

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AROMA360, LLC,
PETITIONER,

v.

AIR ESSSENTIALS, INC.
PATENT OWNER.

Case IPR2025-00707
Patent 10,092,918

PETITIONER’S OPPOSITION TO MOTION TO EXCLUDE

I. INTRODUCTION

Patent Owner seeks to exclude three portions of the deposition testimony of its own expert, Dr. Gerald Micklow, and Petitioner's corresponding reliance on that testimony in its Reply. PO Mot. to Exclude at 1–3. Patent Owner could have sought to have Dr. Micklow himself address this testimony during re-direct at his deposition, but instead Patent Owner has chosen to use attorney argument via this motion to try to explain Dr. Micklow's damaging answers. The fact that Patent Owner seeks to exclude its own expert's testimony rather than trying to address this testimony on the merits merely illustrates the damning nature of this testimony.

For instance, Dr. Micklow testified that he applied his own understanding of the claims instead of the constructions proposed by the parties. In view of this, Petitioner has rightly asserted that the Board should give Dr. Micklow's testimony little to no weight since he did not consider the claims under the same interpretation as the parties. *See* Petition Reply. As another example, Dr. Micklow acknowledged that his opinion was not based on Figure 6 of the '918 Patent even though Figure 6 is the only support for certain disputed limitations addressed by Dr. Micklow's declaration.

Patent Owner's arguments that this testimony should be excluded for being outside the scope of direct are facially flawed. Fundamentally, in several instances, Patent Owner failed to make the necessary "scope" objections during the deposition. Even where the objection was made, the objected-to testimony concerns the very issues which Dr. Micklow opined on in his declaration, namely his opinions that the

prior art references did not teach certain claim limitations. Certainly, Dr. Micklow's understanding of the specification and claim limitations of the '918 Patent at dispute are within the scope of cross-examination.

However, Patent Owner takes the untenable view that an expert should be insulated from cross-examination on issues that undercut their opinion if an expert did not pre-emptively address those issues in their declaration. Notably, Patent Owner does not cite to a single case in its motion that supports that novel proposition. Rather, the long-standing purpose of cross-examination is for the opposing party to explore "the facts and assumption underlying the testimony of an expert witness." *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1575–76 (Fed. Cir. 1991) (quoting *Smith v. Ford Motor Co.*, 626 F.2d 784, 793 (10th Cir. 1980), cert. denied, 450 U.S. 918, 101 S. Ct. 1363, 67 L. Ed. 2d 344 (1981)). That is precisely what happened here and Patent Owner's displeasure with its expert's answers during cross-examination is not a basis to exclude his testimony.

As such, the Board should deny Patent Owner's Motion to Exclude portions of Dr. Micklow's deposition transcript and Petitioner's Reply citing those portions of the transcript.

II. CHALLENGED TESTIMONY IS NOT COMMENSURATE WITH PATENT OWNER'S OBJECTIONS

Patent Owner's motion to exclude Exhibit 1046 at 115:15-18 is premised on a theory that the question exceeded the scope of direct. PO Mot. to Exclude at 6

(alleging “Dr. Micklow’s assignment...[was] not to provide a freestanding legal claim-construction analysis”). However, Patent Owner’s motion acknowledges it only objected to “form” for this testimony. An objection to “form” is materially different than an objection to “scope” and the former does not preserve the latter.

Second, Patent Owner improperly includes questions/answers that were not objected to based on their proximity to a question/answer that was objected to.

The only two portions of challenged testimony with a proper objection to support Patent Owner’s motion are found at 200:14-16 and 158:2-159:2 of Dr. Micklow’s deposition. *See* Ex. 1046; PO Mot. to Exclude at 3. All of the other portions of challenged testimony do not have a proper underlying objection and thus cannot be excluded by Patent Owner’s motion.

A. Objections to “form” are not objections to “scope”

Patent Owner acknowledges that it objected to “form” with regards to the challenged testimony at 115:15-18. PO Mot. to Exclude at 3. Patent Owner attempts to argue that its “form” objection should be treated as a “scope” objection in light of a statement by Petitioner’s counsel that “the proper objections are just for form.” PO Mot. to Exclude at 4 (citing Ex. 1046 at 85:1-4). Patent Owner contends that at this point its counsel “ceased using the phrasing ‘Objection, scope’” during the deposition. *Id.* However, the record of the deposition reflects a very different reality.

