

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE INC.,
Petitioner,

v.

RAH COLOR
TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2019-00627
Patent 7,729,008 B2

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 IPR2019-00627 (Paper No. 121) (“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. 7,729,008 (the “’008 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 28–33 and 36–38 of the ’008 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 1013; the Board’s determination to exclude Exhibit 1014; the Board’s failure to confirm that Exhibit 1013 is admitted prior art; the Board’s failure to confirm that Exhibit 1014 is admitted prior art; the Board’s failure to confirm that Exhibit 1013 is published 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.*

PUBLIC VERSION

Trials@uspto.gov
571.272.7822

Paper 124
Date: August 31, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE INC.,
Petitioner,

v.

RAH COLOR TECHNOLOGIES LLC,
Patent Owner.

IPR2019-00627
Patent 7,729,008 B2

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

IPPOLITO, *Administrative Patent Judge*.

JUDGMENT

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. § 42.64

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

I. INTRODUCTION¹

On February 1, 2019, Petitioner Adobe Inc. filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 28–33 and 36–38 of U.S. Patent No. 7,729,008 B2 (Ex. 1001, “the ’008 patent”). Patent Owner RAH COLOR TECHNOLOGIES LLC filed a Preliminary Response.² Paper 22 (“Prelim. Resp.”; public version in Paper 25³). Additionally, Petitioner filed a Reply (Paper 27) and Supplemental Reply (Paper 31) to Patent Owner’s Preliminary Response, and Patent Owner filed a Sur-reply (Paper 33) to Petitioner’s Reply and Supplemental Reply.

After considering the arguments presented by Patent Owner’s Preliminary Response, we determined that the information presented in the Petition established a reasonable likelihood that Petitioner would prevail with respect to at least 1 of the claims challenged in the petition. Paper 34 (“Dec.”). Pursuant to 35 U.S.C. § 314, we instituted this *inter partes* review as to all of the challenged claims and all grounds raised in the Petition. Dec. 60–61.

¹ 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.

² Patent Owner filed Paper 22 under seal pursuant to the Protective Order entered in this case. See Paper 21, App. A (copy of protective order); Paper 28 (entering protective order). A public version of Preliminary Response available at Paper 25.

³ Unless noted otherwise, citations to “Prelim. Resp.” are to the public version available at Paper 25.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Following institution, Patent Owner filed a Response. Papers 61, 111⁴ (“PO Resp.”). Subsequently, Petitioner filed a Reply (Paper 83, “Pet. Reply”) and Patent Owner filed a Sur-reply (Paper 95, “Sur-reply”).

With our authorization (Paper 56), Petitioner filed a Motion to Submit Supplemental Information. Paper 54 (“Supp. Info. Mot.”). Patent Owner filed an Opposition. Paper 57 (“Supp. Info. Opp.”). We granted Petitioner’s motion in part. Paper 74.

In addition, Patent Owner filed two motions to exclude and a motion to strike. Patent Owner first filed a Motion to Exclude Dr. Green’s Declaration. Paper 97 (“Green Mot.”). Petitioner filed an Opposition to Patent Owner’s motion. Paper 103 (“Green Opp.”).

Patent Owner filed a second Motion to Exclude several of Petitioner’s exhibits and attachments. Paper 108 (“PO Exclude Mot.”). Petitioner opposed Patent Owner’s motion. Paper 113 (“Pet. Exclude Opp.”). Patent Owner filed a reply to Petitioner’s Opposition. Paper 116 (“PO Exclude Reply”).

Patent Owner also filed a Motion to Strike Petitioner’s New Declarations and Evidence. Paper 96 (“Strike Mot.”). Petitioner opposed Patent Owner’s motion. Papers 104, 105 (“Strike Opp.”).

Additionally, Petitioner has filed its own motion to exclude. Paper 109 (“Pet. Exclude Mot.”). Patent Owner filed an opposition.

⁴ Patent Owner filed Paper 61 under seal. A public version of Patent Owner’s Response is available at Paper 111. Unless noted otherwise, citations to “PO. Resp.” are to the public version available at Paper 113.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Paper 112 (“PO Exclude Opp.”). Petitioner filed a reply to Patent Owner’s opposition. Paper 117 (“Pet. Exclude Reply”).

On May 28, 2020, we held a consolidated oral hearing with IPR2019-00627, IPR2019-00628, IPR2020-00629, and IPR2020-00646. A transcript of the hearing is included in the record. Paper 120 (“Hearing Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a). For the reasons we identify below, we determine that Petitioner has not demonstrated by a preponderance of the evidence that claims 28–33 and 36–38 of the ’008 patent are unpatentable.

A. Related Matters

According to Petitioner, “Patent Owner has asserted the ’008 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 has submitted petitions for *inter partes* review challenging related patents in IPR2019-00628 (U.S. Pat. No. 8,416,444 B2), IPR2019-00646 (U.S. Pat. No. 7,791,761 B2), and IPR2019-00629 (U.S. Pat. No. 7,312,897 B2). *Id.*

In addition, Petitioner indicates that the ’008 patent is 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:

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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.*, (W.D.N.Y., Case No. 6:19-cv-06112). Paper 4, 2–3.

B. Real Party-in-Interest

In its Preliminary Response, Patent Owner argued that Petitioner had failed to identify all real parties-in-interest (“RPI”). Prelim. Resp. 41–44. In particular, Patent Owner argued 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 were a RPI, and should have been named in the Petition. Dec. 7–14.

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.*

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

Figure 3A shows the system with prototype node 102 used for pre-production functions (including display 17, hard-copy proofer 16, standard observer meter (SOM) 13), production node 104 (including printing press 15, SOM 13, and proofing device 20), and network 11. *Id.* at 11:58–13:3. Generally, the '008 patent teaches that “[e]ach one of the nodes comprises at least one rendering device.” *Id.* at 9:4–5. “The system distributes the input color image data from one of the nodes to other nodes, . . . and provides a data structure (virtual proof) in the network.” *Id.* at 9:5–9. The '008 patent describes the data structure as having “components shared by the nodes and other components present only at each node.” *Id.* at 9:9–10. Further, the system has 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 9:11–17. This information is “stored in the data structure in different ones of the shared and other components.” *Id.* at 9:17–19.

The '008 patent teaches that its system “computes color transformation functions to translate between human perceptible colors of the measurement data into rendering device colorant values,” distributes the values to remote systems, “implements calibration of rendering devices to a common, human perceptible language of color . . . by producing and storing color transformation information,” and “performs verification of the calibration of the rendering device to maintain accuracy of the stored color

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

transformation information.” *Id.* at 13:22–44. This involves a dynamic “Virtual Proof” data structure “for storing and transmitting files representing color transformation information between network 11 nodes.” *Id.* at 13:48–55. The ’008 patent also describes “‘chromatic adaptation’ transformations to compensate for changes in illumination, viewing conditions, etc. may also be implemented by means of data structures or tables of what are called ‘conditioning’ or color-to-color transforms (output color transforms).” *Id.* at 32:55–59.

D. Challenged Claims

Petitioner challenges claims 28–33 and 36–38. Claim 28 is the only independent claim challenged. Claim 28 is reproduced below:

28. A method for color rendering using a computer system having a display coupled to said computer system, said method comprising the steps of:

displaying on the display a menu of selections which enable a user to select at least user preferences for color reproduction; and

storing in memory at least tonal transfer curves for a plurality of color channels, color image data, and one or more color transformations for converting a first set of color coordinates into a second set of coordinates wherein said tonal transfer curves and said one or more color transformations are at least partly in accordance with calibration data in device-independent units of color and are useable in combination to control rendering of said color image data, and at least one of said one or more color transformations is a chromatic adaptation transform useable to compensate for change in viewing conditions.

Ex. 1001, 50:50–67.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

E. Instituted Grounds of Unpatentability

We instituted *inter partes* review of claims 28–33 and 36–38 of the '008 patent on the following grounds (Dec. 60–61), which are all the grounds presented in the Petition (Pet. 3):

Claims Challenged	35 U.S.C. §⁵	References/Basis
28–30, 32, 33, 36–38	103(a)	ICC v.3.0 ⁶ , User Guide ⁷ , Beretta ⁸
28, 31	103(a)	ICC v.3.01 ⁹ , User Guide, Beretta

In addition to the references listed above, Petitioner filed a first Declaration of Charles Poynton, Ph.D., with its Petition (Ex. 1009, “Dr. Poynton’s First Declaration”) and another declaration from Dr. Poynton with its Reply (Ex. 1070, “Dr. Poynton’s Third Supplemental Declaration”). Petitioner also sought to submit two other supplemental declarations from Dr. Poynton (Paper 54 Attachment CP1, “CP1”, Attachment CP2, “CP2”) as supplemental information, but we did not enter these declarations. Paper 74,

⁵ The '008 patent claims priority is U.S. Patent Application No. 08/606,883, filed on February 26, 1996. Ex. 1001, code (60). 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 '008 patent is before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA version of § 103 applies.

⁶ “InterColor Profile Format,” InterColor Consortium, version 3.0, June 10, 1994 (Exhibit 1013) (“ICC v.3.0”).

⁷ “Adobe Photoshop Version 3.0 User Guide,” Adobe Systems Inc., 1994 (Exhibit 1015) (“User Guide”).

⁸ U.S. Pat. No. 5,416,890, pub. May 16, 1995 (Exhibit 1016) (“Beretta”).

⁹ “International Color Consortium Profile Format,” version 3.01, May 8, 1995 (Exhibit 1014) (“ICC v.3.01”).

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

5–13, 24. Petitioner additionally filed declarations of, *inter alia*, Dr. Thomas Knoll (Ex. 1011), Dr. Phil Green (Ex. 1010), Christopher L. Kelley¹⁰ (Ex. 1074), and Dr. Gerald Murch (Ex. 1088).

Patent Owner filed, *inter alia*, Declarations of Dr. Michael Vrhel (Exs. 2025, 2118, 2120), Dr. Richard A. Holub (Ex. 2121), and Mr. David Ruder (Ex. 2123). The parties also filed transcripts of the depositions of Dr. Poynton (Exs. 1045, 2106¹¹, 2235), Mr. Kelley (Ex. 2236), Dr. Murch (Ex. 2237), and Dr. Vrhel (Ex. 1051).

