

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRYCER, LLC and BRYCER MANAGEMENT, INC.,
Petitioner,

v.

TEGRIS, INC.,
Patent Owner.

IPR2023-01196
Patent 11,126,966 B2

Petitioner's Opposition to Patent Owner's Motion to Exclude

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I. INTRODUCTION

Petitioner opposes Patent Owner's motion to exclude (Paper 33, "Mot."), which seeks the wholesale exclusion of the declaration of Petitioner's expert, Mr. MacInnes (EX1003).

Patent Owner encourages the Board to exclude Mr. MacInnes' opinions based on a laundry list of arguments that amount to an improper attempt to re-argue the merits in a motion to exclude. As the Board has repeatedly explained, such arguments are not the basis for excluding evidence. In reality, Patent Owner's motion is a thinly veiled attempt to recast its simple invention as somehow complicated and argue that there was something special or unique to claiming "a fire hydrant management software system" and "web-based registry." To the contrary, the challenged '966 Patent admits that "fire hydrants" are provided as "*non-/limiting example*" of assets requiring periodic inspection; that "it should be readily appreciated that *any* owned asset may be *substituted* for the fire hydrant"; and that the system may be implemented using "*well-known* computing systems, environments and/or configurations...." EX1001, 1:19-38, 5:1-20 (emphases added). In other words, although the '966 Patent claims were ultimately limited to "fire hydrant management software," they could have just as easily been written to cover any other asset, such as those listed as "substitut[able]" in the patent and consistent with the relevant field of art.

Mr. MacInnes’ opinions, which he is more than sufficiently credentialed to deliver, lay bare precisely how obvious and non-novel the ’966 Patent claims are. Among other qualifications, Mr. MacInnes has over three decades of experience in the asset management field, working with various assets, maintenance, and inspection technologies and systems in the public and private sector, and co-authoring a book capturing the “physical asset” management challenges and solutions in those sectors, EX1003 ¶¶10-14; EX2021, 15:24-21:21, 22:24-23:14, all *before* the earliest possible priority of the ’966 Patent and consistent with the ’966 Patent’s field of art.

Patent Owner also attempts to disparage Mr. MacInnes’ credibility by casting him as dishonest, based primarily on a single inconsistent response to a single deposition question pertaining to his reading of the ’966 Patent’s file history. Patent Owner fails to mention that Mr. MacInnes testified early in the deposition regarding the various materials he considered (which encompassed the file history), confirming similar statements from his declaration. It was only later in the day, when he was asked a similar question again, that he replied, inconsistently, “No.” Instead of asking follow-up questions to clarify the inconsistency, Patent Owner moved on. Its motion makes clear why: Patent Owner thought it could capitalize on Mr. MacInnes’ isolated response as a way to exclude all of his opinions. But far from proving his untrustworthiness, Patent Owner’s citation to this portion of the

deposition, while ignoring the countervailing testimony, highlights its own lack of trustworthiness in bringing its motion.

Mr. MacInnes is both imminently qualified to testify and his opinions will assist the Board in determining the patentability of the challenged claims. Accordingly, Petitioner respectfully submits—consistent with numerous Board decisions and the Consolidated Trial Practice Guide (“CTPG”)—that the Board should deny Patent Owner’s motion.¹

II. ARGUMENT

A. Mr. MacInnes has Significant Experience in Asset Management Systems and is Qualified to Testify

Patent Owner’s Motion does not dispute that Mr. MacInnes is qualified under Petitioner’s proffered level of skill in the relevant art (*e.g.*, asset management and compliance systems)—the same level relied upon by the Board at institution. *See* Institution Decision (“ID”) (Paper 9), 21-22; *see also* ID, 17-20 (discussing claimed

¹ Under Patent Owner’s theories, Patent Owner’s own witnesses should be excluded. But Petitioner did not seek wholesale exclusion. Rather, Petitioner asks the Board to appropriately weigh that testimony in view of the record. *See* Pet. Reply (Paper 26), 1-3 (exemplifying issues with the testimony of Patent Owner’s witnesses).

“fire hydrant management software”).² Rather, Patent Owner seeks to exclude Mr. MacInnes based on his alleged lack of experience concerning “fire hydrants” in particular, claiming that “a POSA should at minimum have knowledge of the inspection and maintenance of fire hydrants and related assets....” Mot., 8-9. This contradicts the ’966 Patent’s own identification of the relevant field of art, which art includes asset management and compliance systems, not restricted only to fire hydrant systems.