In fact, Patent Owner’s counsel, Mr. Eagan, objected to “scope” fifty-six times after this point in the deposition when it alleges it “ceased” doing so. *See, e.g.*, Ex.

1046 at 85:25, 104:22, 137:1, 138:24, 140:3, 141:7, 142:22, 152:22, 153:10, 154:10 (showing ten of the fifty-six instances of objecting to “scope”). Perhaps more important is that many of Patent Owner’s counsel’s later objections to scope included an objection to form, while others did not, confirming that Patent Owner’s counsel viewed objections to “form” and “scope” as separate bases for objections. *Compare* Ex. 1046 at 138:24 (“MR. EAGAN: Objection. Scope. Form.”) *with* 140:3 (“MR. EAGAN: Objection. Scope.”), 147:10 (“MR. EAGAN: Objection. Form.”). The record is replete with similar examples demonstrating that Patent Owner’s counsel was aware of the difference between an objection to scope and an objection to form even after the exchange with Petitioner’s counsel. Thus, the transcript confirms that Patent Owner’s counsel did not use “form” as a substitute for “scope” since counsel continued to make form-only objections, scope-only objections, and combined “form and scope” objections.

B. Patent Owner includes testimony that was not objected to at all

Patent Owner’s table includes questions and answers that were not objected to at all. PO Mot. to Exclude at 3. In particular, Patent Owner challenges testimony at 157:20-158:12 for which no objections was made at the deposition. Since no objection was raised to this testimony during the deposition, it is waived. 37 CFR § 42.53(f)(8)(“Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition”).

At most, Patent Owner objected to the testimony at 158:13-159:2, but Patent Owner cannot obtain exclusion of unobjected to testimony by grouping it with neighboring questions that were objected to.

III. ALL CHALLENGED TESTIMONY IS RELEVANT, CLEAR AND WITHIN THE SCOPE OF DR. MICKLOW'S DECLARATION

Cross-examination extends to the subject matter of direct testimony and matters affecting credibility. 37 C.F.R. § 42.53(d)(5)(ii); FRE 611(b). Patent Owner argues that Petitioner crossed that line by asking about his understanding of the specification and meaning of disputed claim limitations of the '918 Patent. PO Mot. to Exclude at 5–12. Yet, these are all topics specifically related to the question of patentability raised by Dr. Micklow's declaration.

Dr. Micklow's declarations set out his understandings including "that certain issues in an IPR, such as claim construction and whether a claim is invalid as obvious, are assessed from the view of a [POSITA]." Ex. 2002 at ¶14. Dr. Micklow's testimony then relies on his understanding of how a POSITA would view the operation of the '918 Patent to try to distinguish the prior art. *See, e.g., Id.* at ¶19 (opining that if prior art teaches "a non-uniform spray. It will not meet the limitation of 'fluid dispersion.'"), ¶21 (opining that prior art does not teach "an operative fluid designed for mechanical dispersion through gas-flow interaction as required by the '918 Patent.") and ¶24 (opining that prior art teachings are "materially different from the fluid-flow-based atomization described and claimed in the '918 Patent."). In view of these statements,

Petitioner questioned Dr. Micklow on how he understood the operation and the fluid flow to be described and claimed in the '918 Patent so that Petitioner could understand the basis for Dr. Micklow's opinion.

Patent Owner also nominally cites to FRE 401-403 and FRE 702-703, but never attempts to explain why these rules require exclusion. FRE 401-403 have little to no applicability in IPR proceedings and Patent Owner failed to explain why any alleged prejudice outweighs the probative value of the testimony. Patent Owner's citation to FRE 702-703 is even more perplexing because it apparently asserts Dr. Micklow is not qualified to testify on these issues, which, if true, would only reinforce that his declaration should be given no weight.

A discussion of each of the portions of testimony Patent Owner challenged is provided below demonstrating that all of the questions asked were relevant, clear and within the scope of cross-examination.