II. PARTIES' MOTIONS TO EXCLUDE AND STRIKE

Both parties have filed motions to exclude and Patent Owner has additionally filed a motion to strike. Because the outcome of some of these are dispositive of Petitioner's obviousness challenges, we address these motions first.

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

1. *Background*

By way of background, Petitioner submitted Dr. Green's Declaration (Exhibit 1010) with the Petition on February 1, 2019. Dr. Green's Declaration was provided in a related district court litigation where he was subpoenaed to provide Adobe and Quad with copies of ICC Profile specification numbers 3.0, 3.01, 3.2, and ICC.1:2010. Ex. 1010 ¶ 12. At the pre-institution stage, Patent Owner asserted that the version of the ICC v.3.0 in Exhibit 1013 and ICC v.3.01 in Exhibit 1014 were not properly

¹⁰ Mr. Kelley is Petitioner's lead counsel in this case. Pet. 2.

¹¹ The record includes sealed and public versions of this exhibit in accordance with the protective order in this case.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

authenticated, by Dr. Green's testimony in his Declaration, as the industry standards published on or about June 10, 1994 and May 8, 1995. Prelim. Resp. 35.

For the purposes of institution, we determined that Dr. Green's Declaration provided sufficient authentication of Exhibits 1013 and 1014 because he testified that

[t]he copy of the ICC Profile specification number 3.0 that I provided in response to the subpoenas is dated June 10, 1994. The copy of the ICC Profile specification number 3.01 that I provided in response to the subpoenas is dated May 8, 1995. The copy of the ICC Profile specification number 3.2 that I provided in response to the subpoenas is dated November 20, 1995. Each of these specifications was made at or near the date stated on the specification either by or from information transmitted by people with knowledge of the specification's contents. Each of these specifications was kept in the course of a regularly conducted activity of the ICC, and making the specifications was a regular practice of that activity.

Dec. 22 (citing Ex. 1010 ¶ 12) (emphasis removed).

After institution, Petitioner informed Patent Owner and the panel that Dr. Green was not available for cross-examination. In a September 9, 2020 email from Petitioner's counsel wrote an email to Patent Owner's counsel and stated:

We reached out to Phil Green about [Patent Owner's] request for a deposition, and *he declined to appear for a deposition*. As we explained to your team in connection with the Quad case, *because Dr. Green is a third party, [Petitioner] has no control over him*. As we also previously informed your team, because he resides in Norway, *it is our understanding that he cannot be compelled to appear for a deposition. To be clear, [Petitioner] does not object to his deposition, but [Petitioner] cannot force him to appear*.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Green Mot., App. A (email exchange between the parties' counsel from early September 2019) (emphases added).

Subsequently, Petitioner represented to the Board during an October 2, 2019 conference call with the parties that Dr. Green was unavailable for cross-examination. The exchange between the panel and Petitioner's counsel is provided below:

THE [BOARD]: Okay. I think I have an understanding of where you guys are on that. Let's talk about . . . Dr. Green. So are you going to be able to find someone -- are you in the process of finding someone to replace him or take his place? I'm a little concerned that we haven't heard about the fact that one of your witnesses is unavailable.

[COUNSEL FOR PETITIONER]: Yes. So Dr. Green, the reason -- so, he is a third-party witness for the ICC. We obtained a declaration from him through a subpoena in the district court case several months ago. He's actually located in Norway. *There's legal issues with taking a deposition in Norway, first of all, in terms of legality and timing requirements. Also, because he's a third party, we can't force him to attend the deposition, and so we asked him to, and he declined. So what we have offered instead is our expert.* So as I just explained our expert, Dr. Poynton, himself, worked on the ICC specification, and he provided in his supplemental declaration copies of -- his own copies when he was working at the relevant time, so he can provide that testimony that Dr. Green previously provided, so Dr. Poynton can authenticate and discuss the public accessibility of the references.

Ex. 1043, 20:12–21:12 (emphases added).

On the October 2, 2019 conference call with the panel, Petitioner also sought authorization to file a Motion to Submit Supplemental Information. Paper 46, 2–5. We denied that request because the parties were close to an agreement on some of the pending issues. *Id.* at 3. Thereafter, on

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

November 12, 2019, Petitioner renewed its request to submit a supplemental declaration by Dr. Poynton, which was granted. Paper 56, 5. On November 18, 2019, Petitioner submitted Dr. Poynton's supplemental declarations, CP1 and CP2, with its Motion to Submit Supplemental Information. Paper 54. In that motion, Petitioner stated that it "*asked Dr. Green to appear for deposition at [Patent Owner's] request, but Dr. Green declined. Dr. Green resides in Norway, which [Petitioner] understands to prohibit compelled deposition testimony.* Further, because Dr. Green is not affiliated with or paid by [Petitioner], [Petitioner] could not require Dr. Green to appear." *Id.* at 2–3 (emphasis added).

Based on Petitioner's representations regarding Dr. Green's refusal to be cross-examined, Patent Owner cited Dr. Green's unavailability in its Patent Owner Response filed on December 13, 2019. Specifically, Patent Owner argued that Petitioner's versions of the ICC v.3.0 in Exhibit 1013 and ICC v.3.01 in Exhibit 1014 should be excluded because neither could be authenticated as the industry standard specifications without Dr. Green's testimony. PO Resp. 27. Patent Owner further explained that

[b]ased on the current record, the versions of ICC v.3.0 (Exhibit 1013) and ICC v.3.01 (Exhibit 1014) relied upon in the Petition are not authenticated. *They cannot be authenticated on the basis set forth in the Institution Decision because witness Green sponsored by Petitioner (and whose testimony the Board relied upon) declined to be cross-examined.* The unavailable witness' testimony cannot be used.

Id. (emphasis added).

On February 13, 2020, Petitioner's Motion to Submit Supplemental Information was granted-in-part by the panel. Paper 74. In that Order, we denied Petitioner's request to submit Dr. Poynton's supplemental

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

declarations, CP1 and CP2, and the numerous attachments to his declarations as supplemental information. *Id.* at 5–24.

Nearly a month after our February 13, 2020 Order, three months after the Patent Owner’s Response was filed (December 13, 2019), and six months after institution of trial (August 20, 2019), Petitioner informed the panel, on a March 9, 2020 conference call, that Dr. Green had changed his position; Petitioner indicated that Dr. Green was now willing to be cross-examined by Patent Owner. Paper 86, 3–4. Petitioner then argued that it was not too late for Patent Owner to depose Dr. Green. *Id.* On that call, Patent Owner argued that Petitioner had not shown good cause for this late action and that it would not be in the interest of justice for the panel to excuse Petitioner’s failure to make Dr. Green available earlier.

Ultimately, Patent Owner did not depose Dr. Green and, instead, filed the motions to exclude his declaration (Exhibit 1010) discussed herein.

With this background in mind, we turn to the parties’ arguments.

2. Patent Owner’s Contentions

Patent Owner moves to exclude Dr. Green’s Declaration in two separate motions to exclude. Green Mot.; PO Exclude Mot. 3–4.

In its first motion, Patent Owner argues that good cause exists to exclude Dr. Green’s Declaration (Exhibit 1010) because Dr. Green was unavailable for cross-examination for six months after the institution of the *inter partes* review. Green Mot. 1. Patent Owner argues that Rule 53(d)(2) states that “[c]ross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been filed and more than a week before the filing date for any paper in which the cross-

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

examination testimony is expected to be used.” *Id.* at 7 (quoting 37 C.F.R. § 42.53(d)(2)). Patent Owner contends that it requested to depose Dr. Green on September 4, 2019, but that Petitioner represented that it could not make Dr. Green available for cross-examination within a week of the filing date for the Patent Owner’s Response. *Id.* at 4, App. A. Patent Owner notes that this time frame for cross-examination 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 further argues that Petitioner could have, but did not, availed itself of the late action rule, 37 C.F.R. § 42.5(c)(3), and that, 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 relied upon Petitioner’s representations that Dr. Green was not unavailable for his deposition prior to the filing of the Patent Owner’s Response.

Patent Owner argues that Petitioner’s “failure to secure Green’s availability during the Response discovery period is binding on [Petitioner] and these IPRs. Exhibit 1010 should be expunged.” *Id.* at 10.

In the second motion, Patent Owner relies on the same arguments, but adds that Dr. Green’s Declaration is inadmissible hearsay that has not been subject to cross-examination. PO Exclude Mot. 3. Patent Owner asserts that

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

“Petitioner failed to make Green, a non-Reply witness, timely available for deposition.” *Id.* at 4.

3. *Petitioner’s Contentions*

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, 7–8.¹² Specifically, Petitioner argues that it satisfied our rules on cross-examination testimony by making Dr. Green available for a deposition prior to and throughout Patent Owner’s sur-reply period. *Id.* Petitioner contends that “[i]mmediately upon confirming with Dr. Green’s attorneys that he was willing to come from Norway, where he resides, to the United States for the deposition, [Petitioner] informed [Patent Owner] of his availability on February 21, 2020.” Green Opp. 3. Petitioner also emphasizes that Dr. Green is not under the control of Petitioner. *Id.* at 2–4. Petitioner asserts that

[w]hen [Petitioner] submitted Dr. Green’s declaration in these proceedings, [Petitioner] believed that it would be able to secure Dr. Green’s deposition based on prior interactions between [Petitioner’s] counsel and Dr[.] Green. [Petitioner’s] belief initially proved to be wrong; Adobe’s counsel sought Dr. Green’s deposition immediately upon [Patent Owner] requesting it in September 2019, but Dr. Green declined that request.

Green Opp. 3.

¹² In its Opposition to Patent Owner’s second Motion to Exclude, which also addresses Exhibit 1010, Petitioner relies on the same arguments presented in its Opposition to Patent Owner’s Motion to Exclude Dr. Green’s Declaration *Compare* Pet. Exclude Opp. 12, *with* Green Opp.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Petitioner further contends that Dr. Green was not subject to routine discovery because his declaration was not prepared for the proceeding under 37 CFR § 42.51(b)(1)(ii). *Id.* at 4–5 n.2.

Petitioner also 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.

In addition, Petitioner argues that Patent Owner was not prejudiced because it would have had to address Petitioner’s supplemental evidence regardless of Petitioner’s motion for supplemental information. *Id.* at 10. Finally, Petitioner argues that “any prejudice due to timing could be 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.

