

By: Daniel W. McDonald (dmcDonald@merchantgould.com)
Merchant & Gould P.C.
3200 IDS Center
80 South 8th Street
Minneapolis, MN 55402
Tel: (612) 332-5300
Fax: (612) 332-9081

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 RESPONSE TO PATENT
OWNER'S MOTION TO EXCLUDE EVIDENCE**

I. Introduction

Petitioner's Reply and the supporting declaration of Dr. Stone directly responded to the arguments raised in Patent Owner's Response. Patent Owner's Response attempted to show secondary considerations of nonobviousness; Petitioner replied by showing that evidence was weak and lacked the requisite nexus. Patent Owner's Response relied on its expert Declaration; Petitioner's reply cites cross-examination of the expert, which shows his analysis was cursory and deficient. Patent Owner attempted to show that the cited art did not teach or suggest certain claim elements, Petitioner responded by showing that it did. The reply thus properly responded to Patent Owner's arguments. 37 CFR §42.23.

Patent Owner's Motion to Exclude Evidence does not deny that the Reply is responsive. Instead, it is a shotgun motion, but appears devoted mostly to two things. One, complains that Petitioner did not merely repeat what was presented in its Petition, but instead refuted Patent Owner's new evidence of purported secondary considerations. Two, it attempts to cure the flaws in Patent Owner's Response exposed by the Reply by asking the Board to consider additional evidence. Neither of these attacks has merit. Regarding the first, Petitioner's reply is the only and necessary vehicle for Petitioner to respond to flawed evidence of secondary considerations presented in Patent Owner's response. As to the second, Bosch should not be allowed to file a substantive sur-reply at all, let alone under

the guise of a motion to exclude. See *Atuahene v. South Dakota State University*, 2009 U.S. Dist. LEXIS 49976, *25 (D. S.D. 2009) (finding that “justice does not require an additional opportunity” for the party opposing the motion to respond to new material proffered in response to its own arguments); *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBMR2012-00002, Paper 66, slip op. at 62 (A motion to exclude “is not an opportunity to file a sur-reply, and also is not a mechanism to argue that a reply contains or relies on evidence necessary to make out a prima facie case.”)

Patent Owner’s remaining arguments mischaracterize Dr. Stone’s testimony and, at most, speak to its weight, not its admissibility. The motion also fails to show why the evidence is *inadmissible*. Rather than filing a spurious motion to exclude, Patent Owner may address such positions during oral argument. The motion should be denied.

II. Dr. Stone’s Opinions Regarding Secondary Considerations of Non-Obviousness Are Responsive and Admissible.

A. Dr. Stone’s opinions on secondary consideration properly refute the arguments raised by Patent Owner.

Patent Owner argues that Dr. Stone “withheld his opinions” on secondary considerations until his reply declaration. Paper 59 at 1-2. That is not true. Dr. Stone’s initial declaration was submitted in support of Cardiocom’s petition to institute *inter partes* review of the ’192 patent, when Cardiocom had to

demonstrate “a *reasonable likelihood* that [it] would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314 (emphasis added). The Board held that Cardiocom established such a reasonable likelihood and instituted this action. Patent Owner was the first party to submit briefing after the Board instituted this action. Patent Owner (through Dr. David) raised secondary considerations in response to Cardiocom’s obviousness arguments. Cardiocom and Dr. Stone then replied to this showing. Dr. Stone decided that Patent Owner’s evidence of secondary consideration did not change his opinion once it was presented, and was not expected to predict what Bosch might try to present on that issue when he presented his opinions initially.

Secondary considerations are typically presented as part of the patent owner's response and the petitioner's reply. See, e.g., *Vibrant Media, Inc. v. General Elec. Co.* IPR2013-00170, paper 56 at 27 (citing to patent owner’s response and petitioner’s rebuttal arguments in reply while finding that patent owner failed to establish a nexus between the allegedly successful device and the claims of the patent); *see also* MPEP §2145 (“Rebuttal evidence [by the Patent Owner] may relate to any of the Graham factors including the so-called secondary considerations.”) (quoting *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984)). Indeed, Patent Owner often is the party in possession of the information necessary to determine if a nexus exists between the alleged secondary considerations (such

as its own purported commercial success) and the claimed invention. Driving that point home here, Dr. David relied on his discussions with the named inventor and two of Patent Owner's employees for much of his secondary considerations analysis—information to which Dr. Stone had no access.

Patent Owner proffered new secondary consideration evidence and arguments in its Response; Petitioner was allowed to respond to that evidence on reply. See *Calderon v. Experian Info. Solutions, Inc.*, 290 F.R.D. 508, 515 (D. Idaho 2013) (holding that Plaintiff did not improperly raise issue for the first time in reply brief because Plaintiff was merely responding to an issue initially raised in Defendant's opposition brief); *EEOC v. Creative Networks, LLC*, No. CV-05-3032, 2008 U.S. Dist. LEXIS 103381, at *6 (D. Ariz. Dec. 15, 2008) (denying motion to strike where Defendant rebutted, with new evidence, arguments first raised by Plaintiff in its opposition).

Patent Owner does not cite any law supporting its proposition that Petitioner was "required" to analyze secondary considerations in his original declaration. Motion at 2. Patent Owner cites *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), but that case refutes Patent Owner's position. There the patent owner sought to argue last at the hearing, on secondary considerations. The patent owner's request was properly denied. "Rather, the secondary considerations evidence is part of the body of

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.