

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 No. IPR2023-01237
Patent 9,586,805

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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EX1006	U.S. Patent Pub. No. 2018/0057348 to Lowrie (“ <i>Lowrie</i> ”)
EX1007	<u>AFD Onsite Refueling</u> , http://web.archive.org/web/20150922012312/https://www.afdpetroleum.com/fuel/onsite_refuelling (Sept. 22, 2015) (“ <i>AFD</i> ”)
EX1008	<u>Coxreels 1125 Series Hand Crank and Motorized Hose Reels</u> , https://web.archive.org/web/20140408035634/http://www.Coxreels.com/products/hand-crank/1125-series (Apr. 08, 2014) (“ <i>Coxreels</i> ”)
EX1009	<u>Federal Size Regulations for Commercial Motor Vehicles</u> , https://web.archive.org/web/20110716103458/https://ops.fhwa.dot.gov/freight/publications/size_regs_final_rpt/size_regs_final_rpt.pdf (Jul. 16, 2011)
EX1010	Claim Listing
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EX1016	Michael Morton, “Unlocking the Earth: A Short History of Hydraulic Fracturing,” <i>GEO ExPro</i> , Vol. 10, No. 6, December 2013 (https://geoexpro.com/unlocking-the-earth-a-short-history-of-hydraulic-fracturing/) (last accessed July 17, 2023).
EX1017	Frac Shack “Technology” Page, archived on July 11, 2015 (https://web.archive.org/web/20150711214455/http://www.fracshack.com/technology) (“ <i>Frack Shack I</i> ”)
EX1018	Intentionally Omitted
EX1019	B.A. Wells and K.L. Wells. “Shooters – A “Fracking” History.” American Oil & Gas Historical Society, (https://aoghs.org/technology/hydraulic-fracturing) (last accessed

	July 17, 2023).
EX1020	Intentionally Omitted
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EX1022	schematic, Vocabulary.com, https://www.vocabulary.com/dictionary/schematic (accessed June 29, 2023).
EX1023	Bourgoyne, A. T., Jr., K. K. Millheim, M. E. Chenevert and F. S. Young, Jr. (1986). <u>Applied Drilling Engineering</u> , Society of Petroleum Engineers
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I. INTRODUCTION

Patent Owner's ("PO's") Motion to Exclude ("MTE")¹ the redirect portions of Dr. Robert A. Durham's testimony from both his May 9, 2024, and September 25, 2024, depositions is meritless and should be denied.

The Board has long held that counsel defending a witness during deposition is permitted to confer with the witness during a break before redirect examination begins. *See, e.g., Focal Therapeutics, Inc. v. Senorx, Inc.*, IPR2014-00116 at Paper 19, 2-3 (P.T.A.B. July 21, 2014) (precedential). Despite an apparent awareness of this precedential ruling (*see* MTE, 8), PO attempts to circumvent it by accusing Petitioners' counsel of improperly coaching Dr. Durham with no evidence to support its accusation. Instead, PO asks the Board to *infer* that improper witness coaching occurred based solely on the timing of breaks and an apparent misinterpretation of Dr. Durham's testimony. However, the timing of breaks during a deposition alone cannot support such an inference. Further, despite PO's interpretation to the contrary, Dr. Durham's testimony is consistent—including his cross-examination testimony, redirect testimony, and his declarations—and thus likewise fails to support PO's argument. PO has provided *no evidence*, circumstantial or otherwise,

¹ PO's MTE is Paper 31.

that Petitioners' counsel improperly coached Dr. Durham during either deposition, and thus Dr. Durham's testimony should not be excluded.

II. ANALYSIS

PO claims that Dr. Durham's redirect testimony should be excluded under Federal Rules of Evidence ("FRE") 403 as being substantially more prejudicial than probative.² See Paper 31, 4. As movant, PO has the burden of showing that the testimony they seek to exclude meets this threshold under FRE 403. 37 C.F.R. § 42.20(c). PO has not met its burden.

A. Conferring With a Witness After the Conclusion of Cross Examination is Expressly Permitted by *Focal Therapeutics*.

As an initial matter, *Focal Therapeutics* holds that "[t]he prohibition of conferring with the witness ends once cross-examination concludes" and "[t]he prohibition does not exist . . . during the time frame between [the] conclusion of cross-examination and start of re-cross." *Focal Therapeutics*, Paper 19, 3. Counsel is "permitted to confer with the witness before redirect examination begins." *Id.* This is a settled principle of procedure in *inter partes* review proceedings. See, e.g., *Organik Kimya AS v. Rohm and Haas Co.*, IPR2014-00185, Paper 25, 2–3 (P.T.A.B. Aug. 21, 2014) (stating that, "[t]he prohibition of conferring with the witness...does

² In particular, PO seeks to exclude the testimony at Exhibit 2012 at 128:13-134:20 and Exhibit 2030 at 90:25-96:20. See MTE at 1.

not exist...during the time frame between [the] conclusion of cross-examination and the start of re-cross”); *Unified Pats. Inc. v. Pure Data Sys. LLC*, IPR2019-00484, Paper 7, 4 (P.T.A.B. Aug. 1, 2019) (stating that, “although counsel may not confer with a witness during cross-examination, counsel may confer with a witness after cross-examination has concluded and before redirect begins”). Thus, Petitioners’ counsel’s conferences with Dr. Durham were expressly permitted under PTAB precedent.