4. Discussion

The question before us is whether we should exclude Dr. Green’s declaration 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.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Based on the particular facts in the instant proceeding, we disagree with Petitioner's position. To start, Patent Owner sought Dr. Green's deposition as early as September 9, 2019, prior to filing its Patent Owner's Response on December 13, 2019. But Petitioner represented then that Dr. Green refused to be deposed and that Petitioner could not compel Dr. Green's cooperation. When Patent Owner made its request on September 9, 2019, Petitioner's counsel responded that it "does not object to his deposition, but [Petitioner] cannot force him to appear." Green Mot., App. A.

Relying on Petitioner's representations, Patent Owner cited Dr. Green's unavailability in its Response, and argued that Petitioner's versions of ICC v.3.0 in Exhibit 1013 and ICC v.3.01 in Exhibit 1014 could not be authenticated as the industry standard specifications published on or about June 10, 1994 and May 9, 1995, respectively, without the cross-examination of Dr. Green's testimony. PO Resp. 27 ("[Exhibits 1013 and 1014] cannot be authenticated on the basis set forth in the Institution Decision because witness Green sponsored by Petitioner (and whose testimony the Board relied upon) declined to be cross-examined. The unavailable witness' testimony cannot be used."). Because Patent Owner sought Dr. Green's cross-examination for its Patent Owner's Response, we consider the Patent Owner's Response as 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 Rule 53(d)(2), where Patent Owner sought the cross-examination months earlier for the preparation of its Patent Owner Response and

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Petitioner, repeatedly and consistently, represented to Patent Owner and the panel that Dr. Green was not available.

Additionally, we are not persuaded by Petitioner’s argument 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. 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.

The panel, however, had already given the Petitioner an opportunity to address the unavailability of Dr. Green. At the October 2, 2019 conference call, Petitioner explicitly stated for the record (and stated to the panel) that Dr. Green was unavailable for cross-examination “because he’s a third party, we can’t force him to attend the deposition, and so we asked him to, and he declined. *So what we have offered instead is our expert.*” Ex. 1043, 21 (emphasis added). At that time, Petitioner sought our authorization to replace Dr. Green’s testimony with Dr. Poynton’s supplemental declaration in order to fill the void created by Dr. Green’s refusal to be deposed. *Id.* We gave Petitioner the opportunity—albeit unsuccessful—to cure its authentication problems via its motion to submit supplemental information. *See Paper 74.* We are not persuaded that Rule 53(d)(2) required us to devise another opportunity for Petitioner to address the same issue at the Reply stage.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Additionally, we note that 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. PO Resp. 24–25. Petitioner also already had an opportunity to cure Dr. Green’s refusal to appear by proposing a substitute declarant in Petitioner’s Motion to Submit Supplemental Information. *See* Paper 74. 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.

Moreover, Petitioner presupposes that the panel was amenable to extra rounds of briefing, and departing from our Trial Practice Guide. Allowing additional time and briefing to reopen this issue would have countered 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. Further, the burden of the late stage cross-examination of Dr. Green and additional briefing would fall heavily on Patent Owner, which had previously relied on Petitioner’s representations that Dr. Green would not sit for a deposition.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Petitioner argues that “Dr. Green was the only logical choice as the ICC’s declarant in response to [Petitioner’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.

These considerations do not control our decision on whether to exclude Dr. Green’s declaration. Petitioner has never stated that it refused to make Dr. Green available because his testimony was outside the scope of routine discovery or that Patent Owner was not entitled to the deposition. To the contrary, Petitioner’s position has been clear from the start that it “*does not object to his deposition*, but [Petitioner] cannot force him to appear.” Green Mot., App. A (emphasis added). Thus, the issue of routine discovery is beside the point because Petitioner did not refuse to make Dr. Green available on this basis. Further, despite Dr. Green’s status of being outside of Petitioner’s control, Petitioner was nonetheless required to make him available for cross-examination. *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)). Petitioner chose to rely on the declaration of Dr. Green, a non-party witness, for authenticating ICC v.3.0 and ICC v.3.01, as was its option

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

in formulating the Petition.¹³ *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”). Although Petitioner implies that Dr. Green was the *only* choice for authenticating Exhibit 1014 (Green Opp. 7), this contradicts Petitioner’s assertion that the ICC specifications were industry-wide standards that were widely known and disseminated. Pet. 7–8. Notwithstanding, we need not consider how or why Petitioner came to rely on Dr. Green; the fact that he was not available for a timely deposition is the relevant consideration for our inquiry.

We also have considered the potential for prejudice to Patent Owner if we were to overlook Dr. Green’s belated availability. Petitioner previously conceded that 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.

¹³ 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 Exhibits 1013 and 1014 on his testimony. In fact, by relying on Dr. Green’s testimony in the Petition, Petitioner bears the responsibility for Dr. Green’s role in this proceeding.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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 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 would have been made available for a deposition out-of-time. In the absence of an excuse of late action by either party, we find that the late action rule does not control the instant motions to exclude.

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

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

authenticity and public accessibility of Exhibits 1013 and 1014 as pre-1996 ICC documents. *See, e.g.*, Pet. Reply 3 (citing paragraphs 11 and 12 of Dr. Green’s declaration to establish that Exhibits 1013 and 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 motions to exclude Exhibit 1010.

B. Patent Owner’s Motion to Strike Exhibits 1070–1086, 1088, and 1098–1100

As an initial matter, we note that the parties disagree as to whether our February 13, 2020 Order granting-in-part Petitioner’s Motion to Submit Supplemental Information (Paper 74) precludes Petitioner’s filing of Exhibits 1070–1086 and 1088 as a result of our Order. Strike Mot. 1.

Patent Owner argues that the declarations of Dr. Poynton (Ex. 1070), Mr. Kelley (Ex. 1074), and Dr. Murch (Ex. 1088), and associated exhibits (Exs. 1075–1086), are “beyond the scope under 37 C.F.R. § 42.23(b) because they are an unauthorized reply to the Board’s [supplemental information] Order.” Strike Mot. 1. Patent Owner argues Petitioner should have, but did not, seek leave to submit these exhibits as “late supplemental information.” *Id.*

We do not agree with either party’s characterization of our Order granting-in-part Petitioner’s Motion to Submit Supplemental Information (Paper 74). First, in that Order, we determined that Petitioner, the moving party, had not satisfied its burden in showing that Dr. Poynton’s supplemental declarations CP1 and CP2, and accompanying attachments to his declarations were relevant to a claim for which the trial has been instituted per 37 C.F.R. § 42.123(a). *See* Paper 74, 24–25. In our analysis,

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

we explained that not only did Dr. Poynton’s declarations contain several misstatements regarding the Appendices attached to his declarations, but that some of the Appendices themselves were not the documents they purported to be. *Id.* at 6 (“[W]e observe that Dr. Poynton’s first supplemental 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 (Opp. 12) 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.”), 13 (“[G]iven the large number of unsupported and incorrect statements, we are not persuaded that entering Dr. Poynton’s testimony would clarify the record or be in the interest of efficient administration of these proceedings. Accordingly, to the extent they pertain to the ICC specifications, we do not enter Dr. Poynton’s first supplemental declaration and its Appendices as supplemental information.”). Thus, based on the inaccuracies in Dr. Poynton’s proposed declarations and attachments, we determined that Petitioner had not satisfied the requirements of Rule 123(a) for the purposes of submitting supplemental information. *Id.* at 5–13.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

In that way, our Order was limited to evaluating Petitioner’s proposed supplemental information, and, did not further restrict the scope of either party’s future briefing on issues raised in the Petition, Decision on Institution, Patent Owner’s Response, Petitioner’s Reply, and Patent Owner’s Sur-Reply. To be sure, there is overlap in the authentication and public accessibility issues presented in the supplemental information briefing, and in the parties’ subsequent briefs.¹⁴ Nonetheless, as a general matter, we do not agree that we must now strike Petitioner’s Reply evidence solely based on our previous findings regarding supplemental information under Rule 123(a).

With this in mind, we address Patent Owner’s specific challenges to the exhibits.

1. *Exhibit 1074 – Declaration of Mr. Christopher Kelley*
 - a) *Patent Owner’s Contentions*

Patent Owner moves to strike Exhibit 1074, the Declaration of Mr. Kelley, who is Petitioner’s lead counsel in this proceeding. Strike Mot. 6–10; 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

¹⁴ Patent Owner argues that the declarations of Dr. Poynton (Ex. 1070), 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 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.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

declaration as supplemental information. Strike Mot. 8–9 (citing, *inter alia*, Ex. 2236, 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 CP1, 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.

b) Petitioner’s Contentions

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 [Petitioner] was presenting the evidence.” Strike Opp. 11. Remarkably, Petitioner states that we may

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

simply ignore the “explanations of relevance” if we do not find them helpful.
Id.

c) Discussion

We agree with Patent Owner that Mr. Kelley’s declaration is replete with legal arguments 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., id.* ¶¶ 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., id.* ¶ 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. *See id.* ¶¶ 16, 26.

This purported testimony from Mr. Kelley constitutes attorney argument that should have been presented in Petitioner’s briefs. Instead, Petitioner’s Reply improperly incorporates Mr. Kelley’s arguments by citation into the Reply. Pet. Reply 4 (“Canon’s copy of ICC v.3.0 was submitted to the USPTO on June 28, 1995 (Ex. 1076) and its contents are identical to the contents of Exhibit 1013, with the only differences related to

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

formatting (*i.e.*, page breaks and equations or mathematical expressions printing incorrectly). (Kelley, ¶¶9-11.”), 7 (“Cannon, for example, possessed copies of both ICC v.3.0 and ICC v.3.01 having the same contents as Exhibits 1013 and 1014 in 1995 and discussed those copies in patent applications, despite not being an ICC founder. (Exs. 1076, 1079; Ex. 1084, 6-7; Ex. 1086, 11; Kelley, ¶¶9-11, 30.”). Petitioner appears to concede as much when it invites us to ignore at least portions of Mr. Kelley’s declaration. Strike Opp. 11. Specifically, Petitioner states “[t]he explanations of relevance (Ex. 1074 ¶¶ 12-13, 16, 21-22, 26, 31-33, 40-41) were included to assist the Board in understanding why [Petitioner] was presenting the evidence. [Petitioner] requests that the Board simply ignore them if they are not helpful.” *Id.* Similarly, at the hearing, Mr. Kelley stated:

I did want to circle back to Judge Hudalla’s question about sorting through my declaration and what parts to ignore and what parts to not ignore. . . . *We cited to my declaration in support of the comparisons of the documents. And those are the portions that you should look at, the portions that are cited in our briefing.*

Those are the only portions that we cited to and therefore there is no need for you to parse through the other stuff that we didn’t cite to. It’s turned out that it’s not relevant. We’ve ended up explaining the relevance of the documents independently. That’s what I would urge the board to do, just look at the portions that we cited to and I don’t think you need to sift through anything to see those. We’ve highlighted them for you in our briefing.

