

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RESIDEO TECHNOLOGIES, INC.

Petitioner

v.

UBIQUITOUS CONNECTIVITY, LP,

Patent Owner

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Case: IPR2019-01335

U.S. Patent No. 8,064,935

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**MOTION TO SUBMIT SUPPLEMENTAL INFORMATION**

## **TABLE OF EXHIBITS**

<b>Exhibit</b>	<b>Short Name</b>	<b>Description</b>
Ex. 1001	935 Patent	U.S. Patent No. 8,064,935
Ex. 1002	655 File History	File History of U.S. Patent No. 9,602,655
Ex. 1003	Jeffay Declaration	Declaration of Kevin Jeffay under 37 C.F.R. § 1.68
Ex. 1004	Jeffay CV	<i>Curriculum Vitae</i> of Kevin Jeffay
Ex. 1005		Provisional Patent Application No. 60,522,887 File History
Ex. 1006	335 File History	U.S. Patent No. 6,990,335 File History
Ex. 1007	397 File History	U.S. Patent No. 7,257,397 File History
Ex. 1008	532 File History	U.S. Patent No. 7,668,532 File History
Ex. 1009	823 File History	U.S. Patent No. 7,643,823 File History
Ex. 1010	935 File History	U.S. Patent No. 8,064,935 File History
Ex. 1011		15/405,793 Application File History
Ex. 1012	Motion	CPS Energy Motion to Dismiss
Ex. 1013	Complaint	Complaint for Patent Infringement
Ex. 1014		Zatkovich Declaration
Ex. 1015		Ubiquitous Response to CPS Energy MTD
Ex. 1016	Oinonen	U.S. Patent No. 6,275,710 (Oinonen)

<b>Exhibit</b>	<b>Short Name</b>	<b>Description</b>
Ex. 1017	Bielski	European Patent Application No. 1391861 (Bielski)
Ex. 1018	Wu	<i>System integration of WAP and SMS for home network system</i> (Wu)
Ex. 1019	Sears	U.S. Patent Pub. 2002/0069263 (Sears)
Ex. 1020	Menard	US Patent Pub. 2002/0177428 (Menard)
Ex. 1021	Antila	US Patent No. 6,583,770 (Antila)
Ex. 1022	Ehlers	US Patent Pub. 2004/0117330 (Ehlers)
Ex. 1023	Whitley	WIPO Publication No. 99/49680 (PCT/US99/06429) (Whitley)
Ex. 1024	Song	U.S. Patent No. 6,393,297 (Song)
Ex. 1025	SMS Specification	Universal Mobile Telecommunications System (UMTS); Technical realization of the Short Message Service (SMS) (3G TS 23.040 version 3.5.0 Release 1999)
Ex. 1026		RESERVED
Ex. 1027	Kanma	<i>Home Appliance Control System over Bluetooth with a Cellular Phone</i> (Kanma)
Ex. 1028	Lee Declaration	Statutory Declaration of Rupert Lee

## **I. STATEMENT OF PRECISE RELIEF REQUESTED**

Pursuant to 37 C.F.R. § 42.123(a) and in view of the authorization from the Board by email on February 26, 2020, Petitioner, Resideo Technologies, Inc. (“Resideo”) moves to submit the following exhibits as supplemental information, each of which has been served as supplemental evidence: **Exhibit 1029**, which is the Declaration of Dr. Sylvia Hall-Ellis addressing the authenticity and public accessibility, and therefore prior art status, of Wu (Exhibit 1018); and **Exhibits 1030-1038**, which are supporting exhibits to the Declaration of Dr. Sylvia Hall-Ellis.<sup>1</sup>

Resideo asserts that its petition already contains the requisite evidence to demonstrate the prior art status of Wu (*e.g.*, evidence that Wu was published in a well-known publication, Ex. 1003, ¶169, and proof that it had by been deposited and been made available by the British library by June 24, 2003, Ex. 1028). Patent Owner, Ubiquitous Technologies, LP (“Ubiquitous”), however objected to the