As an initial matter, Patent Owner’s argument is premised on the incorrect assertion that there is something unique or special about “fire hydrants,” when its own patent makes clear there is not. For example, the ’966 Patent admits that “[f]or purposes of a *non[-]limiting example* a fire hydrant will be used as an owned asset throughout the specification, however it should be readily appreciated that *any*

² Petitioner’s proffered level stated that a POSA “would have had at least a B.S. in engineering or a related field, and would have had at least two years of experience designing and/or developing *asset management and compliance systems* for regulated assets or system of assets”; that description is approximate—“a higher education or skill level might make up for less experience[], and vice-versa.” ID, 21 (quoting Pet. (Paper 1), 6) (emphasis added).

owned asset may be substituted for the fire hydrant.” EX1001, 1:34-38 (emphases added); *see also, e.g.*, Pet. (Paper 1), 1, 4, 28; Pet. Reply (Paper 26), 7-8, 16-17. The ’966 Patent provides numerous examples of such “substitut[able]” “owned assets requiring annual or regular inspection,” among others: “boilers,” “bridges,” “elevators,” “escalators,” “real estate,” “fire hydrants,” “dams,” “aircraft,” “electrical systems,” “plumbing systems,” “industrial sites,” “environmental interests,” “backflow preventers,” “vehicles,” “aircraft,” “powerplants,” “farm equipment,” “amusement parks/rides,” “kitchens,” “tunnels,” “businesses,” “financials,” and “others.” EX1001, 1:19-38. The patent also relies on admittedly conventional computers and software to implement its system, disclosing each as a generic black box. EX1001, 5:9-20 (“*well-known* computing systems, environments and/or configurations” may be used (emphasis added)), 5:1-8, 5:21-6:14, 6:21-7:64, FIGs. 1, 2, 3; *see also* Pet. (Paper 1), 4.

Mr. MacInnes’ decades of experience in asset management sits squarely within the relevant field of art. Indeed, Mr. MacInnes has “over 35 years of professional experience in engineering, manufacturing, industrial production, enterprise asset management, maintenance management, and supply chain management practices.” EX1003 ¶10. Through this experience, Mr. MacInnes has, for example: worked with a wide range of assets across multiple industries in both the public and private sector; evaluated, designed and deployed workflows

integrating varying asset, maintenance and inspection management technologies; conducted detailed asset management assessment and value propositions for investment in an enterprise asset management; and co-authored a book capturing the “physical asset” management challenges and solutions to the public and private sector. EX1003 ¶¶10-14; EX1004 (CV); EX2021, 15:24-21:21, 22:24-23:14.

But Patent Owner once again, like it did in its merits briefing, ignores the controlling record. Having admitted in its patent that “fire hydrants” are intended to be “non[-]limiting” and “substitut[able]” with any other asset and to use “well-known computing systems, environments and/or configurations[,]” Patent Owner cannot now argue that some special POSA knowledge is necessary related to “fire hydrants and related assets” or “software available for use in connection therewith....” *See, e.g., Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1375-76 (Fed. Cir. 2022); *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1339 (Fed. Cir. 2020); *McCoy v. Heal Sys., LLC*, 850 F. App’x 785, 789 (Fed. Cir. 2021).

Moreover, Patent Owner’s assertions are also contradicted (or at least called into significant question) by the testimony on cross-examination of its own witnesses—they acknowledged that the scope of “related assets” or “life safety systems” can effectively be any asset, including the laundry list identified in the ’966 Patent’s Background. *See, e.g.,* EX1037, 57:4-63:6; EX1038, 34:8-37:13; *see also* Pet. Reply (Paper 26), 7-8 (explaining same).

Regardless, Patent Owner misrepresents Mr. MacInnes’ testimony concerning his experience even under Patent Owner’s proposed level of skill. During cross-examination, Patent Owner asked Mr. MacInnes several questions about his experience in the asset management field, including his familiarity and experience “related to software regarding monitoring for the inspections of hydrants and other life safety systems.” EX2021, 15:24-21:21, 22:24-23:14. Patent Owner ignores this testimony, highlighting only Mr. MacInnes’ testimony before and after this exchange about whether Mr. MacInnes had personally managed fire hydrants or the use of software in connection with such management. Mot., 8-9. That does not contradict the experience Mr. MacInnes gained through his years working with asset management systems in the public and private sector. EX1003 ¶¶10-14, EX1004 (CV); EX2021, 15:24-21:21, 22:24-23:14.

And putting aside “fire hydrants,” there is no dispute that, by 2007, Mr. MacInnes had significant experience working with asset management and compliance systems for regulated assets or systems of assets, including web-registries for tracking asset inspection and compliance, as explained above. *See also* EX1003 ¶¶10-14, EX1004 (CV); EX2021, 15:24-21:21, 22:24-23:14.

