

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SILICON LABORATORIES, INC.
Petitioner

v.

CRESTA TECHNOLOGY CORPORATION
Patent Owner

CASE IPR2015-00626
Patent 7,265,792

PATENT OWNER'S MOTION TO EXCLUDE

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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

Cresta hereby moves to exclude certain portions of the reply declaration of Dr. Douglas Holberg and US Patent 6,369,857 to Balaban (Ex. 1053), for reasons similar to those discussed with regard to striking the portions of Silicon Labs' reply that rely on this evidence in Paper 28.

This motion is made based on objections filed in the record, including the objections filed in Paper 24 on February 18, 2016, and objections made in the conference call with the Board on February 22, 2016 (reflected e.g. in Paper 25). During this call, Cresta objected to and sought to remedy SiliconLabs' untimely disclosure of claim construction positions, untimely reliance on new prior art, and impermissible incorporation by reference of material from one document into another. In its filed objections, Cresta specifically objected to the evidence subject to this motion as irrelevant, prejudicial, and untimely under F.R.E. 401, 402, and 403, 37 C.F.R. 42.23(b), and Trial Practice Guide, part II, § I, (Belated presentation of evidence), and on the grounds that the alleged evidence "includes material not cited in any of Petitioner's substantive papers."

II. Cresta's Motions to Exclude

A. Cresta Moves to Exclude Balaban (Ex. 1053) as irrelevant and not timely presented

Balaban was not submitted with SiliconLabs' Petition. Balaban was not discussed in the Board's institution decision and was not a ground on which IPR

was instituted. In fact, the Board made clear that it granted only three grounds based on specifically enumerated prior art (which did not include Balaban) and "that *inter partes* review is *not instituted* with respect to any other ground of unpatentability." Institution Decision ("ID"), Paper 9 at 27-28. Balaban was not presented as Supplemental Evidence in response to Cresta's objections pursuant to 37 C.F.R. 42.64(b)(2), or as Supplemental Information pursuant to 37 C.F.R. 42.123. As a matter of fact, Balaban was never raised in the IPR before Cresta filed its Patent Owner Response. Rather, SiliconLabs withheld all of its arguments regarding Balaban until well after Cresta had any opportunity to respond, maximizing the unfair prejudice to Cresta. At least because Balaban was never timely presented in the IPR, is not one of the instituted grounds, and Cresta has been denied any opportunity to substantively respond to SiliconLabs' positions, any alleged relevance is substantially outweighed by the unfair prejudice SiliconLab's strategic delays have caused to Cresta.

Petitioner used Balaban to meet one of the claim elements of the challenged claims. Specifically, Petitioner relies on Balaban to teach the "detecting a carrier signal" claim element in the '792 patent. Reply at 10. However, Balaban was not submitted with the IPR 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. SiliconLabs first raised Balaban at the

deposition of Dr. Ion Opris, after Cresta had filed its Patent Owner Response. When asked if he agreed with SiliconLabs' characterization of Balaban, Dr. Opris testified: "Absolutely not." Ex. 1060 at 61:22. But because of SiliconLabs' strategic delay in first presenting its argument in its Reply, Cresta's and Dr. Opris' strenuous disagreement with SiliconLabs' characterizations of Balaban cannot be presented to the Board.

In Paper 29, SiliconLabs seems to acknowledge that its reliance on Balaban to meet a claim element is late and beyond proper Reply scope. Indeed, SiliconLabs' only justification for the untimely and irrelevant submission of Balaban is "[t]his goes to the weight of [Dr. Opris'] testimony." Paper 29 at 2. Not so. Dr. Opris offered testimony in response to patentability positions SiliconLabs took in its Petition. It is not Cresta's or Dr. Opris' burden to scour the universe of prior art and prove patentability. Rather, it is SiliconLab's burden to fully present its unpatentability case in its Petition. No arguments regarding Balaban were advanced by SiliconLabs in its Petition, so there was nothing for Dr. Opris to respond to. That Dr. Opris did not clairvoyantly respond to positions which SiliconLabs never advanced does not at all affect the "weight" that should be afforded his testimony.

The prejudice to both Cresta and the Board is clear. Cresta disagrees with SiliconLabs' mischaracterizations of Balaban. It is also clear from his testimony

that Dr. Opris similarly disagrees. Ex. 1060 at 61:22. Because of SiliconLabs' strategic delays in advancing its arguments and evidence, the Board is presented with only a lopsided mischaracterization of the reference. Still further, Cresta has been denied due process at least because it could not develop the IPR record to adequately reflect the clear patentability of the '792 patent over any combination that includes Balaban. Therefore, any alleged relevance of Balaban is substantially outweighed by unfair prejudice to Cresta, and Ex. 1053 should be excluded under F.R.E. 401/402/403 and/or the PTAB's Trial Practice Guide, part II, § I.

