

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CYANOTECH CORPORATION

Petitioner

v.

THE BOARD OF TRUSTEES OF THE UNIVERSITY OF ILLINOIS

Patent Owner

Case IPR2013-00401^[1]

Patent 5,527,533

Before SCOTT E. KAMHOLZ, SHERIDAN K. SNEDDEN, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(b)**

Submitted: July 23, 2014

^[1] Consolidated with Case IPR2013-00404

In Paper 59, the Patent Trial and Appeal Board (“Board”) authorized Cyanotech Corporation (“Petitioner”) to file this Motion to submit supplemental information under 37 C.F.R. § 42.123(b) comprised of paragraphs 177 to 179 of the “Expert Infringement Report of Shalesh Kaushal M.D., Ph.D.” (Ex. 1082 hereto), submitted by Patent Owner (“PO”) in related district court litigation (“litigation”, Civ. No. 5:12-cv-366-oc-10PRL, M.D.Fla.). Dr. Kaushal’s testimony in Ex. 1082 directly conflicts with his Declaration (Ex. 2015) submitted by PO in this IPR.

Petitioner is entitled to the relief requested to impeach the credibility of Dr. Kaushal on a central point of dispute and to address the questionable merits of PO’s position. See, *Behler v. Hanlon*, 199 F.R.D. 533, 556-58 (D. Md. 2001) (“Impeachment by contradiction or specific error is a well-recognized technique used to bring specific errors in testimony to the attention of the trier of fact...” including by “confronting the witness with his or her own contradictory prior statement...”¹

FED.R.EVID. 806 (made applicable herein by 37 C.F.R. §42.62) provides that when a statement authorized by an opposing party has been admitted in evidence (e.g. under FED.R.EVID. 801(d)(2)(c)), the declarant’s credibility may be attacked

¹ The *Behler* court further noted that “The importance of credibility of witnesses to the trial of cases cannot be overstated, and this is especially true with respect to expert witnesses.” *Id.*, at 558.

by any evidence that would be admissible for those purposes if the declarant had testified as a witness “regardless of when it occurred.”²

Here, Dr. Kaushal’s testimony goes to the heart of PO’s attack on the prior art relied on by Petitioner. In PO’s Response (Paper 32, at 24), PO asserts that “Free radical damage (or the prevention of such damage) is not involved, let alone necessarily and inherently involved, in Vitamin A deficiency or xerophthalmia,” citing Dr. Kaushal’s Declaration, Ex. 2015, ¶28:

As I do not believe that free radical attack plays a role in xerophthalmia or vitamin A deficiency, it is my opinion that retinal damage or disease caused by free radical attack is not inherent to xerophthalmia or vitamin A deficiency.

But in Ex. 1082, ¶179, Dr. Kaushal states in his Expert’s Report in the litigation:

The vast majority of retinal conditions are in some way related to the effects of free-radicals or toxic oxygen species, thus general references to eye health would be likely to induce infringement of the Tso patent.

Thus, in an effort to narrow the patent claims to avoid invalidation in the IPR, Dr. Kaushal’s Declaration argues that free radicals are not involved in vitamin A deficiency (“VAD”) and therefore free radicals are not involved in retinal degeneration (e.g., nyctalopia (night blindness disease)) induced by chronic VAD.

² See also FED.R.EVID. 104(e), 611(b) and the “ ‘relevance’ based approach to impeachment of credibility under Rules 401, 402, and 403 discussed in *Buckley Towers Condominium, Inc. v. QBE Ins. Corp.*, No. 07-22988, 2008 WL 5505415 at *2 (S.D. Fla. Oct. 21, 2008). “Under this approach, the inquiry is whether there is any logical tendency of a given evidence to make a witness’ trial testimony less credible than it would be absent its introduction.” *Id.*, at *2.

In contrast, in an effort to broaden the scope of the claims in the litigation to maximize potential incidents of infringement, Dr. Kaushal takes the opposite view, stating that the “vast majority of retinal conditions” (which would certainly include retinal degeneration caused by VAD) are “in some way related to the effects of free-radicals” such that even “general references to eye health” would fall within the scope of the patent. See Ex. 1082, ¶179.

Dr. Kaushal's contradictory statements regarding the role of free-radicals seriously undermine his credibility and PO's position in this IPR. Fairness and the interests of justice dictate that this new supplemental information be admitted and considered by the Board.

Petitioner could not previously submit this Motion because Ex. 1082 was not served on Petitioner until July 9, 2014, and therefore the supplemental information could not have been obtained earlier.

Respectfully submitted,

Date: July 23, 2014

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CERTIFICATE OF SERVICE

I hereby certify service of the foregoing Petitioner's Motion to Submit Supplemental Information, Exhibit 1082 and Petitioner's Updated Exhibit List to the following counsel for patent owner on July 23, 2014 via email (pursuant to agreement between the parties):

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