

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UMICORE AG & CO. KG

Petitioner

v.

BASF CORPORATION

Patent Owner

Case IPR2015-01123

U.S. Patent 8,404,203

PETITIONER'S MOTION TO EXCLUDE

Pursuant to 37 C.F.R. § 42.64, Petitioner Umicore AG & CO. KG (“Umicore”) hereby respectfully moves to exclude the following evidence offered by Patent Owner BASF Corp. (“BASF”): (1) Paragraphs 28, 48, 54-55, 62-71, 79, 147-150, and 168-177 of the Declaration of Dr. Michael Tsapatsis (Ex. 2018); (2) Paragraph 11 of the February 12, 2016 Declaration of Dr. Ahmad Moini (Ex. 2019); and (3) Paragraph 7 of the Declaration of Olivia Schmidt (Ex. 2034). Umicore filed and served a paper setting forth the grounds for its objections to these paragraphs on February 19, 2016. (*See* Paper 25.) BASF did not serve any supplemental evidence or otherwise respond to the objections.

Much like BASF’s response, the Tsapatsis, Moini, and Schmidt declarations focus on unclaimed features, ignore key facts, and fail to include necessary foundational evidence. Further, each of the witnesses avoid expressing certain opinions themselves and instead improperly rely on uncross-examined statements of others in violation of the hearsay rules. For the reasons set forth below, exclusion of the above identified paragraphs is appropriate under Federal Rules of Evidence 402, 602, 702, 703, or 802.

I. Paragraphs 28, 48, 54-55, 62-71, 79, 147-150, and 168-177 of the Tsapatsis Declaration (Ex. 2018)

BASF has submitted an expert declaration of Dr. Tsapatsis (Ex. 2018) in response to Umicore’s showing of *prima facie* obviousness of the ’203 patent.

Federal Rule of Evidence 702 requires an expert’s opinions to be “based on

sufficient facts or data.” While Rule 703 provides that an expert may rely on otherwise inadmissible materials, he may do so only “[i]f experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion.” Paragraphs 28, 48, 54-55, 62-71, 79, 147-150, and 168-177 of the Tsapatsis declaration violate these Rules and should be excluded.

A. Dr. Tsapatsis’ Reliance on Irrelevant and Untrustworthy Hearsay

The Tsapatsis declaration cites to declarations submitted during reexamination of the ’662 patent. This includes two declarations signed by Dr. Ahmad Moini (Exs. 2003 and 2011), a declaration signed by Pramod Ravindran (Ex. 2004), a declaration signed by Stacey Zones (Ex. 2009), and a declaration signed by Stanley Roth (Ex. 2001). These declarations are not the type of evidence that can be reasonably relied on to support expert opinions. Paragraphs 28, 48, 79, 170, and 174 of the Tsapatsis declaration should all be excluded under Rules 702 and 703.

1. Opinions Based on the Moini Declarations

In paragraph 28, Dr. Tsapatsis cites to a passage in a February 9, 2011 Moini declaration stating that the inventors of the ’662 patent (the parent of the ’203 patent) purportedly “screen[ed] over 900 zeolite materials including over twelve different structure types.” (Ex. 2003, Moini declaration at ¶ 4; *see also* Ex. 2018, Tsapatsis declaration at ¶ 28.) According to Dr. Tsapatsis, this shows that the

patent's subject matter did not entail "routine optimization that was predictable based on prior art teachings." (*Id.*)

First, Dr. Tsapatsis opinion relating to the Moini declaration is irrelevant under Rule 402. Whether or not the inventors of the '662 and '203 patents themselves engaged in a large amount of work when developing BASF's commercial catalyst product has no bearing on obviousness. *See generally KSR Int'l Co. v. Teleflex Inc.*, 550 US 398, 406-407 (2007); *see also Life Techs., Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320, 1325 (Fed. Cir. 2000) ("[T]he path that leads an inventor to the invention is expressly made irrelevant to patentability by statute."). Instead, the relevant question is whether one of ordinary skill in the art would have considered the broadly claimed subject matter of the '203 patent to be a predictable variation of known prior art catalysts. Further, there is no evidence in the record indicating that the testing of "900 zeolite materials" and "twelve different structure types" was directed to any problem solved by the claims of the '203 patent, as opposed to work directed generally to zeolite development. There is also no evidence in the record that any work leading to the claimed invention constituted a large amount of work (as opposed to just a routine volume of laboratory screening conducted by catalyst companies like BASF). Second, such a statement in an uncross-examined declaration submitted by an advocate during patent prosecution is not the type of material experts in the field would rely on in

forming opinions on obviousness. Moreover, Dr. Tsapatsis never discussed this issue with Dr. Moini. Paragraph 28 of the Tsapatsis declaration should be excluded under Rules 402 and 702.

In paragraph 174, Dr. Tsapatsis also cites another declaration signed by Dr. Moini and dated December 18, 2011 (Ex. 2011) to support arguments regarding unexpected results. (*See, e.g.*, Ex. 2018, Tsapatsis Declaration at ¶ 174.) This declaration discussed the purported experimental testing of “two examples from Dedecek.” (Ex. 2011, Moini Declaration at ¶¶ 4-12.) But, Dr. Moini was “not able to obtain natural chabazite samples” identical to those discussed in Dedecek, and instead employed substitute materials with different percentages of silica and alumina (and thus a different SAR). (*See id.* at ¶ 5.) In other words, Dr. Moini did not test Dedecek’s examples. He tested something different.

Later in this same December 2011 declaration, Dr. Moini attempts to compare the prior art samples he tested with “additional Examples representative of the ‘662 invention.” (*Id.* at ¶ 25.) But, rather than discussing examples he himself prepared and tested, Dr. Moini discusses only “data from a colleague.” (*Id.*) Dr. Moini provides no indication of who this “colleague” might be, whether this “colleague” was qualified to synthesize catalysts or perform the described tests, and how the data he reports was collected and maintained. Thus, all of Dr.

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