

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner

v.

VISUAL REAL ESTATE, INC.
Patent Owner

Case IPR2014-01341
Patent 8,078,396

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

Petitioner Google Inc. (“Petitioner”) submits this Response in Opposition to Patent Owner’s Motion to Exclude Evidence Under 37 C.F.R. § 42.64, dated September 25, 2015 (“September 25 Motion”). Because Patent Owner has failed to provide legally sufficient objections under the Federal Rules of Evidence (FRE), its Motion to Exclude should be denied.

Exhibit 1001: Declaration of Dr. Fuchs

Patent Owner moves to exclude paragraphs 12, 16, 39, 40, 47, 50, 52-70 of Exhibit 1001 under FRE 402, 403, 702, 703, 802, 901, and 903 as allegedly lacking “[a]uthentication,” being outside “the declarant’s purported area of expertise” and being directed toward grounds for which “the Board did not institute review.” Patent Owner’s arguments with respect to paragraphs 12, 16, 39, 40, 47, 50, 52-70 of Exhibit 1001 are all directed to the weight of the evidence, not the admissibility of the evidence, and thus are improper in this motion and should be denied. *Liberty Mutual Inc. Co. v. Progressive Casualty Inc. Co.*, CBM2012-00002, Paper 66 at pp. 61-62 (PTAB January 23, 2014). And Patent Owner’s request with respect to paragraphs 12, 16, 39, 40, 47, 50, 52-70 of Exhibit 1001 is improper for the reasons discussed below, and should be denied.

Regarding paragraphs 12, 16, 39, 40, 47, 50, 62, 63, and 66 of Exhibit 1001, the opinions recited therein rely on Dr. Fuch’s “specialized knowledge” as it

applies to “understand[ing] the evidence” and “is the product of reliable principles and methods” as outlined in paragraphs 12, 16, 39, 40, 47, 50, 62, 63, 66, and the rest of Exhibit 1001. *See* FRE 702. The Motion fails to identify any proper evidentiary basis for exclusion of paragraphs 12, 16, 39, 40, 47, 50, 62, 63, and 66 under the FRE, such as relevance, failure to qualify as expert witness testimony, hearsay, lack of authentication, etc. Rather, Patent Owner’s argument goes to “the sufficiency of the evidence to prove a particular fact” rather than explaining why the evidence is not admissible. *See Liberty Mutual*, Paper 66 at p. 61 (PTAB January 23, 2014). The Board here ruled in the Order Denying Patent Owner’s Request for Authorization to File a Motion (Paper 26) that the Board is “capable of weighing the credibility of the evidence” and is “well-positioned to review the evidence and arguments of record [to] assign [the Exhibits] the appropriate weight in making a final determination as to the patentability of the challenged claims.” Paper 26 at p. 4; *see also Kinik Co. v. Chien-Min Sung*, IPR2014-01523, Paper 21 at p. 2 (PTAB Aug. 5, 2015) (“The Board is capable of assessing” the “proper weight to be accorded the testimony of Petitioner’s expert.”). Patent Owner’s arguments with respect to paragraphs 12, 16, 39, 40, 47, 50, 62, 63, and 66 of Exhibit 1001 are directed to the weight of the evidence—not the admissibility of

the evidence—and thus are improper and should be denied. These paragraphs of the Fuchs Declaration are properly admissible under the FRE.

Regarding paragraphs 52-70, which relate to Dr. Fuchs’s application of the Akbarzadeh reference to the ’396 patent, and other “portions of Ex. 1001” where “Declarant references [the] Akbarzadeh article,” Patent Owner’s arguments similarly are not directed toward the admissibility of these paragraphs and Patent Owner has cited no authority that would establish these paragraphs are inadmissible under the FRE. The Board is “capable of weighing the credibility of the evidence” and is “well-positioned to review the evidence and arguments of record [to] assign [the Exhibits] the appropriate weight in making a final determination as to the patentability of the challenged claims.” Paper 26 at p. 4; *see also Kinik*, Paper 21 at p. 2 (“The Board is capable of assessing” the “proper weight to be accorded the testimony of Petitioner’s expert.”). Additionally, paragraphs 67-70 do not address the Akbarzadeh article, but rather indicate “reliable principles and methods” used by Dr. Fuchs in forming his opinions and are therefore admissible. *See* FRE 702. Paragraphs 52-70 are relevant and meet the requirements for expert witness testimony and are therefore admissible under the FRE.