Hearing Tr. 28:4–16 (emphasis added). Given the pervasiveness of improper attorney argument, however, we need not attempt to sort proper

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

from improper portions of Mr. Kelley's declaration. *See* Consolidated TPG, 74. This supports striking Mr. Kelley's declaration in its entirety.

Mr. Kelley's declaration is also of limited or no probative value in this proceeding 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). For example, under cross-examination Mr. Kelley testified that he is not an expert in printing, typography, or comparing documents (Ex. 2236, 13:25–14:25), and yet he testifies to this same subject matter in his declaration when he states that

I compared Exhibit 1076 to Exhibit 1013 and determined that they have identical text except that in Exhibit 1076 something has caused printing errors to appear in the way various equations or mathematical expressions in the document have been printed. Sometimes the differences in the appearance of these mathematical expressions are trivial, *e.g.* characters are overprinted. In a few places there are more serious typographical and formatting errors in the expressions. These errors are limited to mathematical expressions at specific places in the document. *It is clear that where the mathematical expressions in Exhibit 1076 diverge from Exhibit 1013 the differences are printing or formatting errors rather than intentional modifications to the document because they frequently include overprinting or nonsense characters and do not follow standard mathematical notation.* The remainder of the text of Exhibit 1076 is identical to the text of Exhibit 1013.

Ex. 1074 ¶ 9 (emphasis added). Despite Mr. Kelley's admitted lack of expertise, Petitioner attempts to use Mr. Kelley's declaration as a vehicle for introducing “various public copies of the ICC specifications” by establishing

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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.”). Nevertheless, given Mr. Kelley’s lack of firsthand knowledge, we find that his testimony is of no probative value. This also supports striking Mr. Kelley’s declaration.

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. Accordingly, we *grant* Patent Owner’s motion to strike Mr. Kelley’s declaration¹⁵

2. *Exhibit 1070 – Third Supplemental Declaration of Dr. Poynton*
 - a) *Patent Owner’s Contentions*

Patent Owner argues that Petitioner refiled the vast portions of Dr. Poynton’s first supplemental declaration, CP1, as the “Third” supplemental declaration of Dr. Poynton in Exhibit 1070¹⁶. Strike Mot. 2–3.

¹⁵ 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.

¹⁶ Exhibit numbers 1071–1073 have not been used in this proceeding. These appear to be declarations from Dr. Poynton filed in the related proceedings.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Patent Owner argues that Dr. Poynton’s new declaration is “beyond the scope under 37 C.F.R. § 42.23(b) because [it is] an unauthorized reply to the Board’s [supplemental information] Order” that circumvents our February 13, 2020 Order denying entry of CP1 into the record as supplemental information. *See id.* at 3 (“[Petitioner] redlined CP1 and surreptitiously reused 950 words of CP1’s material statements on the ICC in each of Exs. 1070, 1071, and 1073. Ex. 2235, 472:11-473:4, 474:9-21, 475:14-21, 476:16-22.”). 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 further notes that we previously found Dr. Poynton’s CP1 testimony “not credible.” *Id.* at 3 (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.

Patent Owner also disputes certain new testimony from Dr. Poynton (*see* Ex. 1070 ¶ 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, he acknowledged that his testimony regarding the newsgroup was false. *Id.* at 5 (citing Ex. 2235, 487:25–503:8).

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

b) Petitioner's Contentions

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.*

c) Discussion

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 previously 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.

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

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

information order. Paper 74, 5–13. Dr. Poynton’s Third Supplemental Declaration includes testimony regarding the ICC specifications that is similar to that in the CP1 declaration. *See* Strike Mot., Apps. A, B. 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. Thus, at each turn, Dr. Poynton’s testimony has proven unreliable on matters related to the authenticity and public accessibility of the ICC specification. Nonetheless, rather than striking Dr. Poynton’s testimony, we will accord Dr. Poynton’s testimony little to no weight with regard to his testimony pertaining to authenticity and public accessibility presented in Exhibit 1070. Thus, we deny Patent Owner’s motion to strike Dr. Poynton’s Third Supplemental Declaration (Exhibit 1070).

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.

3. *Exhibit 1088 – Declaration of Dr. Murch*

a) *Patent Owner’s Contentions*

Patent Owner moves to strike Exhibit 1088, the Declaration of Dr. Murch. Strike Mot. 10–12. As with Mr. Kelley’s declaration, Patent

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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

b) Petitioner’s Contentions

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).

c) Discussion

In its Reply, Petitioner relies on Dr. Murch’s testimony regarding the public accessibility of Exhibits 1013 and 1014, which we find is responsive to the arguments made in the Patent Owner’s Response. *See* Ex. 1088 ¶¶ 5–6; *see* PO Resp. 1. Thus, we are not persuaded by Patent Owner that Dr. Murch’s Declaration is *per se* improper reply evidence. *See* 37 C.F.R. § 42.23.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Further, Patent Owner makes several arguments attacking the credibility of Dr. Murch's testimony. Strike Mot. 11–12 (“Murch has admitted that his declaration gets a number of other dates wrong by as much as 4+ years. Ex. 2237, 18:4-16; 20:14-30:5. This alone casts substantial doubt on his testimony about the specific date of Exhibit 1013.”). To Patent Owner's point, on cross-examination, Dr. Murch also testified that Exhibits 1013 and 1014 were drafts copies of the ICC v.3.0 and ICC v.3.01 specifications. *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 Exhibits 1013 and 1014 as the particular industry standards published on about June 10, 1994 and May 8, 1995. *See id.* Nevertheless, these considerations go to the weight this evidence should be given, not admissibility. Thus, because we do not find Dr. Murch's Declaration to be improper reply evidence, we deny Patent Owner's motion to strike Exhibit 1088.

4. *Exhibits 1075–1086*

Patent Owner contends that Mr. Kelley admitted in his declaration and deposition that Exhibits 1075–1084 and 1086 all came from publicly available USPTO files. *See* Strike Mot. 10. Patent Owner further argues that Mr. Kelley, “could not identify a reason why these documents were unavailable to [Petitioner] when the Petition was filed.” *Id.* (citing Ex. 2236, 40:11–42:25; 69:8–70:25).

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Patent Owner adds that Exhibit 1085, a letter from William Smythe was available to Petitioner since 2018. *Id.* (citing Ex. 1097, 34:1–13; 36:5–13).

As discussed, we do not as a general matter find that Petitioner’s introduction of new evidence in its Reply to address public accessibility is too late. Moreover, we are not persuaded that our February 13, 2020 Order prohibited Petitioner from presenting arguments and evidence in its Reply regarding these issues. Thus, we deny Patent Owner’s motion to strike Exhibits 1075–1086.

5. *Exhibits 1098, 1099, and 1100*

Patent Owner seeks to strike Exhibits 1098, 1099, and 1100, which Patent Owner contends were prepared and offered for the first time on Petitioner’s re-direct of Dr. Poynton at his April 1, 2020 deposition. Strike Mot. 12. Patent Owner contends these exhibits are improper because these were not included with the Petition, supplemental evidence, supplemental information, or the Reply brief.

Petitioner contends that Exhibits 1098, 1099, and 1100 were used during “redirect in Dr. Poynton’s deposition to (i) rebut the claim in Patent Owner’s questioning that nothing on the internet indicated that ICC specifications were ever available from *sgi.com* (Ex. 2235, 517:11-23) and (ii) to affirm Dr. Poynton’s challenged testimony that he never updated statements about the ICC standard in his Color FAQ. (*Id.*, 559:17-568:2.)” Strike Opp. 12.

Because we do not rely on these exhibits in this Decision, we dismiss Patent Owner’s motion to exclude Exhibits 1098–1100 as moot.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

6. *Exhibits 1071–1073*

Patent Owner’s Motion seeks to strike Exhibits 1071–1073 in this proceeding. Strike Mot. 2 (“Poynton’s Latest Declaration, Exhibits 1070–1073, Should Be Excluded.”). This proceeding does not contain exhibits with those numbers. Thus, we dismiss Patent Owner’s motion to strike Exhibits 1071–1073 as moot.

7. *Conclusion*

For the foregoing reasons, we grant Patent Owner’s motion to strike Exhibit 1074. We deny Patent Owner’s Motion to Strike Exhibits 1070, 1075–1086, and 1088. We dismiss Patent Owner’s Motion to Strike Exhibits 1071–1073 and 1098–1100 as moot.

C. Patent Owner’s Motion to Exclude Exhibits 1002–1004, 1007, 1008, 1010, 1013, 1014, 1017–1034, 1048–1050, 1053, 1056, 1059–1066, 1070–1084, 1086–1096, 1098–1100, Attachments A and B to Paper 104, and Portions of Exhibit 1009

1. *Exhibit 1010 – Dr. Green’s Declaration*

For the reasons discussed above, Patent Owner’s Motion to Exclude Dr. Green’s Declaration, Exhibit 1010 is granted.

2. *Exhibit 1074 – Mr. Kelley’s Declaration*

For the reasons discussed above, Patent Owner’s Motion to Strike Mr. Kelley’s Declaration (Exhibit 1074) is granted. Thus, Patent Owner’s motion to exclude the same is dismissed as moot.

3. *Exhibits 1013 and 1014*

Patent Owner moves to exclude Exhibit 1013, the asserted copy of ICC v.3.0, and Exhibit 1014, the asserted copy of ICC v.3.01 because

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Petitioner has failed to authenticate either document and both constitute inadmissible hearsay. PO Exclude Mot. 1; PO Exclude Reply 2.

