

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RAYMARINE, INC.

Petitioner

v.

NAVICO HOLDING AS

Patent Owner

Case IPR2013-00355

Patent 8,305,840

Before SALLY C. MEDLEY, *Administrative Patent Judge*.

**PATENT OWNER'S OBJECTION TO EVIDENCE UNDER 37 C.F.R. §
42.64(B)(1)**

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner serves and submits the following objections to evidence submitted by Petitioner with its Petition for *inter partes* review. These objections are timely presented as they are served and submitted within ten business days of the decision to institute *inter partes* review. *See id.* Patent Owner reserves the right to file a motion to exclude the evidence identified herein as improper and any supplemental evidence that Petitioner may offer in an attempt to correct the noted improprieties. *See id.* § 42.64(b)(1)-(b)(2); *see also* IPR2013-00020, Paper 17 (“When a party objects to evidence that was submitted during a preliminary proceeding, such an objection must be served within ten business days of the institution of trial . . . If, upon receiving the supplemental evidence, the opposing party is still of the opinion that the evidence is inadmissible, the opposing party may file a motion to exclude such evidence.”).

I. RAY-1009-Martin Klein Declaration

Patent Owner objects to Petitioner’s use of Mr. Martin Klein as an expert witness and the Martin Klein Declaration (RAY-1009) in its entirety.¹

¹ On December 24, 2013, Patent Owner filed a motion to disqualify Martin Klein from serving as an expert witness for certain Raymarine entities—including Petitioner here—in co-pending action styled *Navico, Inc., et al. v. Raymarine, Inc.*,

Mr. Klein served as an expert witness and consultant on behalf of Patent Owner in a recent patent infringement litigation involving sonar imaging technology related to the '840 patent at issue in this proceeding. The application that led to the '840 patent was the subject of discovery in the prior litigation, including depositions of the named inventors. As part of his prior work on behalf of Patent Owner—over an 18-month engagement pursuant to a consulting agreement—Mr. Klein was privy to and a participant in substantial confidential, work product, and attorney-client privileged conversations and other information with the same law firm representing Patent Owner here. Mr. Klein also had private discussions with two of the inventors of the '840 patent with respect to conception, reduction to practice, and other legal issues such as validity; accessed highly confidential technical information of Patent Owner; opined on behalf of Patent Owner on issues of claim construction, validity, and infringement in four expert reports comprising over 500 pages of opinions; and was deposed on two occasions relating to infringement, validity, inequitable conduct, and technical matters pertinent to damages. Importantly, Mr. Klein participated in numerous protected conversations regarding Patent Owner's litigation strategies and intellectual

et al., Inv. No. 337-TA-2981 (International Trade Commission), on December 24, 2013.

property and business practices related to the subject matter of the '840 patent. Consequently, Mr. Klein unquestionably had a confidential relationship with Patent Owner and received confidential and legally protected information that is relevant to the current proceeding. *See, e.g., Certain Mobile Electronic Devices Incorporating Haptics*, Inv. No. 337-TA-834, Order No. 15 (Sept. 20, 2012) (disqualification of an expert based on a prior relationship is appropriate “if (1) the adversary had a confidential relationship with the expert and (2) the adversary disclosed confidential information to the expert that is relevant to the current litigation.”).

As a result of his prior confidential relationship, Mr. Klein had knowledge of and access to the aforementioned information in drafting his Declaration—information that he would never have had access to in this proceeding or in any of the co-pending actions. Mr. Klein’s knowing or unknowing use of this information in preparing his Declaration is improper, harms Patent Owner, gives Petitioner an unfair advantage, and undermines the integrity of the *inter partes* review process. Mr. Klein therefore must be disqualified and his Declaration must be excluded.

II. RAY-1010-Paul Stokes Declaration

Patent Owner objects to Petitioner’s use of Paul Stokes as an expert witness and the Paul Stokes Declaration (RAY-1010) in its entirety.

The Paul Stokes Declaration is substantially similar, and seemingly identical and duplicative in substance, to the Martin Klein Declaration. The Board has noted the peculiar similarity between the two declarations. *See* IPR2013-00355, Institution Decision (Paper No. 13), page 15 (“These declarations appear to be identical in substance”). The confidential, work product, and attorney-client privileged information that taints the Klein Declaration equally infects and taints the substantially identical Stokes Declaration. Thus, even if the Klein Declaration is excluded, the same improper information would still be present in this proceeding via the substantially identical Stokes Declaration and/or Paul Stokes himself, unless Mr. Stokes and his Declaration are likewise excluded.

Exclusion of the Stokes Declaration, and disqualification of Mr. Stokes, is a necessary remedy to ensure that information obtained by way of Mr. Klein’s confidential relationship with Patent Owner is not used in this proceeding to irreparably harm and disadvantage Patent Owner.

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