Exhibit 1006: Akbarzadeh Article

Patent Owner moves to exclude Exhibit 1006 (the “Akbarzadeh Article”) because the Board allegedly did not rely upon Exhibit 1006 in the Decision instituting *Inter Partes* Review. This objection, however, has no basis under the FRE and Patent Owner has cited no authority for this exclusion. Because it has no evidentiary basis, this request for exclusion should be denied.

Moreover, Exhibit 1006 need not be excluded as the Board is “capable of weighing the credibility of the evidence” and is “well-positioned to review the evidence and arguments of record [to] assign [the Exhibits] the appropriate weight in making a final determination as to the patentability of the challenged claims.” Paper 26 at p. 4; *see also Kinik*, Paper 21 at p. 2 (“The Board is capable of assessing” the “proper weight to be accorded the testimony of Petitioner’s expert.”). Additionally, the Board has ruled that when an expert “reviewed these exhibits in reaching the opinions he expressed in this case” and the “exhibits are evidence relied upon by Petitioner to support its assertions with respect to the state of the art” the evidence is relevant. *Apple Inc. v. Smartflash LLC*, CBM2014-00108, Paper 50 at pp.19-20 (PTAB Sept. 25, 2015) Here, Dr. Fuchs properly relied on Exhibit 1006 in forming opinions recited in his Declaration (Ex. 1001) and therefore Exhibit 1006 is admissible. *See* Ex. 1001 at ¶¶ 9, 51-66.

Exhibit 1012: Responsive Declaration of Dr. Grindon

Patent Owner moves to exclude paragraphs 9, 10, 12, 13, 17, 18, 20, 22 of Exhibit 1012 under FRE 402, 403, 702, and 703, as allegedly failing to “have been included as part of Petitioner’s original petition,” as allegedly being based on a “definition of ‘a person of ordinary skill in the art’ [that] is different than the one proposed by Petitioner’s original expert,” as allegedly being “incomplete and inconclusive,” and as allegedly “containing speculative and conclusory statements.” As an initial matter, the Board ruled in the Order Denying Patent Owner’s Request for Authorization to File a Motion (Paper 26) that the Board is “capable of weighing the credibility of the evidence” and is “well-positioned to review the evidence and arguments of record [to] assign Exhibit [1012] the appropriate weight in making a final determination as to the patentability of the challenged claims.” Paper 26 at p. 4. Patent Owner’s arguments with respect to paragraphs 9, 10, 12, 13, 17, 18, 20, 22 of Exhibit 1012 are directed to the weight of the evidence—not the admissibility of the evidence—and thus are improper and should be denied.

Regarding paragraph 13 of Exhibit 1012, this paragraph merely indicates “reliable principles and methods” used by Dr. Grindon in forming his opinions and is therefore admissible and does not address any new issues “not included in

Petitioner's original petition." Paragraph 13 simply expresses that "one of ordinary skill in the art would view the references cited herein in their entirety and in combination with other references cited herein and cited within the references themselves," a sentiment already expressed by Dr. Fuchs in his original declaration. *See* Ex. 1012 at ¶ 13; Ex. 1001 at ¶ 10.