A. Patent Owner Fails to Explain How FRE 401-403 or FRE 702-703 are Applicable to the Underlying Facts

Patent Owner cites to FRE 401-403 yet never once explains why these rules are applicable. See PO Mot. to Exclude at 5, 7, 9 and 12. For example, Patent Owner never explains why the challenged testimony is not relevant under FRE 401/402 or results in unfair prejudice that is "substantially outweighed" by the probative value of the testimony under FRE 403. See *Captioncall LLC v. Ultratec, Inc.*, IPR2014-00780, Paper No. 35 at 8 (PTAB Dec. 1, 2015) (denying motion to exclude where "Patent

Owner fails to address the ‘substantially outweighed’ aspect of the Rule [FRE 403]”).

Here the challenged testimony is not unfairly prejudicial since Patent Owner had an opportunity at the deposition to re-direct Dr. Micklow to address his testimony but chose not to. Moreover, the risk of “unfair prejudice” is either eliminated or diminished in IPR trials since the fact finder is the Board and not a jury. *Neste Oil Oyj v. Reg Synthetic Fuels, LLC*, IPR2013-00578, Paper No. 53 at 10 (PTAB Mar. 12, 2015) (“Proceedings before the Board are not jury trials; in the absence of a jury, the risk of unfair prejudice against which Rule 403 guards is diminished, if not eliminated entirely.”); *Trend Micro Inc. v. Cupp Computing AS*, IPR2019-00764, Paper No. 32 at 5 (PTAB Aug. 25, 2020). In addition, the challenged testimony is highly relevant and probative to the ultimate issues of patentability as it demonstrates the underlying errors in Dr. Micklow’s testimony regarding his analysis of whether the prior art teaches the claim limitations.

Similarly, Patent Owner cites to FRE 702 and 703 but fails to address how they apply. See PO Mot. to Exclude at 5 and 12. Ironically, Patent Owner is asking for its own expert’s opinion to be excluded on the basis of FRE 702 and 703, which is a tacit admission that Dr. Micklow’s direct testimony is unreliable and should be given little weight. If Dr. Micklow cannot provide reliable answer in cross-examination testimony on the subject matter of whether the prior art teaches certain claim limitations, then his direct testimony on these issues is likewise unreliable. Patent Owner’s theory, if upheld, would shield an expert from having to defend their opinions, which is an

untenable result and Patent Owner provides no basis for the Board to adopt this approach.

B. Ex. 1046 at 115:15–18 — Dr. Micklow’s Failure to Apply the Parties’ Claim Constructions

Patent Owner frames this issue as eliciting testimony outside the scope of Dr. Miclow’s “assignment” for his declaration. PO Mot. to Exclude at 6. However, considering the parties’ claim constructions (and the Board’s or Court’s constructions, if available) is a fundamental part of an expert’s analysis to credibly opine on whether the prior art fails to teach the limitations of a claim. Dr. Micklow’s failure to use the constructions set out by the parties goes directly to the credibility and weight of the statements in his declaration that the prior art fails to teach certain limitations.

Indeed, the Federal Circuit has made clear that expert testimony which does not apply the correct claim construction should not be considered. *See, e.g., Trudell Med. Int’l Inc. v. D R Burton Healthcare, LLC*, 127 F.4th 1340, 1349-50 (Fed. Cir. 2025) (quoting FRE 702 and finding that the district court abused its discretion in allowing an expert to offer testimony “untethered from the district court’s claim constructions,” which resulted in a “methodological[ly] unsound[ly]” opinion); *Liquid Dynamics Corp. v. Vaughn Co., Inc.*, 449 F.3d 1209, 1224 n.2 (Fed. Cir. 2006) (affirming the striking of “expert opinion evidence as irrelevant because it was based on an impermissible claim construction”).

Perhaps most telling is that Dr. Micklow testified that “claim construction is

important” and even acknowledged that the parties had “agreed to constructions of certain terms” yet Dr. Micklow did not actually consider those constructions despite acknowledging their importance. *Id.* at 110:21-111:25 and 114:20-115:9. Dr. Micklow’s failure to consider the parties’ claim constructions is not excused by him “interpret[ing] the claims as would be normally interpreted by an engineer.” *Id.* at 116:2-4. If anything, this statement highlights the problem because Dr. Micklow’s declaration relies on an interpretation of claim scope that is materially different than the parties’ constructions.

