

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAUSCH & LOMB INCORPORATED,
Petitioner,

v.

ZEAVISION, LLC,
Patent Owner.

Case IPR2022-00089
Patent 10,307,384 B2

Before ZHENYU YANG, TINA E. HULSE, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

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

A conference call was held on January 5, 2023, among counsel for Petitioner, counsel for Patent Owner, and Judges Yang, Hulse, and Pollock.

On December 20, 2022, we received an e-mail from Petitioner indicating that the parties jointly requested to expunge Exhibit 2006, which Patent Owner filed with its Sur-reply (Paper 24). Ex. 3003. Patent Owner then requested permission to file a Motion Requesting Leave to Submit Exhibit 2006, and Petitioner indicated that it opposes Patent Owner's request. *Id.*

At the center of the dispute is Exhibit 2006, which appears to be a timeline of dates and citations to references that Patent Owner's expert, Dr. C. Kathleen Dorey, purportedly considered for her expert declaration. Patent Owner's request to submit Exhibit 2006 appears to be in response to Petitioner's Reply, which challenges the credibility of Dr. Dorey's declaration, because it does not cite any scientific literature or evidence for support. *See* Paper 20 at 14–16.

As an initial matter, we grant the parties' joint request to expunge Exhibit 2006. The question remains, however, whether Patent Owner has shown good cause for authorization to file its motion for leave to submit Exhibit 2006. We find Patent Owner has not made that showing.

During the call, Patent Owner noted that it recognized that filing Exhibit 2006 with its Sur-reply without leave from the Board was contrary to our rules. *See* 37 C.F.R. § 42.123. Patent Owner argued, however, that good cause exists to file its motion for leave to file Exhibit 2006 because although Dr. Dorey brought the timeline to her cross-examination and referred to it in her testimony, the timeline was not marked as an exhibit.

Patent Owner further argued that it did not know Petitioner would object to its expert testimony as unsupported until Petitioner's Reply, and the only opportunity to submit Exhibit 2006 is with Patent Owner's Sur-reply.

In response, Petitioner argued that Patent Owner should have been aware of Exhibit 2006 as of July 2022, when it submitted Dr. Dorey's declaration. Petitioner also cited 37 C.F.R. § 42.65(a), which states: "Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight." Petitioner also argued that granting Patent Owner's request would be prejudicial, as the hearing is less than one month away, and admitting Exhibit 2006 would require further motion practice, more expert depositions, and a sur-sur-reply. As such, Petitioner argued it would be against the interests of justice to grant Patent Owner's request.

Under the facts and circumstances of this case, we are not persuaded that good cause exists to authorize Patent Owner's motion. The oral hearing in this proceeding is in four weeks (which is two weeks after the originally scheduled hearing date). Paper 22. There is not enough time in the current schedule to brief the issue, prepare and enter a decision on the motion, and then, if the motion were granted, re-open expert discovery and substantive briefing to give Petitioner a fair opportunity to address the exhibit. Thus, granting Patent Owner's request would likely delay the proceeding and would result in increased cost to the parties, all of which go against our mandate to "secure the just, speedy, and inexpensive resolution of every proceeding." *See* 37 C.F.R. § 42.1(b). Moreover, even if we were to admit Exhibit 2006, it is questionable how helpful it would be to Patent Owner

given the underlying references are not in the record for Petitioner (or the panel) to evaluate Dr. Dorey's opinions.

We are also not persuaded that this situation could not have been avoided. Our rules explicitly state that “[e]xpert testimony must disclose the underlying facts or data on which the opinion is based.” *See* 37 C.F.R. § 42.65(a). Furthermore, our Consolidated Trial Practice Guide¹ (“CTPG”) cites that rule and emphasizes that “[expert] testimony must be based on sufficient facts and data. Fed. R. Evid. 702(b). ‘Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.’ 37 C.F.R. § 42.65(a).” CTPG 35.

The CTPG then reiterates that principle when providing guidance on Petitions and Motions Practice:

4. Testimony Must Disclose Underlying Facts or Data: The Board expects that most petitions and motions will rely upon affidavits of experts. Affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based. *See* Fed. R. Evid. 705; 37 C.F.R. § 42.65. Opinions expressed without disclosing the underlying facts or data may be given little or no weight. *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to credit unsupported assertions of an expert witness).

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Id. at 40–41. Counsel practicing before the PTAB are expected to read, understand, and follow our rules.² Although Dr. Dorey has apparently testified as an expert in prior PTAB proceedings, relying on her experience and expertise is not an excuse to disregard our rules.

Having considered the parties’ respective arguments, we find Patent Owner has offered no reasonable explanation for why Exhibit 2006 (or the information in it) could not have been submitted earlier. We, therefore, find Patent Owner has not shown good cause exists to authorize Patent Owner’s Motion for Leave to Submit Exhibit 2006.

ORDER

It is

ORDERED that the parties’ joint request to expunge Exhibit 2006 is *granted*; and

FURTHER ORDERED that Patent Owner’s request for authorization to file a Motion for Leave to Submit Exhibit 2006 is *denied*.

² We note that our rules on expert testimony are not unique to PTAB practice, as they are in line with the Federal Rules of Civil Procedure. *See* Fed. R. Civ. P. 26(a)(2)(B) (requiring expert reports to contain “the facts or data considered by the witness in forming [the opinions]”).

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