
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZF NORTH AMERICA, INC., ZF ACTIVE SAFETY US INC.,
Petitioners,

v.

STONERIDGE CONTROL DEVICES, INC.,
Patent Owner.

Inter Partes Review No. IPR2023-00273
Patent No. 7,021,415

OPPOSITION TO MOTION TO EXCLUDE EVIDENCE

TABLE OF EXHIBITS

Exhibit	Description
2001	Statutory disclaimer under 35 U.S.C. 253(a)
2002	FR 2 693 779 to Ralf-Michael, <i>et al.</i>
2003	Certified Translation of FR 2 693 779
2004	Government Accountability Office Report to the Subcommittee on Courts, Intellectual Property, and the Internet, Committee on the Judiciary, House of Representatives
2005	Declaration of Jeffrey L. Stein, Ph.D.
2006	CV of Jeffrey L. Stein, Ph.D.
2007	Transcript of Deposition of Bruno Lequesne, Ph.D.
2008	U.S. Patent No. 6,397,981 to Tamasho, <i>et al.</i>
2009	Mopar.com listing for Park Brake Actuator (Part No. 68225300AB), viewed August 7, 2023
2010	ZF Press Release dated May 23, 2022
2011	Declaration of Rolf Patrick
2012	Stoneridge, Inc. presentation to TRW, dated February 21, 2003
2013	E-Motors advertisement (Exhibit 4 from Deposition of Lequesne)
2014 ¹	Placeholder - Physical Exhibit Retained By Counsel (Exhibit 5 from Deposition of Lequesne)
2015	Collection of Photographs of Physical Sample of TRW EPBA (i.e., Photos of Ex. 2014; Exhibit 6 from Deposition of Lequesne)
2016	Exhibits A and B from Patent Owner’s Infringement Contentions, served in <i>Stoneridge Control Devices, Inc. v. ZF North America, Inc. et al.</i> , U.S. District Court for the Eastern District of Michigan, Case No. 2:22cv10289
2017	“Electric Parking Brake (EPB) System Market...” from https://www.einpresswire.com/article/632662740/electric-parking-brake-epb-system-market-projected-to-reach-usd-6-07-billion-by-2032-with-7-3-cagr-i-reports-and-data

¹ Patent Owner emailed the Board on July 28, 2023 asking how to handle custody of this physical exhibit. *See* Ex. 2019. Patent Owner’s counsel is currently maintaining custody of the physical exhibit. *Id.*

2018	“Electric Parking Brake Market is Expanding at a CAGR of...” from https://www.globenewswire.com/news-release/2023/7/5/2699470/0/en/Electric-Parking-Brake-Market-is-Expanding-at-a-CAGR-of-12-4-to-Cross-US-5-92-Billion-by-2033-Fact-MR.html
2019	Email dated July 28, 2023 from Patent Owner’s counsel to Board asking how Board would like to handle custody of physical exhibit 2014
2020	The Board’s default protective order
2021	Expunged
2022	Declaration of Holly Stringfield

I. INTRODUCTION

Patent Owner has submitted evidence of copying and other secondary considerations. *See* POR at 60-61. On the subject of copying, Petitioners first adopted vibration isolators into their design after one of the real-parties-in-interest to this case attended Patent Owner’s presentation, which demonstrated that incorporating vibration isolators into an electronic parking brake resulted in reduced noise. *Id.*

In an effort to avoid explaining this chronology, Petitioners have filed a motion (“Motion,” Paper 23) to exclude much of Patent Owner’s evidence of secondary considerations. However, Petitioners’ Motion is a meritless attempt to exclude evidence which Petitioners deem to be problematic to their case. Otherwise, Petitioners improperly use motion practice as a vehicle for addressing the weight of the evidence.

II. RESPONSES TO INDIVIDUAL ITEMS

Petitioners have moved to exclude Paragraphs 160-166 of Ex. 2005, Exhibits 2009-2012, and Exhibits 2016-2018.