As uncovered in the deposition, Dr. Micklow’s opinions are not based on the same understanding of the claim scope that the parties have agreed to or asserted, and thus his opinions are entitled to little or no weight as Petitioner argued in its Reply.

The challenged testimony is within the scope of the direct testimony since it goes to the credibility of Dr. Micklow’s direct testimony and to understanding the claim scope that Dr. Micklow used in opining that the prior art does not teach certain limitations.

C. Ex. 1046 at 200:14–16 — Dr. Micklow’s Admission That Figure 6 Was Not a Basis for His Opinions

Patent Owner does not allege this testimony was improper, but rather uses this section to try to rebut Petitioner’s explanation of the testimony in Petitioner’s reply. PO Mot. to Exclude at 7-9. As such, the Board should dismiss this request as improper additional briefing.

Nonetheless, Patent Owner's belated argument that Dr. Micklow "may" have reviewed Figure 6 does not address the underlying problem that Dr. Micklow did not base his analysis on Figure 6 (which Patent Owner acknowledges Dr. Micklow admitted). *Id.* As explained in Petitioner's Reply, all the arguments in Patent Owner's Response attempting to distinguish prior art based on Figure 6 of the '918 Patent are unsupported attorney argument. Petitioner Reply at 2 ("Patent Owner's arguments regarding Figure 6 in the Response are nothing more than attorney argument."). Patent Owner's acknowledgement that Dr. Micklow did not base his opinions on Figure 6 confirms that there is no expert testimony supporting Patent Owner's attorney arguments for Figure 6.

Moreover, Dr. Micklow's declaration is premised on distinguishing the prior art from the "the fluid-flow-based atomization described and claimed in the '918 Patent." Ex. 2002 at ¶24. Yet, the claims of the '918 Patent are all based on Figure 6, as explained in the Petition and found by the Board. Petition at 10-13 ("Figure 6 of the '918 patent depicts a new embodiment not disclosed in any of the earlier filings...the challenged claims all rely on new matter [Figure 6] for support"); Inst. Dec. at 26-32 (finding claims of '918 Patent only have priority to the date when Figure 6 and related written description added to application). Thus, Dr. Mickow's opinions regarding the fluid flow "described and claimed in the '918 Patent" should have been based on the fluid flow described in Figure 6, yet Dr. Micklow admitted that it was not.

In addition, the Figure 6 question did not ask Dr. Micklow to formulate a new

technical opinion but rather inquired into the basis for the opinions he provided in his declaration. Determining which embodiment(s) of the '918 Patent actually informed those opinions is classic cross-examination concerning foundation and credibility. In this case, the cross-examination confirms that Dr. Micklow's analysis was materially flawed since he did not use as a basis for his opinion the only embodiment that relates to what was actually claimed in the '918 Patent.

D. Ex. 1046 at 157:20–159:2 — Dr. Micklow's Admission That Droplet Uniformity Develops Downstream of the Mixing Chamber

Patent Owner argues that Petitioner's questions for this testimony lacked context and were compound questions. PO Mot. to Exclude at 9-12. Even assuming that were the case, Patent Owner could have sought clarification of Dr. Micklow's answers during re-direct, yet it did not do so. Instead, Patent Owner now seeks exclusion by speculating as to Dr. Micklow's internal thought process despite the lack of any indication of confusion in Dr. Micklow's actual answers.

As explained above, Dr. Micklow's testimony was premised on distinguishing the prior art from the "fluid dispersion" and "fluid-flow-based atomization described and claimed in the '918 Patent." *See, e.g., Id.* at ¶19 (opining that if prior art teaches "a non-uniform spray. It will not meet the limitation of 'fluid dispersion.'"), ¶21 (opining that prior art does not teach "an operative fluid designed for mechanical dispersion through gas-flow interaction as required by the '918 Patent.") and ¶24 (opining that prior art teachings are "materially different from the fluid-flow-based

atomization described and claimed in the '918 Patent.”). In view of such, Petitioner is entitled to ask Dr. Micklow to explain his understanding of the “uniform spray...fluid dispersion” and “fluid-flow-based atomization described and claimed in the '918 Patent,” including whether droplets in the fluid flow become more uniform after exiting the mixing chamber.