In sum, Mr. MacInnes is imminently qualified to testify. *See also, e.g., DraftKings Inc. v. AG 18, LLC*, IPR2022-01446, Paper 36, 13 (PTAB Mar. 12, 2024) (“It is not necessary for Dr. Lane to demonstrate that he is an expert in poker or any

specific wager-based games. Indeed, to testify as an expert under Fed. Rule Evid. 702, a person need not be one of ordinary skill, but may be ‘qualified in the pertinent art.’”) (cite and quote omitted). And, even though there is here, “[t]here is ... no requirement of a perfect match between the expert’s experience and the relevant field.” CTPG, 34 (citing *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010)).

B. Patent Owner’s Shotgun Approach to its Objections Are Contrary to Numerous Board Decisions and Go to the Weight, Not Admissibility, of the Evidence

Patent Owner offers a shotgun approach seeking to exclude the testimony of Mr. MacInnes, listing a series of alleged criticisms. Patent Owner’s approach is both an improper “end run around [the Board’s] rules limiting the length of merits briefing,” *see Envirotainer AB v. Doubleday Acquisitions, LLC*, IPR2022-00851, Paper 70, 92 n.35 & 87 (PTAB Feb. 1, 2024), and an improper attempt to consider merits arguments in a motion to exclude, *see, e.g., Yita LLC v. MacNeil IP LLC*, IPR2023-00172, Paper 70, 118-19 (PTAB June 6, 2024); CTPG, 79.

Indeed, consistent with numerous Board decisions, a motion to exclude, as here, “is not an appropriate mechanism for challenging the sufficiency of evidence or the proper weight that should be afforded an argument.” *Laird Techs., Inc. v. GrafTech Int’l Holdings Inc.*, IPR2014-00025, Paper 45, 42 (PTAB Mar. 25, 2015) (also explaining “general approach” for considering challenges, whereby the Board

“is well-positioned to determine and assign appropriate weight to evidence presented”); *see also, e.g., Yita*, IPR2023-00172, Paper 70, 118-19 (“Patent Owner’s extended recitation of testimony by [various witnesses] goes to the weight not admissibility of [a witness’s] testimony and is not a reason to exclude the testimony.”); *Primera Tech., Inc. v. Automatic Mfg. Sys., Inc.*, IPR2013-00196, Paper 50, 30 (PTAB July 17, 2014) (“To the extent that [the expert] has made statements about his lack of knowledge regarding the state of the art, and to the extent that he did not consider certain evidence in providing his opinions, these considerations affect the weight to be accorded to his testimony; these are not sufficient to exclude his testimony.”); *Xilinx, Inc. v. Intellectual Ventures I LLC*, IPR2013-00112, Paper 51, 41-45 (PTAB Jun. 26, 2014) (expert’s mistake or changed opinion goes to the expert’s credibility, not the admissibility of the entire testimony); CTPG, 79 (“A motion to exclude is not a vehicle for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents”).

1. Patent Owner’s Self-Serving Characterization of Mr. MacInnes as Dishonest is Belied by the Record

Patent Owner’s assertion that Mr. MacInnes is untrustworthy is contradicted by the record. Patent Owner asserts two main points—a single question asked during deposition about the file history and whether Mr. MacInnes wrote his declaration—that it incorrectly contends makes Mr. MacInnes untrustworthy and warrants

exclusion. But, as the record shows, Mr. MacInnes testified truthfully throughout this proceeding.

As to the file history, the only question posed during cross-examination was did he “read the file history,” to which Mr. MacInnes stated “No.” EX2021, 75:14-19. Patent Owner did not ask any other questions about the file history, or seek to question Mr. MacInnes about any statement he made in his declaration about the same (*e.g.*, whether he had reviewed it at any time or anything else about the file history or any opinions concerning the same). This despite Patent Owner soliciting testimony from Mr. MacInnes that earlier confirmed he had reviewed the materials on his list of exhibits (which list includes the file history). EX2021, 27:11-29:15; EX1003 ¶18.

As to whether the opinions are his, whether he drafted his report, that certain opinions allegedly have “factual bases [that] have not been adequately disclosed,” or he could not recall specific changes he made while sitting in his deposition, Mot., 3-7, 10-11, Mr. MacInnes testified under oath that he was involved in drafting, reviewed his report and the opinions were and are his. EX2021, 39:20-40:3, 40:23-41:25; *see also* EX1003, *e.g.*, ¶6. Moreover, Patent Owner fails to explain any specifics as to the particular issues with its laundry list of identified paragraphs, Mot. 5, 10-11, and also seeks to improperly incorporate, without explanation, its

Preliminary Response. Mot., 10-11. If anything, this all goes to the weight (not admissibility) of the evidence.³

The single Patent Office decision Patent Owner cites in its Motion—*Mitchell v. Holt*, a decision in a patent interference—is readily distinguishable. See Mot., 6-7 (citing *Mitchell v. Holt*, Patent Interference No. 105,746, Paper 352 (BPAI Apr. 27, 2012) (EX2047, 21-24)). In *Mitchell*, the witness’ testimony was excluded because he lied in both a past case and the present case and he admitted that he previously falsely testified under oath and that he did not have the skills or knowledge to qualify

