

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PERMIAN GLOBAL INC., AND
MANTICORE FUELS, LLC
Petitioners,

v.

FUEL AUTOMATION STATION, LLC,
Patent Owner.

Case IPR2023-01237

Patent No. 9,586,805

PATENT OWNER'S MOTION TO EXCLUDE

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Exhibit	Description
Ex. 2004	Expert Report of John Roberts
Ex. 2005	FAS Virtual Marking page (https://fluidautomationstation.com/patents/)
Ex. 2006	US Patent 2,603,312
Ex. 2007	US Patent 1,829,173
Ex. 2008	US Patent 3,196,982
Ex. 2009	US Patent 3,430,730
Ex. 2010	US Patent 3,216,527
Ex. 2011	US Patent 2,425,848
Ex. 2012	Transcript of Deposition of Robert Durham
Ex. 2013	ASTM D975 Standard Specification for Diesel Fuel Oils
Ex. 2014	Intentionally Omitted
Ex. 2015	AFLAS TM Reg Serial 73310396
Ex. 2016	Rubber Technology, “TFE/P (Aflas®)/FEPM rubber quality” (https://web.archive.org/web/20160404102358/http://rubbertechnology.info:80/en/-rubber-compounds/tfep-aflasr--fepm-rubber-quality/)
Ex. 2017	AFLAS technical brochure (http://web.archive.org/web/20161221181920/http://agcchem.com/component/jdownloads/finish/9-aflas-fluoroelastomers/7-aflas-fluoroelastomers-technical-brochure?Itemid=0)
Ex. 2018	Intentionally Omitted
Ex. 2019	Brent Oil/Fuel Hose 3106 (http://web.archive.org/web/20160713193942/http://www.desihose.com/viewproduct.aspx?pid=192)
Ex. 2020	Atlas Oil’s Rick Shock Named “Industry Leader” At Texas Oil and Gas Awards
Ex. 2021	<i>FAS v. Comanche Gas Solutions</i> Complaint
Ex. 2022	<i>FAS v. Permian Global, et al.</i> Complaint
Ex. 2023	Ortoleva Declaration

Ex. 2024	Rodger's CV
Ex. 2025	Intelligencer article (digital print The Intelligencer, January 31, 2020)
Ex. 2026	Intentionally Omitted
Ex. 2027	Intentionally Omitted
Ex. 2028	Waterman, "Better Safe Than Sorry"
Ex. 2029	Information Disclosure Statement
Ex. 2030	Transcript of Supplemental Deposition of Robert Durham

I. INTRODUCTION

Patent Owner respectfully moves to exclude the redirect portions of Dr. Robert A. Durham's testimony in both his May 9, 2024, and September 25, 2024, depositions.¹ This testimony was impermissibly coached by Petitioners' counsel through private, off-the-record discussions that occurred during strategically timed breaks taken immediately before redirect examination. As detailed below, Dr. Durham's own admissions reveal that these discussions involved substantive issues directly related to his testimony, in direct violation of established rules prohibiting witness coaching.

These off-the-record consultations contravene the fact-finding purpose of a deposition, which requires testimony that is untainted by suggestions from counsel. Here, Petitioners' counsel not only sought breaks directly before redirect to confer with Dr. Durham but also requested them shortly after prior breaks had already been taken, underscoring a coordinated attempt to influence his responses in anticipation of the redirect examination.

Accordingly, and for the reasons set forth below, Patent Owner respectfully requests that the Board exclude Dr. Durham's coached testimony from consideration.

¹ The portions sought to be excluded are specifically Exhibit 2012 at 128:13-134-20 and Exhibit 2030 at 90:25-96:20.

II. LEGAL BACKGROUND

A party wishing to challenge the admissibility of deposition evidence must make an objection during the deposition. 37 C.F.R. § 42.64(a). Objections may be preserved only by filing a motion to exclude the evidence. 37 C.F.R. § 42.64(c).

