

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FLIR SYSTEMS, INC.,  
Petitioner,

v.

LEAK SURVEYS, INC.,  
Patent Owner.

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Case IPR2014-00411 (Patents 8,426,813 B2 and 8,193,496)  
Case IPR2015-00065 (Patent 8,426,813 B2)

Before FRED E. McKELVEY, JAMES T. MOORE, and  
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

McKELVEY, *Administrative Patent Judge*.

DECISION  
Motions to Exclude  
37 C.F.R. § 42.64(c)

## I. List of Motions

Both parties have filed motions to exclude. 37 C.F.R. § 41.64(c).

Patent Owner ('411/'434):

Patent Owner Motion (Paper 94);  
Petitioner Opposition (Paper 102); and  
Patent Owner Reply (Paper 107).

Patent Owner ('065):

Patent Owner Motion (Paper 51);  
Petitioner Opposition (Paper 59); and  
Patent Owner Reply (Paper 61).

Petitioner ('411/'434):

Petitioner Motion (Paper 95);  
Patent Owner Opposition (Paper 104); and  
Petitioner Reply (Paper 106).

Petitioner ('065):

Petitioner Motion (Paper 52);  
Patent Owner Opposition (Paper 61); and  
Petitioner Reply (Paper 63).

## II. Motions to Exclude

The motions to exclude filed by both parties were “brewed in the same barrel”<sup>1</sup> because for the most part they both amount to impermissible

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<sup>1</sup> Quote from the Supreme Court’s recent decision in *Kimble v. Marvel Entertainment, LLC*, 135 S. Ct. 2401, 2407 (2015).

continued arguments on the merits as opposed to succinctly addressing issues limited to admissibility of evidence.

The motions also amount to improper attempts at enlarging of the page limits of the oppositions and replies.

The rules provide:

The motion [to exclude] must identify the objections in the record in order and must explain the objections.

37 C.F.R. § 42.64(d). The language “in order” means that objections should be discussed in the motion in Exhibit number order. *See* the portion of the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (col. 3) (Aug. 14, 2012) quoted below.

The rules further provide:

The moving party has the burden of proof to establish that it is entitled to the requested relief [sought in the motion].

37 C.F.R. § 42.20(c).

The Office Patent Trial Practice Guide contains the following guidance on challenging admissibility:

*K. Challenging Admissibility*

A party wishing to challenge the admissibility of evidence must object timely to the evidence at the point it is offered and then preserve the objection by filing a motion to exclude the evidence. § 42.64(a), (b)(1), and (c). The time for filing a motion to exclude evidence will be set in the Scheduling Order. A motion to exclude evidence must:

(a) Identify where in the record the objection originally was made;

(b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent;

(c) Address objections to exhibits in numerical order; and

(d) Explain each objection.

A motion to exclude must explain why the evidence is not admissible (*e.g.*, relevance or hearsay) *but may not be used to challenge the sufficiency of the evidence to prove a particular fact.*

Office Patent Trial Practice Guide, 77 Fed. Reg. at 49767 (col. 3)  
(Aug. 14, 2012) (*italics in last paragraph added*).

A motion to exclude is not a vehicle for addressing the weight to be given evidence. Nevertheless, a review of the motions in this case will demonstrate that both parties present numerous arguments which go to the weight to be assigned to the evidence. If a motion addresses only admissibility, then “no problem.”<sup>2</sup> But, if the motion addresses weight, then “no dice.”<sup>3</sup>

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<sup>2</sup> *Kimble*, 135 S. Ct. at 2011.

<sup>3</sup> *Id.*

Arguments relating to the weight a party wants us to assign evidence should appear only in the merits documents, i.e., petition, opposition (also referred to as a response), and reply on the merits.

Another factor in considering whether a motion to exclude should be filed is the forum in which the motion is presented. The Board is comprised of a tribunal of judges “of competent legal knowledge and scientific ability.” 35 U.S.C. § 6(a). There is no jury to impress or convince in our proceedings. Moreover, we are capable of assigning the weight to be given evidence, including assigning “no weight.”

Preserving an objection by way of a motion to exclude should be straightforward.

All evidence in our proceedings is filed in the form of an exhibit. . 37 C.F.R. § 42.63(a).

Once filed, the exhibit is “in evidence.”

In this respect, our practice differs from that in a U.S. district court where a party must move to have evidence admitted.