³ Petitioner again notes the numerous issues with Patent Owner’s witnesses. See n.1, *supra*. Among many others, a Patent Owner witness testified he had never seen the ’966 Patent, or read the claims, until his deposition preparation, despite offering opinions about their interpretation in his declaration. Compare EX1037, 38:20-39:1, 39:7-10, 40:7-19 with EX2016 ¶¶4-5, 24-26, 26-47; see also Pet. Reply (Paper 26), 1-3 (exemplifying this and other issues with testimony). Notably, Patent Owner did not address these in its Sur-Reply (Paper 30), and while they are not directly at issue for this motion (as Petitioner did not move for wholesale exclusion given the numerous prior Board decisions and the CTPG), they demonstrate that the Board should give the entire record the appropriate weight in its Final Written Decision.

as an expert witness. EX2047, 19-24. Nothing of the sort happened here. At most, Patent Owner asserts alleged inconsistencies in Mr. MacInnes' testimony. But, as explained herein, there is no credible allegation Mr. MacInnes lied in the past or here or that Mr. MacInnes does not possess the necessary skills or knowledge to offer expert testimony.

2. Patent Owner's Laundry List of Complaints are Largely Irrelevant and At Best, Go to the Weight, Not Admissibility

As to the other laundry list of items Patent Owner proffers not discussed above, they are largely irrelevant, and in any event, none warrant exclusion.

Patent Owner takes issue with the fact that Mr. MacInnes stated that he was not aware of any secondary considerations when he offered his opinions in his declaration. Mot., 2. That was and remains correct. Indeed, Patent Owner had put forth no evidence regarding the existence of any secondary consideration (and still has not met its burden, Pet. Reply (Paper 26), 19-24, which is an issue that goes to the merits, not exclusion of testimony).

Patent Owner states that Mr. MacInnes "has never opined in a patent matter outside of this proceeding or applied for a patent." Mot., 2. But Mr. MacInnes is not offering opinions on patent law; he is offering his *technical* opinion. *SEB*, 594 F.3d at 1373 (district court did not err in allowing expert testimony on infringement where the expert had "sufficient relevant *technical* expertise"; and noting that the case "comes nowhere close to the '*unusual* situation'" where "a district court abused its

discretion when it admitted the testimony of a *patent law* expert despite the absence of any suggestion of relevant *technical* expertise.”) (cleaned up; emphases added).

Patent Owner states that Mr. MacInnes had been excluded in another unrelated case, Mot., 2-3, but fails to explain how that has any relevance to Mr. MacInnes’ opinions in this matter. It does not. *See* EX2014, *6-8 (granting-in-part and denying-in-part *Daubert* motion in non-patent jury trial case involving metallurgy and the structural integrity of a nozzle).

Patent Owner asserts that Mr. MacInnes did not independently search for prior art, Mot., 2, 12, but fails to explain or provide any support (case law or otherwise) for the novel proposition he was required to do so in order for his opinions to be considered as to the prior art made of record.

Lastly, Patent Owner takes issue with Mr. MacInnes’ testimony in “Paragraphs 50-69 [*sic*: 64] of EX1003”⁴ concerning priority. Mot., 13, 5. As a threshold matter, Patent Owner did *not* address any priority claim in its merits briefing, *see generally* POR (Paper 17); Sur-Reply (Paper 30), despite Petitioner putting it at issue. *See* Pet. (Paper 1), 6-9. Mr. MacInnes also confirmed he reviewed the provisionals during his deposition. EX2021, 27:11-29:15; EX1003 ¶18 (list of

⁴ Only Paragraphs 50-64 discuss priority.

materials considered). Patent Owner did not question Mr. MacInnes on the substance of any priority claim. *See generally* EX2021. Patent Owner’s only basis here is its assertion that Mr. MacInnes’ testimony at Paragraphs 50-64 “merely reflect attorney argument.” Mot., 13. Not so. And notwithstanding, Patent Owner waived this objection by failing to include it in its Objections to Evidence. *See* Patent Owner’s Objections (Paper 11) (no mention of priority date or Paragraphs 50-64). *See also* 37 C.F.R. § 42.64.

III. CONCLUSION

Because Mr. MacInnes is qualified, his testimony will assist the Board in making a patentability determination involving the simple technology-at-issue here, and, at best, Patent Owner’s complaints go to the weight (not admissibility) of the evidence, Petitioner respectfully submits that Patent Owner’s motion to exclude should be denied.

Respectfully submitted,

Dated: October 9, 2024

/Patrick Colsher/
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Petitioner's Opposition to Patent Owner's Motion to Exclude was served via email on October 9, 2024, upon the following counsel of record for Patent Owner:

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