

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMEGA LINER COMPANY, INC.,

Petitioner

v.

BUERGOFOL GmbH,

Patent Owner.

CASE NO.: IPR2023-01372
U.S. PATENT NO. 9,657,882

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
EXCLUDE EVIDENCE (EX2004)**

I. INTRODUCTION

Patent Owner respectfully submits its Opposition to Petitioner's Motion to Exclude Evidence (EX2004) ("Motion"). Petitioner failed to meet its burden of demonstrating that Patent Owner's Exhibit is inadmissible. 37 C.F.R. § 42.20. Instead, the Motion seeks impermissibly broad exclusion of Patent Owner's properly submitted evidence that will assist the Board in addressing the patentability of the '882 Patent's claims, and should be denied in its entirety.

The Motion fails on its merits. Petitioner failed to meet its burden of demonstrating that the challenged exhibit is inadmissible under the Federal Rules of Evidence. Petitioner does not, and in fact, cannot make any showing that the challenged evidence should be excluded because EX2004 properly and plainly shows that the experiments were conducted by or under the supervision of Dr. Boutrid, and hence he has personal knowledge thereof. (EX2004 ¶1).

II. Petitioner's Motion To Exclude Evidence (EX2004), Paper 054 Should Be Denied For Improperly Objecting to the Evidence, For Failing to Identify Where Patent Owner Relied Upon That Evidence, and Hearsay is Not a Permissible Objection To Declaration Evidence

First, Paper 054 is improper as based on Petitioner's wholly insufficient objections to Dr. Boutrid's declaration, Exhibit 2004. 37 C.F.R. § 42.64(b)(1) requires: "The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence." Petitioner failed to do so.

Petitioner's objections consist of 4 broad-brush statements alleged to explain the objections to about 45 full paragraphs of EX2004. Nowhere does Petitioner point to any specific statement made in these paragraphs, but rather lumps them into four (4) generalized categories: (i) paras. 6-11; (ii) paras. 9-10; (iii) paras. 12-23, 31-36; and (iv) paras. 24-30, 37-59, in which each paragraph contains multiple statements. Patent Owner should not have to guess which paragraphs, let alone which statements of any of the multiple dozens of paragraphs Petitioner objected to, and consequently, had no opportunity to submit additional evidence in response to Petitioner's objections. Instead, Petitioner waited until the very end of this proceeding to fully apprise Patent Owner of the specific basis for these objections, which is improper.

Second, Paper 054 fails to point out where Patent Owner relied upon any of the evidence Petitioner seeks to exclude, as set forth in *Mutual Insurance Co. v. Progressive Casualty Insurance Co.* (CBM2012-00002), Paper 66 (Jan. 23, 2014).

Third, statements made by a declarant in an IPR proceeding are not hearsay under FRE 801(c), but rather are sworn testimony that is subject to cross-examination, as explained in *Actifio, Inc. v. Delphix Corp.*, IPR2015-00050, Paper 57 (Mar. 31, 2016).

Fourth, Paper 054 adds additional objections to EX2004 that were not identified in its objections to evidence. For example, with respect to

paragraphs 6-11 of EX2004, Petitioner only objected to these paragraphs under FRE 801, 802, 702, 703, and 37 C.F.R. 42.65, but Paper 054 further objects to these paragraphs under FRE 602, and 701, (pp. 2 and 3), which is improper. Similarly, Petitioner only objected to paragraphs 12-23, and 31-36 under FRE 801 and 802, but yet further objects to these paragraphs under FRE 602 in Paper 054, pg. 9. Finally, Petitioner only objected to paragraph 24-30 and 37-59 under FRE 801 and 802, but yet further objects to these paragraphs under FRE 602 in Paper 054, pg. 11.

Finally, Petitioner presents an entirely new-found objection to Dr. Boutrid's testimony on the grounds that English is not Dr. Boutrid's native language, despite having never objected to EX2004 on this basis. (Paper 054, pg. 8-9). Petitioner's objection is not only untimely, but entirely lacks foundation. Petitioner asserts without support that the statements in English are "not understood by the witness." (Paper 054, pg. 8). The mere fact that a witness, where English is his second language, *prefers* to have his deposition taken in his native language does not mean or otherwise infer that he cannot *understand* English. Petitioner has not and cannot show that Dr. Boutrid does not understand or read English. Petitioner is grasping at straws given the relevance and non-existent factual basis for their objection.

For any one of these reasons set forth above, Petitioner's Motion to Exclude EX2004, Paper 054 should be denied.

III. Petitioner's Objections are Directed to the Weight of the Evidence, Not Its Admissibility

The Motion is improper because Petitioner fails to identify any *legitimate* evidentiary objections regarding the *admissibility* of Patent Owner's evidence. Petitioner instead uses the motion as a vehicle to challenge the *weight* of the evidence. 37 C.F.R. § 42.64. "A motion to exclude ... may not be used to challenge the sufficiency of the evidence to prove a particular fact." Consolidated Trial Practice Guide (Nov. 2019), 79.

