¶¶76, 82-83, 106-112, 130-140. Because Dr. Horenstein did not offer any expert opinions about ISDU's publication date, Patent Owner's request to exclude the paragraphs of the Original Declaration that are identified in footnote 2 of the Motion is baseless and should be denied.

Ex. 1004

Patent Owner asks the Board to exclude Intirion's original complaint for patent infringement because Patent Owner claims it is irrelevant as it is no longer the operative complaint in the district court and litigation and uncited. Motion at 5. Patent Owner is wrong. The complaint is relevant because it provides background information on the procedural history of the parties' dispute in related matters, including the timeline of the parallel district court litigation. The Board may decide what weight to give that relevant evidence in its final written decision. Thus, Patent

Owner's request to exclude the complaint (Ex. 1004) should be denied.

Ex. 1009

Patent Owner asks the Board to wholesale exclude its own claim chart for claim 1 of the '876 patent because that patent is not challenged here and has different claims. *Id.* at 5-6. Patent Owner is again asking the Board to exclude relevant evidence.

As discussed above, the '745 patent is a continuation of the '876 patent. *See* Ex. 1001 at (63). Petitioner relied on the '876 claim chart to show how Patent Owner interpreted the terms "level of smoke" and "amount of smoke" in the parallel district court litigation. Petition at 13 (citing Ex. 1009 at 6). Patent Owner does not disagree with Petitioner's understanding of Patent Owner's construction of those terms. The '876 claim chart is relevant here because the terms "level of smoke" and "amount of smoke" are also in the challenged claims of the '745 patent. Ex. 1001 at cl. 1, 15, 24. Because the '745 patent is a continuation of the '876 patent, common claim terms should be interpreted the same. In its Petition, Petitioner showed the challenged claims of the '745 patent are invalid even if Patent Owner's incorrect construction of those terms is adopted. *See generally* Petition. Although the '876 claim chart includes sections not related to the terms at issue in this proceeding, the Board may ignore those sections. Thus, because the '876 claim chart includes relevant evidence and Patent Owner does not disagree with Petitioner's

understanding of that evidence, there is no basis to exclude the claim chart and Patent Owner's request to do so should be rejected.

Ex. 1012

Patent Owner asks the Board to exclude ISDU as a prior art reference because College Products' evidence of publication is "not credible." Motion at 6-7. This request is facially improper. The Board cannot make credibility determinations or weigh evidence on a motion to exclude. TPG at 79. That should be abundantly clear to Patent Owner when not one of the decisions its motion relies on pertains to a motion to exclude. Motion at 7.

The Petition set forth evidence of prior publication, including as Patent Owner concedes, (i) the April 2007 date printed on the title page of the reference, (ii) the reference's cover page showing that ISDU was input into and published on the IRis digital archive in April 2007, (iii) information about the IRis's publishing practices, including the IRis Brochure, and (iv) date of 2007 in the "Recommended Citation" on the reference's cover page. *See, e.g.*, Petition at 20. Whether that evidence is sufficient to prove ISDU is prior art is an issue that must be decided in the Board's final determination, not in an exclusion order. *See* TPG at 79 ("A motion to exclude ... may not be used to challenge the sufficiency of the evidence to prove a particular fact."). Patent Owner's motion to exclude ISDU is improper and should be denied.

Ex. 1023

A. Paragraphs Referencing Dr. Horenstein's Original Declaration

Patent Owner argues dozens of paragraphs in the Supplemental Declaration should be excluded because they purportedly “whole-sale” incorporate by reference paragraphs from the Original Declaration “covering *different* patents.” Motion at 9 (emphasis in original). As explained below, Petitioner’s argument is baseless, mischaracterizes the record, and is clearly brought to prejudice Petitioner from presenting its invalidity challenges in this proceeding.

First, Patent Owner’s argument is baseless because the Original Declaration and the Supplemental Declaration are *both* part of the record in this proceeding. No laws or rules bar Petitioner from relying on two declarations. The Supplemental Declaration incorporates opinions from the Original Declaration, but there is nothing unusual about that because the Supplemental Declaration does not replace the original declaration, it supplements it. Patent Owner argues the Supplemental Declaration “runs afoul” of 37 C.F.R. § 42.6(a)(3) which states “Arguments must not be incorporated by reference from one document into another document.” *Id.* (emphasis omitted). That regulation is irrelevant here. Dr. Horenstein’s Original and Supplemental Declarations are both of record, both cited in the Petition, and they are expert opinions, not “arguments.” Patent Owner also argues these paragraphs do not satisfy 37 C.F.R. § 42.65(a) because they are not supported by

underlying facts or opinion “in Exhibit 1023 itself.” *Id.* at 10. That regulation does not state an expert’s declaration has to be supported by underlying facts or opinions “in the [declaration] itself.” 37 C.F.R. § 42.65(a). Patent Owner is adding language to the regulation and, in any event, its argument is meritless. Expert declarations commonly rely on extrinsic evidence, such as publications, common knowledge, etc.