We start with 37 C.F.R. § 42.62(a), which instructs us that “[e]xcept as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.” *Id.* Rule 62(b) further instructs “[t]hose portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.” 37 C.F.R. § 42.62(b). These exclusions do not include admissibility requirements for the evidence submitted for the panel’s consideration in an *inter partes* review. *See id.* Consistent with this view, the Consolidated TPG provides procedures for challenging the admissibility of evidence through objections and motions to exclude. Consolidated TPG 78–79 (“A party wishing to challenge the admissibility of evidence other than deposition evidence, must file any objections within five business days of service of evidence to which the objection is directed, or ten days after institution of trial. 37 C.F.R. § 42.64(b)(1). Supplemental evidence is not filed at the time of the objection, but simply served, and is filed only in support of an opposition to a motion to exclude. *See* 37 C.F.R. §§ 42.64(a), 42.64(b)(2).”); *see id.* at 79 (“A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact.”).

Turning to the Federal Rules of Evidence (“FRE”), FRE 901(a) provides that “[t]o 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.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

901(a). Though the evidence required to satisfy this requirement may be “slight,” as Petitioner describes it (Pet. Reply 5), Petitioner must, nonetheless, submit sufficient evidence into the record to support the finding of authenticity.

It bears mentioning that the parties do not dispute that an “ICC v.3.0” specification and an “ICC v.3.01” specification existed at some point in time. *See* Hearing Tr. 47:14–19 (Patent Owner’s Counsel: “So, I don’t think that we’ve ever said that there wasn’t something available. We agree the [‘008] patent does indicate that there was . . . something available. . . , but what has to happen here is [Petitioner] has to show that their specific documents . . . were authentic[.]”). One complication in this proceeding, though, is the existence of multiple drafts and versions of the documents that share similar indicia, like the titles and dates, while also exhibiting discernible differences. For example, Exhibit 1014 includes “DRAFT: DRAFT:DRAFT:DRAFT” in the header. Ex. 1014, 1. Petitioner likens Exhibit 1014 to another version of ICC v.3.01 (Exhibit 1080) obtained from a certified file history of U.S. Patent Application No. 08/606,883. However, the document shown in Exhibit 1080 does not include the “DRAFT” header. *See* Ex. 1080, 12. Further, Dr. Murch, also Petitioner’s proffered witness, testifies that he recognized Exhibits 1013 and 1014 as draft versions rather than final versions of ICC v.3.0 and ICC v.3.01. The exchange during Dr. Murch’s deposition is reproduced below:

Q. So the version that has been identified as Exhibit 1013 that you reviewed, I think you just testified it was your understanding that that was a draft version of the specification?

A. That’s correct.

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

Q. And the same thing would be true with Exhibit 1014, which is ICC version 3.01, correct?

A. That's correct.

Q. And if they were in draft forms, that also means that the versions could have been changing in the 1994 to 1995 time frame, correct?

A. The final versions, certainly. But again, I can't testify to what specific changes may or may not have occurred.

Ex. 2237, 44:4–17.

Dr. Poynton's testimony regarding the ICC drafting and revision processes is also consistent with Dr. Murch's recollection in this regard. Dr. Poynton explained the ICC revision process and confirmed that multiple drafts of similar but modified specification documents were in some form of circulation. The exchange between Dr. Poynton and Petitioner's counsel on redirect is reproduced below:

Q. Who would be able to propose changes to the ICC specifications?

A. I'm sorry, I missed one word, could you – who would be able to?

Q. Propose changes to the ICC specifications.

A. Propose, absolutely anyone.

Q. Anyone outside the ICC or inside of the ICC?

A. Well, any suggestions from people outside would be -- would be considered, and -- and proposals for changes would routinely come from contributors themselves.

Q. How long do revisions to the specification take?

A. Revisions could take anywhere from some number of weeks to even some number of years.

Q. And let's say there is a revision to the specification, what happens after that? Is it distributed?

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

THE WITNESS: Well, that would be -- yeah. As would be the case in all of the standards developments that I'm familiar with, *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.* The document would be edited and a new version would be -- would be promulgated, or pushed out, or distributed with -- with some kind of version number indicating a milestone had been reached in the form of the consensus.

Ex. 2235, 553:5–554:10 (emphasis added). Dr. Poynton added that this process applied to new versions or revisions of the ICC:

Q. Now, does your answer apply to just new versions or revisions along the way?

A. Well, *there were drafts of developments which had been judged potentially useful and those drafts were circulated, and they had various numbers and letters assigned to the version number, and they were distributed more or less widely, depending upon the interest of various people.* At some point when consensus was reached upon new aspects, a version number would, in essence, be stripped of the -- of the indications of various drafts, a version number would be established, a document prepared, and that document then would be distributed as -- as a final version of that particular addition or version of the specification.

Q. And then when you say distributed or circulated, who are you talking about being distributed or circulated to?

A. Well, this would -- the -- the distribution of the drafts would be to all -- virtually all of the contributors to the ICC.

Ex. 2235, 554:16–555:11 (emphasis added). Dr. Poynton also confirmed that this process could take years. Ex. 2235, 553:18–19 (“A. Revisions could take anywhere from some number of weeks to even some number of years.”), *see id.* at 403:14–25 (“It would be entirely reasonable there to say

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

that the ICC was at this point becoming pretty bureaucratic and we have evidence in front of us that indicates that, by virtue of the fact that fixing the typos, basically, and it's not – I'm being a little crude, it's not just fixing the typos, because you will notice in the 3.01 specification that there is some language added to clarify some unclear passages in the 3.0 specification. But it took the ICC a year to crank out that not even a minor revision, but what we would call in the art a dot dot revision.”). It is with this lens that we view the authenticity of Exhibits 1013 and 1014 to determine whether Petitioner has provided sufficient evidence to establish that these exhibits are the published versions of the industry standards released on or about June 10, 1994 and May 8, 1995, respectively, which are the versions that Petitioner relies on for its challenges of unpatentability. Pet. 7–8.

We turn now to the evidence in the record, starting with the Petition.

On page 8 of the Petition, Petitioner asserts:

In June 1994, the ICC publicly released its first specification describing its color management framework, which utilizes standardized device profiles to describe the color reproduction characteristics of input, output, and display devices. (Green ¶ 7.) That specification, numbered 3.0, describes version 2 of the ICC's profiles. (*Id.* ¶ 8.) The specification would be updated several times after June 1994, including under specification numbers 3.01 and 3.2, released in May 1995 and November 1995, respectively. (*Id.* ¶ 7.) Beginning in 2001, the ICC released specifications describing version 4 of its profiles. (*Id.* ¶¶ 9-10.)

By the time the ICC released its first specification in June 1994, the ICC's founders—many of whom were among the largest technology companies of the era—“ha[d] committed to fully support th[e] specification in their operating systems, platforms and applications.” (ICC v.3.0, 7.) As a result, the ICC's specifications were widely adopted soon after their release. Both

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

version 2 and version 4 of the ICC’s profiles have been and continue to be in widespread use today. (Poynton ¶ 195.)

Pet. 8 (footnote omitted). To support these statements, Petitioner relies almost solely on the testimony of Dr. Green contained in his declaration (Exhibit 1010). At the pre-institution stage, Patent Owner challenged the authenticity of Exhibits 1013 and 1014 based on Dr. Green’s testimony. Dec. 21 (“Patent Owner argues that the exhibits attached to Dr. Green’s Declaration (Exhibit 1010) are different versions of the documents in Exhibits 1013 and 1014.”) (citing Prelim. Resp. 35). In its Reply to the Preliminary Response, Petitioner further relied on Dr. Green’s testimony, that as the ICC’s Technical Secretary, he “obtained [ICC v.3.0 and ICC v.3.01] by downloading them from the ICC’s website” and explained the circumstances of their creation. *See* Paper 27, 2 (citing Ex. 1010 ¶¶ 11, 12).

In the Institution Decision, we considered the parties’ arguments on the preliminary record, which included the yet-to-be challenged testimony by Dr. Green. We determined that

the testimony of Dr. Green provides sufficient authentication of Exhibits 1013 and 1014 for purposes of institution of trial. After institution of trial, Patent Owner may submit objections to evidence and Petitioner may file supplemental evidence responding to the objections. *See* 37 C.F.R. § 42.64(b). Petitioner also has an opportunity to submit supplemental information to address this subject, if appropriate. *See* 37 C.F.R. § 42.123.

Dec. 22–23.

After institution, as discussed in detail above, Dr. Green refused to appear for a timely cross-examination after Patent Owner requested his deposition. Green Mot., App. A; Ex. 1043, 20:12–21:12. Given his refusal

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

to be available during the first six months after institution, and Petitioner's repeated representations of the same, we authorized the filing of Petitioner's Motion to Submit Supplemental Information, which we granted-in-part in our February 13, 2020 Order. Papers 56, 74. Having failed to introduce Dr. Poynton's supplemental declaration CP1 and its appendices into the record through its motion, Petitioner addressed authentication in its Reply brief. Pet. Reply 2–5. Petitioner's arguments in its Reply cited new evidence that included a declaration from Petitioner's lead counsel, Mr. Kelley's Declaration (Exhibit 1074). *Id.*

We have granted Patent Owner's motions to exclude Dr. Green's Declaration (Exhibit 1010) because Petitioner was unable to make Dr. Green available for cross-examination in a timely manner. *See supra* § II.A. Consequently, we do not consider Dr. Green's testimony in Exhibit 1010 and, further determine that Petitioner's reliance on the same does not sufficiently authenticate Exhibits 1013 and 1014. *See* Pet. Opp. Exclude 5 (citing Ex. 1010 ¶¶ 7, 10). Likewise, we have stricken Mr. Kelley's Declaration (Exhibit 1074) because it principally contains improper attorney argument. *See supra* § II.B. Thus, we do not consider Exhibit 1074.

