UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,

Petitioner

v.

STRAGENT, LLC

Patent Owner

Case No. IPR2017-00676

U.S. Patent No. 8,209,705

Title: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR SHARING INFORMATION IN A DISTRIBUTED FRAMEWORK

PETITIONER'S MOTION TO EXCLUDE

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I. PRELIMINARY STATEMENT

Pursuant to this Board's Rules and the Federal Rules of Evidence ("FRE"), BMW moves to exclude at least paragraphs 16-28 and 37-103 of Stragent's Exhibit 2001 (Declaration of Jeffrey A. Miller).

In accordance with the Trial Practice Guide, BMW (a) identifies where in the record BMW's original objections were made, (b) identifies where in the record these exhibits were relied upon by Stragent, (c) addresses objections to exhibits in numerical order, and (d) explains the objections. 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012).

II. AT LEAST PARAGRAPHS 16-28 AND 37-103 OF EXHIBIT 2001 SHOULD BE EXCLUDED

Petitioner timely objected to Exhibit 2001 under FRE 702 and 37 C.F.R. § 42.65 as improper expert testimony, because "Dr. Miller's opinions . . . are not the product of reliable principles and methods reliably applied to the facts of the case." Paper 12 at 3. Stragent relies heavily on this objectionable testimony from Dr. Miller at pages 16-22 and 26-57 of its patent owner response (citing to the above-identified paragraphs of Ex. 2001).

Under FRE 702, an expert opinion must be the product of reliable principles and methods, and the expert must reliably apply the principles and methods. *See Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 597 (1993) ("Rules of

Evidence—especially Rule 702—do assign to the trial judge the task of ensuring that an expert's testimony both rests on a reliable foundation and is relevant to the task at hand."). Moreover, the proponent of the expert testimony bears the burden of establishing the reliability of the principles and methods applied by the expert. *Lewis v. CITGO Petroleum Corp.*, 561 F.3d 698, 705 (7th Cir. 2009) ("The proponent of the expert bears the burden of demonstrating that the expert's testimony would satisfy the *Daubert* standard."); *Dart v. Kitchens Bros. Mfg. Co.*, 253 F. App'x 395, 398 (5th Cir. 2007) (citing *Moore v. Ashland Chem. Inc.*, 151 F.3d 269, 276 (5th Cir. 1998) (*en banc*)). 37 C.F.R. § 42.65(a) additionally requires that "Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."

Here, paragraphs 16-28 and 37-103 of Exhibit 2001 are not the product of reliable principles and methods because both Dr. Miller's declaration (Ex. 2001) and his deposition (Ex. 1025) show that Dr. Miller applied a wrong claim construction standard, and misunderstood a key legal concept that impacts his opinions on obviousness. Neither Dr. Miller nor Stragent has established by a preponderance of evidence that Dr. Miller's used a proper claim construction standard, or a correct obviousness standard. Therefore, his opinions on claim construction and opinions resting on the construed terms should be excluded or given no weight under FRE 702 and 37 C.F.R. § 42.65(a).

A. Dr. Miller's Opinions on Claim Constructions and Opinions on Patentability Resting upon the Improper Claim Constructions Should be Excluded

Paragraphs 16-28 of Ex. 2001, containing Dr. Miller's opinions on claim constructions, should be excluded because they are the product of an incorrect claim construction standard. Dr. Miller should have applied the broadest reasonable interpretation ("BRI") to construe the claim terms. *See* 37 C.F.R. § 42.100(b). But he did not.

Dr. Miller's declaration spends 13 paragraphs opining on four different claim terms, yet it is completely silent regarding the claim construction standard applied. Ex. 2001, ¶¶16-28. Later at his deposition, Dr. Miller's testimony exposed that he did not apply the proper standard, or at least did not apply it correctly. *See* Ex. 1025, 29:2-30:23[1].

Dr. Miller was asked to identify the standard he used when construing the terms in the declaration. *Id*., 27:2-4. At first, he answered, "construing the claim terms is providing a definition of what the term is." *Id*., 27:9-11. Dr. Miller then said the standard is stated in his expert declaration, and when pressed to pinpoint, he specifically cited paragraph 16 of the declaration. *Id*., 29:2-30:23 ("Q: So Dr. Miller, it's your belief that paragraph 16 in your declaration in the 676 IPR states the standard for claim construction that you should adopt for construing the claim

[1] A format of page:line is used for Ex. 1025 throughout.

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