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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 7,516,192

**PETITIONER'S MOTION TO EXCLUDE EVIDENCE SUBMITTED BY
PATENT OWNER UNDER 37 C.F.R. § 42.64**

I. Introduction.

Patent Owner and its expert, Dr. Yadin David, fail to establish any nexus between Patent Owner's alleged evidence of secondary considerations of non-obviousness and the actual claimed invention. In fact, Dr. David admitted that he performed no analysis linking the alleged secondary considerations to the claimed invention. Because Patent Owner fails to establish the required nexus, Petitioner Cardiocom, LLC ("Cardiocom") moves, based on Federal Rule of Evidence 402, to exclude the Patent Owner's purported evidence of secondary considerations, in particular Exhibits 2010-2057 and paragraphs 70-110 of Exhibit 2007, submitted with Patent Owner's Response.

Additionally, pursuant to Federal Rule of Evidence 802, the Board should exclude hearsay statements cited by Dr. David regarding statements by Patent Owner employees and the inventor regarding purported commercial success, and other non-obviousness factors. Dr. David introduced hearsay evidence in paragraphs 79, 82, 88, 91, 95-96, 103, 104, 106, 107, and 109 of his declaration, which is Exhibit 2007. In each of these paragraphs, Dr. David refers to or relates hearsay evidence from conversations with unsworn witnesses and documents. While an expert may rely on such documents and conversations in coming to his conclusions, as shown above those opinions should be excluded under Rule 402. Moreover, whether or not the expert's opinions that rely on these statements are

allowed, the cited statements remain hearsay and should not admitted for the purpose of proving the truth of the matters asserted. *See* Fed. R. Evid. 703 and 802. *See also* Fed. R. Evid. 105 (evidence may be admitted for a limited purpose).

Petitioner originally served objections to the foregoing on April 8, 2014. For at least the reasons detailed below, the Board should exclude each of Exhibits 2010-2057 and paragraphs 70-110 of Exhibit 2007 or alternatively limit the admission of the hearsay statements in paragraphs 79, 82, 88, 91, 95-96, 103, 104, 106, 107, and 109 of the David Declaration, Exhibit 2007, to exclude the use of such statements to prove the truth of the matters asserted.

II. Argument.

A. Patent Owner and its Expert Provide No Nexus Between the Proffered Evidence of Secondary Indicia of Non-Obviousness and the Claimed Invention.

Patent Owner's proposed evidence of non-obviousness should be excluded because Patent Owner failed to establish a nexus between the alleged evidence and the claimed features. "The patentee bears the burden of showing that a nexus exists between the claimed features of the invention and the objective evidence offered to show non-obviousness." *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312-13 (Fed. Cir. 2006) (holding that patent owner's evidence of commercial success and failure of others lacked sufficient nexus with the claimed features); *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994) (affirming the Board's rejection of claims and

holding that the patent requester failed to show a nexus between the product's commercial success, copying, and professional recognition and the claims of the invention). Evidence of commercial success of a product is not enough; the patentee must show that the claimed commercial success is tied to claimed features, and not to features found in the prior art. *Ormco*, 463 F.3d at 1312.

Failure to show the nexus should result in exclusion of the evidence. *See Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1376-77 (Fed. Cir. 2005) (holding that the district court erred in considering evidence of non-obviousness when the patent owner's product was commercially successful, but the patent owner had not shown that success to be the direct result of claimed features).

Patent Owner failed here to tie its proffered evidence to the claimed invention. Patent Owner's expert, Dr. David, identified Exhibits 2010-2057 as evidence of non-obviousness. Dr. David commented on those exhibits in paragraphs 70-110 of his declaration. Neither Patent Owner nor Dr. David provides any support that the show that commercial success or the other secondary indicia relied upon are a result of the claimed features of the patent. All the evidence relates to the Health Buddy product, yet Dr. David and Bosch made no showing that the Health Buddy practiced any claims of the '192 patent, let alone that any of the claimed features resulted in commercial success or other indicia of non-obviousness. Reply Declaration of Dr. Stone, Ex. 1022 ("Stone Reply Decl.")

¶64. Dr. David admits that he made no comparison of the claims of the '192 patent to the allegedly successful product:

Q. In your declaration for the '192 patent that you have in front of you, did you provide any element-by-element analysis indicating whether or not any versions of the Health Buddy product practiced any of the claims of the '192 patent?

THE WITNESS: I see. No, I did not.

David Dep. 499:1-9. Similarly, the discussions with the employees related to purported general success and were not specific to the claims of the patent.

Deposition of Dr. David (“David Dep.”) 245:9-246:3 (Ex. 1041).

Dr. David apparently *assumed* that all the proffered secondary evidence he gathered from the inventor and employees was due to the claimed invention, as he admitted that he did not even explore the possibility that any success was due to other factors. David Dep. 171:18- 172:7. His explanation was illuminating:

Q. Why didn't you ask them whether or not the success of the product might have been attributable to something other than what's claimed in the four patents?

MR. VENKATESAN: Objection; form.

THE WITNESS: Simply because it was not one of my tasks to do.

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