

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. LA CV19-06024 JAK (PLAx)

Date October 20, 2021

Title RSA Protective Technologies, LLC v. Delta Scientific Corp.

Present: The Honorable JOHN A. KRONSTADT, UNITED STATES DISTRICT JUDGE

T. Jackson

Not Reported

Deputy Clerk

Court Reporter / Recorder

Attorneys Present for Plaintiffs:

Attorneys Present for Defendants:

Not Present

Not Present

Proceedings: IN CHAMBERS ORDER ON PLAINTIFF RSA’S MOTION FOR PARTIAL SUMMARY JUDGMENT AS TO DAMAGES AND MOTION TO EXCLUDE EXPERT DAMAGES UNDER *DAUBERT* (DKT. 96); RSA’S MOTION TO EXCLUDE EXPERT OPINION OF DR. AZIM ESKANDARIAN (DKT. 98); RSA’S MOTION TO STRIKE IMPROPER EXPERT TESTIMONY (DKT. 144).

I. Introduction

RSA Protective Technologies, LLC (“Plaintiff” or “RSA”) brought this action against Delta Scientific Corporation (“Defendant” or “Delta”) alleging infringement of U.S. Patent No. 8,215,865 (“the ’865 Patent”). Complaint, Dkt. 1. The ’865 Patent relates to a shallow-mount bollard system that protects buildings by preventing them from being rammed by vehicles. Plaintiff has filed a motion for partial summary judgment as to damages and to exclude the expert testimony of Dr. Luna. Dkt. 96 (redacted); Dkt. 104-1 (sealed). Defendant opposed the motion. Dkt. 116 (redacted); Dkt. 131-2 (sealed). Plaintiff replied. Dkt. 142 (redacted); Dkt. 134-2 (sealed).

Plaintiff also moved to exclude the expert testimony of Dr. Eskandarian. Dkt. 98. Defendant opposed the motion. Dkt. 118. Plaintiff replied. Dkt. 139. Finally, Plaintiff has moved to strike improper expert testimony. Dkt. 144 (redacted); Dkt. 134-4 (sealed). Defendant opposed the motion. Dkt. 158 (redacted); Dkt. 163 (sealed).¹

It was determined that these motions are appropriate for decision without oral argument. See Fed. R. Civ. P. 78; Local Rule 7-15. For the reasons stated in this Order, Plaintiff’s Motion to Exclude Expert Testimony Under *Daubert* is **GRANTED**; Plaintiff’s Motion for Partial Summary Judgment as to Damages is **DENIED**; Plaintiff’s Motion to Exclude the Expert Opinion of Dr. Eskandarian is **DENIED**; and Plaintiff’s Motion to Strike Improper Expert Testimony is **GRANTED-IN-PART** and **DENIED-IN-PART**.

II. Background

The ’865 Patent, which issued on July 10, 2012, claims priority from U.S. Patent No. 7,699,558, which in turn claims the benefit of six provisional patent applications filed in 2004 and 2005. See ’865 Patent at

¹ The parties have filed a Joint Stipulation stating that no portion of the Order at Dkt. 170 should remain sealed. See Dkt. 175. Therefore, this Order is now filed unredacted.

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7:7–37. The claimed bollard system in the '865 Patent, “requires very little or no excavation for the base of the bollard system,” which “can be partially or fully assembled prior to bringing it to the installation site.” *Id.* The system “includes one or more bollards secured to a shallow mounting pad or base,” that “is designed to [be] made of heavy materials, so as to have considerable mass.” *Id.* a 2:33–39. “The major benefit in the physics of the bollard system of this invention, is that the striking forces from the crash vehicle are transmitted from the bollard down to the shallow mount pad” and “[t]he shallow mount pad is pushed down onto the soil (horizontal force backwards) instead of into the soil (vertical force downwards) as in the case of deep trench foundations.” *Id.* at 2:41–48.

Plaintiff alleges that Defendant’s shallow mount bollards infringe, *inter alia*, the limitations of Claim 1 of the '865 Patent. Dkt. 1 ¶ 23. Claim 1 recites:

1. A bollard structure comprising:
 - at least one bollard; and
 - a base comprising opposed ends and a plurality of structural members which intersect and are tied together, for each bollard of the bollard structure at least one first structural member extending from a first of the opposed ends of the base to a second of the opposed ends of the base in a first direction intersecting with the opposed ends, and at least one structural member extending to intersect with the at least one first structural member;
 - each bollard being secured to at least one of the at least one first structural member and the at least one structural member of the base for the respective bollard and extending upwardly from the base so as to transmit forces applied to the at least one bollard to the base;
 - wherein the base is configured to be mounted in a shallow excavation with the at least one bollard extending above grade; and
 - wherein the at least one first structural member or the at least one structural member or both are configured or tied together to retain within the base supporting media introduced into the base when the base is mounted in the excavation such that the rotation is resisted of a bollard or bollards and the base from an impact against the bollard or bollards.

'865 Patent, Claim 1.

III. Analysis

A. Legal Standards

1. Summary Judgment

Summary judgment is appropriate when, viewing the evidence and drawing all reasonable inferences in the light most favorable to the nonmoving party, there are no genuine issues of material fact, and the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322–23 (1986). In consideration a motion for summary judgment, a court “does not assess credibility or weigh the evidence, but simply determines whether there is a genuine factual issue for trial.” *House v. Bell*, 547 U.S. 518, 559–60 (2006). A fact is “material” if it “might affect the outcome of the suit under the

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governing law,” such as those necessary to the proof of a defense or a claim, and a dispute as to a material fact is “genuine” if there is sufficient evidence for a reasonable trier of fact to decide in favor of the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). “If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted.” *Id.* at 249–50 (internal citations omitted).