The challenged exchange was also the natural continuation of earlier testimony that was not objected to by Patent Owner’s counsel. Dr. Micklow had testified that the diffusion chamber claimed in the '918 Patent was a chamber where the flow is decelerated while attempting to obtain a fine, uniform spray distribution. Ex. 1046, 117:20–24. He later testified that fluid dispersion “has to happen in the mixing chamber” and described the result as a uniform distribution. *Id.* at 145:11–19. Given that Dr. Micklow identified both the mixing chamber and the diffusion chamber as areas trying to achieve uniform distribution, Petitioner then asked questions trying to understand the structures the '918 Patent utilizes to produce uniform distribution according to Dr. Micklow. In so doing, Petitioner’s counsel asked whether the dispersion could become more uniform as it flowed through the assembly, and Dr. Micklow proceeded to identify the mixing chamber, the downstream flow path, and the diffusion chamber. *Id.* at 152:18–159:2.

Patent Owner’s assertions that the final question was compound or embedded disputed assumptions are baseless. Patent Owner does not point to any question in the exchange that asked for multiple answers. Instead, Patent Owner appears to complain

that because there was a line of follow-up questions seeking additional information this is somehow a compound question. Yet, Patent Owner provides no case law that follow-up questions seeking additional information are equivalent to compound questions.

Likewise, Patent Owner fails to demonstrate what assumptions were disputed. The exchange did not even involve a hypothetical scenario that would require certain assumptions but was rather discussing the embodiment shown in Figure 2 and referenced structures by their specific numerals. *See* Ex. 1046 at 157:8-12 (question directs Dr. Micklow to mixing chamber “232” of “Figure 2”). As another example, Patent Owner contends that Petitioner confused Dr. Micklow by referring to the “diffusion assembly” but Dr. Micklow himself used the phrase “diffusion chamber” (which is part of the diffusion assembly) in his answer making it clear that Dr. Micklow was not confused. Indeed, Dr. Micklow was free to reject any premise, qualify his answer, or explain a different flow path. He instead answered that making the droplets more uniform is “what you attempt to do in the diffusion chamber.” Ex. 1046, 158:20–159:2. There is nothing to indicate that Dr. Micklow was confused by the questions or somehow tricked into believing the ’918 Patent said something it did not.

IV. PATENT OWNER’S MOTION TO EXCLUDE EVIDENCE INCLUDES IMPROPER ADDITIONAL BRIEFING

Patent Owner’s rebuttal to “Petitioner’s broader proposition” set out in

Petitioner's Reply, is improper additional briefing that should not be considered. PO Mot. to Exclude at 11-12. Here, Patent Owner includes over a page of attorney argument designed to substantively rebut Petitioner's merits position on this damaging portion of Dr. Micklow's testimony. Patent Owner's Motion to Exclude Evidence is not the proper vehicle for this briefing, and these arguments should not be considered.

V. CONCLUSION

Patent Owner's Motion to Exclude should be denied in its entirety.

Date: July 16, 2026

Respectfully submitted,

/James P. Murphy/

James P. Murphy

Reg. No. 55,474

Polsinelli, PC

1000 Louisiana Street

Suite 6400

Houston, Texas 77002

Tele: (713) 374-1631

William A. Di Bianca

Reg. No. 58,653

Jordan T. Riviello

Reg. No. 72,515

Polsinelli PC

600 Third Avenue

42nd Floor

New York, NY 10016

Joshua L. Rayes

Reg. No. 74,645

Polsinelli LLP

Three Embarcadero Center

Suite 2400

San Francisco, CA 94115

CERTIFICATE OF SERVICE UNDER 37 CFR § 42.6(e)(4)

The undersigned hereby certifies that a copy of the accompanying Petitioner's Opposition to the Motion to Exclude is being served on July 16, 2026, via electronic mail directed to the following counsel of record for the Patent Owner:

Peter A. Matos
pmatots@malloylaw.com

W. John Eagan
johnegan@malloylaw.com

Victor Bruzos
vbruzos@malloylaw.com

Rafay Asrar
rasrar@malloylaw.com

Tyler Litwak
tlitwak@malloylaw.com
litigation@malloylaw.com

/Ericka McNeil/

Ericka McNeil

Polsinelli PC
1000 Louisiana Street
Suite 6400
Houston, Texas 77002