

**IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF TENNESSEE
NASHVILLE DIVISION**

PLATE, LLC,	)	
	)	
Plaintiff,	)	
	)	Case No. 3:18-00806
v.	)	
	)	
RCTENN, LLC,	)	
	)	
Defendant.	)	

**ORDER GRANTING IN PART DEFENDANT’S MOTION TO EXCLUDE EXPERT
OPINION TESTIMONY OF DR. GRUNE**

**ORDER DENYING PLAINTIFF’S MOTION TO EXCLUDE EXPERT TESTIMONY OF
DEREK WATKINS**

Before the Court is Plaintiff’s Motion to Exclude Expert Testimony of Derek Watkins, filed on January 10, 2020. (ECF No. 87.) Also before the Court is Defendant’s Motion to Exclude Opinion Testimony of Dr. Grune, filed on January 10, 2020. (ECF No. 90.) For the reasons discussed below, Plaintiff’s Motion is **DENIED** and Defendant’s Motion is **GRANTED IN PART**.

I. Factual Background

This is a patent infringement case. For background, the Court adopts the “Asserted Patents and Accused Products” portion from its Order Denying Motions for Summary Judgment of Invalidity, Infringement/Non-Infringement, entered on February 18, 2021 (ECF No. 202), as recited in part below:

This patent action concerns devices for loading ammunition rounds into a pistol magazine, otherwise known as magazine ammunition loaders. (Third

II. LEGAL STANDARD

A. Expert Testimony

“[A] proposed expert’s opinion is admissible, at the discretion of the trial court,” if (1) the witness is qualified by “knowledge, skill, experience, training, or education”; (2) the witness’s testimony is relevant, meaning that it “will assist the trier of fact to understand the evidence or to determine a fact in issue”; and (3) the witness’s testimony is reliable. In re Scrap Metal Antitrust Litig., 527 F.3d 517, 528-29 (6th Cir. 2008) (quoting Fed. R. Evid. 702). In evaluating the reliability of expert opinion testimony, a trial court must consider whether the testimony is based on “sufficient facts or data” and is the “product of reliable principles and methods,” as well as whether the expert “has applied the principles and methods reliably to the facts of the case.” See Fed R. Evid. 702. “Such factors as testing, peer review, publication, error rates, the existence and maintenance of standards controlling the technique’s operation, and general acceptance in the relevant scientific community should be considered in this review.” United States v. Langan, 263 F.3d 613, 621 (6th Cir. 2001) (quoting Daubert v. Merrell Dow Pharm., Inc., 509 U.S. 579, 593-94 (1993)).

“The party offering the expert’s testimony has the obligation to prove the expert’s qualifications by a preponderance of the evidence.” Burgett v. Troy-Bilt LLC, 579 F. App’x 372, 376 (6th Cir. 2014). That being said, “the rejection of expert testimony is the exception rather than the rule.” Fed. R. Evid. 702 advisory committee’s note, 2000 amend. “The task for the district court in deciding whether an expert’s opinion is reliable is not to determine whether it is correct, but rather to determine whether it rests upon a reliable foundation, as opposed to, say, unsupported speculation.” In re Scrap Metal Antitrust Litig., 527 F.3d at 529-30. “[M]ere weaknesses in the factual basis of an expert witness’ opinion bear on the weight of the evidence rather than on its

admissibility.” McLean v. 988011 Ontario, Ltd., 224 F.3d 797, 801 (6th Cir. 2000) (quoting United States v. L.E. Cooke Co., 991 F.2d 336, 342 (6th Cir. 1993) (internal quotation marks and alternations omitted).

B. Expert Disclosure

“[A] party must disclose to the other parties the identity of any [expert] witness it may use at trial” Fed. R. Civ. P. 26(a)(2)(A). “[T]his disclosure must be accompanied by a written report—prepared and signed by the witness—if the witness is one retained or specially employed to provide expert testimony in the case or one whose duties as the party’s employee regularly involve giving expert testimony.” Fed. R. Civ. P. 26(a)(2)(B). “[I]f the witness is not required to provide a written report, this disclosure must state . . . the subject matter on which the witness is expected to present evidence” and “a summary of the facts and opinions to which the witness is expected to testify.” Fed. R. Civ. P. 26(a)(2)(C).

“A party who has made a disclosure under Rule 26(a) . . . must supplement or correct its disclosure or response . . . in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing” Fed. R. Civ. P. 26(e)(1)(A). “If a party fails to provide information or identify a witness as required by Rule 26(a) or (e), the party is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless.” Fed. R. Civ. P. 37(c).