“Summary judgment is as appropriate in a patent case as in any other.” *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 835 (Fed. Cir. 1984). The moving party bears the initial burden of identifying those portions of the pleadings, discovery, and affidavits that demonstrate the absence of a genuine issue of material fact. *Celotex Corp.*, 477 U.S. at 323. Once the moving party meets its initial burden, the nonmoving party must set forth, by affidavit or as otherwise provided in Rule 56, “specific facts showing that there is a genuine issue for trial.” *Anderson*, 477 U.S. at 250 (internal quotation marks omitted). If the non-moving party fails to produce evidence sufficient to show a genuine issue of material fact, “the moving party is entitled to a judgment as a matter of law.” *Celotex Corp.*, 477 U.S. at 322–23.

Mere allegations or denials are not sufficient to rebut the facts proffered by the moving party. *Gasaway v. Nw. Mut. Life Ins. Co.*, 26 F.3d 957, 959–60 (9th Cir. 1994). Nor can the nonmoving party establish the basis to deny a motion for summary judgment by proffering conclusory opinions from an expert. See, e.g., *Soremekun v. Thriffty Payless, Inc.*, 509 F.3d 978, 984 (9th Cir. 2007) (“Conclusory, speculative testimony in affidavits and moving papers is insufficient to raise genuine issues of fact to defeat summary judgment.”); *Arthur A Collins, Inc. v. Northern Telecom Ltd.*, 216 F.3d 1042, 1047-48 (Fed. Cir. 2000).

2. Daubert Standard

Fed. R. Evid. 702 provides:

A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if:

- (a) the expert’s scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;
- (b) the testimony is based on sufficient facts or data;
- (c) the testimony is the product of reliable principles and methods; and
- (d) the expert has reliably applied the principles and methods to the facts of the case.

Fed. R. Evid. 702.

“Rule 702’s ‘helpfulness’ standard requires a valid scientific connection to the pertinent inquiry as a precondition to admissibility.” *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 591-92 (1993). Trial courts must conduct a “preliminary assessment of whether the reasoning or methodology underlying the testimony is scientifically valid and of whether that reasoning or methodology properly can be applied to the facts in issue.” *Id.* at 592-93. *Daubert’s* gatekeeping obligation applies to all expert testimony, not just “scientific” testimony. *Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 147 (1999). In making a reliability determination, courts “scrutinize not only the principles and methods used by the expert, but also whether those principles and methods have been properly applied to the facts of the case.” Fed. R. Evid. 702 Advisory Committee’s Note (2000 Amendment).

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3. Lay Witness Testimony Standard

Fed. R. Evid. 701 provides:

If a witness is not testifying as an expert, testimony in the form of an opinion is limited to one that is:

- (a) rationally based on the witness's perception;
- (b) helpful to clearly understanding the witness's testimony or to determining a fact in issue; and
- (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702.

Fed. R. Evid. 701.

“The third element was added in 2000 to prevent litigants from skirting the *Daubert* standard or the expert disclosure guidelines by introducing expert opinion testimony as lay opinion testimony.” *Siebert v. Gene Security Network, Inc.*, 75 F. Supp. 3d 1108, 1114 (N.D. Cal. 2014). “Where[] a witness is testifying as to institutional operations and practices based on personal knowledge that the witness has accrued over the course of several years of employment, the witness is providing lay testimony not subject to Rule 702.” *Id.* (citing, e.g., *United States v. Munoz–Franco*, 487 F.3d 25, 35–36 (1st Cir. 2007) (permitting opinion testimony by a lay witness where the witness had personal knowledge of bank operations and banking practices that derived from his employment)).

B. Application

1. Motion to Exclude Dr. Luna's Testimony

The parties dispute whether Dr. Luna's use of July 2013 or July 2019 for the hypothetical negotiation date, rather than July 2012, when Defendant allegedly began infringing the '865 Patent, is legal error that makes her opinion unreliable under Fed. R. Evid. 702. Plaintiff argues that Dr. Luna's use of the incorrect hypothetical negotiation dates makes her opinions “legally erroneous and inadmissible.” Dkt. 96 at 13. According to Plaintiff, Dr. Luna placed her hypothetical negotiation date in July 2013, which is six years before the Complaint was filed in July 2019. *Id.* at 12. Plaintiff argues that because Dr. Luna did not use July 2012, which is the date of first infringement, her opinions should be excluded. *Id.* at 12–13.

Defendant responds that Dr. Luna's use of July 2013 rather than July 2012 is a “misstatement” and that there is “no material difference in the analysis of RSA's sales and financials in July 2012 and July 2013.” Dkt. 116 at 6 n.5; *id.* at 7. Defendant relies on Dr. Luna's declaration (Dkt. 116-3), that “her conclusions as to the *Georgia-Pacific* factors would not change if considering a hypothetical negotiation between July 2012 or July 2013.” Dkt. 116 at 7. Defendant also relies on Dr. Luna's declaration that “[t]here was no change in circumstance in that narrow period of one year that would alter her analysis.” *Id.* Defendant argues that “[a]t worst, her reference to a ‘July 2013’ hypothetical negotiation date instead of a 2012 hypothetical negotiation is harmless error” because both parties' “experts had the same factual underpinnings in mind while rendering their opinions.” *Id.*

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In reply, Plaintiff makes four points: (i) the use of the incorrect date is not harmless error; (ii) Dr. Luna's declaration should be stricken as untimely; (iii) Dr. Luna's declaration should be disregarded because it directly contradicts her deposition testimony; and (iv) Dr. Luna's untimely declaration is prejudicial to Plaintiff. *See, generally*, Dkt. 142 at 1–6. Plaintiff also moves to strike Dr. Luna's declaration. Dkt. 144 at 13–15.

