

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**SILICON LABORATORIES, INC.**  
**Petitioner**

**v.**

**CRESTA TECHNOLOGY CORPORATION**  
**Patent Owner**

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**CASE IPR2015-00626**  
**Patent 7,265,792**

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**PATENT OWNER'S LIST PURSUANT TO PAPER 27**

Mail Stop "PATENT BOARD"  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

CASE IPR2015-00626  
Patent 7,265,792

## **I. Introduction**

Pursuant to the Board's Decision (Paper 27), entered February 29, 2016, Patent Owner Cresta Technology Corporation ("Cresta" or "Patent Owner") submits this List providing the location and a concise description of the portions of Petitioner Silicon Laboratories, Inc.'s ("Silicon Labs" or "Petitioner") Reply (Paper 21) that exceed proper reply scope and/or improperly incorporate arguments by reference, pursuant to 37 C.F.R. §§ 42.6(a)(3) and 42.23(b).

## **II. List of Improper Portions of Petitioner's Reply**

### **A. Page 10, last bullet point of Reply; entirety of Balaban (Ex. 1053)**

This section of the Reply contains an argument relying on an alleged prior art reference, Balaban (Ex. 1053), which was presented to the Board for the first time in the Reply. In this section, Petitioner relies on Balaban to teach the "detecting a carrier signal" claim element in the '626 patent. Reply at 10. However, Balaban was not submitted with the original Petition and was not the basis for any ground of the Board's institution decision. Nor was any argument presented before Petitioner's Reply that Balaban teaches this claim element. Balaban was first presented to Cresta at the deposition of Dr. Ion Opris, after Cresta had filed its Patent Owner Response. When asked if he agreed with Silicon Labs' characterization of Balaban, Dr. Opris testified: "Absolutely not." Ex. 1060

at 61:22. The citation of Balaban is outside the permissible scope of the Reply under 37 C.F.R. § 42.23(b).

**B. Page 2, middle paragraph (section labeled “Carrier Signals”) of Reply; paragraphs 33-44 of Holberg Declaration (Ex. 1061); paragraph 9 of Supplemental Holberg Declaration (Ex. 1063); entirety of IEEE Dictionary (Ex. 1054)**

In this section of the Reply, Petitioner takes a new claim construction position and presents new argument for the term “carrier signal.” Ex. 1054 is a dictionary definition cited in support of the claim construction. Both parties applied only the plain and ordinary meaning of this term in their Petition and Patent Owner Response. Petitioner’s proposed new claim construction is improper because it is not in response to a claim construction position advanced by Patent Owner. 37 C.F.R. § 42.23(b); Trial Practice Guide, part II, § I. The claim construction position is also untimely because it was not provided in the petition. 37 C.F.R. § 42.104(b)(3) (petition must identify “[h]ow the challenged claim is to be construed.” )

Additionally, the corresponding sections (§§ 33-44) of the Holberg Declaration (Ex. 1061), as well as the cited section (§ 9) of the Supplemental Holberg Declaration (Ex. 1063), without supporting material in the Reply itself, constitute an impermissible incorporation by reference under 37 C.F.R. § 42.6(a)(3). For example, Petitioner cites to §§ 42-44 of the Holberg Declaration, three paragraphs spanning two pages, with the accompanying single sentence:

“Thus, both the intrinsic and extrinsic evidence support Petitioner’s reading of this term, while Patent Owner’s position is directly at odds with it.” Reply at 2. There is “no meaningful discussion” of what the cited “testimony” says, so all of the citations to the Holberg Declaration in this section are impermissible incorporation by reference. *See, e.g., CaptionCall, LLC v. Ultratec, Inc.*, IPR2013-00549, Paper 73, at 5-6 (PTAB Dec. 1, 2015) (finding that citation to exhibits “with no meaningful discussion” in the citing document was an improper incorporation by reference).

**C. Page 1, bottom paragraph, through page 2, top paragraph (entire section labeled “Select Signal”) of Reply; paragraphs 14-32 of Holberg Declaration (Ex. 1061); paragraph 8 of Supplemental Holberg Declaration (Ex. 1063)**

This section of the Reply concerns the claim construction of the term “select signal.” Petitioner includes a cursory cite to ¶ 8 of the Supplemental Holberg Declaration, and cites the Holberg Declaration as follows: “The Board should reject this construction because it improperly tries to read into the claim the vague notion of ‘information’ in order to distinguish Zenith’s ‘control’ signal. Holberg Rep., ¶¶ 14-32.” Paragraphs 14-32 of the Holberg Declaration (Ex. 1061) take up 11 and a half pages and contain substantive arguments concerning the proper interpretation of the claim term “select signal” which are not included in the Reply. For example, the following arguments are found in the Holberg Declaration but not in the Reply and constitute improper incorporation by reference under 37 C.F.R. §

42.6(a)(3): claim context arguments (§§ 15-16, 18); specification/written description arguments (§§ 17, 19-21, 30); rebuttal of Dr. Opris' opinion and extrinsic evidence arguments (§§ 22-27), arguments concerning the term "in response to" (§§ 26, 28). *See Shenzhen Huiding Tech. Co., Ltd. v. Synaptics Inc.*, IPR2015-01740, Paper 8, at 32-33 (PTAB Feb. 16, 2016) (finding citation to three pages of expert declaration to be impermissible incorporation by reference where the declaration pages contained "essential material" that should have been included in the main document).

Dated: March 3, 2016

Respectfully submitted,

/s/ Michael R. Fleming

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**CERTIFICATE OF SERVICE**  
**BY ELECTRONIC MAIL**

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 3, 2016, a copy of the foregoing document **PATENT OWNER'S LIST PURSUANT TO PAPER 27** was served by electronic mail, as agreed to by the parties, upon the following:

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/s/ Susan Langworthy  
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