III. ANALYSIS

A. Defendant's Motion to Exclude Dr. Grune

“The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. That starting point is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be ready by others of skill in the pertinent art.” Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005) (internal citations omitted). Similarly, “when the patent holder relies on the doctrine of equivalents...the difficulties and complexities of the doctrine require that evidence be presented to the jury or other fact-finder through the particularized testimony of a person of ordinary skill in the art, typically a qualified expert, who (on a limitation-by-limitation basis) describes the claim limitations and establishes that those skilled in the art would recognize the equivalents.” AquaTex Industries, Inc. v. Techniche Sols., 479 F.3d 1320, 1329 (Fed. Cir. 2007). Invalidity for anticipation similarly requires that “there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of invention.” Scripps Clinic & Research Found. v. Genetech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991). Whether a patented invention was obvious at the time of invention is also assessed from the viewpoint of a person with ordinary skill in the art. KSR Intern Co. v. Teleflex Inc., 550 U.S. 398 (2007).

Defendant takes issue with Dr. Grune's testimony for lacking the requisite knowledge, skill and experience in firearms, firearms accessories, and/or ammunition magazine loaders to provide scientific, technical, or other specialized knowledge that would assist the tier of fact in this case. (ECF No. 91 at PageID 2525.) Plaintiff and Dr. Grune do not dispute this point, and instead argue

that such bespoke experience is not necessary. At his deposition, the following exchange occurred regarding Dr. Grune's lack of expertise in firearms:

Q. You're stating in your opinion that you were one of ordinary skill in the art. Is that correct?

A. I'm stating my opinion that I was one of ordinary skill in the art regarding intellectual property and understanding what patents do and what they don't do. I did not state anywhere that I was in any way an expert regarding the field of, as it says here, it says: "One year of design experience in magazine loading devices or related technologies in the field of small arms and have a general proficiency in small arms." **I never said anywhere in my report that I was one of those people.** I do have a Bachelor's Degree in Mechanical Engineering and over 20 years of experience in intellectual property and patents.

Q. Do you consider yourself one of ordinary skill in the art, in the field of assuming that the art is the Plate Patents? You consider yourself one of ordinary skill in the art?¹

A. Regarding what?

Q. Firearms.

A. No. I think we've covered that.

Q. Okay.

A. I'm not a firearms expert.

Q. Do you consider yourself of ordinary skill in the art with respect to firearm accessories?

A. No, we covered that too. **I didn't say that I was an expert in anything to do with firearms specifically.**

The Federal Circuit has held that it is "an abuse of discretion to permit a witness to testify as an expert on the issues of noninfringement or invalidity unless that witness is qualified as an expert in the pertinent art." Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1361 (Fed. Cir. 2008). In Sundance, defendant argued that its expert was qualified because of his extensive experience in patent law and procedure, despite not having experience with segmented

¹ Dr. Grune's counsel objected to form.

tarpaulin systems (the technology at issue). Id. at 1360. The district court allowed defendant's expert to testify, and the Federal Circuit reversed, explaining that:

DeMonte failed to explain how Mr. Bliss possesses the relevant expertise in the pertinent art. Mr. Bliss has no experience whatsoever in the 'field of tarps or covers. Nor does DeMonte purport that Mr. Bliss's experience with engines and the like is sufficiently related to covers....**Admitting testimony from a person such as Mr. Bliss, with no skill in the pertinent art, serves only to cause mischief and confuse the factfinder....We hold that it is an abuse of discretion to permit a witness to testify as an expert on the issues of noninfringement or invalidity unless that witness is qualified as an expert in the pertinent art.** Testimony proffered by a witness lacking the relevant technical expertise fails the standard of admissibility under Fed.R.Evid. 702. Indeed, where an issue calls for consideration of evidence from the perspective of one of ordinary skill in the art, it is contradictory to Rule 702 to allow a witness to testify on the issue who is not qualified as a technical expert in that art. We understand that patent lawyers are often qualified to testify as technical experts, but **such a qualification must derive from a lawyer's technical qualifications in the pertinent art.**

Sundance, 550 F.3d at 1363.

Here, it is undisputed that Dr. Grune lacks the requisite experience in firearms or firearms accessories. Plaintiff appears to pivot from reliance on Dr. Grune's patent law experience to his alleged training and experience in mechanical engineering generally. (ECF No. 100 at PageID 3925.) Plaintiff even goes so far as to make the statement below, perhaps in an attempt to make Dr. Grune's polymers experience more relevant:

However, it is important to note that **this lawsuit is NOT about firearms.** It is about a plastic product that is used in the absence of any firearm, save the ammunition magazine, which has been removed from the firearm to be loaded.

ECF No. 100 at PageID 3925. The "Field of the Invention" in the Asserted Patents, along with every other point of evidence in this litigation, says otherwise. (See, e.g., RE48,152 Patent at 1:33–34 (The present invention relates to ammunition magazines, and more specifically, to magazines loaders."); see also id. at 1:38–41 ("A magazine is a device used to provide rounds of

ammunition to a firearm. An ammunition magazine loader is a device to facilitate the loading of rounds into an ammunition magazine.”.) The case is inescapably about firearms, firearms accessories, and ammunition magazines, as set out by the Asserted Patents. Dr. Grune’s bachelor’s degree in mechanical engineering, and master’s and doctorate degrees in chemical engineering and experience and skill are insufficient to qualify him as a PHOSITA in *this* litigation.