Per the testimony guidelines in the Patent Trial and Appeal Board Consolidated Trial Practice Guide, consistent with the policy expressed in Rule 1 of the Federal Rules of Civil Procedure, and corresponding 37 C.F.R. § 42.1(b), coaching of witnesses in proceedings before the Board is strictly prohibited.

III. FACTUAL BACKGROUND

1. Patent Owner took the deposition of Robert A. Durham, PhD on Thursday May 9, 2024 at the office of Baker Botts in Houston, TX. [EX. 2012]

2. A recess was taken during cross-examination from 12:00 p.m. to 12:51 p.m. CDT. [EX. 2012, 119:1-2]

3. Patent Owner's counsel finished cross-examination shortly afterward at 1:01 p.m., at which point Petitioners' counsel requested another break. During the break, Petitioner's counsel and Dr. Durham left the deposition room together to go to a breakout room. [EX. 2012, 128:8-9]

4. Upon return from this break, Petitioners' counsel conducted a redirect examination of Dr. Durham. [EX. 2012, 128:13-134:20]

5. After redirect, the witness was passed back to counsel for Patent Owner for recross-examination. During re-cross, Dr. Durham admitted that he spoke to counsel about his testimony during the last break. [EX. 2012, 135:16-17]

6. Dr. Durham testified that Petitioners' counsel "asked [him] some questions, and [he] gave her the same or very similar answers that [he] gave here, sure." The questions "were on the same topics." [EX. 2012, 135:25-136:25]

7. When asked shortly after the break and redirect testimony, Dr. Durham claimed he did not know whether the questions Petitioners' counsel asked him during the break were identical or not to the questions asked during redirect. [EX. 2012, 136:22-25]

8. Patent Owner took the deposition of Robert A Durham, PhD again on Wednesday, September 25, 2024 via remote Zoom, based on Dr. Durham's supplemental declaration. [EX. 2030]

9. A recess was taken during cross-examination from 1:54 p.m. to 2:04 p.m. [EX. 2030, 89:23-24]

10. Patent Owner's counsel finished cross-examination one minute after returning from break (at 2:05 p.m.), at which point Petitioners' counsel requested a break. During the break, Petitioner's counsel and Dr. Durham left the deposition room together. [EX. 2030: 90-20-23]

11. Upon return, Petitioners' counsel conducted a redirect examination of Dr. Durham. [EX. 2030: 90:25-96:20]

12. During re-cross examination, Dr. Durham admitted that he spoke to counsel during the last break about the substance of his testimony. [V: 96:22-25]

13. Dr. Durham admitted that he spoke to counsel about the Coxreels reference during the last break. [EX. 2030: 97:1-3]

14. Dr. Durham admitted that the substance of the answers that he gave were part of the discussion with counsel at the break. [EX. 2030: 97:18-23]

15. When asked shortly after the break and redirect testimony, Dr. Durham claimed he could not recall whether the questions Petitioners' counsel asked him during the break were identical or not to the questions asked during redirect. [EX. 2030: 97:15-16]

16. After finding out about Dr. Durham's private discussions with counsel before redirect, Patent Owner's counsel made an objection during both depositions. [EX 2012, 137:1-3; EX. 2030, 98:4-9]

IV. ANALYSIS

For at least the reasons set forth below, the Board should exclude the redirect portions of Dr. Durham's first and second deposition testimony (EX 2012, EX. 2030) as being substantially more prejudicial than probative under FRE 403.

During both depositions (May 9, 2024, and September 25, 2024), Dr. Durham engaged in discussions with Petitioners' counsel during breaks taken between cross-examination and redirect. In both instances, Dr. Durham confirmed that the conversations involved topics directly related to his redirect testimony, constituting coaching attempts. These breaks created an opportunity for potential influence by counsel on Dr. Durham's answers, which violates the Board's Testimony Guidelines prohibiting witness coaching at any point in the proceedings. The Testimony Guidelines expressly provide that "coaching of witnesses in proceedings before the Board [is] strictly prohibited," with no exceptions for any periods during deposition.