A. Paragraphs 160-166 of Ex. 2005

Paragraphs 160-166 contain Dr. Stein’s analysis of secondary considerations. Specifically, these paragraphs contain, first, Dr. Stein’s understanding of the relevant

law and facts, and second, Dr. Stein’s opinion on copying, praise in the industry, commercial success, and secondary considerations as a whole.

As to the “understanding” sections of paragraphs 160-166, these sections are not expert testimony and the Board has declined to exclude similar portions of an expert’s report in the past. *Samsung Electronics America, Inc. et al. v. Smartflash LLC*, CBM2014-11092, Paper 45, 2016 Pat. App. LEXIS 1606, *39 (PTAB March 30, 2016) (“We understand that in these paragraphs, [the expert] is not giving expert testimony about the law, but simply indicating his understanding of the law as background foundation for the declaration. As such, we decline to exclude these paragraphs.”). Indeed, Petitioners’ expert’s report contains the same sort of summary of his understanding of the legal principles underlying his conclusions. Ex. 1002 at ¶¶16-41.

As to the opinion sections of paragraphs 160-166, Petitioners assert Dr. Stein’s testimony constitutes “inadmissible bald conclusion[s].” Motion at 2-3. To begin with, the Board has repeatedly found that whether an expert’s testimony is allegedly conclusory or not adequately based on record evidence is a question of weight, not admissibility. See, e.g., *Cardiovascular Systems, Inc. v. Shockwave Medical, Inc.*, IPR2019-00409, Paper 75, 2020 Pat. App. LEXIS 12544, *66 (PTAB July 8, 2020) (denying motion to exclude expert’s testimony); *Spinal Elements, Inc.*

v. Spectrum Spine IP Holdings, LLC, PGR2021-00050, Paper 47, 2022 Pat. App. LEXIS 4185, *56-57 (PTAB August 17, 2022) (same); *Minerva Surgical, Inc. v. Hologic, Inc.*, PGR2017-00002, Paper 36, 2018 Pat. App. LEXIS 9161, *51 (PTAB May 8, 2018) (same, noting “[a] motion to exclude is not the proper vehicle to challenge the sufficiency of the evidence to prove a particular fact. Rather, it is within our discretion to assign the appropriate weight to be accorded to evidence.”) (citations omitted).

In any case, Petitioners are mistaken that Dr. Stein’s opinions on secondary considerations are lacking. As to copying, Dr. Stein’s opinion is based on (1) his review of claim charts in the related district court litigation between the parties, (2) his inspection of a physical product sold by Petitioners or one of their affiliates, and (3) his understanding of the facts surrounding Patent Owner’s presentation of its prototype design to an affiliate of Petitioners, and Petitioners’ subsequent release of a product having the features of Patent Owner’s novel design. Ex. 2005 at ¶163. The presentation itself is in evidence as Ex. 2012 and the claim charts are in evidence as Ex. 2016.

As to industry praise and commercial success, Dr. Stein’s opinion is based on his review of Petitioners’ parent company’s press release concerning praise in the industry and sales figures for its EPBAs, and the claim charts comparing Petitioners’

product to the '415 Patent claims. *Id.* at ¶¶ 165-166. The statement and claim charts are in evidence for the Board's review as Exs. 2010 and 2016, respectively. In short, Dr. Stein's testimony is well-supported and the Board is equipped to weigh Dr. Stein's testimony along with the evidence on which he relied to form his opinions.

Finally, Petitioners assert that the evidence that Dr. Stein relies on is not the sort of evidence on which an expert would "reasonably rely," citing to cases that concern "inadequate and untrustworthy" data and unauthenticated evidence. Motion at 3. Petitioners provide no further analysis on this point but separately challenge the exhibits on which Dr. Stein relies. Patent Owner will address these exhibits below.

