

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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U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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 1055, 1056, 1057, 1058, 1061, and 1062 submitted with 3M Company, Merck & Co., Inc., and Merck Sharp & Dohme Corp.’s (collectively, “Petitioners”) Reply to Patent Owner’s Response dated May 13, 2019. 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. Exhibits 1055 and 1056

Patent Owner hereby objects to Petitioners’ Exhibits 1055 and 1056, which purport to be the May 9, 2018 Declaration of Charles E. Clemens in IPR 2018-01159, *West Phar, Svcs., Inc v. Sanofi-Aventis Deutschland GmbH* and the Excerpt of Transcript of Video Deposition of Charles E. Clemens, taken October 25, 2007, in *Novo NorDisk v. Sanofi-Aventis U.S. LLC, et al.*, No-3:07-cv-03206 (Dkt No. 233-25), respectively. Grounds for objection to these Exhibits include 37 C.F.R. § 42.61, F.R.E. 402, and F.R.E. 403.

Exhibits 1055 and 1056 reflect testimony from Mr. Clemens in unrelated matters that has been taken out of context. Specifically, Exhibit 1055 relates to Mr. Clemens’s testimony in an unrelated matter regarding a safety device for a pre-

filled syringe and injection device. Exhibit 1056 also relates to an unrelated matter regarding an injector device.

Mr. Clemens's testimony about what a person of ordinary skill in an entirely separate field of art might have known, done, or believed in the context of a different patent with different claim terms and asserted prior art is not relevant to any disputed issue in this matter. Any such testimony is more prejudicial than probative. FED. R. EVID. 402, 403.

B. Exhibit 1057 (Clemens Deposition Transcript)

Patent Owner hereby objects to Petitioners' Exhibit 1057, which purports to be the Deposition Transcript of Charles E. Clemens, taken April 24, 2019. Grounds for objection to Exhibit 1057 include that it is incomplete under F.R.E. 106 and that it is not authenticated under F.R.E. 901. The Clemens Deposition Transcript is incomplete because it does not include an errata sheet signed by Mr. Clemens. Patent Owner further objects to Exhibit 1057 as not authenticated because it does not include an errata sheet signed by Mr. Clemens. Accordingly, Petitioners have failed to establish the accuracy of the information found therein.

C. Exhibit 1058 (Piper Declaration)

Patent Owner hereby objects to Petitioners' Exhibit 1058, 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, F.R.E. 702 and 703 (Improper Expert Testimony and Basis of Expert's Testimony), and the PTAB Trial Practice Guide.

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 16, 17-19, 23, 25, and 28, 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 many instances, Mr. Piper opines on what a POSA would or would not have done or understood with no evidentiary support. For example, in Paragraph 16, Mr. Piper testifies that a POSA would have made various changes described in Reply Figure 1. In Paragraphs 17-19, Mr. Piper asserts that a POSA would have

made the various changes described in Reply Figure 2. In Paragraph 23, Mr. Piper asserts that a POSA “would have known how to connect teeth 7 and teeth 2 so that they interact.” In Paragraph 25, Mr. Piper asserts that a POSA would have known how to modify the combination of Bason and Allsop so that the dose values are visible to a user.” And in Paragraph 28, Mr. Piper cites to a nondescript instance in which he was “called upon to build a dose counter around 1998.” Mr. Piper recreates the invention in hindsight and imputes this knowledge to a POSA without offering any evidentiary support for his opinions. However, 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 impermissibly attempts to gap fill disclosure of claim elements that are not expressly or inherently present in the prior art and/or proposed obviousness combination. For example, in Paragraphs 6-10, Mr. Piper describes a “push-button cap” purportedly disclosed in Allsop, though, as described by Mr. Piper, such element is not expressly or inherently present in Allsop. In Paragraph 20, Mr. Piper describes a purported “snap-fit” between the cap and inhaler body that is not expressly or inherently present in the prior art. In Paragraph 23, Mr. Piper asserts that a POSA would have known how to connect teeth 7 and teeth 2 so that they interact, even though such interaction is not expressly or inherently present in the prior art. In Paragraph 25, Mr. Piper

describes that a POSA would have known to modify the device resulting from the Bason/Allsop combination to ensure that the numbers are visible to a user, even though such is not expressly or inherently present in the prior art. Such testimony cannot serve as a substitute for disclosure of any claim element that is not expressly or inherently present in the prior art and/or the proposed obviousness combination.

Lastly, Mr. Piper's new declaration includes new evidence that could have and should have been presented with the Petition and, thus, is objectionable. *See* Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39989 at 14 (August 13, 2018); *Adidas AG v. Nike, Inc.*, Case IPR2016-00922, 2018 WL 4056113, at *4 (Patent Tr. & App. Bd. Aug. 24, 2018). Specifically, Mr. Piper raises new evidence in Paragraphs 16 (including new Figure 1), Paragraphs 17-20 (including new Figure 2), and Paragraph 23 (describing that a POSA would have extended the diameter of ring 4 so that teeth 7 interact with teeth 2). All of the above evidence was improperly introduced for the first time in Petitioners' Reply and should be excluded.

D. Exhibits 1061 and 1062

Patent Owner hereby objects to Petitioners' Exhibit 1061, which purports to be Jill Matzke, Chapter 16—Dfe for Engineering Managers: Making it Count—Dfe and the Bottom Line, GREEN ELECTRONICS/GREEN BOTTOM LINE

(2000). Patent Owner also objects to Petitioners' Exhibit 1062, which purports to be C. Manoharan, et. al., An Expert System for Design for Robotic Assembly, 1 J. INTELL. MANUF. 17 (1990). Grounds for objection include 37 C.F.R. § 42.61 (Admissibility of Evidence), 37 C.F.R. § 42.23(b), F.R.E. 402, F.R.E. 403, and the PTAB Trial Practice Guide.

Both Exhibits 1061 and 1062 constitute new evidence that could have and should have been presented with the Petition and, thus, is objectionable. *See* Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39989 at 14 (August 13, 2018); *Adidas AG v. Nike, Inc.*, Case IPR2016-00922, 2018 WL 4056113, at *4 (Patent Tr. & App. Bd. Aug. 24, 2018).

These objections have been made within 5 business days from the filing of Petitioners' Reply.

Respectfully submitted,

Patent Owner

Dated: May 20, 2019

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 May 20, 2019, on the following counsel of record for Petitioners:

Steven D. Maslowski
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