Petitioner asserts that Exhibit 2004 is "inadmissible" because Dr. Boutrid's declaration "include[s] or rel[ies] on inadmissible hearsay. *See e.g.*, (Mot., 2). However, Petitioner is actually asserting that the Board should discredit this evidence, not that it is inadmissible under the Rules or FRE. Petitioner's assertions regarding Exhibit 2004 go to the weight, not admissibility, of the evidence because Petitioner asserts grounds for exclusion that are plainly discussed in the text of Exhibit 2004. Petitioner asserts that Dr. Boutrid's declaration is not based on personal knowledge, or in the alternative, must be based on hearsay. *See e.g.*, (Mot. 2:18-19, 4:5-8). However, Petitioner glosses over the fact that Dr. Boutrid is a named inventor on the '882 Patent and was personally involved in the German patent cancellation hearings. *See* (EX2004, ¶¶1, 9, 10). As such, Dr. Boutrid clearly has proper personal knowledge of the matters in his declaration, and a personal basis for making the statements in his declaration. Petitioner's deficient Motion makes it clear

that Petitioner does not have a legitimate basis to exclude the contested portions of Exhibit 2004 but is rather making a thinly veiled argument against the weight of Exhibit 2004.

The Board is perfectly capable of assessing the weight of the evidence and the Motion should be denied for this reason alone.

A. Petitioner's Hearsay Arguments Fail

Hearsay is an out-of-court statement offered for its truth. *See* F.R.E. 801. EX2004 is not hearsay because it is the testimony from the declaration of Dr. Boutrid. (EX2004). This Exhibit is therefore trial testimony, and thus is not hearsay because it is not an out of court statement. *See* 37 C.F.R. § 42.53(a); *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2016-00130, Paper 35 at 19 (P.T.A.B. May 8, 2017) (“[W]e do not consider [the] declarations to be hearsay, as they are not out-of-court statements ... direct testimony is typically provided via affidavit, with cross-examination taken via deposition.”), *aff'd*, 730 F. App'x 934 (Fed. Cir. 2018); *see also, Actifio, Inc. v. Delphix Corp.*, IPR2015-00050, Paper 57 (Mar. 31, 2016).

Petitioner's broad assertions that Exhibit 2004 is “riddled with ... hearsay... and testimony lacking personal knowledge” belies Petitioner's lack of legitimate argument for exclusion. (Mot., 1). Petitioner's argument that Dr. Boutrid could not possibly have the knowledge to make the statements in his declaration is weakened by the clear and logical bases for knowledge provided *in the declaration itself*. *See e.g.*, (EX2004 ¶¶ 1, 3, 9, 10).

Moreover, Petitioner had every opportunity to cross-examine Dr. Boutrid on the matter but **chose not to**. Petitioner scheduled, and had an opportunity to cross-examine Dr. Boutrid on his statements and the basis thereof. At this deposition, Petitioner could have cross-examined Dr. Boutrid on his statements in the declaration. However, Petitioner decided to cancel the deposition at the last minute and is attempting to retroactively cure their strategic mistake. Petitioner's failure to object to the statements of and basis of Dr. Boutrid's personal knowledge, and cancellation of Dr. Boutrid's cross-examination, renders their Motion to Exclude fatally deficient.

Finally, courts have routinely permitted inventors to submit testimony regarding the patents they invented as based on their personal knowledge. *Verizon Servs. Corp. v. Cox Fibernet Va., Inc.*, 602 F.3d 1325, 1339-40 (Fed. Cir. 2010) ("[T]he district court properly allowed testimony from the witnesses about the patents they invented based on their personal knowledge..."); *Supernus Pharm., Inc. v. TWi Pharm., Inc.*, No. 15-369 (RMB/JS), 2017 WL 4182809, at *20 n.12 (D.N.J. Sept. 21, 2017) ("[The inventor] properly testified as to matters which, while technical and specialized, are squarely within his particularized firsthand knowledge and experience as a pharmaceutical scientist employed by [the party] and as an inventor on the Patents-in-Suit."); *Braun Corp. v. Maxon Lift Corp.*, 282 F. Supp. 2d 931, 934 (N.D. Ind. 2003) (admitting inventor opinion testimony about the structure and function of the patented wheelchair lift because it was

based on his personal perception), *aff'd*, 97 F. App'x 335 (Fed. Cir. 2004).

Dr. Boutrid's testimony falls squarely in line with this precedent. As a named co-inventor of the '882 patent, Dr. Boutrid has unique basis of personal knowledge of the matters in his declaration. The statements within Dr.

Boutrid's testimony are based upon his firsthand knowledge and experience as an employee of Patent Owner and as a co-inventor. Petitioner's assertions that Dr. Boutrid is "[o]viously... relying on information from others" completely disregards *how* and *why* Dr. Boutrid has personal knowledge of his statements.

(Paper 054, pg. 3). Petitioner's improper attempts to discredit Dr. Boutrid's personal knowledge and his declaration as hearsay should be disregarded and denied.

In view of the foregoing, Patent Owner respectfully requests that the Board deny the Petitioner's Motion to Exclude Evidence (EX2004) in its entirety.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE EVIDENCE (EX2004), was served by filing this document on the date indicated below through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via e-mail to the following attorneys of record for the Patent Owner listed below:

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