In the Petition, Reply, and Petitioner's Opposition to Patent Owner's Motion to Exclude, Petitioner further relies on Dr. Poynton's testimony. Petitioner relies on paragraph 7, 12, 192–195, 458, and 469 in Dr. Poynton's first declaration, paragraphs 5–19 of Dr. Poynton's Third Supplemental Declaration (Exhibit 1070), and Dr. Poynton's deposition testimony. Pet. 8 (citing Ex. 1009 ¶ 195); Pet. Reply (citing Ex. 1009 ¶¶ 7, 12, 192–195, 458, 469, 1070 ¶¶ 5–19, Ex. 2106, 304:15–310:7); Pet. Exclude Opp. 5 (citing

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Ex. 1009 ¶¶ 12, 194, 195, 458, 469; Ex. 1070 ¶¶ 6–8). Below we discuss these cited sections of Dr. Poynton’s testimony in the context of his cross-examination testimony from three separate depositions (Exhibits 1045, 2106, 2235) regarding authentication of Exhibits 1013 and 1014.

In paragraph 7 of Dr. Poynton’s first declaration (Exhibit 1009), he states

Beginning in 1988, I worked for Sun Microsystems Computer Corporation (“Sun”) in Mountain View, California. While there, I conceived and executed the strategy that brought color management technology to Sun. I investigated color technology and provided color leadership to Sun’s technical, business, and contract teams. I further helped the group that was the predecessor to the current International Color Consortium (ICC) achieve agreement on an industry standard for color device profiles. I was at Sun for eight years.

Ex. 1009 ¶ 7. Although Dr. Poynton’s testimony provides some details of his prior employment and involvement with the International Color Consortium, this paragraph does not, however, by itself, support the notion that the documents in Exhibits 1013 and 1014 are authentic copies of the ICC v.3.0 industry standard released on or about June 10, 1994 and ICC v.3.01 industry standard released on or about May 8, 1995. *Id.*

Similarly, paragraph 12 of Dr. Poynton is a table of exhibits that he reviewed in preparation of Exhibit 1009. *Id.* ¶ 12. This paragraph does not address authentication of Exhibits 1013 or 1014. *Id.*

Indeed, this makes sense when we read paragraphs 7 and 12 together with paragraphs 458 and 469 of Dr. Poynton’s first declaration. Paragraph 458 is reproduced below:

As I explained above in the Background section, ICC v.3.0 is the first published specification of the ICC, which describes version

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

2 of the ICC profile. The ICC published ICC v.3.0 on or about June 10, 1994. (*Green* ¶ 7.) The ICC made the ICC v.3.0 specification available to anyone who wanted a copy. (*Id.* ¶ 6.) Because the community of color scientists, engineers, and enthusiasts was (and still is) relatively small, a person of ordinary skill in the art in 1994 such as myself would have been well aware of the ICC's work and its v.3.0 specification in 1994. If interested in obtaining a copy, that person could have obtained copies of the ICC's specifications simply by asking the ICC (e.g., by phone or by mail).

Ex. 1009 ¶ 458 (emphasis added). Paragraph 469 is reproduced below:

ICC v.3.01 is an update to ICC v.3.0. (*Green* ¶ 7.) As such, the substance of ICCv.3.01 is nearly identical to the substance of ICC v.3.0, except that “[c]hanges from version 3.0 of June 1994 are indicated with bold typeface.” (ICC v.3.01, 1.) The changes relate primarily to correcting typographical errors or adding explanatory text. (*See, e.g., id.*, 7 (correcting “header” to “table”), 20 (adding explanation about the operation of the gamutTag).) I have reviewed ICC v.3.0 and ICC v.3.01, and the differences between the two do not affect my opinions discussed in this declaration as to either reference unless otherwise noted.

Ex. 1009 ¶ 469 (emphasis added). Both paragraphs 458 and 469 rely on Dr. Green's Declaration in Exhibit 1010 for authentication of Exhibits 1013 and 1014. However, Dr. Green's Declaration has been excluded, and, therefore, we accord no weight to Dr. Poynton's testimony regarding the authenticity of Exhibits 1013 and 1014 that is based on this excluded evidence.

Likewise, in paragraph 194, Dr. Poynton testifies that

[t]he ICC publicly released its first specification in June 1994 which described its color management framework, that utilized standardized device profiles to describe the color reproduction characteristics of input, output, and display devices. (*Green* ¶ 7.) That specification, numbered 3.0, describes version 2 of the

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

ICC's profiles. (*Id.* ¶ 8.) The specification would be updated several times since June 1994, including under specification numbers 3.01 and 3.2, released in May 1995 and November 1995, respectively. (*Id.* ¶ 7.) Beginning in 2001, the ICC released specifications describing version 4 of its profiles. (*Id.* ¶¶ 9-10.) Ex. 1009 ¶ 194 (emphasis added). Again, Dr. Poynton's testimony is supported by the excluded testimony of Dr. Green in Exhibit 1010, and is entitled to no weight on this basis.

Dr. Poynton further describes the genesis of the InterColor Consortium and identifies the founding members in his first declaration. Ex. 1009 ¶¶ 192 (“Until the early 1990s, there was no industry-wide standardized color management framework This resulted in software companies aligning themselves with particular hardware vendors to use those vendors' color management system with no guarantee that its software would work with the hardware of other vendors.”), 193 (“[A] group of hardware and software vendors formed the InterColor Consortium (‘the ICC’), which was later renamed the International Color Consortium. The first official meeting of the ICC was held in 1993 in Palo Alto, California. The eight founding members of the ICC were: Adobe; Agfa-Gevaert N.V.; Apple Computer, Inc. (‘Apple’); Eastman Kodak Company; Microsoft Corporation; Silicon Graphics Inc.; Sun Microsystems, Inc.; and Taligent, Inc. At that time, Apple had a color management system called ColorSync, which served as the foundation for the standards created by the ICC.”). In paragraph 195, Dr. Poynton describes ICC's release of its first specification, the adoption of the specifications, and its use:

By the time the ICC released its first specification in June 1994, the ICC's founders—many of whom were among the largest technology companies of the era—“ha[d] committed to fully

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

support th[e] specification in their operating systems, platforms and applications.” (ICC v.3.0, 7.) Because of the universal support of the largest technology companies, the ICC’s specifications were widely adopted soon after their release. In 1994, I was very familiar with the ICC and its specifications, and other persons of ordinary skill in the art would have known about them as well. The specifications were publicly available for download on the Internet, and the ICC provided them anyone who requested it. Both version 2 and version 4 of the ICC’s profiles have been and continue to be in widespread use today.

Ex. 1009 ¶ 195. However, Dr. Poynton’s testimony in paragraphs 192, 193, and 195 does not specifically address the authenticity of Exhibits 1013 and 1014, but, rather, as evidenced by paragraph 194, relies on Dr. Green’s excluded testimony in Exhibit 1010. *Id.* ¶ 194. Thus, we do not find Dr. Poynton’s testimony, in paragraphs 192, 193, and 195, persuasively supports Petitioner’s position that Exhibits 1013 and 1014 are authentic because this testimony relies on Dr. Green’s excluded declaration.

Additionally, Petitioner relies on paragraphs 5–15 of Dr. Poynton’s Third Declaration (Exhibit 1070). Pet. Reply 2–5. In these paragraphs, Dr. Poynton testifies, *inter alia*, that: (1) he was employed at Sun Microsystems (“Sun”) from 1988 to “Spring or Summer” of 1994; (2) he was one of the original dozen or so people actively engaged in drafting ICC v.3.0. in 1991–1994; (3) he continued to work with the ICC after he left Sun; and (4) he “recognize[d] Exhibits 1013 and 1014 as copies of ICC v.3.0 and ICC v.3.01 specifications that were published and publicly distributed by the ICC in June 1994 and May 1995, respectively” based on his “direct involvement in helping create the ICC’s specifications and subsequent use of them in the decades that followed[.]” Ex. 1070 ¶¶ 5–8. Dr. Poynton further testifies that a POSITA “would have been well-aware of the ICC and its

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

specifications since at least June 1994 (when the ICC published and distributed ICC v.3.0).” *Id.* ¶ 9. Dr. Poynton asserts also that the ICC v.3.0 and ICC v.3.01 specifications were generally distributed by email, AppleLink, and a FTP site that was announced in the “sci.engr.color” Usenet newsgroup. *Id.* ¶¶ 9–10. We also note that in Dr. Poynton’s first deposition, he testified regarding his years of involvement in the ICC and its predecessor, others who were involved, and some of his contributions to the content of the specifications. *See* Ex. 2106, 304:1–310:9.

As an author of ICC v.3.0 and ICC v.3.01, Dr. Poynton testifies that he “recognize[d] Exhibits 1013 and 1014 as copies of ICC v.3.0 and ICC v.3.01 specifications that were published and publicly distributed by the ICC in June 1994 and May 1995” based on his *recollection* of the contents and appearance of the documents. Ex. 1070 ¶ 8. However, as Patent Owner has correctly pointed out many times, Dr. Poynton’s recollection of the events and details regarding these documents has been frequently inaccurate. Sur-Reply 2. For example, in paragraph 7 of his first declaration, Dr. Poynton testifies that he worked at Sun for eight years, beginning in 1988. Ex. 1009 ¶ 7. He further testifies that while he was at Sun, he helped the group that was the predecessor to the current International Color Consortium. *Id.* From this testimony, the dates he was employed at Sun (a founding member of the ICC) would have spanned 1988 through 1996. *Id.* According to his initial testimony, based on his recollection, Dr. Poynton would have been working for a founding member (Sun) of the ICC at the time the ICC v.3.0 industry standard and ICC v. 3.01 industry standard were released. *See id.* ¶ 192. At his deposition, however, Dr. Poynton stated there was an error in

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

his CV (and his first declaration). Ex. 2106, 303:13–304:9. Dr. Poynton testified that records in his garage showed he actually left Sun prior to the release of the ICC v.3.0 in June 1994. *Id.* at 304:3–9 (“Well, I encountered a bill of lading from the freight company where my possessions were shipped back from California to Toronto, and that showed a date of -- of 1994. And so I immediately realized that -- that that’s when I returned back to Toronto from California.”).

This timeframe is of some significance because the ICC v.3.0 industry standard was published in June 1994 and the ICC v.3.01 industry standard was published in May 1995. At another deposition, Dr. Poynton clarified that

I had recalled, and even placed in my CV, information that I left Sun in 1995. But the discovery of those documents -- and the particular document that I discovered was, in fact, the moving company weigh bill that documented they’re packing up a lot of boxes, putting them in a truck and sending that truck to Toronto. *And that document was dated, if I remember correctly, late May in 1994.* So upon that discovery, I edited my CV and corrected it, because that -- that was a mistake in my CV. Now, that is pertinent to the matter at hand, I suppose, because I left -- I physically left California within weeks of the issuance of the ICC 3.0 specification. And that’s what makes the -- the rebuilding of my garage relevant to the current discussion, and a matter for brief discussion in -- in this third supplemental declaration.

