

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARDIOCOM, LLC

Petitioner

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.

Patent Owner

CASE IPR2013-00468

Patent No. 7,516,192

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

Patent Owner Robert Bosch Healthcare Systems, Inc. (“Bosch”) hereby moves the Board to exclude certain evidence submitted and relied upon by Petitioner Cardiocom, LLC (“Cardiocom”) and its expert, Dr. Robert Stone.

I. Dr. Stone’s Opinions Relating To Secondary Considerations Of Non-Obviousness

Bosch moves to exclude Dr. Stone’s opinions relating to secondary considerations of non-obviousness set forth in his reply declaration. *See* Ex. 1022 ¶¶ 61-90. Cardiocom relies on these paragraphs in its reply (Paper 52) at 4-5. Bosch objected to these paragraphs in Ex. 2071 at 9-18. These opinions should be excluded (a) because they were raised for the first time on reply, in violation of the Board’s rules of practice and (b) under Federal Rule of Evidence 702 because Dr. Stone lacks foundation to opine on secondary considerations and because he has purported to analyze secondary considerations under a flawed legal standard. In addition, Dr. Stone has offered erroneous claim constructions and selectively cited to Dr. David’s deposition while ignoring portions that contradict the inferences Dr. Stone draws, rendering his opinions unreliable under Rule 702.

A. Dr. Stone’s Opinions on Secondary Considerations Were Improperly Raised For The First Time In Rebuttal.

Dr. Stone’s opening declaration contains no testimony regarding secondary considerations. Dr. Stone admitted during deposition that he did not consider any secondary considerations in forming his original opinions. *See* Ex. 2069 (Stone

Reply Dep.), 783:1-15, 784:15-785:3. Dr. Stone withheld his opinions until reply, depriving Bosch from an opportunity to respond to them.

If Dr. Stone intended to analyze secondary considerations to support his opinion that U.S. Patent No. 7,516,192 (Ex. 1001, “the ’192 patent”) claims are obvious, he was required to have raised them in his original declaration. As the Board recently found, Cardiocom ultimately bears the initial burden of production for evidence demonstrating that the secondary considerations favor a finding of obviousness rather than non-obviousness. *Gnosis S.P.A. v. South Alabama Med. Sci. Found.*, Case IPR2013-00116, Paper 61, at 2-3 (P.T.A.B. Mar. 12, 2014).

Nor can Cardiocom credibly argue that it is simply “responding” to Bosch’s secondary considerations evidence. Having waived its opportunity to present secondary considerations evidence in its opening petition, Cardiocom does not have the right to present such evidence for the first time in rebuttal. In any event, Cardiocom bears the burden of production and ultimate burden of proof, so its rebuttals alone are deficient as a matter of law. *Infra*, Section B.2. Dr. Stone’s opinions must therefore be excluded. *See* Office Patent Trial Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012) (“a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned”).

B. Dr. Stone’s Secondary Considerations Opinions Are Unreliable Under Rule 702.

1. Dr. Stone Is Not Qualified.

Dr. Stone purports to rebut Dr. David’s expert testimony—which is supported by voluminous supporting documents—that the inventions of the ’192 patent helped drive the commercial success of the Health Buddy system they were incorporated into. Dr. David testified as to the existence of at least the following commercial secondary considerations for the ’192 patent: (1) the invention’s commercial success; (2) long felt but unresolved needs; (3) praise by others; (4) teaching away by others; and (5) copying of the inventions by others. Ex. 2007 ¶¶ 70-110. Dr. Stone criticizes these opinions by essentially adopting arguments made by counsel during Dr. David’s deposition. *See generally* Ex. 1022 ¶¶ 61-90.

Dr. Stone’s purported rebuttal testimony is irrelevant and unreliable expert testimony because he has no expertise in evaluating the commercial success of remote health monitoring devices. Dr. Stone’s only articulated expertise relates to technical “development” and “application programming” of various systems and devices. Dr. Stone has not identified expertise regarding the evaluation or comparison of remote health monitoring devices, any marketing expertise, or any other comparable expertise that qualifies him to testify as to commercial secondary considerations. *See generally* Ex. 1008 ¶¶ 1-6. Nor is any such expertise disclosed in his *curriculum vitae*. Ex. 1011.

Dr. Stone’s lack of qualifications is confirmed by the content of his testimony. As discussed in further detail in Section I.A above, Dr. Stone declined

to provide any affirmative opinions regarding secondary considerations. In addition, the form of his rebuttal testimony simply mimics counsel's arguments and suggestive questioning during Dr. David's deposition, rather than offering independent evidence. *See generally* Ex. 1022 ¶¶ 61-90.

Dr. Stone's purely technical background stands in stark contrast to Dr. David, who has a wealth of professional experience in assessing various competing commercial remote health monitoring devices available in the marketplace, which he gained in the course of his duties procuring remote health monitoring devices for the Texas Medical Center in Houston, one of the largest purchasers of remote health monitoring devices. Ex. 2007 ¶¶ 1-2; Ex. 2008; Ex. 1041, 14:14-15:1.

Accordingly, Dr. Stone lacks the expert foundation to opine on whether the claims of the '192 patent are supported by secondary considerations and should not be considered. *See Rambus, Inc. v. Hynix Semiconductor, Inc.*, 254 F.R.D. 597, 604-605 (N.D. Cal. 2008) (excluding under Rule 702 technical expert's testimony on commercial secondary considerations issues); *XpertUniverse, Inc. v. Cisco Sys., Inc.*, No. 09-157-RGA, 2013 WL 865974, at *3 (D. Del. Mar. 7, 2013) (same).

2. Dr. Stone Applied An Unreliable Methodology.

Dr. Stone's rebuttal methodology is deficient because: (1) Dr. Stone's analysis is based on an unsubstantiated legal test; and (2) Dr. Stone merely attempts to rebut Dr. David rather than affirmatively identifying contrary evidence.

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