Responding to Plaintiff's motion to strike, Defendant argues that Dr. Luna's new declaration is "entirely harmless to RSA." Dkt. 158 at 11. Delta reiterates its argument that because the parties were "analyzing the same information" that Dr. Luna's "late disclosure (or clarification) that [her] analysis of a reasonable royalty in July 2012 as compared to a reasonable royalty in July 2013 would be the same" is "not prejudicial" to Plaintiff. *Id.* Defendant argues that Dr. Luna is not changing her conclusions, but is instead clarifying that "because there was no material change in circumstance between July 2012 and July 2013, her analysis of a hypothetical negotiation at either date remains the same." *Id.*

The Federal Circuit has made it clear that "the correct determination of the hypothetical negotiation date is essential for properly assessing damages." *LaserDynamics, Inc. v. Quanta Comp., Inc.*, 694 F.3d 51, 75 (Fed. Cir. 2012) (cleaned up) (reversing and remanding for a new trial on damages where the district court relied on the wrong hypothetical negotiation date). Courts have consistently adhered to the principle that "the date of the hypothetical negotiation is the date that infringement began." *Id.* (citing *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1123 (S.D.N.Y. 1970); *see also, e.g., Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 435 F.3d 1356, 1363–64 (Fed. Cir. 2006) ("[T]he hypothetical negotiation relates to the date of first infringement."); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1580 (Fed. Cir. 1989) ("The determination of a reasonable royalty ... [is based] on what a willing licensor and licensee would bargain for at hypothetical negotiations on the date infringement started.")).

The Federal Circuit has also been "careful to distinguish the hypothetical negotiation date from other dates that trigger infringement liability." *LaserDynamics*, 694 F.3d at 75. "For example, the six-year limitation on recovery of past damages under 35 U.S.C. § 286 does not preclude the hypothetical negotiation date from taking place on the date infringement began, even if damages cannot be collected until some time later." *Id.* (citing *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 870 (Fed. Cir. 1993)). "In sum, '[a] reasonable royalty determination for purposes of making a damages evaluation must relate to the time infringement occurred, and not be an after-the-fact assessment.'" *LaserDynamics*, 694 F.3d at 75 (citing *Riles v. Shell Exploration & Prod. Co.*, 298 F.3d 1302, 1313 (Fed. Cir. 2002)); *see also Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1079 (Fed. Cir. 1983) ("The key element in setting a reasonable royalty ... is the necessity for return to the date when the infringement began."). The Federal Circuit has stated that "[w]ere we to permit a later notice date to serve as the hypothetical negotiation date, the damages analysis would be skewed because, as a legal construct, we seek to pin down how the prospective infringement might have been avoided via an out-of-court business solution." *LaserDynamics*, 694 F.3d at 76. "It also makes sense that in each case there should be only a single hypothetical negotiation date, not separate dates for separate acts of infringement, and that a direct infringer or someone who induced infringement should pay the same reasonable royalty based on a single hypothetical negotiation analysis." *Id.*

These cases make clear that using the wrong hypothetical negotiation date is not harmless error; indeed, altering the timeline required remanding a matter for a new trial on damages based on the correct hypothetical negotiation date. *Id.* ("Because our decision alters the time period when the analysis under

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Georgia-Pacific is to take place, we remand for a new trial on damages pursuant to the [correct] hypothetical negotiation date.”). Thus, Dr. Luna’s use of incorrect hypothetical negotiation dates makes her analysis unreliable.

Dr. Luna’s untimely declaration also does not cure this deficiency. Plaintiff’s counsel asked Dr. Luna repeatedly about the correct hypothetical negotiation date during her deposition. At that time, Dr. Luna stated that her analysis would change based on the dates. Dkt. 144 at 14. Defendant’s argument that “[i]nstead of sifting through the data at her deposition, Dr. Luna then reviewed Mr. Beaton’s report and the data supplied by the parties, and found that the incremental profitability as of July 2012 was 0, and there were 0 additional units to be included,” is equally unavailing. See Dkt. 158 at 12. Plaintiff was entitled to believe that Dr. Luna’s testimony was complete at the close of her deposition. If Dr. Luna wished to amend her testimony, she could have sought to do by seeking to make changes upon receiving the transcript. If she sought to amend her report to include analysis of the correct hypothetical negotiation date, Defendant could have sought leave to do so prior to submitting its opposition briefs.

Because Dr. Luna’s use of the wrong hypothetical negotiation dates makes her report unreliable and because Defendant’s attempt to cure that deficiency is untimely, Plaintiff’s Motion to exclude Dr. Luna’s testimony is **GRANTED** and Plaintiff’s Motion to Strike is **GRANTED** as to Dr. Luna’s declaration.

2. Motion for Partial Summary Judgment as to Damages

As part of its motion to exclude Dr. Luna’s testimony, Plaintiff also seeks partial summary judgment as to damages should Dr. Luna’s testimony be excluded. Dkt. 96 at 13–14. Plaintiff argues that, “[w]ith the exclusion of each of Dr. Luna’s expert opinions of the reasonable royalty, Delta is left with no admissible evidence of the reasonable royalty rate resulting from a hypothetical negotiation at the time infringement began under *Georgia-Pacific*.” *Id.* at 14. Plaintiff argues that the reasonable royalty rate is “the province of expert testimony” and that without testimony to rebut Plaintiff’s expert’s opinion, there is “no genuine dispute as to any material fact and no reasonable trier of fact could find for Delta regarding the reasonable royalty rate to be applied in this case.” *Id.*

