

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REACTIVE SURFACES LTD., LLP

Petitioner

v.

TOYOTA MOTOR CORPORATION

Patent Owner

Case: IPR2016-01914

Patent No. 8,394,618 B2

**PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION FOR
OBSERVATION ON CROSS-EXAMINATION**

In association with *inter partes* review of claims 1-11 (“Challenged Claims”) of United States Patent No. 8,394,618 (“’618 Patent”), Petitioner Reactive Surfaces Ltd. LLP submits the following response to Patent Owner’s Motion for Observation on Cross-examination (“Motion”) of Dr. David Rozzell and Mr. Eric Ray, such cross-examinations both conducted on November 15, 2017.

Observation I.A.1

Patent Owner asserts that Dr. Rozzell’s testimony as it relates to this observation is relevant to the parties’ disagreement regarding the proper definition of the ’618 Patent’s “field of endeavor” and is relevant because it allegedly highlights the hindsight nature of Dr. Rozzell’s definition. (Motion at 1)

The cited testimony is not relevant in the manner asserted by Patent Owner because Dr. Rozzell has testified in regard to the field of endeavor in the context of the field of the claimed invention and in regard to the prior art. (See Ex. 2017 at 10:12-14.) For example, in the context of this observation, when asked “[a]re you aware of any prior art patents or publications that talked about using enzymes containing polymeric coatings to facilitate the removal of fingerprints and other bioorganic stains by vaporization” in the context of the basis of his definition of the field of endeavor, Dr. Rozzell answered “Yes” and, when asked “Can you name --

can you name -- name them” Dr. Rozzell answered “The first one that comes to mind is actually one of the exhibits, I believe it's Wang” (See Ex. 2017 at 10:15-23). Dr. Rozzell goes on to testify as to specific prior art disclosure in Wang supporting the basis of such definition of the field of endeavor. (Ex. 2017 at 47:25-49:24; 57:8-58:9.) For example, in regard to Wang, Dr. Rozzell has testified that:

1. “Well, Wang teaches that the enzymes could be a protease if it's a protein stain or a lipase if it's an oil or lipid or fat-based stain. We tend to break those molecules down, hydrolyze them, and create sort of self-cleansing type mechanism to assist in the removal of that stain.” when asked “[w]hat effect would you say such hydrolyzation, as referenced in Wang or disclosed by Wang, have on a stain of Wang?” (Ex. 2017 at 49:6-14)
2. “It would assist it. It would make it more likely to happen.” when asked what effect would such hydrolyzing have on the ability of a lipid or a bioorganic stain such as a lipid to evaporate?” (Ex. 2017 at 49:20-24)

Observation I.A.2

Patent Owner asserts that Dr. Rozzell’s testimony as it relates to this observation is relevant to the definition of the “field of endeavor” and is relevant

because it highlights the fact that Dr. Rozzell himself lacks any experience or expertise in the relevant “field of endeavor” as he has defined it. (Motion at 2)

The cited testimony is not relevant in the manner asserted by Patent Owner because Dr. Rozzell’s testimony supports his experience as it relates to the underlying enzymatic functionality that can provide for facilitating the removal of fingerprints by vaporization. For example, although Dr. Rozzell has testified that “Personally, I haven't worked on specifically trying to remove fingerprints by vaporization using an enzyme-associated coating” (See Ex. 2017 at 27:5-7), he has unambiguously testified to his in-depth understanding of the underlying mechanism that enables removal of bioorganic stains from a lipase associated coating or substrate by vaporization. (See Ex. 2017 at 27:8-29:12; 38:18-39:14; 43:8-43:22; 49:9-24; 52:8-54:24; 59:16-60:18.) Also supporting his opinion that Buchanan is pertinent and analogous art, Dr. Rozzell has testified that “Buchanan dealt with the whole idea of fingerprints disappearing on the basis of vaporization, and she showed that fingerprints with more volatile components disappeared more quickly.” (See Ex. 2017 at 45:23-46:4.)

Observation I.A.3

Patent Owner asserts that Dr. Rozzell's testimony as it relates to this observation is relevant to Patent Owner's argument that Buchanan is not from the same "field of endeavor" as the '618 Patent and is relevant because it demonstrates that Buchanan falls outside the relevant "field of endeavor" even under Dr. Rozzell's definition. (Motion at 2)

Dr. Rozzell's testimony in this observation must be viewed in the context of him having opined in his Reply Declaration that Buchanan is "highly pertinent and analogous art." (See Ex. 1018 at 38, Ex. 2017 at 13:17-23.) Accordingly, the cited testimony in this observation is not relevant in the manner asserted by Patent Owner because such testimony is consistent with Dr. Rozzell having opined that Buchanan is "pertinent and analogous art" as it relates to the claimed invention. Also supporting his opinion that Buchanan is pertinent and analogous art, Dr. Rozzell has testified that "Buchanan dealt with the whole idea of fingerprints disappearing on the basis of vaporization, and she showed that fingerprints with more volatile components disappeared more quickly." and "[T]he mechanism that they spelled out in the '618 patent as to why their invention worked was that the lipase was converting more higher boiling components in fingerprints to lower boiling, and, thereby, rendering them more vaporizable. So this mechanism of fingerprint disappearing on

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