In a civil action in a U.S. district court the proponent bears the burden of establishing the admissibility of its evidence.

In our proceedings it is the opponent who bears the burden of establishing inadmissibility of an exhibit. 37 C.F.R. § 64(c) (providing for motion to exclude) and § 42.20(c) (movant must establish it is entitled to relief).

The difference is based on the manner in which evidence is presented to the district court vis-à-vis the Board. In district court evidence is presented during an evidentiary trial, whereas before us generally there is no evidentiary trial.

If an opponent has a problem with admissibility of a party's exhibit relied upon in support of a petition, opposition, or reply on the merits,<sup>4</sup> the opponent must object. As noted in the rule, "[t]he objection must identify the grounds for the objection with sufficient particularity to allow correction . . ." thereby giving the party a chance to correct by filing "supplemental evidence." 37 C.F.R. § 42.64(b)(1)–(2).<sup>5</sup>

What follows is an example of how a motion to exclude might be succinctly presented. Suppose a petitioner relies on experimental test data set out in Example 1 of a specification of relied upon prior art patent (say, Ex. 1005) to prove that a particular property is actually obtained when an experimental test, as described in the patent, is conducted.<sup>6</sup>

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<sup>4</sup> Objections during depositions are addressed in § 42.62(a).

<sup>5</sup> Supplemental *evidence* under § 42.64(b)(2) is different from supplemental *information* under § 42.123.

<sup>6</sup> The patent is admissible to prove what is *described* therein. *Joy Technologies, Inc. v. Manbeck*, 751 F. Supp. 225, 233 n.2 (D.D.C. 1990), *aff'd*, 959 F.2d 226 (Fed. Cir. 1992) (prior art document admissible over hearsay objection to prove what is *described* therein).

In addressing the admissibility of Ex. 1005, a motion to exclude could state the following.

Exhibit 1005

1. Identity of the exhibit and portion thereof sought to be excluded: test data described in Exhibit 1005, Example 1.
2. Objection: Hearsay: Fed. R. Evid. 802; 37 C.F.R. § 42.61(c).
3. An objection was made in an Objection to Evidence, filed [state date filed]. *See* Ex. 2011, page x, lines y–z.
4. Petitioner relies on the objected data on pages 5–6 of the Petition.
5. The relied upon data is hearsay. Petitioner has not presented the testimony of any individual having first-hand of the testing described in Example 1.

Nothing more is needed.

If petitioner believes an exception to the hearsay rule applies, petitioner may address the exception in an opposition to which patent owner may a reply.

Any argument on the part of a patent owner concerning weight to be given Example 1 (1) shall *not* appear in, or be made part of, a motion to exclude, but (2) may be raised in the patent owner's opposition on the merits.

Another factor to be considered by a party thinking about filing a motion to exclude, and one that becomes apparent in this the case, is the following.

In the case of the example set out above, the petitioner (not the patent owner) has the burden of proving unpatentability—assuming an IPR is instituted. On the other hand, a patent owner has the burden of proof on the issue of admissibility given that under our practice an exhibit is admitted in evidence when filed—subject, of course, to a subsequent objection and a follow-up motion to exclude. A patent owner may wish to think twice about whether it wants to take on the burden of establishing inadmissibility as opposed to arguing in an opposition that petitioner has failed to sustain its burden to prove its substantive merits case.

### III. Patent Owner’s Motion to Exclude

#### A. Ex. 1011—Merlin User’s Guide

Patent Owner moves to exclude the Merlin User’s Guide (Exhibit 1011) based on an alleged lack of authentication (Fed. R. Evid. 902<sup>7</sup>) and assuming a lack of authentication, relevance (Fed. R. Evid. 401 and 402<sup>8</sup>). Paper 94, page 4

An issue in these proceedings is whether the Merlin User’s Guide is prior art.

As part of its case-in-chief, Petitioner was under a burden to establish that the Merlin User’s Guide is prior art.

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<sup>7</sup> The Federal Rules of Evidence are made applicable to *inter partes* review proceedings, including *inter partes* review trials. 37 C.F.R. § 42.62(a).

<sup>8</sup> If a party succeeds in having an exhibit excluded based on authenticity, then we see no need to mention or address relevance.



One element of establishing that the Merlin User's Guide is prior art is establishing that the Guide was accessible to the public as of an appropriate date. In other words, accessibility of the document is an element of Petitioner's proof.

