

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NATIONAL OILWELL VARCO, L.P.,
Petitioner,

v.

TECHNICAL INDUSTRIES, INC.,
Patent Owner.

Case IPR2017-00860
Case IPR2017-00910¹

Before THOMAS L. GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ The parties are not authorized to use this caption.

BACKGROUND

The patents in these two cases relate to inspection of pipes used in oil fields. In each of the proceedings, on April 12, 2018, Petitioner filed a paper captioned “Unopposed Motion for Leave to File a Motion to Strike the Expert Opinions of Technical’s William Emblom.” Paper 30.² Each motion is accompanied by an exhibit captioned “Petitioner’s Motion to Strike the Proposed Expert Opinions of Patent Owner Technical’s William Emblom.” Ex. 1036.

As is indicated by the captions of the papers, the motions seek to strike the testimony of one of Patent Owner’s technical experts, Dr. William Emblom. The motions allege Dr. Emblom “testified that he has no experience with pipe inspection, and further that his only experience with testing related to a ‘dune buggy’ and ‘channel section,’ not an oilfield pipe.” Ex. 1036, 2 (footnote omitted). Petitioner further alleges “[s]ince Emblom does not meet his own definition of a [person of ordinary skill] . . . Emblom cannot give opinions about the scope and content of the prior art.” *Id.* (footnote omitted). According to Petitioner, under Dr. Emblom’s own definition a person of ordinary skill would have had “a bachelor of science engineering degree *and* 2 – 3 years’ experience in the pipe inspection/testing industry. *Id.* (footnote omitted).

The Board requested a conference call with the parties to discuss the motions, and one was held on April 19, 2018. Judges Thomas Giannetti and Bryan Moore conducted the call. The parties were represented by counsel.

² Unless otherwise indicated, citations are to papers and exhibits in IPR2017-00860. Corresponding papers were filed also in IPR2017-00910.

DISCUSSION

The Board expressed concern that the motions were filed without authorization required by 37 C.F.R. § 42.20. The parties were reminded of their obligation to seek authorization before filing motions and cautioned that any further motions filed without authorization would be stricken.

After hearing from the Petitioner on the merits, the Board denied the motions. The motions seeks to exclude the testimony of a technical witness on the ground that the witness's background and experience do not match exactly the technology of the patents being challenged. That argument is unavailing. It is within our discretion to assign the appropriate weight to testimony offered by the witnesses. *See, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010).

Furthermore, there is no requirement of a perfect match between the expert's experience and the relevant field. *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010). In opposing the motion Patent Owner states Dr. Emblom teaches mechanical engineering and possesses expertise in finite element analysis relevant to the Assanelli reference. Paper 32, 1, 4–5. We determine that his testimony will assist us it in deciding these cases.

Petitioner's reliance on *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363 (Fed. Cir. 2008), is misplaced. That case involved technical testimony from a patent lawyer before a jury. Here, there is no jury, and Dr. Emblom is a professor of engineering, not a lawyer. Ex. 2008, ¶ 1. We therefore determine that Petitioner's arguments, at best, go to the weight of Dr. Emblom's testimony and are not a sufficient basis for excluding his testimony.

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In IPR2017-00910, Petitioner makes the additional argument that “Erbloom’s proposed opinions . . . should be stricken from the record because he . . . has not reviewed the ’138 patent.” IPR2017-00910 Ex. 1043, 3. Patent Owner responds that the specification of the ’138 patent is “identical” to a patent in the same family that was reviewed by Dr. Erbloom. Further, we understand that Patent Owner offers Dr. Erbloom’s opinions not as to specific claim language of the patents, but only for what a person of ordinary skill would understand. IPR2017-00910 Paper 32, 5–6. We, therefore, agree with Patent Owner that Dr. Erbloom’s testimony as to these matters should not be excluded.

It is, therefore,

ORDERED that Petitioner’s Motions to Strike the Proposed Expert Opinions of Patent Owner Technical’s William Erbloom are *denied*.

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