Second, Patent Owner’s motion to exclude seems pointless because the Petition cites to the Original Declaration. By way of example, Patent Owner moves to exclude paragraphs 19, 53, and 72 of the Supplemental Declaration, which incorporate by reference paragraphs 64-92, 284-285, and 289-90, respectively, of the Original Declaration. Yet, the Petition cites, for example, paragraphs 64-67, 285, and 289-90 from the Original Declaration. *See e.g.*, Petition at 8-11, 29, 46. Thus, even if the Board excluded paragraphs 19, 53, and 72 from the Supplemental Declaration, the opinions from the Original Declaration are still in the record and properly relied upon.

Third, Patent Owner’s identification of dozens of paragraphs in the Supplemental Declaration for exclusion is arbitrary and clearly aimed to prejudice and harass Petitioner.

- Paragraphs 1 and 4 of the Supplemental Declaration are merely prefatory paragraphs, where Dr. Horenstein explains his competence to make his opinions, explain the Supplemental Declaration is a

supplement to the Original Declaration, not a replacement, and identifies what information he relied on in forming his opinions. Ex. 1023, ¶¶1, 4. Nothing about those paragraphs incorporates any substantive opinions.

- Paragraphs 6-8 10, 15, 19, 37-39, and 48 of the Supplemental Declaration relate to background information, like the understanding of a POSITA, claim construction law and background, the field of the patents, technology background, the disclosures in the Related Patents, the state of the art, and summary of relevant prior art references. *Id.*, ¶¶6-8, 10, 15, 19, 37-38, 48. Dr. Horenstein does not need to repeat these same opinions in his Supplemental Declaration, nor can Patent Owner seriously claim any prejudice when these opinions are fully laid out in his Original Declaration of record. In fact, in some of these paragraphs, like paragraphs 37-38 on the state of the art, Dr. Horenstein actually repeats his opinion in full and does not merely incorporate the Original Declaration. *Id.*, ¶¶37-38.
- Remaining Targeted Paragraphs:² In the bulk of these paragraphs, Dr.

² Paragraphs 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

Horenstein refers to or cites excerpts from his Original Declaration, but he does not incorporate them by reference. Rather, he provides a separate opinion. *See e.g., id.*, ¶¶65, 81, 203-209. In several other paragraphs, Dr. Horenstein refers to his Original Declaration, but then explains the opinion therein. *See e.g.,* ¶¶58, 62, 65, 74-75. In paragraph 136, Dr. Horenstein incorporates by reference sections in the Supplemental Declaration itself, not opinions from his original declaration. *Id.*, ¶136. Similarly, in paragraph 174, Dr. Horenstein does not incorporate anything by reference, rather he quotes an excerpt from a prior art reference that uses the word “incorporated.” *Id.*, ¶174. In other paragraphs, Dr. Horenstein does not mention or cite his Original Declaration at all. *See e.g., id.*, ¶¶193,196. These examples show Patent Owner arbitrarily selected paragraphs to identify for exclusion, including by simply keyword searching for the word “incorporate.”

For all these reasons, the Board should deny Patent Owner’s motion to exclude.

B. References to Appendices F-H

Patent Owner moves to exclude all paragraphs that refer to Appendices F-H, because these appendices were purportedly not attached to the Supplemental Declaration. Motion at 10. Patent Owner is correct that Petitioner did not attach

Appendices F-H to the Supplemental Declaration. But that is not a basis for exclusion.

Appendix F is Dr. Horenstein's C.V. It is not cited in any paragraphs of the Supplemental Declaration. Moreover, Dr. Horenstein's C.V. is of record as it is attached as Appendix A to the Original Declaration.

Appendix G is a publicly available battery charging specification, identified in the Supplemental Declaration with complete citation as "Battery Charging Specification, Revision 1.1, April 15, 2009, USB Implementers Forum, Inc." Appendix H is also a publicly available article, identified in the Supplemental Declaration as "Apple Introduces the New iPod," Press Release, July 19, 2004. The only paragraph in the Supplemental Declaration that cites these appendices is paragraph 131. Dr. Horenstein cited to those publications merely to corroborate his opinion that USB ports were prolific as charging ports well before the time of the invention. Ex. 1023, ¶131. Patent Owner's motion to exclude paragraph 131 is improper for at least the following reasons.

First, paragraph 131 includes numerous opinions that are not dependent on Appendices G-H, including Dr. Horenstein's opinions on why a POSITA would be motivated to combine the Emma reference with other prior art or the knowledge of a POSITA. *See id.* It would be improper for the Board to exclude the whole of paragraph 131 merely because Dr. Horenstein cites Appendices G-H to support a

subset of statements.

