

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ADOBE INC.,  
Petitioner,

v.

RAH COLOR  
TECHNOLOGIES, LLC,  
Patent Owner.

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Case IPR2019-00628  
Patent 8,416,444

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**PETITIONER'S NOTICE OF APPEAL**

Pursuant to 35 U.S.C. §§ 141, 142, and 319; 37 C.F.R. §§ 90.2-90.3; Federal Rule of Appellate Procedure 15; and Federal Circuit Rule 15, Petitioner Adobe Inc. (“Petitioner”) hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision of the Patent Trial and Appeal Board (“Board”) entered on August 19, 2020 in IPR2019-00628 (Paper No. 122) (“Final Written Decision”), and from all underlying findings, determinations, rulings, opinions, orders, issues, and decisions regarding the *inter partes* review of U.S. Patent No. 8,416,444 (the “’444 Patent”). This notice is timely under 37 C.F.R. § 90.3, having been filed no later than 63 days after the Final Written Decision.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioner states that the issues on appeal include, but are not limited to: the Board’s determination that claims 11, 13, 15, 18, 19, 26, and 27 of the ’444 Patent have not been shown to be unpatentable; the Board’s determination to exclude the declaration of Dr. Phil Green (Exhibit 1010); the Board’s determination to strike the declaration of Christopher L. Kelley (Exhibit 1074); the Board’s determination to exclude Exhibit 1014; the Board’s failure to confirm that Exhibit 1014 is admitted prior art; the Board’s failure to confirm that Exhibit 1014 is published prior art; the Board’s denial of Petitioner’s motion to submit supplemental information; the Board’s consideration of the expert testimony, fact witness testimony, and other evidence in the record; and the Board’s factual findings, conclusions of law, or other determinations supporting or related to the foregoing issues, as well as all other issues decided adversely to Petitioner in any orders,

decisions, rulings, or opinions.

This Notice of Appeal is being e-filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit, along with payment of the required docketing fees. In addition, a true and correct copy of this Notice of Appeal is being filed simultaneously with the Director of the United States Patent and Trademark Office.

In accordance with Fed. Cir. Rule 15 and the associated Practice Notes, a copy of the public version of the Final Written Decision of the Board, which is identical to the non-public version, is attached.

Dated: October 16, 2020

Respectfully submitted,

/ Christopher L. Kelley /

Christopher L. Kelley

Reg. No. No. 42,714

Perkins Coie LLP

3150 Porter Drive

Palo Alto, CA 94304

Telephone: (650) 838-4300

Fax: (650) 838-4350

Email: CKelley@perkinscoie.com

*Counsel for Petitioner/Appellant  
Adobe Inc.*

## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing **PETITIONER'S NOTICE OF APPEAL** has been served in its entirety this 16th day of October, 2020, by the PTAB's E2E electronic filing system, and also by U.S. Mail to the Director of the U.S. Patent and Trademark Office at this address:

Office of the General Counsel  
United States Patent and Trademark Office  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

The undersigned also certifies that a true and correct copy of the foregoing **PETITIONER'S NOTICE OF APPEAL** has been filed in its entirety this 16th day of October, 2020, via the electronic filing system, CM/ECF, with the Clerk's Office of the U.S. Court of Appeals for the Federal Circuit.

The undersigned also certifies that a true and correct copy of the foregoing **PETITIONER'S NOTICE OF APPEAL** was served on this 16th day of October, 2020, by electronic mail (by consent) on the following attorneys of record for Patent Owner:

Irwin Park  
Ragnar Olson  
David P. Berten  
Alison A. Richards  
GLOBAL IP LAW GROUP, LLC  
55 West Monroe St., Suite 3400  
Chicago, IL 60603  
IPark@giplg.com  
rolson@giplg.com  
dberten@giplg.com  
arichards@giplg.com

Dated: October 16, 2020

Respectfully submitted,

*/ Christopher L. Kelley /*

Christopher L. Kelley

Reg. No. No. 42,714

Perkins Coie LLP

3150 Porter Drive

Palo Alto, CA 94304

Telephone: (650) 838-4300

Fax: (650) 838-4350

Email: CKelley@perkinscoie.com

*Counsel for Petitioner/Appellant  
Adobe Inc.*

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Before FRANCES L. IPPOLITO, NATHAN A. ENGELS, and  
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

JUDGMENT<sup>1</sup>

Final Written Decision

Determining No Challenged Claims Unpatentable  
Granting-in-Part Patent Owner's Motions to Exclude  
Granting-in-Part Patent Owner's Motion to Strike  
Dismissing Petitioner's Motion to Exclude  
*35 U.S.C. § 318(a); 37 C.F.R. §§ 42.5, 42.64*

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<sup>1</sup> This decision refers to material that has been designated as "Parties and Board Only" in the PTAB E2E system. The parties shall file jointly a proposed redacted version of the Decision within two weeks of the entry date of this Decision.

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Adobe Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 11, 13, 15, 18, 19, 26, and 27 of U.S. Patent No. 8,416,444 B2 (Ex. 1002, “the ’444 patent”). Paper 2 (“Pet.”). Patent Owner, RAH Color Technologies LLC (“Patent Owner”), filed a Preliminary Response. Papers 22<sup>2</sup>, 26<sup>3</sup> (“Prelim. Resp.”). Petitioner also filed a Preliminary Reply (Paper 30) and Supplemental Preliminary Reply (Paper 34), and Patent Owner filed a Preliminary Sur-reply (Paper 36). Taking into account the arguments presented in these papers, we determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail with respect to its unpatentability challenges. Pursuant to 35 U.S.C. § 314, we instituted this proceeding on August 20, 2019, as to all challenged claims and all grounds of unpatentability. Papers 37<sup>2</sup>, 77<sup>3</sup> (“Dec. on Inst.”).

During the course of trial, Patent Owner filed a Patent Owner Response (Papers 62<sup>2</sup>, 112<sup>3</sup>, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 84, “Pet. Reply”). Patent Owner also filed a Sur-reply. Paper 96 (“PO Sur-reply”). An oral hearing was held on May 28, 2020, and a transcript of the hearing is included in the record. Paper 121 (“Tr.”).

With our authorization (Paper 57), Petitioner filed a Motion to Submit Supplemental Information. Paper 55 (“Supp. Info. Mot.”). Patent Owner

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<sup>2</sup> This paper was sealed in accordance with the Protective Order entered in this case. *See* Paper 21, App. A (copy of protective order); Paper 31 (entering protective order).

<sup>3</sup> This paper is the public version.

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filed an Opposition. Paper 58 (“Supp. Info. Opp.”). We granted Petitioner’s Motion in part. Paper 74.

Petitioner filed declarations of Charles Poynton, Ph.D., with its Petition (Ex. 1009) and its Reply (Ex. 1071). Petitioner also sought to submit a declaration of Dr. Poynton (Paper 55, Attachment CP1, “CP1 declaration”) as supplemental information, but we did not enter this declaration. Paper 74, 5–13, 24. Petitioner additionally filed declarations of, *inter alia*, Dr. Phil Green (Ex. 1010), Christopher L. Kelley<sup>4</sup> (Ex. 1074), and Gerald Murch, Ph.D. (Ex. 1088). Patent Owner filed, *inter alia*, Declarations of Dr. Michael Vrhel with its Preliminary Response (Ex. 2029), Opposition to Petitioner’s Motion to Submit Supplemental Information (Ex. 2118), and Response (Ex. 2120). The parties also filed transcripts of the depositions of Dr. Poynton (Exs. 1045, 2106<sup>5</sup>, 2235), Mr. Kelley (Ex. 2236), Dr. Murch (Ex. 2237), and Dr. Vrhel (Ex. 1051).

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 11, 13, 15, 18, 19, 26, and 27 of the ’444 patent. For the reasons discussed below, Petitioner has not demonstrated by a preponderance of the evidence that claims 11, 13, 15, 18, 19, 26, and 27 of the ’444 patent are unpatentable.

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<sup>4</sup> Mr. Kelley is Petitioner’s lead counsel in this case. Pet. 2.

<sup>5</sup> The record includes sealed and public versions of this exhibit in accordance with the protective order in this case.



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### I. BACKGROUND

#### A. *Real Parties-in-Interest*

Petitioner identifies itself, Adobe, Inc., as the only real party-in-interest (“RPI”). Pet. 1. Patent Owner identifies itself, RAH Color Technologies, LLC, as the only RPI. Paper 4, 2; Paper 10, 2.

In its Preliminary Response, Patent Owner argued that Petitioner had failed to identify all RPIs. Prelim. Resp. 43–46. In particular, Patent Owner argued that the RPIs include Quad/Graphics, Inc. (“Quad”), Dalim Software, Inc. (“Dalim”), Xerox Corporation (“Xerox”), Heidelberger Druckmaschinen AG (“Heidelberger”), and Electronics for Imaging (“EFI”). *Id.*

We reviewed these allegations in our Institution Decision, and determined that Patent Owner had failed to establish that any of these entities was an RPI that should have been named in the Petition. Dec. on Inst. 10–16.

