

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRYCER, LLC, and BRYCER MANAGEMENT, INC.,
Petitioners

v.

TEGRIS, INC.,
Patent Owner.

Case No. IPR2023-01196
Patent No. 11,126,966

Before KAREN I. SWEENEY, *Trial Paralegal*

**PATENT OWNER'S REPLY IN SUPPORT OF THEIR
MOTION TO EXCLUDE EVIDENCE**

I. Summary

Patent Owner's Motion to exclude, inter alia, points out very succinct, yet substantial issues which disqualify Mr. MacInnes' Declaration; namely, his (1) lack of experience with fire-hydrants and related assets, (2) material misrepresentations made under oath, (3) failure to consider secondary indicia of non-obviousness, and (4) admission that there are errors in his declaration which he could/would not identify. Each of these issues highlight the unreliability of Mr. MacInnes' Declaration. Rather than address these very serious issues, Petitioners attempt to divert the attention of this Board with incorrect, unsupported, conclusory statements about Mr. MacInnes's alleged experience, irrelevant allegations about Patent Owner's declarants, and false assertions that the issues raised only pertain to the weight of the evidence not the admissibility. Mr. MacInnes' Declaration is unreliable and as such the Board should strike it.

Petitioners admit that the claims of the patent were limited to fire hydrant technology ("although the '966 Patent claims were ultimately limited to 'fire hydrant management software,' ..." Paper 34, p.1) but then inexplicably allege that Mr. MacInnes general, non-fire hydrant experience qualifies him as an expert in fire hydrants (Id. at II.A.) - it does not. Regarding Mr. MacInnes' alleged fire hydrant experience, Petitioners can only point to Mr. MacInnes' testimony regarding the

experience of other people in his team or third parties as opposed to his personal experience. (Paper 34, p. 7, EX2021, 15:24-21:21, 22:24-23:14). Mr. MacInnes is not a qualified expert.

Petitioners also attempt to gloss over the very serious fact that Mr. MacInnes falsely declared under oath that he read the prosecution history (Doc. 34. at 2), See. *Mitchell v. Holt*, Patent Interference No. 105,746 (Paper No. 352, Decision filed April 27, 2012) (EX2047). Without citation, Petitioners incorrectly assert that “he testified earlier in the deposition regarding the various materials he considered (which encompass the file history) ...”. However, Mr. MacInnes only testified that his list of documents considered was complete, not accurate (EX2021, 29:6-16). When asked specifically if he had read the file history, his answer was unequivocally “No” (*Id.* at 75:16-19), which directly contradicts his sworn declaration.

Petitioners also failed to address additional unreliable aspects of the opinions set forth in the declaration (signed by Richard MacInnes (EX1003) but drafted by counsel). EX2021, p. 42. The record demonstrates that Mr. MacInnes failed to sufficiently consider every opinion set forth in the Declaration. For example, Mr. MacInnes testified at his deposition that counsel for Petitioners drafted everything in EX1003 related to the prior art references and that he made no edits to any of the analysis thereof. EX2021, 42:1-21. Similarly, Mr. MacInnes declared he was not aware of any evidence of objective indicia of non-obviousness, yet during his

deposition he testified that he did not consider those issues. (EX2021, 90:14-97:11. Mr. MacInnes also admitted that the declaration contains other errors but could not identify them. EX2021, p. 11.

Mr. MacInnes' declaration is unreliable in its entirety, as it contains admittedly false statements, Mr. MacInnes failed to ensure that it includes his opinions, as opposed to attorney argument, and it includes unidentified errors, which makes it impossible to determine which if any portions are accurate or reliable.

II. Petitioners Argument that MacInnes Testified Truthfully During His Deposition Does Not Address the Lack of Reliability of his Declaration.

Petitioners make the irrelevant argument that Mr. MacInnes is trustworthy because he testified truthfully in his deposition. Paper 34, p. 9. The relevant fact is he swore to the truthfulness of false statements set forth in his declaration. MacInnes' "truthful" deposition testimony regarding the false statements and unidentified (but admitted) errors in his declaration merely prove the unreliability thereof. Petitioners also assert that MacInnes' sworn statement that he was not aware of any evidence of objective indicia of obviousness "was and remains correct." Paper 34, p. 12. However, Mr. MacInnes statement: "I am not aware of any objective indicia of non-obviousness relevant to the claims of the '966 Patent." EX1003, ¶¶20-21 is not entirely accurate. Mr. MacInnes never investigated those issues. EX2021, pp. 33, 91-93. This additional misleading sworn statement further

undermines the reliability of his declaration. When an expert witness misstates objective facts under oath, his subjective opinions cannot be trusted. EX2047, pp. 21-22.

Petitioners also incorrectly argue that *Mitchell v Holt*, is distinguishable. Paper 34, pp. 11-12. The Board’s reasoning in *Mitchell* for excluding the expert’s declarations is directly applicable here, where Mr. MacInnes made false sworn statements in his declaration, and he lacks knowledge of a POSA. Mr. MacInnes signed his declaration attesting under penalty of perjury that the statements therein are “true and correct,” when they were neither. Not only does it prove his unreliability, but it demonstrates his blind adoption of counsel’s opinions.

III. MacInnes’s Experience is Insufficient to Qualify as an Expert.

Petitioners argue that Mr. MacInnes has knowledge and experience with asset management generally (Paper 34, p. 2). However, his only knowledge and experience regarding inspecting fire hydrants and the applicable regulations and codes is that “his team” used an off-the-shelf product called Maximo (developed by a third party) to perform audits of other companies’ asset management practices. EX2021, pp. 18, 21-24, 70-71. The gaps in his knowledge regarding fire hydrant inspections and his failure to fill them by investigating that subject matter before forming his opinions establish that he lacked a proper foundation to opine on the knowledge of a POSA or teachings in the prior art. Those gaps are central to this

dispute, as Petitioners rely exclusively on his testimony to fill various gaps in the prior art, *e.g.*, [8d] and [8e]. *See e.g.*, Paper 26, pp. 1, 8, 11, 13, 14. Petitioners also failed to address the relevance of Mr. MacInnes' inexperience testifying as an expert in patent and other cases and the fact that portions of his only other declaration were excluded because, as here, he signed a declaration prepared by counsel that he had not sufficiently considered. Paper 34, pp. 12-13, EX2014, p. 4. Mr. MacInnes' opinions should be excluded for lacking sufficient foundation, as he lacks knowledge and experience related to inspecting fire hydrants and the applicable codes and regulations.

IV. CONCLUSION

For the foregoing reasons, Tegris respectfully requests that the Board exclude the MacInnes Declaration EX1003 for failing to meet the threshold standard of reliability for admissibility. Mr. MacInnes (1) made false and misleading statements under oath, (2) failed to consider the prosecution history in his evaluation of the Patent, (3) failed to consider secondary indicia of non-obviousness, (4) lacks the requisite experience of an expert, (5) confirmed, but could not/would not identify additional errors in his declaration, and (5) wholesale adopted the opinions of counsel without sufficiently confirming the accuracy or his agreement with the same.

Date: October 16, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S REPLY IN SUPPORT OF THEIR MOTION TO EXCLUDE EVIDENCE was served on the above referenced date via email on the following attorneys for the Petitioners:

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