Plaintiff states that “Dr. Grune’s testimony will focus on the mechanical functions present in the accused products compared with the mechanical functions disclosed in the asserted patents. His report, and his expected testimony, will describe various structures and their effect upon the functionality of the claimed invention as well as their functionality within the accused products. He will discuss expected effects upon functionality given various possible changes to structures within the claimed invention and the accused products. He will also testify about difficulties associated with designing a magazine loader, and how those difficulties have been addressed.” (ECF No. 100 at PageID 3924.)

For the reasons stated above, Defendant’s motion to exclude Dr. Grune’s testimony is **GRANTED IN PART** on the issues of noninfringement and invalidity, including obviousness and anticipation. Dr. Grune, may however, still, testify on the issue of infringement, as well as structure and mechanical function, to the extent that these are included in his existing expert report. Plaintiff is hereby **ORDERED** to identify, within 7 days of entry of this Order, i.e., February 25, 2021, the remaining portions of Dr. Grune’s expert testimony that Plaintiff, in light of the Court’s ruling herein, still proposes to use at trial on the limited issues of infringement and reissue proceedings.

B. Plaintiff's Motion to Exclude Derek Watkins

Plaintiff's motion fails for the same reasons Defendant's succeeds—it puts forth an incorrect standard for the qualifications necessary to provide expert testimony in a patent matter. Plaintiff argues that “Mr. Watkins’ testimony regarding validity and infringement of the asserted patents[] should be excluded because Mr. Watkins is not qualified to testify as an expert on these subjects[.]” (ECF No. 87 at PageID 2055.) Plaintiff emphasizes Mr. Watkins deposition testimony in which he admits that “he is not a patent law expert, that he is not a patent agent, that he is not an attorney, that he has never taken the bar, that he is not licensed to practice before the U.S. Patent Office, and that he is not licensed to provide legal opinions regarding patent infringement or validity.” (Id.)

Whether Mr. Watkins is an expert in patent law is not the standard. The Federal Circuit has rejected this exact line of argument in a case where Defendants argued that an expert had never attended law school, practiced patent law, or appeared as a lawyer. See Endress + Hauser, Inc. v. Hawk Measurement Sys. Pty. Ltd., 122 F.3d 1040, 1042 (Fed. Cir. 1997) (“It is of course **nonsense** to contend that only lawyers or patent lawyers can be expert witnesses in a patent suit.”) (emphasis added). In Endress, the district court relied on the expert testimony of Plaintiff’s expert, a professor of electrical engineering at Purdue University, who opined on infringement of patents directed to ultrasonic level-measuring equipment. Id. at 1042. Defendants attacked Plaintiff’s expert for not being a “person of ordinary skill in the art” and therefore unable to opine on §103 obviousness. Id. The court called this objection “meritless” based on Plaintiff’s expert’s “substantial credentials as an electrical engineer”. Id.

The relevant question is whether Mr. Watkins can opine on issues of infringement and invalidity. “These issues are analyzed in great part from the perspective of a person of ordinary

skill in the art, and testimony explaining the technical evidence from that perspective may be of great utility to the factfinder.” Sundance, 550 F.3d at 1361. Accordingly, a similar result follows as the court’s decision in Endress.

Defendant asserts that “Mr. Watkins is qualified to offer opinion testimony by knowledge, skill, experience, training, and education” based on his degrees in mechanical engineering and 15 years of experience in the firearms industry. (ECF No. 99 at PageID 3912.) In fact, Plaintiff does not seem to dispute Mr. Watkins’ experience and knowledge, focusing instead on his lack of experience in patent law. (ECF No. 87 at PageID 2056 (“While Mr. Watkins may have experience in firearms and the manufacture of firearms accessories, he lacks any education or licensing in patent law.”).) Mr. Watkins began working in the firearms industry in 1995 as an engineer with Remington Arms, and has worked in the industry in some form or fashion since then. (ECF Nos. 87-1, 87-2.) It is precisely that experience, knowledge, and skill in designing and producing firearms-related products that qualifies him to be an expert in a case regarding patent infringement in the context of ammunition magazine loaders (see, e.g., ’552 Patent). Plaintiff’s motion is therefore **DENIED**.

IV. CONCLUSION

For the foregoing reasons, Plaintiff’s Motion to Exclude Testimony is **DENIED** and Defendant’s Motion to Exclude Testimony is **GRANTED IN PART**.

IT IS SO ORDERED, this 18th day of February, 2021.

/s/ Jon P. McCalla
JON P. McCALLA
UNITED STATES DISTRICT JUDGE