Second, Dr. Horenstein refers to Appendices G-H simply to corroborate his opinion that USB ports were prolific as charging ports well before the priority date. *See id.* His opinions are not unreliable just because the Appendices were not attached. It is common for experts to rely on background information to inform their opinions, including common knowledge. It is common knowledge that USB ports were being used to charge cell phones long before 2014. Neither Patent Owner nor its expert disagree with that, nor could they seriously do so. The Board can weigh Dr. Horenstein's opinion without the Appendices.

Third, Appendices G-H are publicly available articles and the Supplemental Declaration provides complete citations for these documents. These publications are not difficult to access. They are available for free online, and easily accessible as the first link that appears in a Google search result. Thus, Patent Owner cannot seriously claim any prejudice.

For these reasons, the Board should deny Patent Owner's motion to exclude paragraph 131 of the Supplemental declaration.

C. Paragraphs Referencing Figaro Sensor

Patent Owner asks the Board to exclude paragraphs referencing a typographical error in prior art reference Smith. Motion at 10-11. The only paragraphs Patent Owner identifies is paragraph 205 of the Supplemental

Declaration and paragraphs 167-169 of the Original Declaration. *Id.* Patent Owner's request should be denied for at least the following reasons.

First, the four paragraphs identified by Patent Owner include several opinions beyond Dr. Horenstein's mention of a typographical error, including several opinions about what Smith teaches. Ex. 1023, ¶205; Ex. 1002, ¶¶167-169. Patent Owner's attempt to have those paragraphs excluded in their entirety is facially improper.

Second, within the four identified paragraphs, Dr. Horenstein concludes that Smith's disclosure included a typographical error in the model number of a Figaro smoke sensor. That opinion was based on his review of Smith combined with the publicly available model numbers offered by Figaro in a product sheet. Patent Owner argues the "typo" opinions should be excluded because Petitioner has not established the product datasheet is prior art nor offered a witness to authenticate the document. *Id.* That argument is baseless. As an initial matter, whether the product data sheet is prior art itself is irrelevant; it is not an alleged prior art reference. Documents published *after* a priority date can be used to corroborate what was disclosed *before* the priority date, like prior art. *See, e.g., Disney Enters., Inc. v. Kappos*, 923 F. Supp. 2d 788, 801 (E.D. Va. 2013) ("Publications published after the date of invention have long been allowed 'as evidence of the state of the art existing on the filing date of an application.'") (quoting *In re Hogan*, 559 F.2d 595, 605 & n. 17 (C.C.P.A. 1977)). Indeed, in its Institution Decision, the Board relied on the

datasheet to confirm a POSITA's understanding of the prior art. Institution Decision at 28. That aside, yet again, Patent Owner is improperly using a motion to exclude as a vehicle to have the Board weigh evidence and assess the credibility of Petitioner's expert. *See* TPG at 79.

For the foregoing reasons, the Board should deny Petitioner's request to exclude paragraphs 167-169 of the Original Declaration and paragraph 205 of the Supplemental Declaration.

D. Paragraphs Referencing ISDU

Patent Owners asks the Board to exclude all paragraphs of Dr. Horenstein's declaration that refer to ISDU because ISDU is purportedly "not prior art." Motion at 11. As explained above in connection with Ex. 1012, Patent Owner's request to exclude ISDU or opinions related thereto is improper because it asks the Board to weigh the evidence pertaining to publication and prematurely rule on the merits of Petitioner's invalidity challenge.

Ex. 1024

Patent Owner requests the Board exclude Exhibit 1024 (hereafter "the Northeastern Email") because it is purportedly insufficient evidence to establish the publication date of the ISDU reference. *Id.* at 11-13. Patent Owner's request to exclude the Northeastern Email is misplaced and meritless. The Northeastern Email is not evidence Petitioner relied on to establish a publication date for the ISDU

reference. Rather, that email chain was introduced into the record to respond to Patent Owner's objection that Petitioner failed to establish a publication date for the ISDU. That email chain showed the University believed the ISDU reference was published well before the priority date, but the University would not provide a formal declaration without a third party subpoena. Ex. 1024. Petitioner relied on the Northeastern Email to seek leave from the Board to take third party discovery of Northeastern University. Paper 17. The Board denied Petitioner leave to take that discovery. Paper 27. Petitioner reserves the right to appeal that decision, including that good cause exists for that discovery based on the Northeastern Email.

* * *

For the foregoing reasons, Petitioner respectfully request the Board deny Patent Owner's motion to exclude.

Dated: December 23, 2024

Respectfully submitted,

/Domingo M. LLagostera/
Domingo M. LLagostera
Reg. No. 70,684
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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e), the undersigned certifies that a copy of the foregoing **PETITIONER’S OPPOSITION TO PATENT OWNER’S MOTION TO EXCLUDE PETITIONER’S EVIDENCE UNDER 37 C.F.R. §42.64** was served on counsel of record on December 23, 2024, by electronic mail at the following address, as authorized by Patent Owner in its Mandatory Notices:

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