After institution, neither party presented any arguments or evidence on this issue. That being the case, the record is unchanged on this issue. Thus, we determine that for the same reasons discussed in the Institution Decision, Petitioner has sufficiently shown that Quad, Dalim, Xerox, Heidelberger, and EFI are not RPIs. *Id.*

#### B. *Related Proceedings*

According to Petitioner, “Patent Owner has asserted the ’444 patent and three related patents against Petitioner in the United States District Court for the Northern District of California, [*RAH Color Techs. LLC v. Adobe Inc.*] Case No. 3:18-cv-03277-SI.” Pet. 1. Petitioner also indicates that it

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has submitted petitions for *inter partes review* challenging related patents in Case IPR2019-00627 (U.S. Patent No. 7,729,008 B2), Case IPR2019-00646 (U.S. Patent No. 7,791,761 B2), and Case IPR2019-00629 (U.S. Patent No. 7,312,897 B2). *Id.*

In addition, Petitioner indicates that the '444 patent or related patents are also involved in four other cases: *RAH Color Techs. LLC v. Xerox Corp.* (W.D.N.Y., Case No. 6:18-cv-06746); *Elecs. For Imaging, Inc. v. RAH Color Techs. LLC* (E.D. Va., Case No. 1:18-cv-01436); *RAH Color Techs. LLC v. Heidelberger Druckmaschinen AC* (N.D. Ill., Case No. 1:19-cv-00193); and *RAH Color Techs. LLC v. Dalim Software GmbH* (N.D. Ill., Case No. 1:19-cv-00275). *Id.* at 2. According to Petitioner:

The *Adobe*, *Xerox*, and *EFI* cases have been centralized for coordinated pretrial proceedings in the Northern District of California by the Judicial Panel on Multidistrict Litigation (MDL No. 2874; N.D. Cal. Case No. 3:18-md-02874). On January 25, 2019, the Judicial Panel on Multidistrict Litigation issued a Conditional Transfer Order to centralize the *Heidelberger* and *Dalim* cases in the Northern District of California as well.

*Id.*

Patent Owner also identifies the same cases, as well as *RAH Color Techs. LLC v. Eastman Kodak Co.*, Case No. 6:19-cv-06112 (W.D.N.Y., Case No. 6:19-cv-06112). Paper 4, 3; Paper 10, 3.

### C. The '444 patent

The '444 patent is titled "System for Distributing and Controlling Color Reproduction at Multiple Sites." Ex. 1002, code (54). According to Petitioner, the earliest application to which the '444 patent claims priority is

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U.S. Patent Application No. 08/606,883, filed on February 26, 1996. Pet. 4–5; *see also* Ex. 1002, code (60).

The '444 patent relates to a color management system “for controlling color reproduction of input color image data in a network having nodes (or sites).” Ex. 1002, code (57). In particular, the '444 patent relates to a system “for distributing and controlling color reproduction at multiple sites, and particularly to . . . the color output of rendering devices, such as proofing devices and presses, at multiple sites or nodes of a network to provide a uniform appearance of color within the output colors attainable at each rendering device.” *Id.* at 1:19–31.

The '444 patent discloses “controlling color reproduction of input color image data representing one or more pages . . . in a network having nodes (or sites).” *Id.* at 9:4–7. “Each one of the nodes comprises at least one rendering device.” *Id.* at 9:7–8. Input color image data is distributed “from one of the nodes to other nodes and provides a data structure (virtual proof) in the network.” *Id.* at 9:8–11. The '444 patent also discloses a

means for providing color calibration data at each node characterizing output colors (colorants) of the rendering device of the node, and means for producing at each node, responsive to the color calibration data of the rendering device of the node, information for transforming the input color image data into output color image data at the rendering device of the node.

*Id.* at 9:13–18. At each node, the input color image data may be transformed into “output color image data for the rendering device of the node responsive to the information in the data structure.” *Id.* at 9:20–23. The '444 patent further discloses a “rendering device of each node renders a color reproduction of the pages responsive to the output color image data” so that

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displayed colors “appear substantially the same within the output colors attainable by the rendering devices.” *Id.* at 9:23–28.

Figure 3A of the '444 patent is reproduced below.

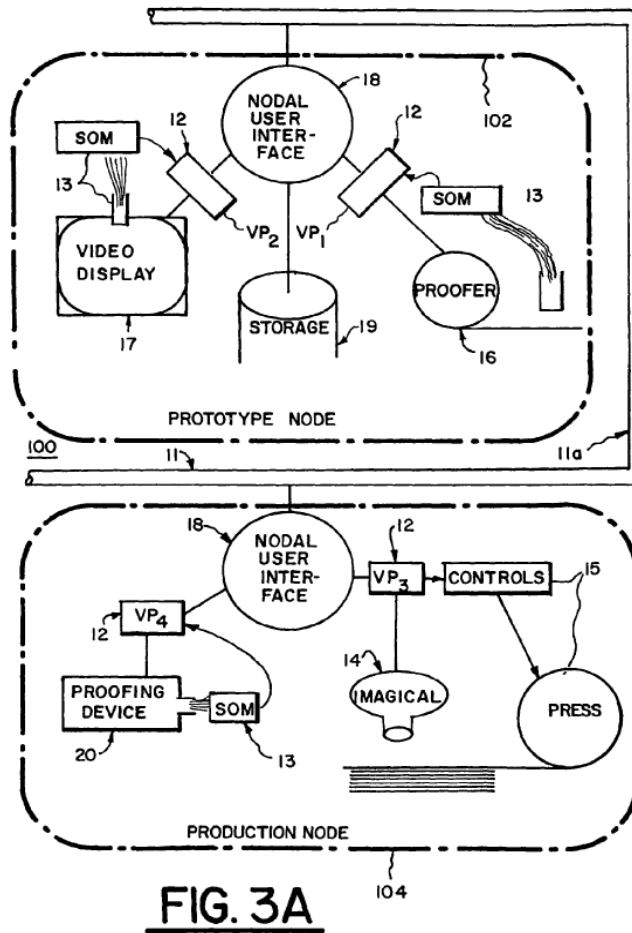


Figure 3A depicts prototype node 102 connected to production node 104 via network 11. *Id.* at 11:54–12:6. Prototype node 102 allows a user to interface with a node to perform pre-publishing functions and to input digital color image data. *Id.* at 12:6–43. Using prototype node 102, a user may design a page layout and define color preferences for rendering of color image data. *Id.* Production nodes 104 control production of a rendering

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with a control system and a production rendering device, such as press 15 or a printer (not shown). *Id.* at 12:44–65.

Each node includes circuitry that operates responsive to programming stored at the node. *Id.* at 12:66–13:42. The circuitry “accepts measurement data from CMIs and computes color transformation functions to translate between human-perceptible colors of the measurement data into rendering device colorant values.” *Id.* at 13:17–20. The circuitry also “processes and transmits color graphical/image data from one node or site in a network 11 to another” and issues “reading instructions to CMIs mounted on a rendering device to measure rendered color images, and issue rendering instructions to a rendering device at the node using a stored color transformation.” *Id.* at 13:20–25. The circuitry additionally calibrates a rendering device “to a common, human perceptible language of color . . . by producing and storing color transformation information.” *Id.* at 13:33–37.

The '444 patent also discloses a virtual proof (VP) data structure, which is “a file structure for storing and transmitting files representing color transformation information between network 11 nodes.” *Id.* at 13:43–47. The VP has components or files that are shared, including “files representing the user color preferences,” which are needed by each node in calibrating a rendering device. *Id.* at 13:62–66. “Each rendering device has its own version of a VP stored at its associated node . . . .” *Id.* at 13:66–14:1. Each VP “contains data for procedures necessary to mediate conversions from the color of input image data to colorant, and vice versa, in such a way that the recording device at one particular node of the network can represent the output of other equipment to[] the best degree possible.” *Id.* at 9:43–47.

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*D. Illustrative Claim*

Of the challenged claims, only claim 11 is independent. Claims 13, 15, 18, 19, 26, and 27 depend directly or indirectly from claim 11.

Claim 11, reproduced below, is illustrative of the claimed subject matter.

11. A system for controlling color reproduction comprising:
- a computer at a site;
  - memory storing information, said information comprising:
    - data representing tonal transfer functions for a plurality of color channels;
    - one or more color transformations for converting a first set of color coordinates into a second set of coordinates;
    - a gamut filter, said gamut filter representing an array stored in a file and accessible through a file header, wherein said array has inputs which are color values and outputs indicative of whether said color values of said inputs are inside or outside of a color gamut; and
    - a chromatic adaptation transform stored in a file and accessible through a file header, said chromatic adaptation transform enabling conversion of input color coordinates to output color coordinates representative of different viewing conditions;
  - said memory storing programs for performing at least one color conversion utilizing at least part of said stored information; and
  - a network interface enabling communication of at least part of said information by said computer with at least one other site using a network protocol.

Ex. 1002, 49:13–37.

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*E. Prior Art*

Petitioner relies on the following prior art:

International Color Consortium Profile Format, version 3.01, May 8, 1995 (Ex. 1014, “ICC v.3.01”);

Adobe Photoshop Version 3.0 User Guide, Adobe Systems Inc., 1994 (Ex. 1015, “User Guide”);

U.S. Patent No. 5,416,890, filed Dec. 11, 1991, issued May 16, 1995 (Ex. 1016, “Beretta”);

TIFF Revision 6.0, Final — June 3, 1992 (Ex. 1017, “TIFF 6.0”);

M. Scott-Taggart, “Matching the Proof to Achieve Quality—Recent Developments,” *Packaging Technology and Science*, Vol. 5, 211–15 (April 1992) (Ex. 1018, “Scott-Taggart”); and

P. Herzog, “A New Approach to the Representation of Color Gamuts,” *Proceedings of the IS&T/SID 1995 Color Imaging Conference: Color Science, Systems and Applications*, 78–81 (1995) (Ex. 1019, “Herzog”).