Ex. 2235, 477:21–478:14 (emphasis added).

Additionally, Dr. Poynton testifies that he had a webpage on which he linked another version of the ICC specification, a version 3.0A. *See* Ex. 1045, 466:14–25. Dr. Poynton testified that “[e]very indication is that [version 3.0A] . . . would have been modified slightly from version 3.0 and slightly in advance of the agreement upon 3.01.” *Id.* at 468, 19–24.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

Dr. Poynton testified that he worked on the ICC v.3.0 and ICC v.3.01 specifications as an author and has personal knowledge of the “whole development of the document” (*see id.* at 464:19–23), but he also admits in his deposition that “I have to say, at this moment I cannot recall exactly what’s in 3.0A.” *Id.* at 468:16–18. Then, moments later, Dr. Poynton states that

I should also point out that these documents 3.0, 3.0A, 3.01, these are all astonishingly similar. I mean, I think you can see from the exhibits that, you know, during the editing process of 3.01 decision was made to place the change -- the changed passages in bold face. And there’s a very small number of changed passages. These documents were substantially identical.

id. at 472:24–473:8. Dr. Poynton’s testimony here highlights the authentication issue in this proceeding – that there exists similar draft versions of documents that were created on different dates that contained different information. And, even as an author of these documents, Dr. Poynton’s memory is unreliable and he cannot recall the differences in the content of the various versions of the documents.

Further, Dr. Poynton concedes that his recollection of other events surrounding his time at Sun and the dissemination of the ICC specifications is inaccurate. In paragraph 10 of his Third Declaration, Dr. Poynton testifies that during his time at Sun, a Usenet newsgroup “sci.engr.color” had thousands of subscribers and a FTP site announced on that newsgroup allowed any member of the public to download the ICC’s specifications. Ex. 1070 ¶ 10. Specifically, Dr. Poynton testifies that

by the time the ICC released the ICC v.3.01 specification in May 1995, Silicon Graphics Inc. hosted an FTP site that allowed any member of the public to download the ICC’s specifications for

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

free without any confidentiality restrictions. *This FTP site was well-known by persons of ordinary skill in the art by 1994. For example, I recall the FTP site being announced in the “sci.engr.color” Usenet newsgroup (which was short for “science/engineering/color”) while I was still at Sun. The “sci.engr.color” newsgroup had thousands of subscribers by May 1995, including subscribers interest in color science such as myself and other persons of ordinary skill in the art.*

Id. ¶ 10 (emphasis added). During his deposition, Dr. Poynton admitted that his recollection of these details was inaccurate. This deposition exchange is provided below:

[Q.] I’m going to start with the sentence that says: “For example, I recall the FTP site being announced in the ‘sci.engr.color’ Usenet Newsgroup (which was short for ‘science/engineering/color’) while I was still at Sun.” That statement is inaccurate, correct?

A. That statement and the following sentence are not accurate.

Q. Correct. So the following sentence that says: “The ‘sci.engr.color’ newsgroup had thousands of subscribers by May 1995, including subscribers interest” – probably should say interested – “in color science such as myself and other persons of ordinary skill in the art.” That statement is also inaccurate, correct?

A. As I just explained concerning the dating of the creation of the newsgroup, I am convinced that the newsgroup was not created until after the end of my employment at Sun. The -- my employment at Sun ended in 1994, as you know, and my statement concerns May 1995. You've shown me evidence that indicates that the newsgroup was created even a short period of time after that. My testimony about -- well, for example, when you showed me the color FAQ, that document was created during my employment at Sun and posted to other newsgroups. *So the two sentences that you've pointed out in my third declaration, I concede being inaccurate, I concede that my recollection of my*

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

engagement with that newsgroup during my employment at Sun was not correct.

Ex. 2235, 532:24–534:2 (emphasis added).

On the whole, we find that Dr. Poynton’s testimony regarding the authenticity of Exhibits 1013 and 1014 to be entitled to little weight. First, Dr. Poynton’s recollection of the timeframe in question contains admitted inaccuracies, which cast doubt on his memory of the events and details from a quarter century ago. Ex. 2235, 477:21–478:14, 552:24 –534:2. Second, he confirmed that multiple drafts of the specifications would have been circulated during the development of the documents. Ex. 2235, 553:5–554:10. He admitted that he could not recall the changes between the various versions of the documents. Ex. 1045, 468:16–18. Third, the testimony of Dr. Murch, another original member of the ICC on Apple’s behalf and Petitioner’s other declarant, calls into question Dr. Poynton’s testimony that Exhibits 1013 and 1014 are the industry standards published on or about June 1994 and May 1995. Ex. 2237, 44:4–17. Fourth, to the extent that Petitioner relies on Exhibit 1010 (Green Declaration) and Exhibit 1074 (Kelley Declaration) to corroborate Dr. Poynton’s testimony (Pet. Reply 3), these declarations do not bolster Dr. Poynton’s testimony because we have granted Patent Owner’s motions to exclude Exhibit 1010 and to strike Exhibit 1074. Thus, we determine that Dr. Poynton’s testimony on authentication is entitled to little or no probative weight.

Next, we turn to Petitioner’s other evidence of authentication. As mentioned, Petitioner relies on the declaration of Dr. Murch, who was an original member of the ICC on Apple’s behalf. Pet. Reply 4 (citing Ex. 1088 ¶ 4). Petitioner argues that “Mr. Murch confirms the authenticity

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

of Exhibits 1013 and 1014.” *Id.* at 3 (citing Ex. 1088 ¶¶ 5–6). However, Petitioner’s argument is contradicted by Dr. Murch’s testimony on cross-examination that he recognized Exhibits 1013 and 1014 to be *draft* versions, i.e., not final versions, of ICC v.3.0 and ICC v.3.01. Ex. 2237, 44:4–17. Thus, we are not persuaded that Dr. Murch’s testimony in Exhibit 1088 establishes that Exhibits 1013 and 1014 are the industry standards published on or about June 10, 1994 and May 8, 1995.

Additionally, we consider Petitioner’s arguments based on the examples in Rule 901(b) of the Federal Rules of Evidence. Pet. Reply 3–4. 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. 901(b)(4). Specifically, Petitioner cites “their titles, version numbers, dates, copyrights, contact information, and profile description” on Exhibit 1014 and contends these indicia can support authentication even without direct testimony. Pet. Reply 3 (citing *United States v. Holmquist*, 36 F.3d 154, 167 (1st Cir. 1994)).

We are not persuaded by Petitioner’s argument. For example, 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: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 a final

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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 that lacks this 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. Further, although Exhibit 1013 does not contain the same header, we note that Dr. Murch testified that Exhibits 1013 and 1014 appeared to be draft copies of the ICC v.3.0 and ICC v.3.01 specifications. *See* Ex. 2237, 43:15–44:17. Therefore, there is doubt as to whether the characteristics of these documents are “distinctive” in light of these particular circumstances. Having considered Petitioner’s cited indicia together with “all the circumstances,” including the “DRAFT” header on Exhibit 1014, we are not persuaded that the indicia on Exhibits 1013 and 1014 are sufficient to satisfy FRE 901(b)(4).

We note further that 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 example with respect to Exhibit 1076 and Exhibit 1079, which Petitioner characterizes as “documents with text identical to Exhibits 1013 and 1014” except for some formatting differences and “little bits of handwriting.” Pet. Exclude Opp. 4 (citing Exs. 1075, 1076, 1078, 1079)¹⁷.

¹⁷ Exhibit 1075 is an information disclosure statement (“IDS”) from U.S. Patent Application 08/496,100 (issued as U.S. Patent 5,615,312 to Canon

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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 4 (acknowledging added “handwriting in Exhibit 1079). The same applies to Petitioner’s treatment of Exhibit 1013 and Exhibit 1076. *Id.* 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 1013 and 1076 and between Exhibits 1014 and 1079, Petitioner’s evidentiary basis for the points of comparison is the testimony of Mr. Kelley. *See* Pet. Reply 3–4 (citing Ex. 1074 ¶¶ 9–11, 20) (relying on Kelley’s stricken testimony regarding Exhibits 1076, 1078, 1079). As discussed above, we have stricken Mr. Kelley’s testimony as improper attorney argument. *See supra* § II.B. As such, we do not credit Petitioner’s alleged evidence regarding the contents or status of Exhibits 1076, 1078, and 1079 that are based on Mr. Kelley’s testimony. Additionally, Petitioner relies on Exhibit 1077 as an “identical” copy of Exhibit 1013. Pet. Reply 4. Petitioner, again, relies on the stricken testimony of lead counsel Mr. Kelley. *Id.* (citing Ex. 1074 ¶ 20). We decline to draw inferences about the authenticity of Exhibits 1013 and 1014 based on alleged similarities with Exhibits 1076, 1077, 1078, and

(“the ’312 patent”). Exhibit 1076 is non-patent literature from the file history of the ’312 patent. Exhibit 1078 is an IDS from U.S. Patent Application 08/529,111 (issued as U.S. Patent 5,646,752 to Canon (“the ’752 patent”). Exhibit 1079 is non-patent literature from the file history of the ’752 patent.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

1079 in the absence of admissible evidence about the same. We also note that the same legal and evidentiary deficiencies apply to Petitioner's analysis of Exhibit 1080. *See* Pet. Exclude Opp. 3; Ex. 1074 ¶¶ 37–41. For these reasons, we are 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 refers to the testimony of Dr. Green. Pet. Reply 4 (citing Ex. 1010 ¶¶ 11, 12). Nevertheless, as discussed above, we have excluded the declaration of Dr. Green as 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 that Exhibits 1013 and 1014 were produced from ICC computer servers is not supported by credible evidence. We also note that the presence of the “DRAFT” header in Exhibit 1014 and the different versions of both ICC v.3.01 (e.g., Ex. 1080) and ICC v.3.0 (e.g., Ex. 1076) in the record creates some doubt about the authenticity of both documents. Thus, we are not persuaded that Exhibits 1013 and 1014 are authenticated under the ancient document example of Rule 901(b)(8).