Regarding paragraphs 17, 18, and 20 of Exhibit 1012, each of these paragraphs is directly responsive to portions of the Patent Owner's Response. As the Board has recognized, "[t]he very nature of a reply is to rebut the patent owner's response" and "[m]uch depends on the specific arguments made in the patent owner response." *Ford Motor Co. v. Paice LLC & The Abell Foundation, Inc.*, IPR2014-00579, Paper 45 at p. 29 (PTAB Sept. 28, 2015). Indeed, each of paragraphs 17 and 20 of Exhibit 1012 explicitly identifies the specific portions of the Patent Owner's Response to which they respond while paragraph 18 serves as a continuation of the discussion of paragraph 17 and is therefore responsive to the same portions of the Patent Owner's Response as paragraph 17:

- "VRE mischaracterizes my previous testimony by stating that I admitted that Di Bernardo 'teaches against adding computational overhead to its system' and 'teaches not to perform 3D reconstruction

of scenes as being costly and inefficient.’ **See Resp. at pp. 4, 9-10, 19-21.**” Ex. 1012 at ¶ 17 (emphasis added).

- “VRE asserts that Fruh does not disclose ‘generating a composite image ... wherein the portions are aligned in a dimension consistent with the continuum.’ **See Resp. at pp. 15-17.**” Ex. 1012 at ¶ 20 (emphasis added).

Additionally, Patent Owner’s arguments for moving to exclude these portions of the testimony in Exhibit 1012 ignores well-known and frequent holdings from the Board that “a motion to exclude is not a proper vehicle for a party to raise the issue of testimony in a rebuttal declaration exceeding the permissible scope of reply testimony.” *Chicago Mercantile Exchange, Inc. v. 5th market, Inc.*, CBM2014-00114, Paper 35 at p. 52 (PTAB Aug. 18, 2015); *see also Vibrant Media Inc. v. General Electric Co.*, IPR2013-00170, Paper 56 at p. 31 (PTAB June 26, 2014) (“Whether a reply contains arguments or evidence that are outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to our determination.”); *Liberty Mutual*, Paper 66 at p. 62 (“a motion to exclude . . . is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make out a prima facie case.”). Indeed, in *Chicago Mercantile Exchange*, the Board found that as long as expert declaration testimony submitted

with a Petitioner's Reply "is responsive to . . . arguments or evidence raised in the patent owner response," the declaration testimony is admissible. *Chicago Mercantile Exchange*, Paper 35 at pp. 59-60; *see also Apotex Corp. v. VIV Healthcare Co. and VIV Healthcare UK LTD.*, IPR2014-00876, Paper 39 at p. 3 (PTAB June 25, 2015) (holding that "there was no need for Patent Owner to file a sur-reply to Petitioner's Reply" because the Board "will determine whether a reply and accompanying evidence are outside the scope of a proper reply and evidence when the parties' briefs are reviewed and the final written decision is prepared.")). Here, in each of paragraphs 17, 18, and 20 of Exhibit 1012, Dr. Grindon offers testimony that is in direct response to issues raised by the Patent Owner in the Patent Owner's Response and therefore do not exceed the permissible scope. Paragraphs 17, 18, and 20 are admissible under the FRE.

Regarding paragraphs 9, 10, and 12 of Exhibit 1012, Patent Owner alleges that paragraphs 9, 10, and 12 provide a "definition of 'a person of ordinary skill in the art' [that] is different than the one proposed by Petitioner's original expert." Here too, Patent Owner is making a substantive argument rather than raising a proper basis to exclude under the FRE. As such, this assertion should be disregarded and the motion to exclude these paragraphs denied.

Moreover, Patent Owner is improperly elevating form over substance—demanding a verbatim or an *ipsissimis verbis* test between paragraph 16 of Dr. Fuchs’ Declaration (Exhibit 1001) and paragraph 12 of Dr. Grindon’s declaration (Exhibit 1012)—even though the law does not require such a test. Patent Owner ignores that paragraph 16 of Dr. Fuchs’ Declaration (Exhibit 1001) and paragraph 12 of Dr. Grindon’s Declaration (Exhibit 1012) describe, in fact, the same type of skill level for the purposes of this proceeding, and most certainly establish that both Dr. Fuchs and Dr. Grindon are qualified to testify in this proceeding. Further, Patent Owner’s assertion that Dr. Fuchs and Dr. Grindon relied on different definitions of “a person of ordinary skill in the art” erroneously assumes that “electrical engineering” does not qualify as a “related engineering field” (listed in paragraph 16 of Dr. Fuchs’ Declaration) to the areas of computer science, computer graphics, and imaging technology. Paragraphs 9, 10, and 12 are admissible under the FRE.