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<sup>1</sup> Petitioner is filing each of these Exhibits contemporaneously with the instant motion. This practice has been previously endorsed by the Board. *Canon Inc., et al. v. Avigilon Fortress Co.*, Case IPR2019-00311, Paper 17 at 8 (P.T.A.B. August 14, 2019).

authenticity of Wu, under Federal Rule of Evidence 901, in its Objections to Petitioner's Exhibits under 37 C.F.R. § 42.64(b)(1). In this same filing, Ubiquitous also objected to Exhibit 1028, the declaration of Rupert Lee (the "Lee Declaration") as allegedly conclusory and without sufficient explanation under Federal Rule of Evidence 702.

Challenged Grounds 2A-2D in Resideo's Petition depend on the prior art status of the Wu reference. Resideo therefore moves to submit supplemental information to provide additional evidence of public availability of Wu.

## **II. STATEMENT OF MATERIAL FACTS**

1. On July 15, 2019 Petitioner filed IPR2019-01335 challenging the patentability of claims 1-22 of U.S. Patent No. 8,064,935 (the "935 Patent" – Exhibit 1001). The petition raised two main grounds of unpatentability, with each main ground containing various sub-grounds. The grounds raised in the Petition are as follows:

**1A:** Claims 1-3, 7, 11-15, 17-19, and 21 are unpatentable under 35 U.S.C. §103 over Oinonen and Whitley.

**1B:** Claims 4-6 and 16 are unpatentable under 35 U.S.C. §103 over Oinonen, Whitley, and Sears.

**1C:** Claim 8 is unpatentable under 35 U.S.C. §103 over Oinonen, Whitley, and Antila.

**1D**: Claims 9-10 is unpatentable under 35 U.S.C. §103 over Oinonen, Whitley, Antila, and Ehlers.

**1E**: Claims 20 and 22 are unpatentable under 35 U.S.C. §103 over Oinonen, Whitley, and Menard.

**2A**: Claims 1-4, 7-9, 11-15, 17-19, and 21 are unpatentable under 35 U.S.C. §103 over Bielski and Wu.

**2B**: Claims 5-6 and 16 are unpatentable under 35 U.S.C. §103 over Bielski, Wu, and Sears.

**2C**: Claim 10 is unpatentable under 35 U.S.C. §103 over Bielski, Wu, and Ehlers.

**2D**: Claims 20 and 22 are unpatentable under 35 U.S.C. §103 over Bielski, Wu, and Menard.

The Wu reference (Exhibit 1018) relied upon by Resideo in Grounds 2A-2D is an article entitled “System integration of WAP and SMS for home network system” by chi-Hsiang Wu and Rong-Hong Jan (“Wu”) which was published in Volume 42, Issue 4 of *Computer Networks*. The Petition asserts that Wu is prior art under 35 U.S.C. § 102(b) because the article was publicly available before the critical date of the 935 Patent. *See* Paper 2 at 13.

2. Exhibit 1028, filed with the Petition, is a statutory declaration by Mr. Rupert Lee of The British Library. Mr. Lee describes that the Wu reference was

catalogued on June 24, 2003 and would have been available for public use from that date at The British Library. Ex. 1028, ¶3.

3. The earliest-claimed priority date of the 935 Patent is November 18, 2004, making the §102(b) critical date November 17, 2003.

4. Ubiquitous did not challenge the authenticity or availability of Wu in its Preliminary Response. *See generally* Paper 6.

5. On January 27, 2020, trial was instituted on all challenged claims based on all asserted grounds. *See* Paper 7 at 56.