In opposition, Defendant argues that there is “no authority that a party who does not present their own expert is precluded from contesting the conclusions and opinions of the other party’s expert.” Dkt. 116 at 10. Defendant further argues that it should have the opportunity to cross-examine Plaintiff’s expert and that the “fact finder is not required to accept Mr. Beaton’s analysis.” *Id.* Defendant points to evidence it “intends to present at trial evidence bearing on the reasonableness of Mr. Beaton’s conclusions.” *Id.* at 11. This evidence includes “(1) the three settlement agreements relating to the ’865 Patent that RSA entered into with other parties, (2) the commercial relationship between RSA and Delta, (3) the value of the invention of the ’865 patent, (4) the parties’ conveyed sales, (5) profitability of products made under the ’865 patent, (6) those products’ current popularity, (7) advantages of the ’865 patent over the prior art, and (8) Delta’s profits on the accused products.” *Id.*

In reply, Plaintiff reiterates its argument that a reasonable royalty rate is the province of expert testimony and that without an expert to oppose Plaintiff’s expert’s opinion, “there is no reason to try damages.” Dkt. 142 at 7. Plaintiff argues that Defendant does not point to “specific evidence that it plans to present” and that it “remains undisputed that Delta does not have any admissible evidence of a reasonable royalty to rebut [Plaintiff’s expert’s opinion].” *Id.* at 7–8.

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The Federal Circuit has held that it is “[the patentee’s] burden, not [the accused infringer’s], to persuade the court with legally sufficient evidence regarding an appropriate reasonable royalty.” *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 872 (Fed. Cir. 2010) (citing *Lucent Tech. Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1329 (Fed. Cir. 2009)). “As a matter of simple procedure, [an accused infringer] [has] no obligation to rebut until [a patentee] met its burden with reliable and sufficient evidence.” *ResQNet.com*, 594 F.3d at 872; see also *id.* (“This court should not sustain a royalty award based on inapposite licenses simply because [an accused infringer] did not proffer an expert to rebut [patentee’s expert].”). Further, “[a] court is not restricted in finding a reasonable royalty to a specific figure put forth by one of the parties.” *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 926 F.2d 1161, 1168 (Fed. Cir. 1991).

Plaintiff’s argument that Defendant’s lack of an expert requires summary judgment as to the reasonable royalty rate is unavailing. First, the use of expert testimony is permissive. 35 U.S.C. § 284 (“The court may receive expert testimony as an aid to the determination of damages or what royalty would be reasonable under the circumstances.”) (emphasis added). Thus, even without expert testimony, Defendant may still present a claim for damages to the factfinder based on the admitted, relevant evidence, including testimony by lay witnesses. Second, Plaintiff has the burden of persuading the factfinder with sufficient evidence of an appropriate reasonable royalty. See *Lucent*, 580 F.3d at 1329. Once Plaintiff has met that burden, Defendant may respond to that evidence with exhibits, lay witness testimony and by cross-examining Plaintiff’s expert. See *AVM Techs., LLC v. Intel Corp.*, No. 1:15-cv-00033-RGA, 2017 WL1753999, *1 (D. Del. May 1, 2017) (allowing the plaintiff to put on fact testimony and call the defendant’s expert to present plaintiff’s argument regarding a reasonable royalty). Defendant has provided sufficient evidence to raise a dispute of material fact as to the reasonable royalty rate.

For the foregoing reasons, Plaintiff’s motion for partial summary judgment as to damages is **DENIED**.

3. Motion to Exclude Dr. Eskandarian’s Testimony

Plaintiff argues that Dr. Eskandarian’s expert testimony should be excluded because “his opinions are . . . the product of the application of improper law[and] the result of improper methodology.” Dkt. 98-1 at 1. In response, Defendant argues that Plaintiff’s objections go to the weight and not the admissibility of Dr. Eskandarian’s opinions. See, generally, Dkt. 118.

“[A] district court may exclude evidence that is based upon unreliable principles or methods, legally insufficient facts and data, or where the reasoning or methodology is not sufficiently tied to the facts of the case.” *Summit 6, LLC v. Samsung Elec. Co., Ltd.*, 802 F.3d 1283, 1295 (Fed. Cir. 2015). “But the question of whether the expert is credible or the opinion is correct is generally a question for the fact finder, not the court.” *Id.* at 1296. “Indeed, ‘[v]igorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof are the traditional and appropriate means of attacking shaky but admissible evidence.’” *Id.* (citing *Daubert*, 509 U.S. at 596). “To the extent [the expert’s] credibility, data, or factual assumptions have flaws, these flaws go to the weight of the evidence, not to its admissibility.” *Summit 6*, 802 F.3d at 1299. Thus, “where the methodology is reasonable and its data or evidence are sufficiently tied to the facts of the case, the gatekeeping role of the court is satisfied, and the inquiry on the correctness of the methodology and of the results produced thereunder belongs to the factfinder.” *Id.* at 1296.

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a) Written Description

Plaintiff argues that Dr. Eskandarian’s written description opinion should be excluded for three primary reasons: (i) Dr. Eskandarian stated that he found “no express disclosure” of resisting rotation in the base, contradicting the law on written description, which does not require an express disclosure; (ii) Dr. Eskandarian testified at his deposition that the specification failed to include any experimental data to explain to a person of ordinary skill in the art how the base resists rotation, which is also not required; and (iii) Dr. Eskandarian failed to consider the prosecution history where the Patent Office expressly found written description support for the claim term “rotation is resisted.” Dkt. 98-1 at 2–4. Defendant responds that Dr. Eskandarian applied the law properly and that disagreeing with the patent examiner is not a reason to exclude Dr. Eskandarian’s testimony. Dkt. 118 at 4. In reply, Plaintiff reiterates its argument that Dr. Eskandarian “failed to even consider relevant evidence” and that such failure “makes his opinion unreliable.” Dkt. 139 at 2-3.