Regarding paragraph 22, Patent Owner argues that Exhibit 1012 is “incomplete and inconclusive since Declarant states that he has not completed his analysis or acquired all the necessary information to form his opinion.” Patent Owner’s arguments here are erroneous and furthermore address the sufficiency of the evidence rather than the admissibility of it. To be clear, paragraph 22 of

Exhibit 1012 merely indicates that Dr. Grindon's opinions were formed based on knowledge he had at that time and that it is possible that other relevant materials *may* exist and that such materials, if in existence, *may* cause him, at some future time, to "attain supplemental insights that may result in added observations." Ex. 1012 at ¶ 22. Patent Owner did not identify a single statement in Dr. Grindon's Declaration that is allegedly "incomplete" or identify any "necessary information" that was not before Dr. Grindon when forming his opinions. Paragraph 22 is admissible under the FRE, and nothing in Patent Owner's motion to exclude establishes otherwise.

Next, Patent Owner argues in its motion that Paragraph 18 should be "entitled to little or no weight." First, "a motion to exclude . . . is not an opportunity to file a sur-reply" and Patent Owner's arguments regarding paragraph 18 are clearly directed toward "sufficiency of the evidence to prove a particular fact" rather than an explanation as to "why the evidence is not admissible." *Liberty Mutual*, Paper 66 at pp. 61-62.

Second, Dr. Grindon's direct testimony in Exhibit 1012 plainly states that his analysis is based upon his "knowledge and experience" in this field, and courts have long recognized that testimony based on an expert's experience is proper and reliable under FRE 702. *Metavante Corp. v. Emigrant Sav. Bank*, 619 F.3d 748,

761 (7th Cir. 2010) (“An expert’s testimony is not unreliable simply because it is founded on his experience rather than on data.”). “An expert may base his opinion on experience alone, and [arguments critical thereof] implicate the weight of the evidence, rather than its admissibility.” *Figueroa v. Boston Scientific Corp.*, 254 F. Supp. 2d 361, 368 (S.D.N.Y. 2003); *see also Mobile Med. Int’l Corp. v. Advanced Mobile Hosp. Sys., Inc.*, Case No. 2:07-CV-231, 2015 WL 778553, at *5 (D. Vt. Feb. 24, 2015) (holding that an expert’s opinions were “admissible to the extent they are based upon his specialized knowledge of the relevant time period, and he will not be disqualified for lack of reliability.”). Furthermore, the Board has recognized that, as provided by FRE 703, “[a]n expert may base an opinion on facts or data in the case that the expert has been made aware of or personally observed. If experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion on the subject, ***they need not be admissible for the opinion to be admitted.***” *Corning Inc. v. DSM IP Assets B.V.*, IPR 2013-00043, Paper No. 97 at p. 7 (PTAB May 1, 2014) (quoting FRE 703) (emphasis added). Also, Patent Owner’s objections ignore the fact that Dr. Grindon fully considered Fruh (Ex. 1004 in IPR2014-01341), Yoichi (Ex. 1004 in IPR2014-01338), and other later references that further support Dr. Grindon’s analysis in paragraph 18. *See* Ex. 1012 at ¶¶ 10, 17-18, 20-21; IPR2014-01338; Ex. 1012 at

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¶¶ 10, 21, 28; IPR2014-01341, Ex. 1012 at ¶¶ 10, 17-18, 20-21. In short,
Paragraph 18 is admissible under the FRE.

For the foregoing reasons, Patent Owner's Motion to Exclude should be
denied.

Respectfully submitted,

Dated: October 9, 2015

/Michael Hawkins/
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(Trial No. IPR2014-01341)

Attorney for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on October 9, 2015, a complete and entire copy of this Petitioner's Response in Opposition to Patent Owner's Motion to Exclude Evidence was provided via email to the Patent Owner by serving the correspondence email addresses of record as follows:

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