B. Ex. 2009

Ex. 2009 is a screenshot from the website of a seller of Petitioners' products. Petitioners first assert that Ex. 2009 is not authenticated. In support, Petitioners cite cases that are over 20 years old. Motion at 4. More modern courts take a different approach. A website screenshot can be authenticated "when a witness testifies that she saw and printed the posting from the website as long as the screenshots contain circumstantial indicia of authenticity." *Pietrangelo v. Refresh Club, Inc.*, No. 18-cv-1943 (DLF), 2023 U.S. Dist. LEXIS 176296, at *34 (D.D.C. Sep. 29, 2023) (collecting cases) (internal quotation marks omitted). As Petitioners note, Patent Owner has provided Petitioners with a declaration of Holly Stringfield as supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2). The declaration is being

filed as Ex. 2022 with this paper. In the declaration, Ms. Stringfield indicates that she visited the URL indicated, captured a screenshot from the URL and that the capture represents what she viewed at the URL. Ex. 2022 at ¶ 4. Moreover, Ex. 2009 includes indicia of authenticity such as the name and logo of the seller, Mopar, a date and time stamp, and the first segment of the URL.² *Id.*

Petitioners next assert that Ex. 2009 is hearsay. Motion at 5. Patent Owner relies on Ex. 2009 to show commercial success and in particular that Petitioners' product is used in common vehicles such as the Jeep Cherokee. POR at 60. However, Ex. 2009 need not be considered for the truth of the matter asserted to support the commercial success issue and therefore, at a minimum, has a non-hearsay purpose. For instance, Ex. 2009 shows that Mopar, an automotive parts company owned by the same company that owns the Jeep brand, sells Petitioners' product in connection with the Jeep Cherokee, which is a different point than the truth of whether or not Petitioners' product is actually compatible with the Jeep Cherokee.

Moreover, this case is unique in that the commercial success at issue is on the part of Petitioners (and/or their affiliates), and not Patent Owner. In order to prove commercial success, Patent Owner has relied on various out of court statements

² Exhibit A to Ms. Stringfield's declaration (Ex. 2022) is another screenshot of the same webpage with the full URL.

(including those made by Petitioners' parent company) because of the inherent challenges associated with discovering another's financial information. Because Patent Owner cannot simply submit its own sales information to prove commercial success, the Board should evaluate the circumstantial evidence that Patent Owner did provide for what it fairly conveys on the matter of commercial success. *See, e.g., W.R. Grace & Co.-Conn v. InterCat, Inc.*, Civil Action No. 93-522 LON, 1997 U.S. Dist. LEXIS 22586, at *121 (D. Del. Sep. 8, 1997) (finding "the evidence of commercial success is strong evidence of nonobviousness" based in part on circumstantial evidence).

Finally, Petitioners assert that Ex. 2009 is irrelevant to the issue of secondary considerations for lack of nexus to the '415 Patent. Motion at 5-6. However, as already explained in the POR, nexus is presumed in this case because Patent Owner has shown that Petitioners' product embodies the claims of the '415 Patent. POR at 62. There is a nexus between Ex. 2009 and the '415 Patent because Ex. 2009 shows Petitioners' product (which Petitioners do not deny).

C. Ex. 2010

Ex. 2010 is a screenshot of a press release by Petitioners' parent company regarding the commercial success of the EPBA product.

Petitioners first assert that Ex. 2010 lacks authentication. Motion at 6. Ex. 2010 has been authenticated by Ms. Stringfield in the same manner as Ex. 2009,

discussed above, and contains the same sort of indicia of authenticity. Ex. 2022 at ¶5 and Exhibit B thereto.

Petitioners next assert that Ex. 2010 is hearsay. However, Ex. 2010 need not be considered for the truth of the matter asserted therein. For instance, Ex. 2010 could be used to show that Petitioners' parent company ZF Friedrichshafen AG is proud of its EPBA product line, and not necessarily to prove the specific number of units sold.

