IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALLSTEEL INC.
Petitioner

v.

DIRTT ENVIRONMENTAL SOLUTIONS LTD.
Patent Owner

Case IPR2015-01691
Patent No. 8,024,901

Before SALLY C. MEDLEY, SCOTT A. DANIELS, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*

REPLY DECLARATION OF JOSEPH J. BEAMAN, JR.

Introduction and Summary of Opinion

1. This declaration is in reply to Patent Owner's Response in Case No. IPR2015-001691. I have previously opined on the patent in this case, and I incorporate by reference my statements and opinions of my previous declaration. Ex. 1018. In addition to the documents listed in Appendix B of Ex. 1018, I have also considered the following documents for this report: (1) Patent Owner's Response (Paper 24); (2) Declaration of Rollin C. Dix, Ph.D in Support of the Patent Owner's Response (Ex. 2009); (3) Declaration of Geoffrey Gosling in Support of the Patent Owner's Response (Ex. 2004); (4) Deposition Transcript of Rollin C. Dix, Ph.D (Ex. 1030); and (5) Deposition Transcript of Geoffrey Gosling (Ex. 1031).

2. In this report, I address the Patent Owner's Response and Dr. Dix's opinions presented in his report and in his deposition.

Legal Standards

3. I have not been asked to offer an opinion on the law; however, as an expert assisting the Board in determining patentability, I understand that I am obliged to follow existing law as stated in my previous declaration. (Ex. 1018 at ¶¶ 26-35.) I understand that one aspect of the legal test for obviousness under 35 U.S.C. § 103 is "[t]he test for obviousness is not whether the features of a

secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (C.C.P.A. 1981) (Paper 10 at 15).

4. My analysis of the obviousness issues in this case is fully consistent with this principle, as I have never understood the obviousness test to require an analysis of whether a "secondary" reference may be bodily incorporated into the structure of a "primary" reference. I have never understood that the test of obviousness requires that any and all teachings of one prior art reference must dominate an obviousness analysis to the exclusion of the teachings of other prior art references. Rather, in conducting my analysis, I attempted to discern what a given set of references taken as a whole would have suggested to a person of ordinary skill. (Ex. 1018 at ¶ 28, 31.)

Level of Ordinary Skill in the Art

5. My opinions expressed in this declaration, my previous declaration, and my deposition regarding a person of ordinary skill in the art are based on a hypothetical person presumed to have known the relevant art at the time of the filing of the '901 patent.

6. I understand that Dr. Dix and the Patent Owner agree with my opinion of what I consider to be the level of a person of ordinary skill in the art. (Ex. 2009 at ¶ 11; Paper 24 at 15.) However, I disagree with Dr. Dix and the Patent Owner on the creativity level of the person of ordinary skill in the test for obviousness. As stated in my previous declaration, "a person of ordinary skill is also a person of ordinary creativity…[and] a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." (Ex. 1018 at ¶ 33.) It is my opinion that Dr. Dix's artificial limitations on the creativity of a person of ordinary skill are inconsistent with his own testimony and my testimony.

7. I believe that Dr. Dix has applied a test for obviousness that only allows a person of ordinary skill to bodily incorporate elements of the prior art. I believe that Dr. Dix has limited the range of potential combinations that a person of skill would come up with in view of the prior art to those that unduly preserves all elements of one reference at the expense of the creativity of a person of ordinary skill with regard to the teachings of other references. In effect, Dr. Dix imposes artificial blinders on the person of ordinary skill at odds with what would have been immediately recognized as well-known technology.

8. Dr. Dix also seems to contradict or downplay the creativity level of a person of ordinary skill. Dr. Dix discusses his understanding of an obviousness

analysis during his deposition at Ex. 1030 at 81:19-83: 15. Dr. Dix appears to believe that an element of an obviousness analysis is whether or not the secondary reference can be physically incorporated into another reference. Mr. Sullivan, attorney for the Petitioner, summarily asks and Dr. Dix answers:

> Mr. Sullivan: So what're doing in your [obviousness] analysis is you're looking, for example, at a physical embodiment of the Raith reference, right? And then you're looking at a physical embodiment of the EVH reference, for example, and you're looking at how you would take the physical structures of EVH and potentially put them into Raith and analyzing to what extent a person of ordinary skill would do that. That's the analysis, right?
>
> Dr. Dix: That's correct.

(Ex. 1030 at 83:6-15.)

9. In contrast, in my review of Dr. Dix's deposition testimony, Dr. Dix repeatedly confirmed that some of his senior design students, who, if anything, are slightly less skilled than a person of ordinary skill, would easily combine certain elements of EVH with Raith, MacGregor with Raith, and Yu with Raith. For example, Dr. Dix offered the following during his deposition:

> Mr. Sullivan: So your students, your senior design students, it would be well within their competency to design their own horizontal structural support to pair it with the connecting strip system of Raith, right?
>
> Dr. Dix: That's I believe what I said, yes.

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