The timing and frequency of breaks requested by Petitioners' counsel in both depositions support an inference of intentional witness coaching. In each instance, Petitioners' counsel requested a break immediately after Patent Owner's counsel had completed cross-examination and shortly after a prior break had already been taken. In the first deposition, a recess was taken during cross examination from 12:00 p.m. to 12:51 p.m., and Patent Owner's counsel completed cross-examination ten minutes after return from recess, at which point Petitioners' counsel requested another break. In the second deposition, a recess was taken during cross examination from 1:54 p.m. to 2:04 p.m, and Patent Owner's counsel completed cross-examination one minute after return from recess, at which point Petitioners' counsel requested another break. This repeated pattern suggests a calculated tactic designed to influence Dr.

Durham's responses before redirect examination, rather than a legitimate need for a pause.

Still further, coaching can be inferred from Dr. Durham's changing of his responses given during cross-examination. For example, as background, in contradiction to numerous instances in Petitioner's petition and Dr. Durham's original declaration, Petitioner argued on reply that it was only relying on teachings from the Coxreels reference rather than an incorporation of a Coxreels reel into Van Vliet. Relatedly, the following exchange regarding Dr. Durham's positions on the Coxreels reference occurred during cross examination:

Q. Now, in your testimony in these IPRs, you haven't identified a specific Coxreels reel that you are proposing would be combined with the Van Vliet reference; correct?

A. Correct, it's the teachings of Coxreels that I'm relying on, not a particular model, just the overall teachings, particularly the teachings of a fluid flow path going through the spindle of the reel and then onto the hose.

Q. Okay, so you're not proposing in this matter that a specific Coxreels reel would be incorporated into Van Vliet's mobile fuel delivery system?

A. Correct. It's the teachings of Coxreels that are important.

Q. Okay, it's not your position that it would have been obvious for a POSITA to incorporate a specific Coxreels reel into Van Vliet's mobile fuel delivery system?

A. Right.

[EX. 2030, 35:5-23]. Realizing this testimony was inconsistent with Patent Owner's grounds for rejection and Dr. Durham's original declaration, Patent Owner's counsel requested a break at the conclusion of cross examination, even though the parties

returned from a break a minute before cross-examination concluded. Then, on redirect, after conferring with counsel privately in a break room, Dr. Durham testified:

A. Well, I -- I understood counsel's question to be asking is there any specific model of the 1125 series that would be uniquely applicable to Van Vliet; in other words, only this one model, are you picking one model out of the 20 or so in Coxreels, and my answer is, no, any of these could have been valuable and could have been dropped in.

[EX. 2030, 95:14-20]. That is, Dr. Durham went from testifying on cross that he was relying on the teachings of Coxreels rather than a particular model to testifying on redirect that any specific model of Coxreels could be dropped into Van Vliet. This change in testimony was clearly influenced by the private conversation with counsel during the requested break.

A deposition is a truth-seeking exercise meant to reflect the witness's unaltered knowledge and recollection, not guided responses shaped by attorney input. By discussing testimony topics with counsel, Dr. Durham's responses were likely influenced, which compromises the integrity of his statements and the credibility of the deposition. FRE 403 states that testimony should be excluded if its probative value is substantially outweighed by its prejudicial impact. Dr. Durham's coached responses during redirect are prejudicial, undermining the fairness and credibility of his testimony.

Patent Owner recognizes that *Focal Therapeutics, Inc. v. Senorx, Inc.*, IPR2014-00116, Paper 19, pp. 2-3 (P.T.A.B. July 21, 2014) holds that counsel is “permitted to confer with the witness before redirect examination begins.” However, the *Focal Therapeutics* opinion should not be construed as a blanket allowance for all conduct, including coaching, in the intervening time between cross-examination and re-direct examination.

V. CONCLUSION

For the foregoing reasons, Patent Owner’s Motion to Exclude should be granted.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

Dated: November 5, 2024

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on November 5, 2024, a true and correct copy of the foregoing document was served electronically via e-mail in its entirety on counsel identified below by Petitioner for service at

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