The test for sufficiency of written description “is whether the disclosure of the application . . . reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). “[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.*

Dr. Eskandarian did not apply the wrong legal standard for his written description analysis. Dr. Eskandarian’s report states that his counsel informed him that “a claim is invalid for lack of written description if the patent specification, which consists of the written description of the patent including the drawings and the as-filed claims, fails to adequately describe all elements of the claim *such that one of ordinary skill in the art in reading the patent would determine that the inventor possessed the claimed invention.*” Dkt. 100-3 ¶¶ 24-25 (emphasis added). Dr. Eskandarian’s report only states that he found no “specific disclosure” of resistance to rotation of the base in the provisional applications and no “express disclosure” in the specification. *Id.* ¶¶ 61-63.

Dr. Eskandarian’s deposition testimony regarding the lack of experimental data in the specification bears directly on whether the specification conveys to a person of ordinary skill in the art with reasonable certainty that the inventor possessed the claimed invention at the time of the effective filing date. See Dkt. 100-4, Ex. 13 at 102:14–25, 103:2–5, 170:15–171:2. The cases cited by Plaintiff only state that express disclosure of the *exact terms of the claim* is not required, but Dr. Eskandarian’s opinion is that there is no express disclosure of the *concept* of resisting rotation of the base. See Dkt. 98-1 at 3 (*quoting Nalpropion Pharms., Inc. v. Actavis Labs. FL, Inc.*, 934 F.3d 1344, 1350 (Fed. Cir. 2019)); *see also id.* (*citing Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1347 (Fed. Cir. 2016) (written description requirement met when exact words from claim were absent from the specification because the words it did use “*would express the same concept*”) (emphasis added)). Although the specification need not disclose the express terms, the specification must at least describe the concept with reasonable clarity. If does not do so, the written description requirement would be without effect.

Dr. Eskandarian’s report also expressly states that he considered the provisional applications in his analysis. *Id.* ¶ 62. To the extent Plaintiff argues that Dr. Eskandarian should have considered the USPTO’s analysis during the reexamination of the ’865 Patent, this goes to the weight of his testimony, not its admissibility, and can be addressed on cross-examination. See *Summit 6*, 802 F.3d at 1299; *see*

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also Millennium Cryogenic Techs., Ltd. v. Weatherford Artificial Life Sys., Inc., No. 4:12-cv-00890-KPE, 2012 WL 4104813, *2–3 (S.D. Tex. Sept. 17, 2012) (denying accused infringer's motion to exclude testimony by patentee's technical expert on the basis that the expert failed to review the prosecution history; that issue goes to the weight, not the admissibility, of the expert's testimony).

Because Dr. Eskandarian did not improperly apply the law as provided to him, and because the evidence on which he relied in forming his opinions is sufficiently tied to the facts of the case, the dispute as to his conclusions go to the weight of this evidence, not its admissibility. *See Summit 6*, 802 F.3d at 1299.

For the foregoing reasons, the Motion to Exclude the Expert Opinion of Dr. Eskandarian regarding Defendant's written description defense is **DENIED**.

b) Indefiniteness

Plaintiff also argues that Dr. Eskandarian applied the wrong standard in determining that the '865 Patent is indefinite. Dkt. 98-1 at 5. Plaintiff argues that Dr. Eskandarian's assertion that the '865 Patent is indefinite "for not specifying which, if any, of [several tests for rating crash-worthiness] it meets" is "not the law." *Id.* In opposition, Defendant argues that Dr. Eskandarian examined the '865 Patent and "concluded that there is insufficient guidance for a POSITA to understand how to tell what structures meet the limitation and which do not." Dkt. 118 at 3–4. In reply, Plaintiff argues that Dr. Eskandarian did not review the prosecution history or provisional applications which contain the details necessary for the invention to be definite. Dkt. 139 at 2.

"[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Dr. Eskandarian's report demonstrates that his analysis applied the correct standard for indefiniteness. It repeatedly states the proper standard of "reasonable certainty" while explaining why he finds the '865 Patent's specification insufficient. *See* Dkt. 100-3 ¶¶ 26, 64–67.

Many cases have addressed whether the failure to disclose how to measure a variable in the intrinsic evidence renders a claim term indefinite. *See Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1342–45 (Fed. Cir. 2015) (affirming finding that term "molecular weight" was indefinite where there were several ways to measure molecular weight that differed significantly); *Takeda Pharmaceutical Co. Ltd. v. Zydus Pharmaceuticals USA, Inc.*, 743 F.3d 1359, 1366–68 (Fed. Cir. 2014) (affirming finding that claims were not indefinite despite several ways to measure the claimed "average particle diameter" because the difference in results from the different measuring techniques was not significant enough). Finally, any failure to consider adequately the prosecution history or provisional applications goes to the weight, not the admissibility of Dr. Eskandarian's testimony. *See Summit 6*, 802 F.3d at 1299.

For the foregoing reasons, the Motion to Exclude the Expert Opinion of Dr. Eskandarian regarding Defendant's indefiniteness defense is **DENIED**.

c) Obviousness

Plaintiff also argues that Dr. Eskandarian's opinion on obviousness is unreliable and should be precluded

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for two reasons: (i) he “failed to consider or offer any opinion on whether a PHOSITA would have had any reasonable expectation of success in making his proposed modifications to the various prior art references he relies on;” and (ii) he “did not consider any secondary considerations of nonobviousness, such as copying.” Dkt. 98-1 at 6–7. In its opposition, Defendant argues that “Dr. Eskandarian [was] not obligated to discuss an express motivation to combine and reasonable expectation of success.” Dkt. 118 at 7. Defendant adds that Dr. Eskandarian “did discuss a motivation to combine the identified prior art references and reasonable expectation of success” and that he “specifically discussed a motivation to combine a number of prior art references,” as well as “market pressures for shallow mount barriers, and the use of well-known techniques to achieve well-known results.” *Id.* at 7–8. Finally, Defendant argues that there is no evidence of copying and any failure to consider secondary considerations goes to the weight and not the admissibility. *Id.* at 10–11.

