

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3M COMPANY, MERCK & CO., INC., and
MERCK SHARP & DOHME CORP.,
Petitioner,

v.

APTAR FRANCE SAS,
Patent Owner.

Case IPR2018-01055
Patent 9,370,631 B2

**PATENT OWNER’S OBJECTIONS TO EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64**

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(b)(1), the undersigned, on behalf of Aptar France SAS and AptarGroup, Inc. (collectively, “Patent Owner”), hereby submits the following objections to Exhibits 1002, 1032, and 1033 submitted with 3M Company, Merck & Co., Inc., and Merck Sharp & Dohme Corp.’s (collectively, “Petitioners”) Petition for *Inter Partes* Review dated May 10, 2018. Pursuant to 37 C.F.R. § 42.62, Patent Owner’s objections below apply the Federal Rules of Evidence (“F.R.E.”).

II. OBJECTIONS TO PETITIONERS’ EXHIBITS

A. Exhibit 1002 (Piper Declaration)

Patent Owner hereby objects to Petitioners’ Exhibit 1002, Expert Declaration of S. David Piper (“Piper Declaration”). Grounds for objection to the Piper Declaration include 37 C.F.R. § 42.61 (Admissibility of Evidence), F.R.E. 402, F.R.E. 403, and F.R.E. 702 and 703 (Improper Expert Testimony and Basis of Expert’s Testimony).

The Piper Declaration constitutes attorney argument and legal conclusions in the guise of factual expert opinion testimony and is improper under F.R.E. 602, 702, and 703. The arguments of counsel cannot take the place of evidence in the record (*In re Schulze*, 346 F.2d 600, 602 (C.C.P.A. 1965)), and Petitioners’ attempt to facilitate that by dressing those arguments as expert opinion, however thinly

supported, should not be permitted. The Piper Declaration contains conclusory statements that merely parrot Petitioners' legal arguments, which is not permissible expert testimony. *Krippelz v. Ford Motor Co.*, 667 F.3d 1261, 1269 (Fed. Cir. 2012) (“[T]he opinions of [Mr. Krippelz’ expert] are not a substitute for the actual [prior art] disclosure”). The Piper Declaration cannot substitute or supplement the actual disclosures of the alleged prior art.

Specifically, in Paragraphs 17, 20-22, 134, and 135, Mr. Piper makes uncorroborated statements that are not supported by any objective evidence and constitute improper expert testimony under F.R.E. 702 and 703. In Paragraphs 17 and 135, Mr. Piper testifies that he was asked to “design and build a dose indicator and, like others in the industry, . . . looked to the mechanism of a mechanical pen that converted axial motion into rotational motion.” Ex. 1002 at ¶ 17; *see also id.* at ¶135. Mr. Piper cites no evidence in support of his claim that he designed and built such a dose indicator or any evidence that its mechanisms converted axial motion into rotational motion.

In Paragraphs 20-22, Mr. Piper described that a POSA would have “adjusted the design, dimensions, and tolerances of the counter to ensure that the counter wheel would rotate before the medicine is expelled.” Ex. 1002 at ¶ 21. Mr. Piper recreates in hindsight the invention, citing only to references which are not asserted as grounds for invalidity in this proceeding. *Id.* at ¶¶ 20. Mr. Piper’s words cannot

serve as a substitute for disclosure in the prior art and are irrelevant under F.R.E. 402 and 403.

Mr. Piper also opines on what a POSA would or would not have done or understood with no evidentiary support. For example, Mr. Piper states that “[a] POSA would have routinely looked to other small, inexpensive mechanical devices when seeking to improve devices like Bason in such ways.” *Id.* at ¶ 135. Mr. Piper’s uncorroborated testimony cannot fill the gaps between the disclosures of the prior art and the invention described in the ’631 Patent.

B. Exhibit 1032 (Wimpenny)

Patent Owner hereby objects to Petitioners’ Exhibit 1032, U.S. Patent No. 7,090,662 (“Wimpenny”). Grounds for objection to Wimpenny include 37 C.F.R. § 42.61 (Admissibility of Evidence), F.R.E. 402, and F.R.E. 403.

Wimpenny is cited in the Petition for the proposition that “others working on the design and development of counting mechanisms for use in medical devices, including MDIs, looked to simple pen technology.” Petition at 4; *see also id.* at 54. However, Wimpenny was not filed until March 22, 2004 and, thus, is not probative of what a POSA would have known at the time of the invention in 2003. Wimpenny is therefore irrelevant under F.R.E. 402 and 403.

C. Exhibit 1033 (Campling)

Patent Owner hereby objects to Petitioners' Exhibit 1033, International Publication NO. WO 2007/045904 ("Campling"). Grounds for objection to Campling include 37 C.F.R. § 42.61 (Admissibility of Evidence), F.R.E. 402, and F.R.E. 403.

As for Wimpenny, Petitioners cite to Campling for their assertion that "others working on the design and development of counting mechanisms for use in medical devices, including MDIs, looked to simple pen technology." Petition at 4; *see also id.* at 54. Again, however, Campling was not filed until April 26, 2007 and, thus, is not probative of what a POSA would have known at the time of the invention in 2003. Campling is therefore irrelevant under F.R.E. 402 and 403.

These objections have been made within 10 business days from the November 8, 2018 institution of trial.

Respectfully submitted,

Patent Owner

Dated: November 26, 2018

By: /s/ Ashley N. Moore

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the foregoing was served electronically via e-mail on November 26, 2018, on the following counsel of record for Petitioners:

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Dated: November 26, 2018

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