In evaluating the case on the merits, we determined that the Guide was accessible to the public.

Furthermore, where a patent owner's motion to exclude raises the same issue (i.e., authenticity based on an alleged lack of accessibility) as an issue required to be proved by a petitioner as part of a case-in-chief (i.e., accessibility), there is no need to further consider that issue in connection with a motion to exclude.

To complete the analysis, we will note that most of the argument raised in Patent Owner's Motion to Exclude related to Exhibit 1011 goes to the weight to be assigned as opposed to whether Exhibit 1011 is admissible.

Lastly, we see no reason to (1) decide whether a petitioner has proved accessibility on the merits and (2) also decide whether a patent owner has sustained its burden in a motion to exclude to prove that the same document was not accessible.

#### B. Exhibits and Testimony Unrelated to a Printed Publication Issue

Patent Owner objects to the admissibility of various exhibits relied upon by Petitioner concerning what Patent Owner refers to as Petitioner's "own proprietary information." Paper 94, page 7.

The objection, as discussed in the motion, is somewhat confusing and as best we can tell relates to relevance.

*First*, Patent Owner argues that the evidence is not a printed publication and therefore cannot be prior art within the meaning of 35 U.S.C. § 311(b).

*Second*, Patent Owner maintains that a person having ordinary skill in the art (referred to as POSITA) would not have known of the evidence.

In rendering our Final Written Decision, we have considered as prior art only that identified in the Petition. However, non-prior art evidence may be used to establish that a particular Exhibit is prior art. In our view, that is all that Petitioner has done. We have given the remaining Exhibits the weight to which they are entitled, but based on other Exhibits have found that the Merlin User Guide is prior art.

Petitioner responds to this portion of the Motion to Exclude on the basis that the Exhibits establish the “state of the art.” In deciding the merits, we have given no weight to the “state of the art” argument because we did not need to do so to determine that Petitioner established the prior art status of the Merlin User Guide. Thus, the state of the art issue raised in the motion to exclude has been rendered moot.

### C. Petitioner’s Reply Evidence

Patent Owner objects to the admissibility of some “supplemental information” filed by Petitioner. Paper 94, page 10.

Patent Owner also complains about “new reply exhibits” filed by Petitioner with its Reply, based apparently on Petitioner’s alleged failure to file a motion under § 42.123(b).

There are two answers to Patent Owner’s argument.

*First*, filing of supplemental *information* in an IPR is governed by 37 C.F.R. § 42.123. In various orders entered in these IPRs, we authorized filing of supplemental information. *See* Paper 102, page 8.

*Second*, a motion is not needed to file supplemental *evidence* following an objection made in connection with evidence filed with a reply. Rather, the rules relating to objection to admissibility apply to evidence submitted with a reply.

#### D. Outside the Scope Evidence

Patent Owner maintains that evidence filed by Petitioner with its Petitioner's Reply is outside the scope of Patent Owner's Opposition. Paper 94, page 11.

Patent Owner further maintains that declaration evidence filed with the Reply could have been presented in declarations filed with the Petition. *Id.*

We have considered the evidence and assigned the weight to which we believe it is entitled.

The rules authorize a reply. The object of a reply is to address arguments made in an opposition. While it may be true that Petitioner theoretically could have presented the reply arguments and evidence with the Petition, it is also true that a Petitioner does not have to anticipate all arguments which might be made in an opposition. To some extent, the relief sought by Patent Owner would in effect mean that a petitioner could never file a reply. Such a position is inconsistent with the procedures established by the rules, including authorization of reply on the merits. It is also

inconsistent with American jurisprudence which generally gives the party with the burden of proof the last word.

To the extent that Patent Owner seeks to render inadmissible Dr. Richards testimony based on his alleged failure to disclose facts and data underlying his opinion, and to the extent Dr. Richards testified as an “expert”, a failure to reveal underlying facts and data goes to the weight to be assigned testimony. 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). *See also* Paper 102, page 10.

#### E. Richards, Woolaway, and Sandsten Declarations

We have considered Patent Owner’s objections to various portion of the declaration testimony of the three above-identified witnesses. Paper 94, page 11.

But, we agree with Petitioner that the objections raise “weight” as opposed to “admissibility” issues. We have assigned the testimony the weight to which it is entitled.