In reply, Plaintiff argues that Defendant “attempts to conflate ‘motivation to combine’ and ‘reasonable expectation of success’ into a single requirement, when they are separate.” Dkt. 139 at 3. Plaintiff further argues that Dr. Eskandarian failed to “address or explain how specifically those prior art references on which he relies would achieve specifically the result as claimed by the ‘865 Patent.” *Id.*

“A person of ordinary skill is also a person of ordinary creativity.” *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). And “[o]ne of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419–20. Dr. Eskandarian’s report opines on the motivation to combine the prior art references. See Dkt. 100-3 ¶¶ 87–89 (combining the teachings of Turpin and DSC501); Dkt. 100-3 ¶¶ 219–221 (combining the teachings of Darcy and DSC501). In these paragraphs, Dr. Eskandarian discusses the market pressures for shallow mount barriers, and that it would have been an “obvious choice by a POSITA to use the well-known technique of adding concrete into the interior of the base of the barrier.” *Id.* at ¶¶ 87–88, 219–220. Dr. Eskandarian further opines on the benefits of weight added through concrete to the structure before concluding that “[s]uch results would have been very predictable to a POSITA.” *Id.* at ¶¶ 89, 221. Thus, Dr. Eskandarian discussed the motivation to combine and the reasonable expectation of success of doing so.

As to the secondary indicia of non-obviousness, Dr. Eskandarian stated:

Secondary indicia of non-obviousness may include a long felt but unmet need in the prior art that was satisfied by the invention of the patent; commercial success covered by the patent; unexpected results achieved by the invention; praise of the invention by others skilled in the art; taking of licenses under the patent by others; and deliberate copying of the invention. Even assuming such indicia exists, it is my understanding that there must be a nexus between any such secondary indicia and the claimed invention.

Dkt. 100-3 ¶ 33.

Although this analysis is not detailed, it shows that Dr. Eskandarian considered such indicia when forming his opinion. Moreover, whether Dr. Eskandarian considered the secondary indicia presented by Plaintiff goes to the weight of his testimony, not its admissibility. See *Keytrack, Inc. v. Key Register, LLC*, No. 3:03-cv-00870-WHA, 2004 WL 2944043, at *4 (N.D. Cal. Mar. 30, 2004) (“At this point, however, the record is unclear on whether the expert’s failure to consider the other secondary factors substantially

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outweighs the *Graham* factors and the prior art combinations that were considered by Dr. Adams. Simply put, his failure to consider the other evidence goes to the weight of his opinion. The failure does not justify exclusion of relevant testimony.”); *see also Inline Connection Corp. v. AOL Time Warner Inc.*, No. 1:02-cv-00272-MPT, 1:02-cv-00477-MPT, 2007 WL 275928, at *5 (D. Del. Jan. 29, 2007) (“Whether Waring adequately addressed or failed to address relevant secondary considerations goes to weight, not reliability under FRE 702.”).

For the foregoing reasons, the Motion to Exclude the Expert Opinion of Dr. Eskandarian regarding Defendant’s obviousness defense is **DENIED**.

d) Methodology

Plaintiff argues that Dr. Eskandarian used improper methodology because he only considered prior art provided to him by Defendant and did not conduct an independent search for other possible prior art. Dkt. 98-1 at 8. Plaintiff argues that Dr. Eskandarian’s failure to consider independently found prior art, deposition testimony from other witnesses, the prosecution history of the ’865 Patent, and the reexamination proceedings before the USPTO requires exclusion of Dr. Eskandarian’s testimony. *Id.* at 7–9. In opposition, Defendant argues that there is no requirement that Dr. Eskandarian conduct an independent search for prior art. Dkt. 118 at 8. Defendant also argues that Dr. Eskandarian did consider the prosecution history of the ’865 Patent. *Id.* at 9. Defendant further argues that even if Dr. Eskandarian did not review the prosecution history or deposition testimony by other witnesses, this goes to the weight of his testimony and not its admissibility. *Id.* In reply, Plaintiff reiterates that Dr. Eskandarian’s failure to consider certain evidence requires the exclusion of Dr. Eskandarian’s testimony. Dkt. 139 at 3–5.

“To the extent [the expert’s] credibility, data, or factual assumptions have flaws, these flaws go to the weight of the evidence, not to its admissibility.” *Summit 6*, 802 F.3d at 1299. Thus, “where the methodology is reasonable and its data or evidence are sufficiently tied to the facts of the case, the gatekeeping role of the court is satisfied, and the inquiry on the correctness of the methodology and of the results produced thereunder belongs to the factfinder.” *Id.* at 1296.

Based on a review of Dr. Eskandarian’s report, the methodology used is reasonable and the data and evidence are sufficiently tied to the facts of this case. Any claimed failure to review certain material goes to the weight of Dr. Eskandarian’s testimony and not to its admissibility. *Id.* at 1299.

For the foregoing reasons, the Motion to Exclude the Expert Opinion of Dr. Eskandarian based on methodology is **DENIED**.

4. Motion to Strike Dr. Eskandarian’s Testimony

Plaintiff moves to strike paragraphs 2–7 of Dr. Eskandarian’s declaration (Dkt. 120), which Defendant submitted in opposition to Plaintiff’s motions for summary judgment. Dkt. 144 at 6–13. Plaintiff argues that each of these paragraphs contains a new opinion that is not in Dr. Eskandarian’s expert report. *Id.* Defendant responds that these paragraphs are consistent with Dr. Eskandaraian’s expert report and deposition testimony. Dkt. 158 at 5–10. Defendant also argues that, even if the opinions were untimely, they should still be admitted because they are substantially justified and their admission would not be prejudicial. *Id.* at 9.