*F. The Instituted Grounds*

We instituted *inter partes* review of claims 11, 13, 15, 18, 19, 26, and 27 of the ’444 patent on the following grounds (Dec. on Inst. 78), which are all the grounds presented in the Petition (Pet. 4):

<b>Claims Challenged</b>	<b>35 U.S.C. §</b>	<b>References/Basis</b>
11, 27	103(a) <sup>6</sup>	ICC v.3.01, TIFF 6.0, Beretta

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<sup>6</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the effective filing date of the ’444 patent is before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA version of § 103 applies.

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<b>Claims Challenged</b>	<b>35 U.S.C. §</b>	<b>References/Basis</b>
11, 13, 18	103(a)	ICC v.3.01, TIFF 6.0, Beretta, User Guide
11, 13, 19, 26	103(a)	ICC v.3.01, TIFF 6.0, Beretta, User Guide, Scott-Taggart
11, 15	103(a)	ICC v.3.01, TIFF 6.0, Beretta, Herzog

**II. ANALYSIS**

The dispositive issue in this case is whether Petitioner has shown by a preponderance of the evidence that Exhibit 1014 is an authentic copy of the ICC v.3.01 industry-standard specification that the International Color Consortium (ICC) allegedly “published on or about May 8, 1995.” Pet. iv, 8–10, 18. In the Petition, Petitioner primarily attempted to authenticate Exhibit 1014 using the declaration testimony of Dr. Green, the Technical Secretary of the ICC since 2005.<sup>7</sup> See *id.* at 18–19; Supp. Info. Mot. 2; Ex. 1010 ¶¶ 1–2. Dr. Green attached a copy of ICC v.3.01 that he allegedly downloaded from the ICC’s website as an attachment to his declaration. Ex. 1010 ¶¶ 11–12 & attached “Exhibit 2” to Ex. 1010. For the purposes of institution, we determined that Dr. Green’s declaration provided sufficient authentication of Exhibit 1014 as a record of the ICC. Dec. on Inst. 28–29 (citing, *inter alia*, Ex. 1010 ¶¶ 7, 11–12).

After institution, Patent Owner sought to take the deposition of Dr. Green, but he declined to appear for a deposition. Supp. Info. Mot. 2–3;

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<sup>7</sup> Petitioner also contends that it put forth testimony from Dr. Poynton indicating that Exhibit 1014 is authentic. Pet. Reply 3–4. We discuss Dr. Poynton’s testimony below.



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*see also* Ex. 1043, 20:20–21:12 (Petitioner’s counsel acknowledging Dr. Green was unavailable during an October 2, 2019, conference call). Petitioner contends that it could not compel Dr. Green to testify because he is not affiliated with Petitioner and because he resides outside of the United States. Supp. Info. Mot. 3. Dr. Green’s unavailability was one of premises of Petitioner’s Motion to Submit Supplemental Information. *See id.* at 2–3. In particular, Petitioner sought to enter Dr. Poynton’s CP1 declaration (with voluminous appendices) to compensate for the loss of Dr. Green’s testimony. *Id.* at 3 (“In view of Dr. Green’s unavailability and [Patent Owner] disputing the authenticity and public accessibility of ICC v.3.0 and ICC v.3.01, Dr. Poynton provided additional detail regarding his personal involvement with the ICC in his first supplemental declaration.”).

We ultimately did not enter Dr. Poynton’s CP1 declaration. Paper 74, 13, 24. Among other things, we found that “Petitioner ha[d] not established that Dr. Poynton’s first supplemental declaration and its Appendices are relevant to determining the authenticity and public accessibility of Petitioner’s asserted ICC v.3.0 and ICC v.3.01 references.” *Id.* at 13. We also noted “inaccuracies and misstatements” in Dr. Poynton’s CP1 declaration testimony and found that, “given the large number of unsupported and incorrect statements,” entering his testimony would not have “clarif[ied] the record or be[en] in the interest of efficient administration of these proceedings.” *Id.*

After we denied entry of the CP1 declaration, Petitioner responded in several ways with respect to authenticating Exhibit 1014. First, nearly three months after Patent Owner’s Response had been filed, and a few days before filing its Reply, Petitioner indicated that Dr. Green had changed his position

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and had agreed to be deposed in the United States. Paper 86, 3. Second, Petitioner filed new declarations from Dr. Poynton (Ex. 1071), Mr. Kelley (Ex. 1074), and Dr. Murch (Ex. 1088) regarding authenticity with its Reply. Third, Petitioner made certain new and additional arguments regarding authentication. *See* Pet. Reply 3–5.

With our authorization (Paper 88, 3), Patent Owner filed a motion to exclude Dr. Green’s testimony (Paper 98, “Green Mot.”) based on his unavailability during the time leading up to the filing of its Response. Petitioner filed an Opposition. Paper 104 (“Green Opp.”). We also authorized Patent Owner to file a motion to strike (Paper 97, “Strike Mot.”) certain arguments and evidence presented with Petitioner’s Reply that were allegedly beyond the scope of Patent Owner’s Response. Paper 88, 2. Patent Owner’s motion to strike concerned Dr. Poynton’s new declaration, Mr. Kelley’s declaration, and Dr. Murch’s declaration, among other things. Petitioner filed an Opposition. Papers 105, 106 (“Strike Opp.”).

Furthermore, as authorized by the Scheduling Order in this case (Paper 38), Patent Owner also filed a general motion to exclude (Paper 109, “PO Exclude”) several exhibits submitted by Petitioner. Among the exhibits Patent Owner seeks to exclude are Exhibit 1014 and the declarations of Dr. Green and Mr. Kelley. Petitioner filed an Opposition (Paper 114, “Pet. Exclude Opp.”) and Patent Owner filed a Reply (Paper 118, “PO Exclude Reply”).

We now consider each of these motions, as well as Petitioner’s evidence purporting to authenticate Exhibit 1014, as we determine whether Petitioner has established the authenticity of Exhibit 1014 by a preponderance of the evidence.

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*A. Patent Owner's Motion to Exclude Dr. Green's Declaration  
(Exhibit 1010)*

Patent Owner moves to exclude Exhibit 1010, Dr. Green's declaration. Green Mot. 1; PO Exclude 3–4. Patent Owner argues that Dr. Green must have been made available more than one week before the filing of its Response in order for us to consider his testimony. Green Mot. at 7–8. Patent Owner notes that this time frame is established both by our rules and by the Scheduling Order entered in this case. *Id.* at 3 (quoting Paper 38, 3), 7 (quoting 37 C.F.R. § 42.53(d)(2)). Patent Owner argues that Petitioner could have, but did not, avail itself of the late action rule, 37 C.F.R. § 42.5(c)(3), and that, in even if it had, Petitioner could not have met the “good cause” or “interests of justice” standards for late action. *Id.* at 8–9 (citing, *inter alia*, Paper 86, 4). Patent Owner additionally argues that taking a deposition of Dr. Green during the reply period would have been prejudicial to Patent Owner because its ability to use information learned during the deposition is constrained by the fact that sur-replies are limited in scope, size, and time. *Id.* at 9–10. Patent Owner also notes it had already expended time and money defending against Petitioner's bid to cure Dr. Green's unavailability with supplemental information. *Id.* at 2, 10. Because Dr. Green was not made available timely for a deposition, Patent Owner moves to exclude Exhibit 1010 as inadmissible hearsay. PO Exclude 3 (citing Fed. R. Evid. 801–802).

Petitioner contends that Patent Owner had a full and fair opportunity to cross-examine Dr. Green but that Patent Owner passed on the opportunity. Green Opp. 1, 7–8; *see also* Pet. Exclude Opp. 14 (“Exhibit 1010 contains testimony presented for the current hearing and Dr. Green agreed to appear

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for cross-examination, so his testimony is not hearsay.”). Specifically, Petitioner argues that it satisfied our rules on cross-examination testimony by making Dr. Green available for deposition prior to and throughout Patent Owner’s sur-reply period. Green Opp. 1, 7–8. Petitioner also emphasizes that Dr. Green is not under the control of Petitioner. *Id.* at 2–4. Petitioner further contends the late action rule in § 42.5(c)(3) is inapposite because Petitioner is not asking us to compel a deposition of Dr. Green. *Id.* at 8. Finally, Petitioner argues that “any prejudice due to timing could [have] be[en] cured by allowing [Patent Owner] additional time and briefing to address Dr. Green’s testimony, both of which were agreeable to [Petitioner].” *Id.* at 2.

The question before us is whether we should exclude Dr. Green’s declaration as inadmissible hearsay based on Petitioner’s failure to make him available for cross-examination in a timely manner. In particular, the parties disagree as to how we should apply the cross-examination provision of 37 C.F.R. § 42.53(d)(2), which states that cross-examination ordinarily takes place “more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used.” Petitioner would have us interpret this to mean that cross-examination could happen at any time so long as Patent Owner has a chance to respond in any responsive paper, i.e., an opportunity to file a sur-reply in this case. *See* Green Opp. 5–6.

Based on the particular facts of this case, we disagree. Patent Owner sought Dr. Green’s deposition prior to filing its Response, but Petitioner acknowledged that he was not available. Green Mot., App. A (email exchange between the parties’ counsel from early September 2019).

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Accordingly, in its Response, Patent Owner cited Dr. Green's unavailability and argued that the version of ICC v.3.01 in Exhibit 1014 could not be authenticated and should be excluded. PO Resp. 24–25. As such, the Response is the “paper in which the cross-examination testimony [wa]s expected to be used” under § 42.53(d)(2). This means that Petitioner's offer to make Dr. Green available during the reply period was not timely under the rule.

