

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC.

Petitioner,

v.

FACET TECHNOLOGIES, LLC

Patent Owner.

Case No. IPR2023-00712

U.S. Patent No. 8,840,635

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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I INTRODUCTION

Patent Owner (“PO”) moves to exclude Exhibit 1052, Ms. Voyten’s deposition transcript, as inadmissible hearsay. Mot. at 2. PO’s motion should be denied because even if Exhibit 1052 constitutes hearsay, it qualifies for the residual exception under Federal Rule of Evidence (“FRE”) 807. Exhibit 1052 is also admissible under FRE 703 because [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

For these reasons, PO’s motion should be denied.

II EXHIBIT 1052 QUALIFIES UNDER THE RESIDUAL EXCEPTION

Under FRE 807, the residual exception applies if “(1) the statement is supported by sufficient guarantees of trustworthiness—after considering the totality of the circumstances under which it was made and evidence, if any, corroborating the statement; and (2) it is more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts.” Fed. R. Evid. 807. The deposition transcript of Ms. Voyten’s testimony meets both requirements. *See, e.g., Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683 (Paper 13), at 13-14 (PTAB Aug. 14, 2020) (declining to exclude deposition testimony because it fell within the residual exception).

First, Ms. Voyten’s deposition transcript is supported by sufficient guarantees of trustworthiness. Ms. Voyten was deposed under oath in the related district court litigation, *Facet Technologies, LLC v. LifeScan, Inc.*, No. 2:22-cv-1717-MCS-MAR (C.D. Cal. Apr. 28, 2023), where she was cross-examined by PO’s counsel. Because [REDACTED], PO’s counsel was motivated to and in fact did cross examine Ms. Voyten regarding the specific factual issues on which LifeScan relies on her in this proceeding. Because Ms. Voyten gave sworn testimony in her deposition and PO had the opportunity to cross-examine her on her testimony, her deposition transcript bears the same guarantees of trustworthiness as a transcript of a witness deposed in this proceeding.

Second, Ms. Voyten’s deposition testimony is more probative on the point for which it is offered than any other evidence that Petitioner could otherwise obtain. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] And

contrary to PO's assertions, submitting a declaration from Ms. Voyten would not have been more probative than the testimony she already provided under PO's cross-examination in the related district court litigation. Even if a declaration from Ms. Voyten had been submitted, it would have contained essentially the same testimony and facts that PO already elicited from Ms. Voyten during her deposition. If PO truly thought that Ms. Voyten needed to be subject to further cross-examination on these topics, PO could have requested the opportunity to retake her deposition in these IPR proceedings in connection with its submission of

a sur-reply—as it did with respect to Petitioner’s three experts, Joel Delman, Paul Hatch, and Mr. Rosenfarb. That PO made no such attempt to do so establishes that its Motion to Exclude her testimony is an elevation of form over substance.

PO’s cases cited in support of its Motion are distinguishable. In *ABS Global, Inc. v. XY, LLC*, the Board noted that the deposition testimony did not qualify for the residual exception because it was cumulative of other evidence Petitioner had identified and was therefore not “more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts.” IPR2018-01224 (Paper 28), at 19 (PTAB Dec. 9, 2019). Here, by contrast, Ms. Voyten’s deposition is not cumulative of any other evidence Petitioner has provided. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

PO’s reliance on *The Data Company Technologies Inc. v. Bright Data Limited* is also distinguishable. In that case, the Board excluded deposition transcripts from a trial involving Patent Owner and “non-parties to these

proceedings.” IPR2022-00135 (Paper 51), at 80-81 (PTAB May 31, 2023). Thus, the testimony in that case was never subject to any type of cross-examination by Petitioner. Here, at her deposition in the district court litigation, Ms. Voyten was subject to extensive cross-examination by PO’s counsel concerning the same issues that are the subject of this proceeding. Because Ms. Voyten’s deposition testimony is supported by sufficient guarantees of trustworthiness and is more probative than other evidence that could be offered, Exhibit 1052 is admissible under the residual exception of FRE 807.

III MR. ROSENFARB’S INDEPENDENT, EXPERT OPINIONS ARE ADMISSIBLE AND PO OFFERS NO BASIS FOR THEIR EXCLUSION

PO’s attempts to exclude Mr. Rosenfarb’s testimony should also be rejected. PO’s arguments fail for multiple reasons.