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Plaintiff's arguments can be divided into four groups based on paragraphs in Dr. Eskandarian's declaration: Paragraphs 2–4, Paragraph 5, Paragraph 6, and Paragraph 7.

a) Paragraphs 2–4

Paragraphs 2–4 state:

2. When an object rotates, it rotates about an axis of rotation. In the bollard structure of U.S. Patent No. 8,215,865 (the "865 Patent", the "base" of the structure has an axis of rotation. Similarly, the "bollard" has its own axis of rotation.

3. Reference in the '865 Patent to "rotation at the base of the bollard" means that the axis of rotation is at the front of the base where the bollard attaches to the base. In other words, the bollard would rotate relative to the base. This means that the rotation is of the bollard, not the base (pad).

4. If the bollard and base were to rotate together as a single unit as a result of a collision, that axis of rotation would be at the back wall of the base, not at the base of the bollard.

Dkt. 120 ¶¶ 2–4.

Plaintiff argues that Paragraphs 2–4 are new expert opinions because Dr. Eskandarian's report did not mention a separate axis of rotation. Dkt. 144 at 6–8. Plaintiff adds that Dr. Eskandarian did not offer these opinions at his deposition. *Id.* at 7. In response, Defendant argues that Dr. Eskandarian's declaration is "entirely consistent with his prior opinion, and merely provides a more pointed response [to Plaintiff's expert's opinion]." Dkt. 158 at 7. Defendant also argues that "[t]his is not a change in position, but a more specific explanation in view of [Plaintiff's expert's] unexpected opinions suggesting that there is only one axis of rotation for the bollard(s) and the base." *Id.* Defendant adds that, if the opinions are accepted, even if they are deemed new, they would not prejudice Plaintiff, whose expert offered similar statements in his deposition. *Id.*

Dr. Eskandarian's expert report made it clear that he considered rotation of the bollard and the base as separate from one another. Dkt. 100-3 ¶¶ 61, 63. Moreover, Paragraphs 2–4 do not offer new factual bases for Dr. Eskandarian's opinion. Although the paragraphs are more detailed than Dr. Eskandarian's report, they are entirely consistent with and do not significantly expand on any prior opinions or reasoning. Even assuming, *arguendo*, that these were deemed new opinions, accepting them will not be prejudicial to Plaintiff, whose expert has opined in this area, and because Plaintiff can cross-examine Dr. Eskandarian at trial.

b) Paragraph 5

Paragraph 5 states:

5. The terms "resistance to rotation" and "breach" are not interchangeable when it comes to security barriers. When considering performance of a security barrier, the definition of

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a “breach” has changed over time. The penetration distance of a vehicle is considered in crash certifications, and the penetration distance is reflected in the certification rating for a given barrier structure. As such, the term “breach” is imprecise, and does not provide more clarity to the performance requirements of the bollard system. In addition, a bollard or bollard and base may rotate to some degree while not allowing or at least limiting vehicle penetration.

Dkt. 120 ¶ 5.

Plaintiff argues that Paragraph 5 contains a new opinion because Dr. Eskandarian’s report never stated that “breach” and “resistance to rotation” had “entirely different definition[s].” Dkt. 144 at 8. Plaintiff further argues that Dr. Eskandarian did not testify about this opinion at his deposition. *Id.* at 8–9. In response, Defendant argues that “[t]he ’865 Patent does not define ‘resistance to rotation’ as avoiding ‘breach,’ and Dr. Eskandarian could not possibly have been expected to anticipate [Plaintiff’s argument that resistance to rotation means breach] in his opening report.” Dkt. 158 at 7–8. Defendant adds that Dr. Eskandarian has “personal knowledge of the industry and the way the term ‘breach’ is used in the industry” and that “Paragraph 5 of his declaration reflects his understanding of the term.” *Id.* at 8. Defendant then argues that, even if the opinion were deemed new, it is substantially justified, and its admission will not prejudice Plaintiff, because Dr. Eskandarian is simply responding to Plaintiff’s argument and disagreeing with Plaintiff’s expert. *Id.* at 9.

Paragraph 5 is consistent with and does not significantly expand on Dr. Eskandarian’s report. Dr. Eskandarian’s report makes clear that he did not find a measure for “resistance to rotation” in the claim language or in the specification. Dkt. 100-3 ¶ 65. The term “breach” is used in the specification. Paragraph 5 of Dr. Eskandarian’s declaration makes it clear that Dr. Eskandarian does not consider the specification’s use of “breach” as providing the measure for “resistance to rotation.” Again, this is not a case of a surprising, new opinion. Dr. Eskandarian made it clear from the beginning that he did not find support for “resistance to rotation” in the specification so it is no surprise that Dr. Eskandarian has maintained that opinion by stating that the term “breach” “does not provide more clarity to the performance requirements of the bollard system.” Dkt. 120 ¶ 5.

c) Paragraph 6

Paragraph 6 states:

6. In Delta’s DSC800RFB and TT203R bollard systems discussed in my report, concrete is held between the upper and lower plate. This is easier to understand when considering the use of larger plates, extending further from the edges of the bollard structure. But even with the smaller plates shown in the drawings of the DSC800RFB and TT203R, it is clear that there is concrete sandwiched between the plates and accordingly is within the base.

Dkt. 120 ¶ 6.

Plaintiff argues that this paragraph offers a new opinion that was not provided in Dr. Eskandarian’s report or during his deposition. Dkt. 144 at 9–11. Defendant responds that Paragraph 6 simply clarifies earlier opinions by provided an example and is consistent with Dr. Eskandarian’s opening report and deposition

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testimony. Dkt. 158 at 8.