Petitioner argues that the qualifier “ordinarily” in § 42.53(d)(2) “makes clear that it should be applied with flexibility to account for the individual circumstances of each case.” Green Opp. 6. Petitioner asks us to apply § 42.53(d)(2) “such that Dr. Green's deposition would not be untimely even if it means that his deposition would occur out of the ‘ordinary’ order.” *Id.* at 7. Moreover, according to Petitioner, Patent Owner could have availed itself of extra time and briefing to address a late deposition of Dr. Green. *Id.* at 2.

Our Trial Practice Guide states that, “absent special circumstances, discovery will proceed in a sequenced fashion.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 7 (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Consolidated TPG”). “The sequenced discovery allows parties to conduct meaningful discovery before they are required to submit their respective motions and oppositions during the trial.” *Id.* at 22. Importantly, the sequence ensures that “the scope of the trial continually *narrows*.” *Id.* at 23 (emphasis added).

By the time Petitioner offered to present Dr. Green for deposition, Patent Owner had already addressed authentication issues based on Dr. Green's unavailability in its Response. *See* PO Resp. 24–25. Petitioner

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also had been given an opportunity to cure its authentication problems via its Motion to Submit Supplemental Information, though that effort was unsuccessful. *See* Paper 74. In this way, the panel had already afforded Petitioner “special circumstances” to address authentication in light of Dr. Green’s unavailability. As such, reopening issues related to Dr. Green’s testimony during the reply period would have had the effect of broadening, rather than narrowing, the scope of the trial. Further, Petitioner’s proposal to allow Patent Owner additional time and briefing (Green Opp. 2) presupposes that the panel was amenable to extra rounds of briefing. But allowing additional time and briefing to reopen this issue would have been counter to our charge to “secure the just, speedy, and inexpensive resolution” of this case (37 C.F.R. § 42.1), particularly given the extraordinarily large record that already exists in this case.

We also have considered the potential for prejudice to Patent Owner if we were to overlook Dr. Green’s belated availability. Petitioner had already conceded Dr. Green was unavailable (Green Mot., App. A), and Patent Owner responded to this concession (PO Resp. 24), so belatedly reopening this issue is tantamount to reintroducing arguments that are beyond the allowable scope of replies. *See* 37 C.F.R. § 42.23(b). Patent Owner correctly notes (Green Mot. 9–10) that sur-replies are limited in size, limited by the type of rebuttal evidence allowed, and subject to short deadlines. Under the circumstances of this case, it would have been unfair to require or expect Patent Owner to readdress Dr. Green’s declaration in its Sur-reply. In addition, Petitioner’s proposed remedy of “additional time and briefing” (Green Opp. 2) unfairly would have exposed Patent Owner to additional costs. This is particularly true in light of Patent Owner’s previous

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expenditures of time and money opposing Petitioner's bid to submit supplemental information (*see id.* at 10), which itself was premised on Dr. Green's unavailability. Supp. Info. Mot. 2–3. Under these circumstances, we agree that proceeding with Dr. Green's deposition out-of-time would have worked significant prejudice against Patent Owner.

In light of the parties' arguments (Green Mot. 8–9; Green Opp. 8–9), we further have considered how the late action rule in § 42.5(c)(3) affects our consideration of the instant Motion to Exclude. As stated in a prior Order (Paper 86, 4), neither party made a request to show good cause for or otherwise excuse a late action under § 42.5(c)(3) with respect to a potential deposition of Dr. Green during the reply period. And, as Petitioner notes (Green Opp. 8), Patent Owner could not be forced to take Dr. Green's deposition. By similar logic, Patent Owner could not be forced to address Dr. Green's declaration testimony on its merits during the reply period simply because he was made available for a deposition out-of-time. In the absence of a late action by either party, we find that the late action rule does not control the instant Motion to Exclude.

Petitioner argues that “Dr. Green was the only logical choice as the ICC's declarant in response to Adobe's litigation subpoena.” Green Opp. 7. Petitioner also contends Dr. Green was not subject to “routine discovery” in 37 C.F.R. § 42.51(b)(1)(ii) because Dr. Green's declaration was prepared for a related litigation and was not “prepared for [this] proceeding.” Green Opp. 4–5 & n.2. In spite of this, Petitioner maintains that it “made good-faith efforts to procure the deposition of the ICC's designated witness and ultimately succeeded in those efforts.” *Id.* at 7.

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Nevertheless, these considerations do not control our decision on whether to exclude Dr. Green’s declaration. Petitioner chose to rely on the declaration of Dr. Green, a non-party witness, for authenticating ICC v.3.01, as was its option in formulating the Petition.<sup>8</sup> *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356–57 (2018) (noting that the petition “is supposed to guide the life of the litigation” and a petitioner’s contentions “define the scope of the litigation all the way from institution through to conclusion”). Despite Dr. Green’s status of being outside of Petitioner’s control, Petitioner was nonetheless required to make him available for cross-examination.<sup>9</sup> *See Consolidated TPG*, 23 (“[A] party presenting a witness’s testimony by affidavit should arrange to make the witness available for cross-examination. This applies to witnesses employed by a party as well as experts and *non-party witnesses*.” (emphasis added)). Although Petitioner implies that

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<sup>8</sup> Notably, Petitioner could have assessed Dr. Green’s tolerance for “mak[ing] himself another target in [Patent Owner’s] litigation campaign,” as Petitioner characterizes it (Green Opp. 9), prior to staking the authentication of Exhibit 1014 on his testimony. By relying on Dr. Green’s testimony in the Petition, Petitioner bore the responsibility for Dr. Green’s role in this proceeding.

<sup>9</sup> Petitioner argues that Dr. Green’s declaration “was originally prepared for a related litigation rather than this proceeding,” so Dr. Green is not subject to routine discovery under 37 C.F.R. § 42.51(b)(1)(ii). Green Opp. 4–5 n.2. Nevertheless, Petitioner did not previously characterize Dr. Green’s testimony as being subject to our “additional discovery” rules or otherwise argue that it was not required to make Dr. Green available for cross-examination. We agree with Patent Owner (PO Exclude 4) that Petitioner waived any such suggestion while attempting to submit Dr. Poynton’s CP1 declaration as supplemental information. *See Supp. Info. Mot.* 5–6 (“Dr. Poynton’s supplemental testimony is needed because of Dr. Green’s unavailability . . .”).



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Dr. Green was the *only* choice for authenticating Exhibit 1014 (Green Opp. 7), this is contrary to Petitioner’s assertion that the ICC specifications were industry-wide standards that “were widely known and disseminated.” Pet. 8–10; Pet. Reply 6. If that is true, then members of the relevant public potentially could have authenticated Exhibit 1014. Notwithstanding, we need not consider how or why Petitioner came to rely on Dr. Green; the fact that he was not available timely for a deposition is the relevant consideration for our inquiry.

Given that Petitioner failed to make Dr. Green available for cross-examination prior to the filing of Patent Owner’s Response, we determine that the statements in Exhibit 1010 constitute inadmissible hearsay. *See* Fed. R. Evid. 801–802. We agree with Patent Owner (PO Exclude 4) that Petitioner offers Exhibit 1010 “for the truth of the matters asserted about the authenticity and public accessibility of Ex. 1014 as a pre-1996 ICC document.” *See, e.g.*, Pet. Reply 4 (citing paragraphs 11 and 12 of Dr. Green’s declaration to establish that Exhibit 1014 came from the ICC’s business records). Under these circumstances, we find good cause for excluding Dr. Green’s declaration. Therefore, we *grant* Patent Owner’s motion to exclude Exhibit 1010.

*B. Patent Owner’s Motion to Strike Dr. Poynton’s Third Supplemental Declaration (Exhibit 1071)*

Patent Owner moves to strike Exhibit 1071<sup>10</sup>, the Third Supplemental Declaration of Dr. Poynton. Strike Mot. 2–6. Patent Owner argues that

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<sup>10</sup> Petitioner’s motion also refers to declarations by Dr. Poynton in related cases as Exhibits 1070, 1072, and 1073. Strike Mot. 1–3. These exhibit

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Petitioner refiled “vast portions” of Dr. Poynton’s CP1 declaration in Exhibit 1071 in contravention of our Order denying entry of the CP1 declaration as supplemental information. *Id.* at 1–3 (citing, *inter alia*, Paper 74). In support of this argument, Patent Owner provides charts highlighting similarities between the non-entered CP1 declaration and Dr. Poynton’s Third Supplemental Declaration. *Id.*, Apps. A, B. Patent Owner also cites cross-examination testimony from Dr. Poynton in support of its contention that Patent Owner “redlined CP1 and surreptitiously reused 950 words of CP1’s material statements on the ICC.” *Id.* at 3 (citing Ex. 2235, 472:11–473:4, 474:9–21, 475:14–21, 476:16–22). Patent Owner notes that we previously found Dr. Poynton’s CP1 testimony “not credible.” *Id.* (quoting Paper 74, 8). Given Petitioner’s purported reuse of the CP1 declaration testimony, Patent Owner argues that Petitioner’s “repeated submission of objectively false statements” from Dr. Poynton qualifies for sanctions. *Id.* at 5–6 (citing 37 C.F.R. § 42.12(a)).