B. Dr. Durham’s Redirect Testimony from the May 9, 2024 Deposition Should Not Be Excluded.

PO accuses Petitioners’ counsel of improper coaching at the May 9 deposition based only on 1) Dr. Durham’s having spoken to Petitioners’ counsel during the post-cross-examination break about topics and questions similar to those addressed in his redirect testimony, and 2) PO’s view that Petitioners’ counsel requested that break too quickly with respect to a previous recess. Paper 31, 5. As to the former, by PO’s logic, any discussion with Dr. Durham about the substance of his redirect testimony during a post-cross-examination break would constitute improper coaching. *See id.* (“Dr. Durham confirmed that the conversations involved topics directly related to his redirect testimony, constituting improper coaching attempts.”). But that cannot be, since *Focal Therapeutics* expressly permits discussions on these topics. *See Focal Therapeutics*, Paper 19, 2 (“Petitioner’s

counsel initiated a private conference with his witness *to discuss his redirect testimony.*” (emphasis added)).

Moreover, the “timing and frequency of breaks” is not enough to “support an inference of intentional witness coaching” as alleged by PO. The Board’s ruling in *Cisco Sys., Inc. v. Centripetal Networks, Inc.* is instructive. IPR2018-01454, (P.T.A.B. Mar. 5, 2020). With similar facts relating to the timing of breaks taken during a deposition, the Board denied a motion to exclude redirect testimony filed by the patent owner. *Id.* at Paper 33, 43. Like here, the petitioner in that case requested a recess between the cross examination of its witness and redirect. *Id.* at Paper 25, 5-6. Also like here, that recess followed a lunch break that occurred prior to the conclusion of the cross examination. *Id.* at 5. In *Cisco*, the time between the requested recess before the redirect and the conclusion of the preceding lunch break was only 3 minutes—compared with 10 minutes in this case. *Id.*

In *Cisco*, patent owner moved to exclude the redirect testimony of the petitioner’s expert alleging “it [was] the result of improper witness coaching.” *Id.* at 6. In its motion, patent owner described the timing of the breaks discussed above and argued that “because the recess at issue was taken shortly after an hour-long lunch recess had already occurred, there is circumstantial evidence that Petitioner’s counsel and Dr. Reddy did not use the recess simply as a rest break, but rather to discuss the substance of Dr. Reddy’s cross-examination testimony and re-direct

examination to come.” *Id.* at 7. The Board in *Cisco* denied the patent owner’s motion in its final written decision stating, “we are not persuaded that redirect testimony is substantially more prejudicial than probative under FRE 403.” *Id.* at Paper 33, 43.

Indeed, the patent owner in *Cisco* alleged **additional** facts—not present in this case—to support an inference of coaching and the Board still denied the motion. For example, in *Cisco*, petitioner’s counsel “instructed the witness not to answer [patent owner’s] questions related to the substance of the discussions that occurred during the recess.” *Id.* at Paper 25, 7. Unlike in *Cisco*, here, Petitioners’ counsel **did not object** to PO asking Dr. Durham about what was discussed during the breaks at issue. PO in fact did ask Dr. Durham several questions about his conference with Petitioners’ counsel during the breaks, and Dr. Durham answered every question that PO asked. *See e.g.*, EX2012, 134:24-137:17; EX2030, 96:23-98:3. Dr. Durham’s answers do not indicate that he was improperly coached, and PO does not argue otherwise. Particularly in view of PO’s burden of proof, the Board cannot infer that any improper coaching occurred when PO had every opportunity to discover evidence of coaching and failed to do so.

C. Dr. Durham’s Redirect Testimony from the September 25, 2024 Deposition Should Not be Excluded.

1. Timing of breaks during a deposition does not support an inference of witness coaching.

Like the May 9 redirect testimony discussed above, PO argues that the “timing and frequency of breaks requested by Petitioners’ counsel” also supports an inference of improper witness coaching at the September 25 deposition. Paper 31, 5. For at least the same reasons discussed above in Section II.B, these facts are insufficient to support an inference of improper witness coaching.