6. On February 10, 2020, Ubiquitous objected to the authenticity of the Wu reference and to the conclusions drawn in the Lee Declaration in its Objections to Petitioner's Exhibits under 37 C.F.R. § 42.64(b)(1). *See* Paper 9 at 1. In particular, Ubiquitous objected to these exhibits as follows:

Exhibit 1018 (Wu): "FRE 901: Petitioner has not produced sufficient evidence to support finding that Exhibit 1018 is authentic." *Id.*

Exhibit 1028 (Lee Declaration): "FRE 702: Opinions contained in Exhibit 1028 are conclusory and lack sufficient explanation. The opinions are not based on sufficient facts or data, and are not the product of reliable principles and methods." *Id.*

7. On February 24, 2020, Petitioner timely served on Ubiquitous supplemental evidence consisting of Exhibits 1029-1038 described below, pursuant to 37 C.F.R. § 42.64(b)(2).

8. On February 24, 2020, Petitioner emailed counsel for Ubiquitous, and asked whether it would oppose Petitioner's forthcoming request to file the instant motion. On February 25, 2020, the parties conferred and counsel for Ubiquitous indicated that they would not oppose Petitioner's request.

9. On February 26, 2020, Petitioner emailed the Board requesting permission to file the instant motion. Petitioner's request was granted later the same day.

10. Exhibit 1029 is the declaration of Dr. Sylvia D. Hall-Ellis (the "Hall-Ellis Declaration"), who is an Adjunct Professor in the School of Information at San José State University. The Hall-Ellis Declaration addresses the authenticity and public availability of the Wu reference. The declaration first describes library cataloging practices and continues by analyzing the library catalog records relevant to the Wu reference. Dr. Hall-Ellis also describes that she personally procured her own copy of the Wu reference from the Library of Congress, which includes a date stamp indicating that the article was cataloged on June 25, 2003. Exhibit 1038 at 2; Exhibit 1029 at 17. Dr. Hall-Ellis' declaration ultimately concludes that the Wu

reference was publicly available as of June 25, 2003, which is more than 1 year prior to the filing date of the 935 Patent. Exhibit 1029 at 21.

11. Exhibits 1030-1038 are supporting exhibits to the Hall-Ellis Declaration. Exhibit 1030 is Dr. Hall-Ellis' curriculum vitae. Exhibits 1031-1037 are Machine-Readable Cataloging (MARC) records relevant to the availability of the Wu reference. Exhibit 1038 is a copy of the Wu reference that Dr. Hall-Ellis personally obtained from the Library of Congress.

### **III. ARGUMENT**

Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information in accordance with the following: (1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted. (2) The supplemental information must be relevant to a claim for which the trial has been instituted. Entry of the proposed supplemental information is appropriate because the exhibits are both timely and relevant to a claim for which trial has been instituted. *See* 37 C.F.R. § 42.123(a).

#### **A. The Request Was Timely.**

37 C.F.R. § 42.123(a) requires a request for authorization to file a motion to submit supplemental evidence to be made within one month of the date trial was instituted. As set forth in material facts ("MFs") 5 and 9, Petitioners' request was timely.

**B. Each Exhibit is Relevant to a Disputed Trial Issue.**

Wu is a reference in Grounds 2A-2D. *See* MFs 1, 5. As set forth in MF 6, Ubiquitous has challenged whether the Wu reference is authentic and, thus, whether it qualifies as prior art.<sup>2</sup> As a result of these evidentiary challenges, the issue of public accessibility is ripe and is properly addressed by the Board at this stage of the proceeding. *Cisco Systems, Inc., v. Centropetal Networks, Inc.*, IPR2018-0144, Paper 14 at 3 (P.T.A.B. May. 2, 2019).