Patent Owner also disputes certain new testimony from Dr. Poynton (*see* Ex. 1071 ¶ 10) regarding announcements allegedly made in a “sci.engr.color” Internet newsgroup about the availability of ICC specifications from an FTP site by 1994. Strike Mot. 3–5. Patent Owner notes that when Dr. Poynton was confronted with certain evidence on cross-examination that the “sci.engr.color” newsgroup did not exist prior to 1996,

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numbers are not used in this case. Although Dr. Poynton’s declarations in IPR2019-00627 (Ex. 1070) and IPR2019-00646 (Ex. 1073) include nearly identical content regarding the ICC specifications (*see* Strike Mot., App. A), the only relevant exhibit for this case is Exhibit 1071.

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he acknowledged that his testimony regarding the newsgroup was false. *Id.* at 5 (citing Ex. 2235, 487:25–503:8).

Petitioner argues “[t]he great bulk of Dr. Poynton’s third supplemental declaration is ordinary rebuttal of arguments made in [Patent Owner’s] response” and that “[m]uch of this expands on similar passages in his original declaration that [Patent Owner] has never challenged.” Strike Opp. 9. Petitioner also acknowledges that Dr. Poynton’s testimony on the active dates of the “sci.engr.color” newsgroup might be wrong, but that it “is an understandable, if regrettable, error” that “does not justify striking all of Dr. Poynton’s testimony.” *Id.*

Patent Owner establishes that Dr. Poynton’s Third Supplemental Declaration includes at least some of the same testimony from the CP1 declaration (*see* Strike Mot., Apps. A, B) that we did not enter as supplemental information. Paper 74, 13. Although we previously found that Dr. Poynton’s CP1 declaration would not “clarify the record or be in the interest of efficient administration of these proceedings” (Paper 74, 13), we did not expressly prohibit the introduction of further testimony from Dr. Poynton. We also note that Dr. Poynton’s Third Supplemental Declaration appears to include at least some new testimony. For these reasons, we decline to strike Dr. Poynton’s Third Supplemental Declaration solely because Dr. Poynton includes testimony similar to that in his CP1 declaration.<sup>11</sup>

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<sup>11</sup> Patent Owner also argues that the declarations of Dr. Poynton (Ex. 1071), Mr. Kelley (Ex. 1074), and Dr. Murch (Ex. 1088), and associated exhibits (Exs. 1075–1086), are beyond the scope of allowable reply evidence under 37 C.F.R. § 42.23(b). Strike Mot. 1–2. These declarations and exhibits are

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Nevertheless, we have serious concerns about the veracity of Dr. Poynton’s testimony in its totality. Dr. Poynton’s CP1 declaration included a “large number of unsupported and incorrect statements” regarding the ICC specifications that we detailed in our supplemental information Order. Paper 74, 13; *see also id.* at 6 (“[W]e observe that Dr. Poynton’s [CP1] declaration contains several deficiencies, including inaccurate, incomplete, or irrelevant statements regarding ICC v.3.0 and ICC v.3.01 that are not supported by the ‘Appendices’ accompanying his declaration.”), 8 (“Dr. Poynton’s proffered testimony about Appendices CC and DD being copies of the ICC specifications from 1994 or 1995 is not credible; the documents he relies upon for this testimony, Appendices CC and DD, are dated later (i.e., 1998) and do not support his testimony.”), 10 (“During the January 24, 2020 conference call with the parties, Petitioner informed the panel that, contrary to Dr. Poynton’s testimony, Appendix F was not obtained from a USPTO file history. As such, we agree with Patent Owner . . . that Appendix F, and Dr. Poynton’s accompanying testimony, is not relevant to Petitioner’s efforts to establish that Exhibit 1013 was from before February 1996.”).

With respect to the instant Motion, Patent Owner establishes that Dr. Poynton’s Third Supplemental Declaration includes testimony regarding the ICC specifications that is similar to that in the CP1 declaration. *See*

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at least partially responsive to Patent Owner’s arguments regarding to the printed publication status of the ICC specifications. *See* PO Resp. 1. Given that *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, 15 (PTAB Dec. 20, 2019) (precedential), expressly allows reply evidence in this situation, we decline to strike these exhibits as being out-of-scope.

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Strike Mot., Apps. A, B. As discussed above, such testimony has proved to be unreliable. In addition, Patent Owner has shown (*id.* at 3–5) and Petitioner has acknowledged (Strike Opp. 9) further incorrect statements in Dr. Poynton’s newly added testimony about the ICC specifications; these go beyond the credibility issues that we previously found in the CP1 declaration. *See, e.g.*, Ex. 2235, 532:24–534:4 (Dr. Poynton acknowledging errors in his direct testimony (Ex. 1071 ¶ 10) regarding the time by which an FTP site for downloading ICC specifications was announced in an Internet newsgroup). Thus, at each turn, Dr. Poynton’s testimony has proven unreliable on matters related to the authenticity and public accessibility of the ICC specification. Rather than striking Dr. Poynton’s testimony, however, we accord little to no weight to Dr. Poynton’s testimony pertaining to the authenticity and public accessibility of ICC specifications. Thus, we *deny* Patent Owner’s motion to strike Exhibit 1071.

We also decline to sanction Petitioner to the extent it has reintroduced testimony from Dr. Poynton. As discussed above, we previously found that the same or similar testimony did not satisfy the requirements of Rule 123(a) for the submission of the proffered supplemental information into the record. Paper 74. However, our previous analysis in that context did not prohibit either party from further developing the record on outstanding issues in the proceeding. Thus, we deny Patent Owner’s request for sanctions.

### C. *Patent Owner’s Motion to Strike Mr. Kelley’s Declaration (Exhibit 1074)*

Patent Owner moves to strike Exhibit 1074, the Declaration of Mr. Kelley. Strike Mot. 6–10. As stated above, Mr. Kelley is Petitioner’s

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lead counsel in this case. Pet. 2. Patent Owner characterizes Mr. Kelley's declaration as an improper rejoinder to our decision (Paper 74) not to enter Dr. Poynton's CP1 declaration as supplemental information. Strike Mot. 8–9 (citing, *inter alia*, Ex. 2235, 45:12–25 (Mr. Kelly testifying that his declaration “attempts to provide the information the Board said was missing in Poynton's comparison”)). Patent Owner notes that Mr. Kelley included five documents Dr. Poynton attached to his CP1 declaration, and that Mr. Kelley purports to compare certain of these documents to the ICC specifications in Exhibits 1013 and 1014. *Id.* at 7–8. Patent Owner argues Mr. Kelley is not an expert in “printing, typography, or document comparison” and has “had no involvement or personal experience with the ICC specifications in the 1990s.” *Id.* at 6 (citing Ex. 2236, 13:12–23, 13:25–15:15). Patent Owner also argues that Mr. Kelley's declaration includes attorney argument that Petitioner improperly attempts to incorporate by reference into Petitioner's Reply in contravention of 37 C.F.R. § 42.6(a)(3). *Id.* at 8–10.

Petitioner argues that Mr. Kelley's declaration “establishes the precise relationship between various public copies of the ICC specifications, which the Board believed was a prerequisite for their admission.” Strike Opp. 11 (internal citations omitted). During an earlier conference call with the Board, Mr. Kelley likened his testimony to an attorney declaration where an attorney attests to an exhibit being a “true and correct copy” of that exhibit. Ex. 1097, 13:10–14:3. Petitioner also notes that Mr. Kelley's declaration includes certain “explanations of relevance” that Petitioner “included to assist the Board in understanding why Adobe was presenting the evidence.” Strike Opp. 11 (citing Ex. 1074 ¶¶ 12, 13, 16, 21, 22, 26, 31–33, 40, 41).

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Remarkably, Petitioner states that we may simply ignore the “explanations of relevance” if we do not find them helpful. *Id.*

We agree with Patent Owner that Mr. Kelley’s declaration is replete with argumentative statements akin to those found in briefs. For example, the declaration includes arguments about public accessibility. *See, e.g.*, Ex. 1074 ¶ 13 (“The fact that representatives of Canon believed that they were free to submit a copy of the ICC Profile Format v.3.0 specification to the PTO confirms the testimonial evidence from Dr. Phil Green, Technical Secretary of the ICC, Dr. Murch, and Dr. Poynton that the ICC Profile Format v.3.0 specification was freely distributed.”). Moreover, as acknowledged by Petitioner (Strike Opp. 11), Mr. Kelley explains why he believes certain exhibits are relevant. *See, e.g.*, Ex. 1074 ¶¶ 40–41 (providing reasons why Exhibit 1080 allegedly is relevant). In addition, Mr. Kelley applies various Federal Rules of Evidence in his declaration. *See, e.g.*, Ex. 1074 ¶ 44 (explaining why statements made in a patent application are purportedly subject to the hearsay exception under Fed. R. Evid. 803(16)). Mr. Kelley also states why he believes that certain exhibits attached to Dr. Green’s declaration are authentic.<sup>12</sup> *See* Ex. 1074 ¶¶ 16, 26.

This purported testimony from Mr. Kelley constitutes attorney argument that should have been presented in Petitioner’s briefs. Petitioner appears to concede as much when it invites us to ignore at least portions of Mr. Kelley’s declaration. Strike Opp. 11. Given the pervasiveness of

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<sup>12</sup> For example, Mr. Kelley states a case for authenticating the documents attached to Dr. Green’s declaration with reference to Federal Rule of Evidence 901(b)(8). *See infra* § I.F.

