

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHNSON MATTHEY INC. and JOHNSON MATTHEY PLC,
Petitioners

v.

BASF CORPORATION,
Patent Owner

Case IPR2015-01266
Patent 9,039,982

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION
TO EXCLUDE UNDER 37 C.F.R. § 42.64(c)**

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I. PRECISE RELIEF REQUESTED

Pursuant to 37 CFR § 42.64(c), Johnson Matthey Inc. and Johnson Matthey PLC oppose BASF Corporation's ("Patent Owner's") motion to exclude and request that it be denied.

II. PARAGRAPHS 26-30 OF DR. TENNENT'S DECLARATION RECOUNT HIS PERSONAL KNOWLEDGE OF THE INDUSTRY.

For almost 30 years, Dr. Tennent designed and commercialized wall flow filters for Corning, one of the preeminent manufacturers of substrates in the industry. Tennent Decl., JM 1003, ¶ 2-10. From his own personal knowledge, he recounted how by 2002 Corning had received requests from auto and truck manufactures "to develop a filter that could accommodate a catalyst washcoat loading of between 100 g/L to 125 g/L," which reflected a "move towards developing higher porosity filters, so that they could be combined with high catalyst loading." *Id.* at ¶ 26. Specifically, Dr. Tennent personally observed a demand for a high porosity filter that could accommodate "a very high SCR washcoat loading" and still achieve acceptable backpressure. *Id.* at ¶ 26, 29.

Dr. Tennent disclosed the underlying facts of his testimony: his own personal experience working in the relevant industry at the relevant time, where he received requests from auto and truck manufacturers for exactly that type of filter. *Id.* at ¶ 26. Patent Owner mischaracterizes his testimony as "generalized statements about an industry without underlying evidence." Patent Owner's

Motion to Exclude, 3. But in reality, the challenged testimony describes how Dr. Tennent personally observed a demand for a specific type of wall flow filter that could accommodate a high SCR washcoat loading. No matter whether that testimony is characterized as fact testimony or expert testimony, it is based on Dr. Tennent's own personal knowledge and, therefore, admissible. *See* Fed. R. Evid. 602 (fact witness may testify to a matter if the witness has "personal knowledge of the matter"); *see also* Fed. R. Evid. 703 (expert witness "may base an opinion on facts or data in the case that the expert has ... personally observed").

Patent Owner cites two opinions, one from district court and one from the PTAB, but neither supports excluding Dr. Tennent's testimony. In one, *Rambus Inc. v. Hynix Semiconductor Inc.*, the court excluded testimony where the expert offered conclusory testimony about long-felt need where he had "limited experience" in the relevant DRAM industry and his "involvement with the DRAM industry appears minimal and he has had no experience in marketing DRAMs and minimal [experience], at best, in designing them." 254 F.R.D. 597, 608 (N.D. Cal. 2008). The court recognized, however, that if the expert had "extensive experience in design or marketing in the DRAM industry," then he would have been competent to offer an opinion about long-felt need. *Id.* Here, Dr. Tennent established his extensive experience developing wall flow filters, including serving as Research & Development Leader for the development and commercialization of

multiple new wall flow filters. Tennent Decl., JM 1004, ¶ 2-10. Thus, unlike the expert in *Rambus* who had “at best” “minimal” relevant experience, Dr. Tennent has almost 30 years of experience designing and commercializing wall flow filters and had personally observed requests for a high porosity wall flow filter that could accommodate a high SCR washcoat loading.

In the second opinion, *Nestlé Purina Petcare Co. v. Oil-Dri Corp. of Am.*, IPR2015-00737, two experts offered testimony about the content of specific compositions in the prior art, not on general trends in the relevant industry. Paper No. 37 at 17-18 (PTAB Jun. 20, 2016). Though the testimony “pertain[ed] to a physical composition that could be tested to determine its content, or about which specific information could be obtained,” neither expert did either. *Id.* Here, by contrast, Dr. Tennent provided specific underlying facts to his opinions, testifying that, “[b]ased on the requests that Corning received,” “auto and truck manufacturers were ... trying to develop a filter that could accommodate a catalyst washcoat loading of between 100 g/L to 125 g/L.” Tennent Decl., JM 1004, ¶¶ 2-10.

In paragraphs 26-30 of his declaration, Dr. Tennent recounts specific information from his own personal experience. Accordingly, that testimony is admissible. *See* Fed. R. Evid. 602; *see also* Fed. R. Evid. 703.

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