First, PO mischaracterizes Mr. Rosenfarb’s testimony as “repeatedly parrot[ing] back the inadmissible hearsay testimony of Ms. Voyten for the truth of the matters asserted.” Mot. at 7. PO is incorrect. While isolated paragraphs of Mr. Rosenfarb’s declaration quote from Ms. Voyten’s deposition testimony ([REDACTED]), the overwhelming majority of his testimony contains Mr. Rosenfarb’s opinions [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Because PO has offered no basis to exclude these independent and reliable expert opinions, its Motion should be denied on that basis alone. In fact, despite repeatedly demanding to take Mr. Rosenfarb's deposition in these proceedings—after twice doing so in the district court—PO withdrew its notice of deposition days before Mr. Rosenfarb was scheduled to sit for his third deposition in this patent infringement dispute.

Second, even if Ms. Voyten's testimony is considered inadmissible hearsay, Mr. Rosenfarb was permitted to rely on her deposition testimony under Federal Rule of Evidence 703, which provides: "If experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion on the subject, they need not be admissible for the opinion to be admitted." Here again, PO cannot credibly dispute that testimony from Ms. Voyten is evidence on which damages experts routinely rely. [REDACTED]

i4i Ltd. P'ship v. Microsoft Corp., 598 F.3d 831, 856 (Fed. Cir. 2010) (concluding that “a survey was properly admitted over [defendant’s] hearsay objection under Federal Rule of Evidence 703, since the survey was used to estimate the amount of infringing use, a key number in [plaintiff’s] damage calculation”); *NetFuel, Inc. v. Cisco Sys. Inc.*, 438 F. Supp. 3d 1031, 1036 (N.D. Cal. 2020) (ruling under FRE 703 that an expert “could appropriately rely on [a] blogpost to perform its instructions as a basis for his opinion and analysis” regarding infringement); *In re Toyota Motor Corp. v. Unintended Acceleration Mkt’g, Sales Practices, & Prods. Liability Litig.*, 978 F. Supp. 2d 1053, 1073 n.25 (C.D. Cal. 2013) (concluding that an expert “may rely on deposition transcripts from this case to form his opinion”); *Interwoven, Inc. v. Vertical Comput. Sys.*, No. CV 10-04645 RS, 2013 WL 3786633, at *7 (N.D. Cal. July 18, 2013) (“Experts are, however, permitted to rely on hearsay evidence in coming to their conclusions, so long as an expert in the field would reasonably rely on that information.”); *Dana Corp. v. Am. Standard, Inc.*, 866 F.Supp. 1481, 1501 (N.D. Ind. 1994) (“[The expert] based his opinions on his understanding of what various depositions reported, and he may do that under Rule 703.”).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] This further supports Petitioner's view that Mr. Rosenfarb has appropriately relied on the sworn testimony of LifeScan's 30(b)(6) designated witness, Ms. Voyten, who was subject to vigorous cross examination by PO's counsel.

Third, PO's cases do not support excluding Mr. Rosenfarb's testimony. PO cites to a single district court case and a New Jersey State Court case for the assertion that experts may not transmit hearsay to a jury. *See Triboro Quilt Mfg. Corp. v. Luve LLC*, No. 10-cv-03604, 2014 WL 1508606, at *7 (S.D.N.Y. Mar. 18, 2014) (experts "may not simply transmit that hearsay to the jury"); *but cf. Agha v. Feiner*, 965 A.2d 141, 149 (N.J. Feb. 26, 2009) (noting that although NJRE 703 permits a hearsay statement to be referred to by a testifying expert for the purpose of apprising the jury of the basis for his opinion, it is incumbent upon the trial judge to instruct the jury regarding its limited use). However, the cases PO cites to do not apply here where the Board considers the data, not a jury. *See* 37 C.F.R. § 42.62(b) (portions of the Federal Rules of Evidence relating to juries shall not

apply); *see also Nestle Healthcare Nutrition, Inc. v. Steuben Foods, Inc.*, IPR2015-00249 (Paper 76), at 13 (PTAB June 2, 2016) (finding deposition testimony admissible under FRE 703 because the Board makes the determination, not a jury).

Fourth, PO fails to explain why it would be unreasonable for Mr. Rosenfarb to rely on Ms. Voyten’s deposition when forming his expert opinion. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] PO also had the

opportunity to depose Mr. Rosenfarb on the basis of his opinions but elected not to do so. Because Ms. Voyten’s deposition testimony provides some of the underlying facts that form the basis of Mr. Rosenfarb’s opinion, Exhibit 1052 should be considered by the Board. *Nestle Healthcare Nutrition Inc.*, IPR2015-00249 (Paper 76), at 11 (Under 37 C.F.R. § 42.65(a), “[t]he implication is that

ordinarily the underlying facts that form the basis of an expert opinion should be considered”).

VI CONCLUSION

For the reasons set forth above, Petitioner respectfully requests that the Board deny Patent Owner’s Motion to Exclude.

Dated: May 3, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), I certify that on May 3, 2024, I caused to be served a true and correct copy of Petitioner's Opposition to Patent Owner's Motion to Exclude by email to Patent Owner's counsel:

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