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improper attorney argument, however, we need not attempt to sort proper from improper portions of Mr. Kelley's declaration. *See* Consolidated TPG, 74. We also agree with Patent Owner (Strike Mot. 9–10) that, in contravention of 37 C.F.R. § 42.6(a)(3), Mr. Kelley's declaration is tantamount to an improper attempt by Petitioner to incorporate arguments and further elaborations into its main papers by reference to Mr. Kelley's declaration. *See* Pet. Reply 1, 4, 7 (citing Kelley declaration); Strike Opp. 11 (citing Kelley declaration for “the precise relationship between various public copies of the ICC specifications” and “explanations of relevance”). These procedural defects related to Mr. Kelley's role as lead counsel support striking Mr. Kelley's declaration in its entirety.

Mr. Kelley's declaration also is concerning because he is neither a percipient witness nor an expert regarding the subject matter of his declaration, as he admitted during cross-examination. *See* Ex. 2236, 13:18–23 (Mr. Kelley testifying he “never heard of the ICC specification before [he] began this -- this work”), 13:25–15:8 (Mr. Kelley testifying that he does not present himself as an expert). Nevertheless, Petitioner attempts to use Mr. Kelley's declaration as a vehicle for introducing “various public copies of the ICC specifications” by establishing their “precise relationship.” Strike Opp. 11. Mr. Kelley also purports to synthesize other declarants' testimony regarding ICC specifications via citations and allusions to that testimony. *See, e.g.*, Ex. 1074 ¶ 14 (“I am informed by the testimony of Dr. Green, Dr. Murch and Dr. Poynton that the ICC developed the ICC v.3.0 and v.3.01 specifications.”). Given Mr. Kelley's lack of firsthand knowledge, we find that his testimony is of little or no probative value. This also supports striking Mr. Kelley's declaration.



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Having considered the parties' arguments, we are persuaded that Mr. Kelley's declaration is improper because it includes attorney argument that ultimately is incorporated by reference in Petitioner's papers. Mr. Kelley's testimony is also suspect because he is neither a percipient witness nor an expert in the subject matter of his testimony. Accordingly, we *grant* Patent Owner's motion to strike Mr. Kelley's declaration.<sup>13</sup>

*D. Patent Owner's Motion to Strike Dr. Murch's Declaration (Exhibit 1088)*

Patent Owner moves to strike Exhibit 1088, the Declaration of Dr. Murch. Strike Mot. 10–12. As with Mr. Kelley's declaration, Patent Owner contends that Dr. Murch's declaration is an improper reply to our decision (Paper 74) not to enter Dr. Poynton's CP1 declaration as supplemental information. Strike Mot. 10–11. Patent Owner also contends Dr. Murch's testimony regarding the dates of the ICC specifications "is of limited value" because he misstated certain dates related to his own education and employment history "by as much as 4+ years." *Id.* at 11 (citing Ex. 2237, 18:4–16; 20:14–30:5). Patent Owner additionally notes that Dr. Murch did not know whether the versions of the ICC specifications

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<sup>13</sup> We further note that, in response to Patent Owner's criticism that Mr. Kelley did not "include or attach any comparisons (*e.g.*, redlines)" of the various versions of the ICC specifications (Strike Mot. 7), Petitioner included such comparisons as attachments to its Opposition to the motion to strike. Strike Opp. 7, Attachments C-1 to C-4. Given that we have now stricken the underlying declaration of Mr. Kelley, we do not consider these comparisons. We also agree with Patent Owner (Paper 108, 6–7) that Petitioner's attempt to include these comparisons in the Opposition is untimely and out-of-scope.

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in Exhibits 1013 and 1014 were draft or final versions. *Id.* at 11–12 (quoting Ex. 2237, 44:4–17).

Petitioner argues that Dr. Murch’s declaration is responsive to Patent Owner’s arguments about public accessibility of the ICC specifications. Strike Opp. 12. Petitioner then highlights certain aspects of Dr. Murch’s testimony that it contends are responsive, including Dr. Murch’s testimony on the authenticity of Exhibits 1013 and 1014 and the implications of the words “DRAFT” on Exhibit 1014. *Id.* (citing Ex. 1088 ¶¶ 4–6).

As above with the Third Supplemental Declaration of Dr. Poynton, we do not find good cause for striking Dr. Murch’s declaration simply because the declaration testimony responds to our supplemental information Order. Nevertheless, Patent Owner highlights deposition testimony regarding the ICC specifications that is incongruent with Dr. Murch’s direct testimony in his declaration. Specifically, on cross-examination, Dr. Murch could not identify whether Exhibit 1014 was a draft or final copy of the ICC v.3.01 specification. *See* Ex. 2237, 43:15–44:17. This undermines his testimony about how the words “DRAFT” on Exhibit 1014 were merely something that the ICC “regularly add[ed]” to specifications. Ex. 1088 ¶ 6. It also calls into question his identification of Exhibit 1014 as the particular version of the ICC v.3.01 industry standard that was published in 1995. *See id.* These considerations go to the weight this evidence should be given, not to its admissibility. Thus, we *deny* Patent Owner’s motion to strike Exhibit 1088. Nevertheless, given that Dr. Murch’s declaration testimony does not reflect his uncertainty regarding whether Exhibit 1014 is a draft, we give his testimony regarding the authenticity and public accessibility of the ICC specifications little to no weight.

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### *E. Patent Owner's Motion to Exclude Exhibits 1078–1080*

Patent Owner moves to exclude two versions of ICC v.3.01 (and an associated exhibit) in Exhibits 1078–1080. PO Exclude 6–7. Petitioner introduced these exhibits with its Reply. Pet. Reply 1, 3–4. Petitioner contends Exhibit 1079 is “a copy of ICC v.3.01 submitted to the USPTO on September 15, 1995 by a third party, Canon,” during the prosecution of Patent No. 5,646,752. *Id.* at 4. Petitioner also cites an Information Disclosure Statement (IDS) in Exhibit 1078 from the prosecution of the same patent; the IDS is dated September 15, 1995, and lists ICC v.3.01. *Id.* Petitioner additionally contends Exhibit 1080 is a copy of ICC v.3.01 that Patent Owner submitted “during prosecution of the ’444 patent’s ultimate parent, the ’909 patent.” *Id.* at 1.

Patent Owner argues that Exhibits 1078–1080 are inadmissible as irrelevant. PO Exclude 6 (citing Fed. R. Evid. 401). According to Patent Owner, Exhibits 1079 and 1080 are the same versions of ICC v.3.01 that Petitioner attempted to enter as supplemental information as Appendices AA and I, respectively, to Dr. Poynton’s CP1 declaration. *See id.* Patent Owner argues that we had previously ruled the versions of ICC v.3.01 in Exhibits 1079 and 1080 “to be irrelevant to questions about [Exhibit 1014] *inter alia* because of their differences.” PO Exclude 6–7 (citing Paper 74, 10–12).

Patent Owner’s argument for excluding Exhibits 1078–1080 is premised entirely on our prior decision not to enter Appendices AA and I of Dr. Poynton’s CP1 declaration as supplemental information. PO Exclude 6–7 (citing Paper 74, 10–12). Our decision did not, however, expressly preclude the reintroduction of the same documents as exhibits with

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Petitioner's Reply. Moreover, Patent Owner's allusion to "differences" between Exhibits 1079 and 1080 and Exhibit 1014 (*see id.*) is not a developed or persuasive argument as to why we should exclude Exhibits 1078–1080 as irrelevant. Under these circumstances, we *deny* Patent Owner's motion to exclude Exhibits 1078–1080.<sup>14</sup>

### *F. Motion to Exclude Exhibit 1014*

Patent Owner moves to exclude Exhibit 1014 because, *inter alia*, it has not been authenticated. PO Exclude 1.

Petitioner contends that Patent Owner's arguments relate to the sufficiency of Petitioner's evidence that the version of ICC v.3.01 in Exhibit 1014 is a printed publication, and not to the admissibility of Exhibit 1014. Pet. Exclude Opp. 1 (citing, *inter alia*, Consolidated TPG, 79). Petitioner further argues Patent Owner is estopped from contesting the authenticity of Exhibit 1014 based on statements regarding prior art ICC industry standards in the specification of the '444 patent. *Id.* (citing Ex. 1002, 3:35, 7:62–8:7, 18:37–48). Petitioner also argues that Patent Owner submitted an Information Disclosure Statement identifying the ICC v.3.01 specification, along with a copy of the specification itself, during prosecution of a related application. *Id.* at 3 (citing Ex. 1080, 4, 12–84). Petitioner also contends Exhibit 1014 has been authenticated (1) based on Dr. Green's, Dr. Murch's, Dr. Poynton's, and Mr. Kelley's testimony (*id.* at

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<sup>14</sup> Nevertheless, as discussed below (*see infra* § II.F), we do not agree with Petitioner about the import of Exhibits 1078–1080 for authenticating Exhibit 1014 in light of the admissible evidence.

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1–2; Pet. Reply 1–5); (2) based on the public records provision of Federal Rule of Evidence 901(b)(7) (Pet. Exclude Opp. 4); (3) as an ancient document under Federal Rule of Evidence 901(b)(8) (*id.*); and (4) based on its distinctive characteristics under Federal Rule of Evidence 901(b)(4) (Pet. Reply 4).

“To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Fed. R. Evid. 901(a). Petitioner contends Exhibit 1014 is the published version of the ICC v.3.01 industry standard. Pet. iv, 8–10, 18; Pet. Reply 1–3, 5–7.