Petitioner cites sections in the '008 patent that characterize ICC specifications, including ICC v.3.01, as prior art. Pet. Exclude Opp. 2

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

(citing Ex. 1001, 3:32, 7:60–8:5, 18:41–43). Petitioner also argues that, during prosecution of an application in the priority chain of the '008 patent, Patent Owner identified the ICC v.3.0 and ICC v.3.01 specifications in Exhibits 1077 and 1080 as ICC v.3.0 and ICC v.3.01. *Id.* at 3 (citing Ex. 1006, 48; 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 unrelayed-on text cut off at the endings of a few paragraphs." Pet. Exclude Opp. 3. Moreover, again, the basis for the comparison of the various versions of both specifications in this record is tied to Mr. Kelley's stricken declaration. *See* Pet. Reply 3 ("Further, Exhibit 1013 is authenticated through the copy of ICC v.3.0 submitted by [Patent Owner] itself to the USPTO. (Ex. 1077.) The contents of [Patent Owner's] copy are identical to those of Exhibit 1013. (Kelley, ¶20.)"); *see* Sur-Reply 5 ("Kelley testified that he had no involvement with any ICC specifications in the 1990s and he has no personal experience or knowledge about them. Ex. 2236, 13:12-23. There is no evidence that Kelley had ever seen any ICC specifications before he began his work as [Petitioner's] lawyer in the IPR sometime before [Petitioner] filed its IPR Petition in February 2019, nearly 25 years after the critical date. Although his declaration Exhibit 1074 purports to "include comparisons between different copies of the InterColor Consortium ("ICC") Profile Format specification" (Exhibit 1074 ¶2)."). Furthermore, we also note that other versions of the ICC specifications are present in this record, which creates doubt on whether the various versions

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

of the specifications are the same. *See* Exs. 1076, 1080. Moreover, we are not persuaded that the Board must engage in a page-by-page or word-by-word comparison of hundreds of pages to ascertain the authenticity of Petitioner's evidence. Thus, to the extent Patent Owner made any concessions during prosecution of the related patent application, we are not persuaded that these are sufficient, on this record, to authenticate Exhibits 1013 and 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 the general proposition of these cases does not apply here, because Petitioner has not established that the patent applicant's alleged concession relates to the particular references being asserted here, Exhibits 1013 and 1014.

Petitioner also cites several prior cases as supporting its use of Exhibits 1079 and 1080 to bolster the authenticity of Exhibits 1013 and 1014 (PO 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*

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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. PO 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. Furthermore, *Enhanced* involved an appeal of a Board’s decision in an *ex parte* reexamination, which differs from an *inter partes* review in which the Federal Rules of Evidence expressly apply. *Id.* at 1349; *see* 37 C.F.R. § 42.62(a) (“[e]xcept as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding”); *see also In re Epstein*, 32 F.3d 1559, 1565 (Fed. Cir. 1994) (“Agencies may provide for the application of evidence rules, as the PTO has so provided in patent interference proceedings, 37 C.F.R. § 1.671(b) (1993), and patent public use proceedings, *id.* § 1.292(a), both of which are *inter partes* in nature. The PTO has not, however, provided for the application of evidence rules during *ex parte* examination.”). As can be seen, none of these cases

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

pertains to authenticating a reference by comparing it to other documents, which is the dispositive issue here.

In summary, without direct evidence authenticating Exhibits 1013 and 1014 as copies of the published ICC v.3.0 and ICC v.3.01 industry standards rather than merely draft copies of unknown circulation history, Petitioner relies on circumstantial evidence based on similar documents. But the documents are different. For example, Exhibit 1014 includes “DRAFT” markings that Exhibit 1080 does not have. Although Petitioner argues that it is beyond doubt that ICC v.3.0 and ICC v.3.01 were well-known and published industry standards (*see, e.g.*, Pet. Reply 1–3, 5–7; PO Exclude Opp. 3, 5), we cannot discern from this record if those characterizations distinctly apply to the particular documents in Exhibits 1013 and 1014. Under the totality of these circumstances, we find Patent Owner has satisfied its burden and we *grant* Patent Owner’s motion to exclude Exhibits 1013 and 1014.

4. *Exhibits 1002–1004, 1007, 1008, 1017–1034, 1048–50, 1053, 1056, 1059–1066, 1081–1084, 1086, 1087, 1089–1096, 1098, 1099, and Attachments A and B to Paper 104*

Patent Owner’s motion to exclude on Exhibits 1002–1004, 1007, 1008, 1017–1034, 1048–50, 1053, 1056, 1059–1066, 1081–1084, 1086, 1087, 1089–1096, 1098–1100, and Attachments A and B to Paper 104 is dismissed as moot because we do not rely on these documents for this Decision.

PUBLIC VERSION

IPR2019-00627

Patent 7,729,008 B2

5. *Paragraphs 123, 171, 181, 190-191, 195, 308-310, 477-478, 519, 604-609, 612-615, 619-624, 626-628, 636, 638-640, 644-649, 651, 653-654, 658-665, 673-676, 678-684, 692, 694-695, 698-708, 710, 712-713, 715-717, 718, 725, 728, 732, 736, 738-739, and 742 of Exhibit 1009*

Patent Owner moves to exclude paragraphs 123, 171, 181, 190-191, 195, 308-310, 477-478, 519, 604-609, 612-615, 619-624, 626-628, 636, 638-640, 644-649, 651, 653-654, 658-665, 673-676, 678-684, 692, 694-695, 698-708, 710, 712-713, 715-717, 718, 725, 728, 732, 736, 738-739, and 742 of Dr. Poynton's Declaration in Exhibit 1009. PO Exclude Mot. 13-14. Patent Owner argues that these paragraphs lack foundation and do not satisfy FRE 603, 702, 703 and 705. *Id.* However, Patent Owner does not explain what aspects of each of these paragraphs lacks foundation. *Id.* Under these circumstances, we deny Patent Owner's motion to exclude these portions of Dr. Poynton's first declaration.

6. *Paragraphs 1-40, 42, 100-102, 104-122, 124-155, 159-160, 162-170, 172-180, 182-186, 192-194, 300-306, 311-322, 400-476, 479-518, 600-602, 610-611, 616-618, 625, 629-635, 637, 641-643, 650, 652, 655-657, 666-672, 677, 685-691, 693, 696-697, 709, 711, 714, 717, 719-724, 726-727, 729-731, 733-735, 737, 740-741, 743-744, 800-888, 900-1097, 1200-1373, and Appendix A-D of Exhibit 1009*

Patent Owner further argues that Paragraphs 1-40, 42, 100-102, 104-122, 124-155, 159-160, 162-170, 172-180, 182-186, 192-194, 300-306, 311-322, 400-476, 479-518, 600-602, 610-611, 616-618, 625, 629-635, 637, 641-643, 650, 652, 655-657, 666-672, 677, 685-691, 693, 696-697,

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

709, 711, 714, 717, 719–724, 726–727, 729–731, 733–735, 737, 740–741, 743–744, 800–888, 900–1097, 1200–1373, and Appendix A–D of Dr. Poynton’s Declaration (Exhibit 1009) should be excluded because these were not cited in the Petition. However, Petitioner relies on Dr. Poynton’s testimony for authentication of Exhibits 1013 and 1014. *See* Pet. Reply 2–5 (citing Ex. 1009 ¶¶ 7, 192–195), which we have discussed above. Moreover, to the extent that Dr. Poynton’s testimony discusses other issues, we have not relied upon those sections for our decision. Thus, we dismiss Patent Owner’s motion to exclude these paragraphs as moot.

D. Petitioner’s Motion to Exclude

Petitioner moves to exclude some or all of Exhibits 2121–2123 and 2141–2143. Paper 109. Petitioner’s motion to exclude is dismissed as moot because we do not rely on these exhibits (or portions thereof).

III. OBVIOUSNESS GROUNDS BASED ON ICC V.3.0 AND ICC V.3.01

All of the instituted grounds rely on Petitioner’s ICC v.3.0 (Exhibit 1013) or ICC v.3.01 (Exhibit 1014) as the primary reference. *See supra* § I.E. We have excluded Exhibits 1013 and 1014 above. *See supra* § II.C.3. 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 28–33 and 36–38 of the ’008 patent would have been obvious based on the asserted grounds of unpatentability.

IV. CONCLUSION

Petitioner has not shown, by a preponderance of the evidence, that Exhibits 1013 and 1014 are authentic copies of the published ICC v.3.0 and ICC v.3.01 industry standards respectively. Thus, we grant Patent Owner’s

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

motion to exclude Exhibits 1013 and 1014. As a result, Petitioner has not shown, by a preponderance of the evidence, that the subject matter of claims 28–33 and 36–38 of the '008 patent would have been obvious based on the asserted grounds of unpatentability, which all rely on either ICC v.3.0 or ICC v.3.01 as the primary reference.

In summary:

Claims	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
28–30, 32, 33, 36–38	103(a)	ICC v.3.0, User Guide, Beretta		28–30, 32, 33, 36–38
28, 31	103(a)	ICC v.3.01, User Guide, Beretta		28, 31
Overall Outcome				28–33, 36–38

ORDER

Accordingly, it is:

ORDERED that Petitioner has not shown by a preponderance of the evidence that claims 28–33 and 36–38 of the '008 patent are unpatentable;

FURTHER ORDERED that Patent Owner's motions to exclude Exhibit 1010 (Paper 97; Paper 108), the declaration of Dr. Phil Green, is *granted*; and

FURTHER ORDERED that Patent Owner's motion to exclude (Paper 108) Exhibits 1013 and 1014 are *granted*;

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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

FURTHER ORDERED that Patent Owner's motion (Paper 97) to strike is *denied or dismissed as moot* in all other aspects as set forth above;

FURTHER ORDERED that Patent Owner's motion to exclude (Paper 108) is *denied or dismissed as moot* in all other aspects as set forth above;

FURTHER ORDERED that Petitioner's motion to exclude (Paper 112) is *dismissed as moot*;

FURTHER ORDERED that the parties agree upon and file, as a Paper, a proposed redacted public version of this decision within two weeks of the entry date of this decision; and

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.

PUBLIC VERSION

IPR2019-00627
Patent 7,729,008 B2

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