UNITED STATES PATENT AND TRADEMARK OFFICE

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PRAXAIR DISTRIBUTION, INC.
Petitioner

v.

MALLINCKRODT HOSPITAL PRODUCTS IP LTD.,
Patent Owner

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Case: IPR2015-00891
Patent: 8,573,210 B2

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PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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I.   INTRODUCTION

Praxair Distribution, Inc. ("Petitioner") filed a petition for *Inter Partes* review ("IPR") to challenge the validity of U.S. Patent No. 8,573,210 ("'210 Patent") under 35 U.S.C. § 103. With its petition, Petitioner included Exhibit 1002, an expert declaration of Dr. Robert Stone. Dr. Stone is an expert in the field of the alleged invention of the '210 Patent and the prior art references. On April 11, 2016, Patent Owner ("PO") filed a Motion to Exclude Evidence (Paper 44) seeking to exclude Exhibit 1002 and Exhibit 2020, Dr. Stone's deposition transcript, arguing that Dr. Stone did not perform a correct obviousness analysis (a legal endeavor) and failed "to apply any recognized legal standards." Paper 44 at 2. However, Dr. Stone is not required to perform any legal analysis; indeed, 37 C.F.R. § 42.65(a) and this Board's precedent confirms that such testimony is improper.

PO bases its Motion to Exclude Evidence on the assertion that "Dr. Stone rendered [his] opinions without ever analyzing the *claims* of the '210 Patent." Paper 44 at 1-2 (emphasis in original). But PO's fundamental premise is flawed. Dr. Stone testified that he was "asked to review certain documents, including U.S. Patent No. 8,573,210 (which I refer to as the '210 Patent) (Ex. 1001), and to provide my opinions on what those documents disclose." Ex. 1002 at ¶ 3; *see also* Ex. 2020 at 104:1-3 (describing his review of the claims). He explained his task in

more detail during his deposition: "the claims put a box around what I was looking at." Ex. 2020 at 56:8-10; *see also* 105:1-2 ("Obviously, the claims put bounds on it."). And during his deposition, Dr. Stone answered several questions about the scope of the claims of the patents he opined about. *See* Ex. 2020 at 83:10-14 ("I believe the claim is that it's intermittent."); 114:17-20 ("I believe some of the patents claim particular types of nitric oxide therapies and levels."). In sum, Dr. Stone *did* review the claims, and offered opinions within the "box" or "bounds" defined by the claims.

While Dr. Stone analyzed the subject matter of the claims, he did not provide a "claim-by-claim analysis," *e.g.* by providing a claim chart or other breakdown of each claim in each patent. The fact that Dr. Stone did not do a claim-by-claim analysis *does not* provide a basis for excluding his testimony. This is a task within the Board's purview.

PO's Motion to Exclude should be denied for other reasons as well. First, Dr. Stone provided proper expert testimony in his declaration in the form of a scientific opinion. Second, he did not use improper hindsight reasoning in forming his scientific opinion. Third, PO's Motion to Exclude is procedurally flawed because PO failed to preserve its objections pursuant to 37 C.F.R. § 42.64, a prerequisite to filing a Motion to Exclude.

II. DR. STONE'S TESTIMONY IS PROPER EXPERT TESTIMONY

Expert declarations are frequently useful, but are not required, to support Final Written Decisions finding claims to be obvious. *See, e.g.*, *Valeo, Inc. v. Magna Elec., Inc.*, Case Nos. IPR2014-00227 and IPR2014-00228, Paper 13 at 19 (May 29, 2014) ("expert testimony is not required in every case"); *see also Black Swamp IP, LLC v. VirnetX Inc.*, Case No. IPR2016-00167, Paper 12 at 4 (Feb. 4, 2016). As the Federal Circuit held in *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1240 (Fed. Cir. 2010), "*KSR* and our later cases establish that the legal determination of obviousness may include recourse to logic, judgment, and common sense, *in lieu* of expert testimony. *See, e.g., Perfect Web*, 587 F.3d at 1329; *Ball Aerosol*, 555 F.3d at 993."

PO generally argues that Dr. Stone's expert testimony should be excluded because it does not contain a claim-by-claim analysis comparing prior art disclosures to claim limitations. PO alleges that a claim-by-claim analysis is the "requisite analysis" to be performed by an expert. Paper 44 at 6. But there is no requirement that an IPR Petition be supported by expert testimony at all, and there is no requirement that expert testimony, if submitted, must provide claim-by-claim analysis as suggested by PO.[1] Indeed, as explained below, there was no need to

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[1] PO cites *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.* to support its argument that such a claim-by-claim expert opinion is required. Paper 44 at 7

provide such a claim-by-claim analysis here given the technology involved is not complex and the prior art systems use the *same* terminology as the language in the patent claims.

A.   Dr. Stone Provided a Proper Scientific Opinion

In his declaration, Dr. Stone provided a proper scientific opinion on the technical feasibility of combining certain aspects of the prior art. *See* Ex. 1002. Before drafting his declaration, Dr. Stone reviewed the '210 Patent as well as prior art references including U.S. Patent No. 7,114,510 ("'510 Patent"), U.S. Patent No. 5,558,083 ("'083 Patent"), English-language translation of French Patent Publications No. 2 917 804 ("FR '804 Publication"), a drug label from the Center for Drug Evaluation Research, Application Number: NDA 20845, INOMAX® ("INOMAX label"), and ISO/IEEE 11073-30300 "Health informatics -- Point-of-care medical device communication -- Part 30300: Transport profile -- Infrared

(*citing* 694 F.3d 1312, 1327 (Fed. Cir. 2012)). *ActiveVideo Networks* is an appeal from a District Court judgment, where the evidentiary standard is clear and convincing evidence, and not preponderance of the evidence as is the case here. *Id.*; *see also* 37 C.F.R. § 42.1(d). Moreover, to the extent this case is relevant, nothing in the cited case *requires* that claim-by-claim expert testimony is required even under the more stringent district court evidentiary standard. *ActiveVideo Networks, Inc.*, 694 F.3d at 1327.

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