First, we consider the testimony put forth by Petitioner for authenticating Exhibit 1014. As discussed above (*see supra* § II.A), we have excluded the declaration of Dr. Green, which was the primary way Petitioner attempted to authenticate Exhibit 1014 in the Petition. *See* Pet. 18–19 (citing, *inter alia*, Ex. 1010 ¶¶ 6–7); *see also* Pet. Reply 4 (citing Ex. 1010 ¶¶ 11–12). Regarding Petitioner’s cited evidence of authenticity in the Reply (*see* Pet. Reply 1–5), we have stricken the declaration of Mr. Kelley (*see supra* § II.A) and have accorded little to no weight to Dr. Poynton’s testimony pertaining to the authenticity and public accessibility of ICC specifications (*see supra* § II.B).

The remaining authentication evidence cited by Petitioner includes Dr. Poynton’s initial declaration (Exhibit 1009) and Dr. Murch’s declaration. *See* Pet. 18–19; Pet. Reply 3–4. Dr. Poynton’s recollection of the time frame in question contains admitted inaccuracies, which cast doubt on his memory of the events and details from a quarter century ago. *See* Ex. 1071 ¶ 5 n.1 (Dr. Poynton admitting an error in his curriculum vitae related to the dates of

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his employment with Sun Microsystems, the organization he represented at the ICC); Ex. 2235, 477:21–478:14 (Dr. Poynton’s cross-examination testimony regarding the same), 532:24–534:4 (Dr. Poynton acknowledging errors in his direct testimony regarding the active dates of the “sci.engr.color” Internet newsgroup). Even if we were to overlook Dr. Poynton’s credibility issues, Dr. Poynton’s initial declaration does not authenticate Exhibit 1014. Rather, the most germane passage cited by Petitioner states the following: “As the cover page of ICC v.3.01 indicates, ICC v.3.01 was published on May 8, 1995 by the ICC. (ICC v.3.01, 1; Green ¶ 7.)” Ex. 1009 ¶ 468. As can be seen, Dr. Poynton’s testimony merely restates what is printed on the front page of ICC v.3.01<sup>15</sup>, and he further relies on Dr. Green’s now-excluded testimony. *See id.* Without support from Dr. Green, however, Dr. Poynton’s testimony is not persuasive evidence that Exhibit 1014 is the published version of ICC v.3.01.<sup>16</sup> In addition, Petitioner’s contention that Dr. Poynton “identified Exhibit 1014 as ‘ICC v.3.01’” in his original declaration (*see* Pet. Reply 3 (citing Ex. 1009 ¶ 12)) refers to nothing more than a row of data in Dr. Poynton’s 3-page table of the materials he considered. *See* Ex. 1009 ¶ 12 (listing the “Exhibit” as “Ex. 1014 (‘ICC v.3.01’)” and the “Description” as “International Color Consortium Profile Format, version 3.01, dated May 8, 1995”). This also is

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<sup>15</sup> Presumably, Dr. Poynton’s reference to “the cover page of ICC v.3.01” refers to the version of ICC v.3.01 in Exhibit 1014, but that presumption would only be based on Dr. Poynton’s list of references considered (*see* Ex. 1009 ¶ 12), which we discuss directly below.

<sup>16</sup> Dr. Poynton similarly relies on Dr. Green’s excluded testimony in other paragraphs of his first declaration. *See, e.g.*, Ex. 1014 ¶¶ 194, 469.

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not probative evidence authenticating Exhibit 1014. Petitioner's other cited paragraphs merely list Dr. Poynton's experience in the ICC (Ex. 1009 ¶ 7) or else provide general background on ICC specifications (*see, e.g., id.* ¶¶ 192–193, 195, 458, 469); as such, they do not support the authentication of Exhibit 1014.

Further, Exhibit 1014 includes the word “DRAFT” across its header, and Dr. Murch testified during cross-examination that he was uncertain whether Exhibit 1014 is a draft or final version of the published ICC v.3.01 industry standard. *See* Ex. 2237, 43:15–44:17. Correspondingly, Dr. Poynton testified that “drafts would be circulated among contributors. Drafts in many standards efforts, including the ICC, were even distributed outside the immediate contributors. And -- and at some point agreement would -- or consensus would be achieved.” Ex. 2235, 553:20–554:5. Given the “DRAFT” header on Exhibit 1014, Dr. Poynton's statements regarding the distribution of various drafts, and Dr. Murch's uncertainty about whether Exhibit 1014 is a draft, Petitioner's remaining testimonial evidence does not establish that Exhibit 1014 is an authentic copy of the ICC v.3.01 industry standard published on or about May 8, 1995 by the ICC. For these reasons, Petitioner's arguments for authenticating Exhibit 1014 based on the testimony of Dr. Green, Dr. Murch, Dr. Poynton, and Mr. Kelley are not persuasive.

Next, we consider Petitioner's arguments based on the examples in Rule 901(b) of the Federal Rules of Evidence. Rule 901(b)(4) provides an example where “[t]he appearance, contents, substance, internal patterns, or other distinctive characteristics of the item, taken together with all the circumstances” may satisfy the requirement of Rule 901(a). Fed. R. Evid.

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901(b)(4). Specifically, Petitioner cites “the title, version number, date, copyright, contact information, and profile description” on Exhibit 1014 and contends these indicia can support authentication even without direct testimony. Pet. Reply 4 (citing *United States v. Holmquist*, 36 F.3d 154, 167 (1st Cir. 1994)). We are not persuaded by Petitioner’s argument. Even if we were to consider the indicia in Exhibit 1014 mentioned by Petitioner (e.g., title, version number, date, copyright), we cannot overlook the “DRAFT: DRAFT:DRAFT:DRAFT” header on Exhibit 1014. *See* Ex. 1014, 1. Nor can we overlook Dr. Murch’s uncertainty about the draft or final status of Exhibit 1014 (Ex. 2237, 43:15–44:17) and Dr. Poynton’s testimony regarding distribution of draft copies (Ex. 2235, 553:20–554:5). This evidence suggests that the document in Exhibit 1014 is not the published version of the ICC v.3.01 industry standard. Petitioner also attempts (Pet. Reply 1–2) to liken Exhibit 1014 to another version of ICC v.3.01 in Exhibit 1080 that lacks this “DRAFT” header. *See* Ex. 1080, 12. Again, this undercuts Petitioner’s suggestion that Exhibit 1014 is an authentic version of the published ICC v.3.01 industry standard based on the distinctive characteristics of Exhibit 1014. Thus, having considered Petitioner’s cited indicia together with “all the circumstances,” including the “DRAFT” header, we are not persuaded by Petitioner’s arguments under Rule 901(b)(4).

The public records example of Rule 901(b)(7) states that an item may be authenticated with “[e]vidence that: (A) a document was recorded or filed in a public office as authorized by law; or (B) a purported public record or statement is from the office where items of this kind are kept.” Fed. R. Evid. 901(b)(7). Petitioner purports to apply this Rule with respect to



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Exhibit 1079, which Petitioner characterizes as “a document that is identical to Exhibit 1014 (save for some handwritten scribbles added to Exhibit 1079), [that] has been maintained in the files of the PTO since Canon filed it with the Patent Office in September 1995.” Pet. Exclude Opp. 4 (citing Exs. 1078, 1079). Petitioner argues that “[a]ny minor differences in the printed appearance of Exhibits 1014 and 1079 or 1080 do not alter the fact that the text itself is authentic.” *Id.*

We are not persuaded by Petitioner’s arguments. First, Petitioner purports to apply the public records example to one document, Exhibit 1079, for the benefit of authenticating another admittedly different document, Exhibit 1014. *See* Pet. Exclude Opp. 4 (acknowledging added “handwritten scribbles” and “minor differences in the printed appearance” of Exhibit 1079); Pet. Reply 4–5 (mentioning “handwritten notes” and “formatting differences” in Exhibit 1079). Yet Petitioner fails to cite any legal authority sanctioning such an application of Rule 901(b)(7) where the item to be authenticated is different from the alleged public record itself. And, even if we were to overlook the differences between Exhibits 1014 and 1079, Petitioner bases its comparison of these two documents and attempts to explain the relevance of Exhibit 1079 via the testimony of Mr. Kelley. *See* Pet. Reply 4 (citing Ex. 1074 ¶¶ 30); Ex. 1074 ¶¶ 30–33. As discussed above, we have stricken Mr. Kelley’s testimony. *See supra* § II.C. We decline to draw inferences about the authenticity of Exhibit 1014 based on alleged similarities with Exhibit 1079 and 1014 in the absence of admissible evidence about the same. The same legal and evidentiary deficiencies apply to Petitioner’s analysis of Exhibit 1080. *See* Pet. Exclude Opp. 4; Pet. Reply 1 (citing Ex. 1074 ¶¶ 37–39); Ex. 1074 ¶¶ 37–41. For these reasons, we are

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not persuaded by Petitioner's arguments based on the public records example of Rule 901(b)(7).

Rule 901(b)(8) states that an ancient document may be authenticated with "evidence that it: (A) is in a condition that creates no suspicion about its authenticity; (B) was in a place where, if authentic, it would likely be; and (C) is at least 20 years old when offered." Fed. R. Evid. 901(b)(8). Petitioner argues that Exhibit 1014 "is over 20 years old and was found where it would be expected to reside on the computer servers of the ICC." Pet. Exclude Opp. 4. Petitioner appears to be referring to the testimony of Dr. Green, "who provided a copy of ICC v.3.01 from the ICC's business records." Pet. Reply 4 (citing Ex. 1010 ¶¶ 11, 12). Nevertheless, as discussed above, we have excluded the declaration of Dr. Green as inadmissible hearsay and because Petitioner did not make Dr. Green available for a deposition in a timely manner. *See supra* § II.A. Thus, Petitioner's contention about Exhibit 1014 arising from ICC computer servers is not supported by admissible evidence. We also note that the presence of the "DRAFT" header in Exhibit 1014 and the different versions of ICC v.3.01 in the record (e.g., Ex. 1080) creates suspicion about Exhibit 1014's authenticity. Thus, we are not persuaded that Exhibit 1014 is authenticated under the ancient document example of Rule 901(b)(8).