Relatedly, Petitioners assert that Ex. 2010 is irrelevant because it does not call out a specific one of Petitioners' products. Motion at 7. However, Ex. 2010 refers to the extraordinary success of Petitioners' EPBAs, and the accused product is a type of EPBA (which Petitioners do not deny). Ex. 2010 is thus at a minimum circumstantial evidence of commercial success and is relevant. *See, W.R. Grace, cited supra.*

Petitioners are likewise incorrect that there is no nexus between Ex. 2010 and the '415 Patent. Motion at 7. First, as discussed above, nexus is presumed in this case. Moreover, the subject of Ex. 2010 is the class of products (EPBAs) to which the accused product belongs. Ex. 2010 thus at least in part bears on a product which has the features of the '415 patent.

D. Ex. 2011

Ex. 2011 is a declaration of Rolf Patrick. Mr. Patrick testified about a presentation that was shown to an affiliate of Petitioners.

Petitioners first assert that Mr. Patrick lacks personal knowledge regarding “what occurred during the alleged presentation,” and his testimony is based on hearsay, because he did not attend the meeting when the presentation occurred. Motion at 8. However, Petitioners overlook that Mr. Patrick’s testimony does not relate to what occurred during the meeting but rather the contents of the document, Ex. 2012, that he helped prepare and that he personally knows was presented to Petitioners’ affiliate. Ex. 2011 at ¶¶ 4-8.

Petitioners also assert that Mr. Patrick lacks personal knowledge or has presented opinion testimony of a lay witness as to a 2003 TRW design (referred to as the “current design” in Ex. 2012). Motion at 8-9. Again, however, Mr. Patrick testified that he contributed to the presentation (Ex. 2011 at ¶4) and therefore he does have personal knowledge of what is meant by the term “current design” in that document. Likewise, Mr. Patrick’s testimony about the use of the “current design” in the Audi A8 is based on his personal knowledge. *Id.* Mr. Patrick was a sales account manager at the time (Ex. 2011 at ¶3) and it would follow that in that position he had personal knowledge of competitors’ products.

Petitioners next assert that Mr. Patrick's testimony at ¶¶ 6 and 9-10 amounts to improper expert testimony by a fact witness. Motion at 9. However, none of Mr. Patrick's testimony is opinion testimony. It is fact testimony based on his perception of the presentation, the '415 Patent, and/or his knowledge of TRW's products at the time. No rule of evidence precludes a fact witness from testifying in this manner.

Finally, Petitioners assert that Ex. 2011 is irrelevant because the presentation (Ex. 2012) has no nexus to the '415 Patent. Motion at 10-11. The next section addresses why Ex. 2012 is in fact relevant and there is a nexus between Ex. 2012 and the '415 Patent. It follows that Ex. 2011, which concerns Ex. 2012, is likewise relevant and has the requisite nexus.

E. Ex. 2012

Ex. 2012 is a presentation made by Patent Owner to an affiliate of Petitioners concerning the invention of the '415 Patent.

Petitioners first assert that Ex. 2012 is not authenticated. Motion at 11. Specifically, Petitioners assert that Mr. Patrick cannot authenticate Ex. 2012 because he did not attend the meeting when it was presented. However, Petitioners ignore that Mr. Patrick testified that he was part of the team that prepared the presentation and as a result has personal knowledge of the contents of the presentation and the work that went into preparing it. Ex. 2011 at ¶ 4. Mr. Patrick also testified based on

his personal knowledge that the presentation in Ex. 2012 was shown to Petitioners' affiliate. *Id.* With this testimony Mr. Patrick authenticated Ex. 2012.

Petitioners also assert that Ex. 2012 is hearsay. Motion at 11-12. However, Petitioners are incorrect that Ex. 2012 is being offered for the truth of the matter asserted therein (for example, the technical information shown). *Id.* Instead, Ex. 2012 is offered for the proposition that Patent Owner communicated certain information to Petitioners. POR at 60.