2. Dr. Durham did not change his responses.

For the September 25 redirect testimony, PO also alleges that “coaching can be inferred from Dr. Durham’s changing of his responses given during cross-examination.” Paper 31, 6. However PO is wrong at least because the singular “example” of redirect testimony PO cites merely shows Dr. Durham clarifying his understanding of PO’s prior questions and reiterating what he said in his original declaration—not a retreat from his prior opinions. In the MTE, PO includes only the allegedly-contradictory *answer* from Dr. Durham’s redirect. But the full exchange makes clear Dr. Durham’s opinions and how they relate both to his testimony on cross and to his declaration.

Q. Now, directing you to the next paragraph, paragraph 150 of [Deposition Exhibit 5] we’re looking at, if you could just read the first sentence there. Read it slowly so the court reporter can get it. Sorry.

A. “It would have been obvious to a POSITA to use the specific reel described in Coxreels and the system of Van Vliet.”

Q. Is that your testimony in these proceedings?

A. Yes, a POSITA could have taken any of the 1125 series reels and, depending on the particular application, use those with the system of Van Vliet.

Q. Do you recall your testimony earlier today when patent owner’s counsel was asking you and asked that you're not proposing in this matter that a specific Coxreels reel would be incorporated into Van Vliet’s mobile fuel delivery system. Do you recall that testimony?

A. Yes.

Q. And how does that relate to what you said here in your declaration?

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.

Q. So your testimony, as stated there in paragraph 150, do you stand by that testimony?

A. Yes, of course.

EX2030, 94:15-95:23.

PO would prefer to ignore the full context Dr. Durham gave on re-direct so that it can mischaracterize his testimony without obstacle. For example, in its Surreply for IPR2023-01236, PO argues that Dr. Durham’s cross-examination

answer “contradicts” testimony in his original declaration. IPR2023-01236, Paper 30, 6-7 (citing EX2047 at 35:5-23). However, the Surreply selectively quotes Dr. Durham’s cross-examination testimony and fails to cite or even acknowledge Dr. Durham’s redirect testimony that, as shown above, explains how his testimony supports and relates to his original declaration. Notably, when PO solicited the purportedly-contradictory testimony on cross-examination, PO’s counsel had not even given Dr. Durham a copy of his original declaration to review.³ Far from using Dr. Durham’s deposition as “a truth-seeking exercise”, PO’s “gotcha” tactics would make Dr. Durham’s deposition a memory test about his lengthy declarations in 3 different IPRs. To the contrary, PO should not be allowed to argue that Dr. Durham contradicted his original declaration while excluding his clarified testimony once he was permitted to refresh his memory with the declaration.

Indeed, the full context of PO’s earlier cross-examination (*e.g.*, the testimony *immediately* before the purportedly-contradictory testimony referenced in the MTE) supports exactly what Dr. Durham clarified on redirect—that he understood PO’s question as related to specific models of reels from *Coxreels*:

³ Dr. Durham’s original declaration (Exhibit 5 to the deposition, which PO failed to include in EX2030 but which is attached as EX1059 here) was first provided to Dr. Durham at the beginning of his redirect testimony. *See* EX2030, 91:24 – 93:6.

Q. So Dr. Durham, which *models* of the Coxreels 1125 series reel have nitrile seals?

A. Those *models* that are not 1 inch I.D.

Q. And 1 inch I.D. would be -- if you look at the *list of the model numbers* in Coxreels, when you say 1 inch I.D., you're referring to the measurement listed in the fourth column there?

A. Yes, sir, the one marked I.D.

Q. Well, there's another I.D. --

A. Oh, well --

Q. I just want to make sure that --

A. Well, the same. I mean, the optional capacity -- well, okay, *you're talking about model numbers*, yes, it's the *model numbers* from that fourth column capacity, not the optional capacity.

Q. So anything that doesn't have 1 inch in the fourth column here would have a nitrile seal?

A. Yes, that's the way I understand a POSITA would understand Coxreels to state. It's a bad way to put it. It's how a POSITA would read Coxreels.

EX2030, 34:10-35:4 (emphasis added); *compare id.* at 95:12-20 (Dr. Durham describing that he "understood [PO's] counsel's question to be asking is there any specific model of the 1125 series that would be uniquely applicable to Van Vliet."). Far from any improper coaching, this context confirms how Dr. Durham understood PO's subsequent questions and why he later clarified, on redirect, to remove any ambiguity. Particularly in view of this detailed context, the Board should evaluate

all of Dr. Durham's testimony when considering the merits of the IPR, including the redirect testimony, and doing so would not unfairly prejudice PO.

III. CONCLUSION

For the foregoing reasons, PO's MTE should be denied in its entirety.

Respectfully submitted,
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CERTIFICATE OF SERVICE

The undersigned hereby certifies on this 12th day of November, 2024,
**PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO
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Respectfully submitted,
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