IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

In re U.S. Patent No. 6,240,376		Trial No.:	IPR 2012-00042
Application No.:	09/127,587		
Filed:	July 31, 1998		
Issued:	May 29, 2001		
		Atty. Dkt. No.	007121.00004
Inventors:	Alain Raynaud Luc M. Burgun		
Patent Owner:	Mentor Graphics Corporation		
For:	METHOD AND APPARATUS FOR GATE-LEVEL SIMULATION OF SYNTHESIZED REGISTER TRANSFER LEVEL DESIGNS WITH SOURCE-LEVEL DEBUGGING		

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY IN SUPPORT OF PATENT OWNER'S MOTION TO EXCLUDE DECLARATION TESTIMONY OF DR. BRAD HUTCHINGS UNDER 37 C.F.R. §42.64(c)

Patent Owner properly preserved its right to move to exclude the declaration testimony of Dr. Hutchings, by timely objecting to the testimony once the deficiency in the basis of Dr. Hutchings' opinions was revealed in cross-examination. The bases for the objection were not evident from the declaration itself. Petitioner's attempts to justify Dr. Hutchings' reliance on the contingency of a Board ruling of anticipation, in place of considering and forming an opinion regarding the scope and meaning of the contingent amended claims in their entirety, fail to establish admissibility of the testimony under Fed. R. Evid. 702.

I. Patent Owner's Objection was Timely

Petitioner urges that the basis for Patent Owner's objection was evident from Dr. Hutchings' declaration itself, and thus that Patent Owner's objection was untimely. Petitioner's Opposition (Paper No. 48) at 3. This is incorrect. There is no indication in Dr. Hutchings' declaration that he had failed to consider the amended claims in their entirety. To the contrary, Dr. Hutchings' declaration indicates that he had reviewed the `376 patent and Patent Owner's Substitute Motion To Amend (*see* Hutchings Decl. (Ex. 1013) at ¶ 9), and that his opinions were based on that review. *Id.* at ¶ 11. Further, Dr. Hutchings acknowledged in his declaration that "claim terms are to be construed in light of the *surrounding claim language* . . . ." *Id.* at ¶ 14 (emphasis added). *Nowhere* does Dr. Hutchings' declaration indicate what cross-examination revealed to be the case. Dr. Hutchings

did not consider or form an opinion about the unamended portions of the proposed substitute claims. Instead, he relied on the contingency of the Board finding the original claims anticipated by Gregory as a reason not to consider these portions.

As set forth in detail in Patent Owner's Motion to Exclude (Paper No. 42), the limited nature of Dr. Hutchings' review and consideration of the amended claims was revealed in his cross-examination. *Id.* at 5-8. Thus, it was not until completion of cross-examination of Dr. Hutchings that Patent Owner had a basis for raising its objection. Patent Owner made its objection within five business days following the deposition where the bases for the objection arose, and thus Patent Owner should be considered to have timely objected within the spirit of Rule 42.64(b)(1).

II. Dr. Hutchings' Opinions, Based Only On Amended Portions of the Claims, Are Incompetent and Inadmissable under Fed. R. Evid. 702

Petitioner relies on the law of the case doctrine in its attempt to justify the incomplete bases for its expert's opinions. But this doctrine has no application to the current scenario.[1] *First*, there is no law of the case in this IPR regarding

[1] The case principally relied upon by petitioner, *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340 (Fed. Cir. 2012), provides no support for Petitioner's position. The Court there merely held that it was error to permit a "jury to engage in fact finding regarding whether [two prior

unpatentability of the patent claims at issue. *Secondly*, Dr. Hutchings is Petitioner's proffered expert offering an evidentiary opinion, not a party or fact finder (e.g., jury). Regardless of any law of the case, Dr. Hutchings' opinions must be well founded in order to be admissible under Fed. R. Evid. 702. They are not.

Dr. Hutchings apparently agrees, *a priori*, with a decision the Board has yet to make. With respect to elements of the original patent claims that are also present in the amended claims, he relies solely on the contingency of the Board finding the patent claims in the trial to be anticipated by Gregory. Blindly presuming how the Board might ultimately rule, Dr. Hutchings fails to fulfill his obligation as a testifying expert to consider all the facts necessary to provide a well-founded opinion.

---

art references] disclose all of the claim elements," given a prior decision that had concluded that the two references presented a *prima facie* case of obviousness. *Id.*at 1348. What Petitioner failed to mention is the Court's further holding that "it was not error to allow the jury to consider the strength of that *prima facie* case in making the ultimate determination of obviousness. When the ultimate question of obviousness is put to the jury, the jury must be able to review all of the evidence of obviousness." *Id.* at 1349. Petitioner's other case citations, none of which deal with a scenario comparable to the instant one, are similarly inapposite.

Contrary to the premise of Petitioner's argument, a Board decision that the original claims are anticipated by Gregory would not eliminate the need for a consideration of the amended claims in their entirety. The amended portions of the claims must be considered in the context of the claims as a whole.[2] They are not independent modules that can be lifted from the claims and considered in isolation.

For example, one cannot competently opine on whether Gregory discloses alone, or renders obvious in view of the alleged knowledge of one skilled in the art, the *amended* claim 34 portion without considering and forming an opinion regarding the meaning and scope of the *original* claim 34 portions. The amended portion of claim 34 reads, "generating instrumentation logic to provide the instrumentation signal, the instrumentation logic comprising instrumentation logic circuitry that is additional to circuitry specified in the source code." This amended portion is further defined by the original claim 34 recitation of "the instrumentation signal being indicative of an execution status of the at least one statement [within the RTL synthesized source code]." When asked whether it is possible "to create a signal indicating execution status without additional logic gates" (emphasis added) Dr. Hutchings could not answer the question because he had formed no opinion

---

[2] Dr. Hutchings acknowledged this requirement (*see* Hutchings Decl. (Ex. 1013) at ¶ 14), but admittedly failed to fulfill it.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.