Paragraph 6 provides further clarification to the opinions stated by Dr. Eskandarian in his report and during his deposition. See Dkt. 100-3 ¶¶ 159–160, 198, 203. This is not a new opinion nor is one that is inconsistent with, or significantly broader than, those stated in Dr. Eskandarian’s report or through his deposition testimony.

d) Paragraph 7

Paragraph 7 states:

7. It is well known that among various structural members, such as tubular steel, channel beams, angles, and I-beams, that tubular steel provides better torsional resistance.

Dkt. 120 ¶ 7.

Plaintiff argues that Dr. Eskandarian “never opined that tubular steel members provide ‘better torsional resistance’ than other members” in his report or deposition testimony. Dkt. 144 at 11–12. Defendant responds that “Dr. Eskandarian’s statement relates to information within his personal knowledge as a POSITA.” Dkt. 158 at 9. Defendant further argues that the statement is a “principle of physics, and well within Dr. Eskandarian’s knowledge.” *Id.* at 9–10. Defendant argues that the admission of the statement would not be prejudicial to Plaintiff because “RSA had an opportunity to rebut this statement” in its reply papers. *Id.* at 10.

Dr. Eskandarian’s statement in Paragraph 7 is “a reasonable synthesis and/or elaboration of the opinions contained in [his] report.” *LivePerson, Inc. v. [24]7.AI, Inc.*, No. 4:17-cv-01268-JST, 2018 WL 6257460, at *1 (N.D. Cal. Nov. 30, 2018). Although Dr. Eskandarian did not specifically opine on the strength of tubular steel or that tubular steel provides better torsional resistance in his expert report, this opinion is a “principle of physics” that is “well within Dr. Eskandarian’s knowledge.” This opinion is consistent with those in his expert report, i.e., that tubular steel was known and used in the industry. This clarification is not a new opinion.

For the foregoing reasons, Plaintiff’s Motion to Strike Improper Expert Testimony is **DENIED**.

5. Motion to Strike David Dickinson’s Testimony

Plaintiff argues that several portions of David Dickinson’s declaration (Dkt. 121), contain impermissible expert testimony by a lay witness. Dkt. 144 at 15–18. Defendant responds that all of Mr. Dickinson’s statements are within his personal knowledge as former president of Delta and are admissible as testimony by a lay witness. Dkt. 158 at 2–5.

“The advisory committee notes that accompanied the amendment that added Rule 701(c) made clear that particularized knowledge that the witness has by virtue of his or her position in the business is not scientific, technical, or other specialized knowledge, even if it involves knowledge that the average person would have to consult an expert about, like the value or projected profits of a business or that a substance appeared to be a narcotic.” *Open Text S.A. v. Box, Inc.*, No. 3:13-CV-04910-JD, 2015 WL 393858, at *7

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(N.D. Cal. Jan. 29, 2015) (internal quotations omitted) (*citing* Fed. R. Evid. 701, advisory committee's note to 2000 amendment). "Thus, just because the underlying facts and data are technical in nature does not transform the information into expert testimony when those facts are within the personal knowledge and experience of the company's employee." *Id.* (internal quotations and citations omitted).

Mr. Dickinson's declaration reflects the particularized knowledge he gained through his work in his position. As a percipient, lay witness, Mr. Dickinson can testify to the state of the art of the industry based on information that is within his personal knowledge as former president of Delta. *See, e.g., Avocent Redmond Corp. v. Rose Electronics*, No. 2:06-cv-01711-RSL, 2013 WL 1855738, *3-4 (W.D. Wash. 2013) (denying motion to exclude "state of the art" testimony of four prior employees where they were employed by the plaintiff at the relevant time, were active in the relevant field at precisely the time of the invention, and had personal knowledge regarding the state of the art at the crucial time). Mr. Dickinson was the president of Delta at the relevant time, was active in the relevant field at the time of the invention and has personal knowledge regarding the state of the art at the relevant time. That a typical, lay person would need to consult an expert about the effect that the use of concrete has on bollard design does not warrant a determination that Mr. Dickinson's testimony must be deemed that of an expert. Therefore, Mr. Dickinson can testify as to the state of the art that is within his personal, particular knowledge.

Although Mr. Dickinson can testify to the state of the art, that does not mean that he may testify as to other issues at trial, e.g., obviousness or invalidity, that require "highly technical and specialized knowledge" that is beyond the scope of Rule 701." *Carpenter Tech. Corp. v. Allegheny Techs., Inc.*, No. 5:08-cv-02907-LS, 2012 WL 5507959, *1 (E.D. Pa. Nov. 14, 2012) (collecting cases demonstrating that "the clear weight of authority militates against permitting lay testimony on the issue of obviousness"); *see also Munchkin, Inc. v. Luv N' Care, Ltd.*, No. 2:13-cv-07228-ODW (AGRx), Dkt. 147 (C.D. Cal. Feb 24, 2015) (granting motion to exclude lay witness testimony on issues regarding invalidity).

For the foregoing reasons, Plaintiff's Motion to Strike Improper Expert Testimony as to David Dickinson's declaration is **DENIED**.

IV. Conclusion

For the foregoing reasons, Plaintiff's Motion for Partial Summary Judgment as to Damages and Motion to Exclude Expert Damages Under *Daubert* (Dkt. 96) is **DENIED** as to summary judgment for damages and **GRANTED** as to the exclusion of Dr. Luna's testimony; Plaintiff's Motion to Exclude Expert Opinion of Dr. Azim Eskandarian (Dkt. 98) is **DENIED**; and Plaintiff's Motion to Strike Improper Expert Testimony is **GRANTED** as to Dr. Luna's declaration (Dkt. 116-3) and **DENIED** as to Dr. Eskandarian's declaration (Dkt. 120) and David Dickinson's declaration (Dkt. 121).

IT IS SO ORDERED.

Initials of Preparer

_____ : _____
cw