B. Cresta Moves to Exclude paragraphs 33-44 of Holberg's Reply Declaration (Ex. 1061) and paragraph 9 of Supplemental Holberg Declaration (Ex. 1063) as not timely presented and irrelevant because it has never been discussed in a substantive paper

Silicon Labs offered no particular claim construction for "carrier signal" in its Petition. The Board's IPR rules could not be clearer on this point: the Petition **must** "[p]rovide a statement of the precise relief requested for each claim challenged. The statement **must** identify the following: ... (3) How the challenged claim is to be construed." 37 C.F.R. 42.104(b). Rather than follow this rule in its Petition or opening expert declaration, SiliconLabs again withheld its evidence and argument until Reply, well after Cresta would have any opportunity to respond. To further compound the prejudice to the Board, SiliconLabs does not even discuss much of the alleged evidence in its Reply paper. Rather, SiliconLabs effectively granted itself a page-limit extension and presents its untimely evidence only in a

declaration, forcing Cresta and the Board to hunt through the record to even identify the alleged evidence. Such tactics should not be countenanced, and the evidence should be excluded.

Petitioner takes a new claim construction position for the first time in Reply. Both parties applied only the plain and ordinary meaning of this term in their Petition and Patent Owner Response. But now SiliconLabs presents alleged extrinsic evidence, in the form of purported expert testimony and unqualified legal opinion, to support a brand new proposed meaning for "carrier signal." This new claim construction position is explicitly **not** in response to any claim construction position advanced by Cresta. This alleged evidence, which is only offered to provide support for the untimely claim construction, is therefore irrelevant, untimely, and should be excluded.

Just as with Balaban, the prejudice to Cresta and the Board is clear. Cresta has not been able to respond to SiliconLabs' alleged evidence, and the Board is again left with a lopsided record. Any alleged relevance of these paragraphs of Dr. Holberg's reply declarations is substantially outweighed by unfair prejudice to Cresta, and they should be excluded under F.R.E. 401/402/403 and/or the PTAB's Trial Practice Guide, part II, § I.

Additionally, the corresponding sections (§§ 33-44) of the Holberg Declaration (Ex. 1061) and paragraph 9 of Supplemental Holberg Declaration (Ex.

1063), without meaningful discussion in the Reply itself, constitute an impermissible incorporation by reference under 37 C.F.R. § 42.6(a)(3). *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). For example, in ¶¶ 33-36, Petitioner makes claim context arguments relying on claims 15 and 20. In ¶¶ 37-38, Petitioner argues that the specification does not support Dr. Opris claim construction. In ¶¶ 39-40, Petitioner argues that the Petitioner's claim construction is supported by extrinsic evidence. In ¶¶ 41, Petitioner argues that the Petitioner's claim construction is supported by the intrinsic evidence. In ¶¶ 42-43, Petitioner argues that the Holberg cross-examination testimony is consistent. Petitioner cites to ¶¶ 42-44 of the Holberg reply 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. None of these arguments are actually included in SiliconLabs' Reply. This evidentiary hide-and-seek tactic should be rejected, and the unexplained evidence excluded. *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999) ("[Incorporation] by reference amounts to a self-help increase in the length of the [] brief [,]" and "is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play

archeologist with the record."); *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, IPR2014-00454, Paper 12, p. 10 (8/29/2014).

Again, SiliconLabs does not even try to justify the prejudice and untimeliness of the evidence on any basis other than it purportedly goes to the "weight" of Dr. Holberg's testimony. This, again, is a red herring. SiliconLabs acknowledges that the claim construction argument and supporting evidence is not in response to any Cresta claim construction position. The "weight" of evidence in response to this argument is thus irrelevant because the claim construction argument itself is untimely and should be excluded. And the purported "weight" that SiliconLabs would ascribe to Dr. Holberg's testimony is not "meaningfully discussed" in its substantive paper. Paragraphs 33-44 of Dr. Holberg's reply declaration and paragraph 9 of Supplemental Holberg Declaration (Ex. 1063) should be excluded.

C. Cresta Moves to Exclude paragraphs 14-32 of Holberg Declaration (Ex. 1061) as irrelevant because it has never been discussed in a substantive paper

Similarly, the "select signal" portion of the Reply concerns the claim construction of the term "select signal," but improperly seeks to incorporate by reference a vast swath of Dr. Holberg's Reply declaration. Petitioner 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); response to 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). Just as discussed above with regard to "carrier signal," SiliconLab's hide-the-ball presentation of the evidence is improper, and Paragraphs 14-32 of the Holberg Declaration should be excluded.

Dated: March 14, 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 14, 2016, a copy of the foregoing document **PATENT OWNER'S MOTION TO EXCLUDE** was served by electronic mail, as agreed to by the parties, upon the following:

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