Petitioner additionally cites several prior cases as supporting its use of Exhibits 1079 and 1080 to bolster the authenticity of Exhibit 1014 (Pet. Exclude Opp. 4–5), but these cases are distinguishable from the instant case. Most of Petitioner's cited cases focus on using additional documents to establish the public accessibility of a reference, rather than establishing the authenticity of a reference. For example, Petitioner characterizes *In re*

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*Wyer*, 655 F.2d 221, 226 (CCPA 1981), as establishing “*publication . . . by proof of access to ‘a perceptible description of the invention.’*” Pet. Exclude Opp. 4–5 (emphasis added) (quoting *Wyer*). Petitioner’s citation to *SAP America, Inc. v. Realtime Data LLC*, IPR2016-00783, Paper 19 at 9 (PTAB Oct. 5, 2016), likewise relates to “public accessibility” by Petitioner’s own reckoning. Pet. Exclude Opp. 4–5. In another case cited by Petitioner, *Seabery North America Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 60 at 10–13 (PTAB Oct. 2, 2017), a witness established the authenticity of each of three different versions of a reference that were being considered in a public accessibility analysis. Furthermore, Petitioner cites *In re Enhanced Security Research, LLC*, 739 F.3d 1347, 1355–56 (Fed. Cir. 2014), but that case is not relevant to the instant admissibility issue in an *inter partes* review because it pertains to the propriety of using partial copies of a reference during patent prosecution. As can be seen, none of these cases pertains to authenticating a reference by comparing it to other documents, as Petitioner seeks to do here.

Petitioner additionally cites sections in the ’444 patent that characterize ICC specifications, including ICC v.3.01, as prior art. Pet. Exclude Opp. 2 (citing Ex. 1002, 3:35, 7:62–8:7, 18:37–48). Petitioner argues that, during prosecution of an application in the priority chain of the ’444 patent, Patent Owner identified the ICC v.3.01 specification in Exhibit 1080 as ICC v.3.01. *Id.* at 3 (citing Ex. 1080, 4). Petitioner contends these characterizations are binding on Patent Owner. *Id.* at 2–3.

We are not persuaded by Petitioner’s arguments. Petitioner concedes that Exhibit 1080 differs from Exhibit 1014 “in a ‘DRAFT’ heading, a copyright notice, and some unrelieved-on text cut off at the endings of a small

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number of paragraphs.” Pet. Exclude Opp. 2. Thus, to the extent Patent Owner made any concessions during prosecution of the related patent application, they relate to a different document than Exhibit 1014.

Accordingly, we do not agree that Patent Owner’s statements regarding Exhibit 1080 during prosecution work to authenticate Exhibit 1014. Nor do Patent Owner’s mentions of ICC v.3.01 in the ’444 patent serve to authenticate Exhibit 1014, because no record evidence links these mentions to the particular document in Exhibit 1014.

Petitioner’s citations to case law do not fare better. Petitioner cites several cases for the proposition that “[a] statement in a patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.” Pet. Exclude Opp. 2 (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988)); see also *id.* (citing *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1362 (Fed. Cir. 2007); *In re Nomiya*, 509 F.2d 566, 571 (CCPA 1975)). Nevertheless, we agree with Patent Owner (PO Exclude Reply 3–4) that this general proposition does not apply here, because Petitioner has not established that the patent applicant’s alleged concession relates to the particular reference being asserted here, Exhibit 1014.

In summary, Petitioner does not establish by a preponderance of the evidence that Exhibit 1014 is an authentic copy of the published ICC v.3.01 industry standard rather than merely a draft copy with an unknown circulation history. Without direct evidence authenticating Exhibit 1014, Petitioner relies on circumstantial evidence based on similar documents. But the differences in those similar documents undermine Petitioner’s case for

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authentication. And, most concerningly, Exhibit 1014 includes “DRAFT” markings that Exhibit 1080 does not have. Although Petitioner argues that it is beyond doubt that ICC v.3.01 was a well-known and published industry standard (*see, e.g.*, Pet. Reply 1–3, 5–7; Pet. Exclude Opp. 3, 5), we cannot discern from this record if those characterizations apply to the particular document in Exhibit 1014. Under these circumstances, we *grant* Patent Owner’s motion to exclude Exhibit 1014 because Petitioner has not shown by a preponderance of the evidence that Exhibit 1014 is the published version of the ICC v.3.01 industry standard, which is what Petitioner claims it to be.

### *G. Obviousness Grounds Based on ICC v.3.01*

All of the instituted grounds rely on Petitioner’s asserted version of ICC v.3.01 in Exhibit 1014 as the primary reference. *See supra* § I.F; *see also, e.g.*, Pet. 34 (relying only on ICC v.3.01 for teaching “a computer at a site” in independent claim 11). We have excluded Exhibit 1014 above. *See supra* § I.F. As a result, Petitioner’s obviousness grounds are fatally flawed. Thus, we determine Petitioner has not shown by a preponderance of the evidence that the subject matter of claims 11, 13, 15, 18, 19, 26, and 27 of the ’444 patent would have been obvious based on the asserted grounds of unpatentability.

### *H. Remaining Motions*

Petitioner moves to exclude portions or all of several exhibits. Paper 110. Petitioner’s motion to exclude is *dismissed as moot* because we do not rely on these exhibits (or portions thereof). Patent Owner moves to

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exclude other exhibits not already discussed in this Decision. *See generally* PO Exclude. Patent Owner also moves to strike additional exhibits not already discussed in this Decision. *See generally* Strike Mot. To the extent that Patent Owner's motions seek to exclude or strike exhibits that we have not already discussed, Patent Owner's motions are *dismissed as moot* because we do not rely on these other exhibits (or portions thereof).

### III. CONCLUSION

Petitioner has not shown, by a preponderance of the evidence, that Exhibit 1014 is an authentic copy of the published ICC v.3.01 industry standard. Thus, we grant Patent Owner's motion to exclude Exhibit 1014. As a result, Petitioner has not shown, by a preponderance of the evidence, that the subject matter of claims 11, 13, 15, 18, 19, 26, and 27 of the '444 patent would have been obvious based on the asserted grounds of unpatentability, which all rely on ICC v.3.01 as the primary reference.

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In summary:

<b>Claims</b>	<b>35 U.S.C. §</b>	<b>References/Basis</b>	<b>Claims Shown Unpatentable</b>	<b>Claims Not Shown Unpatentable</b>
11, 27	103(a)	ICC v.3.01, TIFF 6.0, Beretta		11, 27
11, 13, 18	103(a)	ICC v.3.01, TIFF 6.0, Beretta, User Guide		11, 13, 18
11, 13, 19, 26	103(a)	ICC v.3.01, TIFF 6.0, Beretta, User Guide, Scott-Taggart		11, 13, 19, 26
11, 15	103(a)	ICC v.3.01, TIFF 6.0, Beretta, Herzog		11, 15
<b>Overall Outcome</b>				11, 13, 15, 18, 19, 26, 27

**ORDER**

Accordingly, it is:

ORDERED that Petitioner has not shown by a preponderance of the evidence that claims 11, 13, 15, 18, 19, 26, and 27 of the '444 patent are unpatentable;

FURTHER ORDERED that Patent Owner's motion (Papers 98, 109) to exclude Exhibit 1010, the declaration of Dr. Phil Green, is *granted*; and

FURTHER ORDERED that Patent Owner's motion (Paper 97) to strike Exhibit 1071, the Third Supplemental Declaration of Charles Poynton, Ph.D., is *denied*;

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FURTHER ORDERED that Patent Owner's motion (Paper 97) to strike Exhibit 1074, the declaration of Christopher L. Kelley, is *granted*;

FURTHER ORDERED that Patent Owner's motion to (Paper 97) strike Exhibit 1088, the declaration Gerald Murch, Ph.D., is *denied*;

FURTHER ORDERED that Patent Owner's motion (Paper 97) to strike is *dismissed as moot* in all other respects;

FURTHER ORDERED that Patent Owner's motion (Paper 109) to exclude Exhibits 1078–1080 is *denied*;

FURTHER ORDERED that Patent Owner's motion (Paper 109) to exclude Exhibits 1014 is *granted*;

FURTHER ORDERED that Patent Owner's motion (Paper 109) to exclude is *dismissed as moot* in all other respects;

FURTHER ORDERED that Petitioner's motion to exclude (Paper 110) is *dismissed as moot*;

FURTHER ORDERED that, because this is a Final Written Decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.



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Petitioner:

Christopher L. Kelley  
James F. Valentine  
Wing H. Liang  
PERKINS COIE LLP  
kelley-ptab@perkinscoie.com  
jvalentine-ptab@perkinscoie.com  
wliang@perkinscoie.com

Patent Owner:

Irwin Park  
David P. Berten  
Alison A. Richards  
Ragnar Olson  
GLOBAL IP LAW GROUP, LLC  
ipark@giplg.com  
dberten@giplg.com  
arichards@giplg.com  
rolson@giplg.com