Finally, Petitioners assert that Ex. 2012 is irrelevant for lack of nexus. Motion at 12. Specifically, Petitioners claim that Patent Owner has not shown that the design in Ex. 2012 relates to the claims of the '415 Patent. *Id.* However, as Patent Owner already explained, Ex. 2012 shows claimed features including a sub-frame and at least one isolator that provides sound/vibration isolation. POR at 60 (citing Ex. 2012 at pages 4-5, 22).

F. Ex. 2016

Ex. 2016 is a claim chart comparing Petitioners' product to the claims of the '415 Patent that was prepared for district court litigation between the parties.

Petitioners assert Ex. 2016 is unauthenticated. Motion at 12. However, Ms. Stringfield testified that Ex. 2016 is an excerpt of Patent Owner's First Amended Disclosure of Infringement Contentions in the district court litigation between the parties, which she filed with the Eastern District of Michigan and which was entered

on the Court’s docket. Ex. 2022 at ¶8. Ms. Stringfield has authenticated Ex. 2016, which Petitioners ignore.

Petitioners also assert Ex. 2016 is irrelevant. Motion at 12. As discussed above, Ex. 2016 is relevant at least to the issue of nexus in relation to secondary considerations because it shows that Petitioners’ product embodies the claims of the ‘415 Patent.

G. Ex. 2017

Ex. 2017 is a screenshot of an article concerning the market for electric park brakes.

Petitioners first assert that Ex. 2017 lacks authentication. Motion at 13. Ex. 2017 has been authenticated by Ms. Stringfield in the same manner as Exs. 2009 and 2010, discussed above, and contains the same sort of indicia of authenticity. Ex. 2022 at ¶6 and Exhibit C thereto.

Petitioners next assert that Ex. 2017 is hearsay. However, Ex. 2017 is offered only for the fact that the author of Ex. 2017 deems Petitioners to be a “key player” in the electric parking brake market. Ex. 2017 is not offered for the truth of that matter. *Quanergy Systems, Inc., v. Velodyne Lidar, Inc.*, IPR2018-00255, Paper 59, 2019 Pat. App. LEXIS 4828, *57 (PTAB May 23, 2019) (denying motion to exclude “evidence of industry praise and commercial success,” namely “articles from Forbes, The Verge, and Bloomberg,” because “[w]e do not consider news articles such as

these to be inadmissible hearsay as they are offered simply as evidence of what [each] described, not for proving the truth of the matters addressed in the document.”) (internal quotations omitted).

Finally, Petitioners assert that Ex. 2017 is irrelevant. However, much like Ex. 2010, Ex. 2017 concerns the type of product (electric park brakes) to which the ‘415 Patent relates and thus constitutes relevant circumstantial evidence of commercial success. That Ex. 2017 does not mention a specific product by name does not make it irrelevant.

H. Ex. 2018

Ex. 2018 is a screenshot of an article about the market for electric parking brakes.

Petitioners first assert that Ex. 2018 lacks authentication. Motion at 13-14. Ex. 2018 has been authenticated by Ms. Stringfield in the same manner as Exs. 2009, 2010, and 2017, and contains the same sort of indicia of authenticity. Ex. 2022 at ¶7 and Exhibit D thereto.

Petitioners next assert that Ex. 2018 is hearsay. However, like Ex. 2017, Ex. 2018 is offered only for the fact that the author of Ex. 2018 deems Petitioners to be a “key company” in the electric parking brake market. Ex. 2018 is not offered for the truth of that matter. *See Quanergy*, cited *supra*.

Finally, Petitioners assert that Ex. 2018 is irrelevant. However, Ex. 2018 concerns electric park brakes and thus constitutes relevant circumstantial evidence of commercial success. Ex. 2018 is not irrelevant simply because it does not mention a specific product by name.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on February 8, 2024, a copy of the foregoing document was served electronically via email in its entirety on the following:

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