Exhibit 1029, the Hall-Ellis Declaration, addresses the public availability of the Wu reference and thus, the prior art status of Wu. Exhibit 1029 is therefore relevant under 37 C.F.R. § 42.123(a). MF 10. Indeed, new Exhibit 1029 includes

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<sup>2</sup> The fact that Exhibits 1029-1038 were also served as supplemental evidence is of no moment to this decision. There is no regulatory prohibition against entering exhibits as supplemental information that have also been served as supplement evidence, provided they are relevant to a claim for which trial has been instituted. *See Valeo North America, Inc. v. Magna Electronics, Inc.*, Case IPR2014-01204, Paper 26 at 5 (P.T.A.B. Apr. 10, 2015); *see also Wangs Alliance Corp. v. Koninklijke Philips N.V.*, Case IPR2015-01290, Paper 19 at 4-6 (P.T.A.B. Jan. 26, 2016) (addressing Ex. 1008, which was served as supplemental evidence).

statements from Dr. Sylvia D. Hall-Ellis, relating to cataloging practices, specific library catalog records relevant to the Wu reference, and references a copy of the Wu reference she obtained from the Library of Congress, which includes a date stamp indicating that the article was cataloged on June 25, 2003. Exhibit 1038 at 2; Exhibit 1029 at 17. Dr. Hall-Ellis supports her statements by way of Exhibits 1030-1038. MF 11.

While Resideo disagrees with the evidentiary challenges by Ubiquitous, the supplemental information presented here responds to the challenge by Ubiquitous. Moreover, Exhibits 1029-1038 do not change the evidence on which Petitioner relied in the Petition. Petitioner submitted the Lee Declaration with the Petition, which addresses the public availability and thus, prior art status of Wu. MF 2. Exhibit 1029 and supporting Exhibits 1030-1038 thereto merely provide additional evidence confirming the publication and public accessibility of Wu before the critical date of the 935 Patent. MFs 10-11. Moreover, Exhibit 1038, the copy of Wu personally obtained by Dr. Hall-Ellis, is the same Wu that was submitted by Petitioner with the Petition. *Cf.* Exhibit 1018 & Exhibit 1038.

Finally, Resideo's supplemental information is consistent with the type of evidence the Board has consistently allowed to address a reference's status as a printed publication. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 15 (PTAB Dec. 20, 2019) (precedential) citing *Nikon Corp. v. ASML*

*Netherlands B.V.*, IPR2018-00688, Paper 16 at 5–6 (PTAB Oct. 29, 2018)

(granting motion to submit librarian declaration as supplemental information);

*Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2014-01149, Paper 19 at 6–7

(PTAB March 30, 2015) (granting motion to submit supplemental information as to librarian declarations attesting to the public accessibility of documents on which trial was instituted).

**C. There is no Prejudice to Ubiquitous.**

Ubiquitous does not oppose the present request. In addition, Ubiquitous received Exhibits 1029-1038 on February 24, 2020 (MF 7), nearly two months before the Patent Owner Response deadline of April 20, 2020. MF 7. Ubiquitous thus, has sufficient time to address the supplemental information contained in Exhibits 1029-1038. *See Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369, Paper 37 at 5 (P.T.A.B. Feb. 5, 2014) (finding less than two months of time sufficient).

In addition, the entry of these exhibits will provide Ubiquitous with the benefit of being able to review and respond to the supplemental information in its Patent Owner Response. Indeed, reviewing the information now may avoid costly and/or piecemeal briefing with respect to public accessibility. Should Ubiquitous elect not to argue the prior art status issue in its Patent Owner Response and decline to pursue its evidentiary objection in a Motion to Exclude, neither party need address the issue

again. Thus, addressing this evidence now will further ensure “the just, speedy, and inexpensive resolution” of the proceeding pursuant to 37 C.F.R. § 42.1(b). *Nikon Corp. v. ASML Netherlands B.V.*, IPR2018-00688, Paper 16 at 4 (P.T.A.B. Oct. 29, 2018).

#### IV. CONCLUSION

Entry of Exhibits 1029-1038 as supplemental information under 37 C.F.R. § 42.123(a) is appropriate for the reasons discussed above.

Dated: February 28, 2020

Respectfully submitted,

/S. Benjamin Pleune/

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing MOTION TO  
SUBMIT SUPPLEMENTAL INFORMATION was served electronically on  
February 28, 2020 on counsel of record for the Patent Owner as follows:

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Date

By /S. Benjamin Pleune/  
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