### IV. Petitioner’s Motion to Exclude

#### A. Hossack Declaration

Petitioner challenges opinions set out in declaration testimony of Dr. Hossack. Paper 95, page 2.

According to Petitioner, Patent Owner bears the burden of establishing the admissibility of the challenged opinions, citing *Bourjaily v. United States*, 483 U.S. 171, 175–176 (1987). *Id.*

Petitioner's reliance on *Bourjaily* overlooks a significant difference between our proceedings and criminal proceedings in a U.S. district court. In the context of U.S. district court proceedings, the Supreme Court held that the proponents had to establish that a co-conspirator's statement fell within the scope of the applicable rule. In our proceedings an exhibit is in evidence when filed and it is incumbent on the opponent to prove that the exhibit is inadmissible.

According to Petitioner, Dr. Hossack lacks the necessary expertise to voice opinions on in the relevant field. Paper 95, page 3. Petitioner also complains that Dr. "Hossack's opinion does not 'fit' the facts of this case and therefore should be excluded as unreliable . . . ." Paper 95, page 4. Petitioner still further argues that there is no underlying data to support the opinions. Paper 95, page 6. A variety of other points are made in support of the objection.

Even if we were to agree that the "expert" credentials of Dr. Hossack are not the most desirable, we nevertheless have considered Dr. Hossack's testimony and given such weight as we deemed appropriate.

#### B. Hausler Declaration

Petitioner argues that Dr. Hausler is not sufficiently qualified, from a technical point of view, to voice opinions on the scope and content of the prior art, including Strachan, Kulp and the Merlin Brochure. Paper 95, page 8. But, scope and content of the prior art are factual matters. Based on our backgrounds, we are capable of determining the scope and content of the prior art based on what is described in the prior art. Petitioner's basis for

exclusion in reality goes to the weight we are asked to assign Dr. Hausler's testimony.

Petitioner further argues that Dr. Hausler's testimony is devoid of facts and underlying data to connect objective evidence of obviousness to the claimed subject, i.e., the testimony fails to establish the necessary "nexus." Any "nexus" issue sought to be raised under the guise of a motion to exclude is resolved when we resolve the merits. The same analysis applies to Petitioner's argument that Dr. "Hausler makes no effort to account for the contribution that unclaimed features made to that alleged [commercial] success." Paper 95, page 10.

C. Siegel, Feldman, and Smylie

1. Feldman

Direct declaration testimony of Feldman was placed in evidence by Patent Owner. Ex. 2065 ('411/'434); Ex. 2105 ('065).

Despite a request by Petitioner, Patent Owner failed to make Feldman available for cross-examination.

Accordingly, Petitioner states that it will make the lack of an opportunity to cross-examination the subject of a separate request to strike the direct declaration testimony of Feldman. Paper 95, page 11. There is no need for a motion to strike.

Cross-examination (1) was recognized in antiquity,<sup>9</sup> (2) was adopted

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<sup>9</sup> Proverbs 18:17 (New King James): "The first one to plead his cause seems right. Until his neighbor comes and examines him."

as part of the Common Law of England,<sup>10</sup> (3) was standard practice in the United States before and after Independence, and (4) is recognized as essential to American jurisprudence, both in criminal<sup>11</sup> and civil cases.<sup>12</sup> Accordingly, it should surprise no one that under our practice, a party is entitled to cross-examine the declaration testimony of an opponent's witnesses. 37 C.F.R. § 42.51(b)(1)(ii).

Patent Owner offered Feldman as a witness. Patent Owner, not Petitioner, was obligated to make the witness available, including if necessary seeking leave to issue a subpoena under 35 U.S.C. § 24. Patent Owner has taken the position that Petitioner could have sought leave to issue the subpoena. Even if true, it was not Petitioner's burden to ferret out the whereabouts of Feldman so that Petitioner could cause a subpoena to be

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<sup>10</sup> Wm. Blackstone, *Commentaries on the Laws of England*, pages 372–374 (1768), published by The University of Chicago Press ISBN 0-226-05550-7 (2002)) (relevant portions of pages 372–374 are set out in Appendix 1.

<sup>11</sup> U.S. Const. amend. VI; *Pointer v. Texas*, 380 U.S. 400, 404 (1965) (“Moreover, the decisions of this Court and other courts throughout the years have constantly emphasized the necessity for cross-examination as a protection for defendants in criminal cases.”)

<sup>12</sup> *United States v. Int'l Harvester Co.*, 274 U.S. 693, 703 (1927) (“But it is entirely plain that to treat the statements in this report—based upon an ex parte investigation and formulated in the manner set for the—as constituting in themselves substantive evidence upon the question of fact here involved, violates the fundamental rules of evidence entitling the parties to a trial of issues of fact . . . upon the testimony of persons . . . who are produced as witnesses and are subject to the test of cross-examination.”).

issued to compel cross-examination testimony of a witness that Patent Owner asks us to consider.

The motion to exclude the direct declaration of Feldman will be *granted*.

## 2. Siegell and Smylie

Petitioner seeks to exclude testimony by Siegell and Smylie to the effect that both were surprised concerning performance of a Hawk camera. Paper 95, page 12. The “surprise” argument is said to be contradicted by contemporaneous data. *Id.* Balancing of evidence, and crediting some evidence over other evidence, is a chore we engage in on a routine basis. We do not need to exclude evidence to weigh contradictory evidence.

## D. Parrish

Petitioner maintains, for a variety of reasons, that “[because . . . [Parrish’s] proffered conclusions are supported by only his *ipse dixit*,<sup>[13]</sup> Parrish’s conclusory opinions are entitled to no weight and thus should be excluded.” Paper 95, page 13. We elect to take Petitioner up on evaluating and assigning “weight” and decline to “exclude” the Parrish testimony even if, at the end of the day, we find it is not entitled to any weight.

## E. Martini

Petitioner seeks exclusion of declaration testimony by Martini on the grounds that it is unreliable. Paper 95, page 13.

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<sup>13</sup> *Ipse dixit*. “He himself said it, a bare assertion resting on the authority of an individual.” BLACK’S LAW DICTIONARY, page 828 (6th ed. 1990).



To make out its case, Petitioner discusses technical issues associated with bandwidths. *Id.* at 14. A review of the argument made in the motion to exclude shows that it is really an argument on the merits in which case we have to assign testimony pro and con the weight to which it is entitled.

V. Order

Upon consideration of the Motions to Exclude, and for the reasons given, it is

ORDERED that the motion to exclude the Feldman testimony is *granted*.

FURTHER ORDERED that Ex. 2065 ('411/'434) and Ex. 2105 ('065) are *excluded* from evidence.

FURTHER ORDERED that the Motions to Exclude are otherwise *denied*.

Case IPR2014-00411/434 Patents 8,426,813 B2; 8,193,496 B2  
Case IPR2015-00065 Patent 8,426,813 B2

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## Appendix 1

Wm. Blackstone  
*Commentaries on the Laws of England*,  
portions of pages 372–374 (1768),  
published by The University of Chicago Press  
ISBN 0-226-05550-7 (2002)

The oath administered to the witness is not only that what he deposes shall be true, but that he shall also depose the *whole* truth: so that he is not to conceal any part of what he knows, whether interrogated particularly to that point or not. And all this evidence is to be given in open court, in the presence of the parties, their attorneys, the counsel, and all by-standers; and before the judge and jury: each party having liberty to except to its competency, which exceptions are publicly stated, and by the judge are openly and publicly allowed or disallowed, in the face of the country; which must curb any secret bias or partiality, that might arise in his own breast.

\* \* \* \* \*

This open examination of witnesses *viva voce*, in the presence of all mankind, is much more conducive to the clearing up of truth, than the private and secret examination taken down in writing before an officer, or his clerk, in the ecclesiastical courts, and all others that have borrowed their practice from the civil law: where a witness may frequently depose that in private, which he will be ashamed to testify in a public and solemn tribunal. There an artful or careless scribe may make a witness speak what he never

meant, by dressing up his depositions in his own forms and language; but he is here at liberty to correct and explain his meaning, if misunderstood, which he can never do after a written deposition is once taken. Besides the occasional questions of the judge, the jury, and the counsel, propounded to the witnesses on a sudden, will sift out the truth much better than a formal set of interrogatories previously penned and settled: and the confronting of adverse witnesses is also another opportunity of obtaining a clear discovery, which can never be had upon any other method of trial.

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These are a few of the advantages attending this, the English, way of giving testimony, *ore tenus*. Which was also indeed familiar among the *ancient* Romans, as may be collected from Quintilian; who lays down very good instructions for examining and cross-examining witnesses *viva voce*.