

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

**TINNUS ENTERPRISES, LLC, and
ZURU LTD.**

Plaintiffs,

v.

TELEBRANDS CORP., et al.,

Defendants.

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No. 6:15-cv-00551 RC-JDL

JURY DEMANDED

MEMORANDUM OPINION AND ORDER

Before the Court is Plaintiffs’ Tinnus Enterprises, LLC (“Tinnus”) and ZURU Ltd. (“ZURU”) (collectively “Plaintiffs”) Motion to Exclude Dr. Ken Kamrin’s Opinions on Objective Indicia of Non-Obviousness. (Doc. No. 267.) Defendants Telebrands Corp. (“Telebrands”), Bed Bath & Beyond, Inc. (“Bed Bath”), and BulbHead.com (“Bulbhead”) (collectively “Defendants”) have filed a response (Doc. No. 284), to which Plaintiffs have filed a reply (Doc. No. 289) and Defendants have filed a sur-reply (Doc. No. 291). Upon consideration of the parties’ arguments, the Court **GRANTS** Plaintiffs’ Motion (Doc. No. 267).

BACKGROUND

On June 9, 2015, Plaintiffs filed the instant action against Defendants Telebrands and Bed Bath, alleging infringement of U.S. Patent No. 9,051,066 (“the ’066 Patent”). Specifically, in the original complaint, Plaintiffs allege that Telebrands’s Balloon Bonanza product infringes the ’066 Patent. (Doc. No. 1.) Plaintiffs moved this Court to enter a preliminary injunction against Telebrands’s alleged infringing Balloon Bonanza products. (Doc. No. 9.) The Court held a hearing on the preliminary injunction and ultimately found that the preliminary injunction should be granted. (Doc. Nos. 66, 84.) The Court then issued an Injunctive Order pursuant to

Fed.R.Civ.P. 65 on December 22, 2015. (Doc. No. 91.) Sometime after the issuance of the injunction, Defendants developed a new Battle Balloons product, which was then added to the case and is accused of infringing claims of the '066 Patent. (Doc. No. 117.) Thereafter, Plaintiffs also added Defendant Bulbhead. (Doc. No. 227.)

On August 29, 2016, opening expert reports were issued in this case. At that time Defendants' expert, Dr. Ken Kamrin issued his opening expert report regarding invalidity of the '066 Patent. (Doc. No. 267-6 "Kamrin Report".) In his report, Dr. Kamrin contends that the '066 Patent is invalid as obvious pursuant to 35 U.S.C. § 103. *Id.* at 14–40. Dr. Kamrin also opines that the claims are obvious in view of any secondary considerations of non-obviousness, including commercial success, industry praise, long-felt need, failure by others, and copying of the Bunch O Balloons product. *Id.* at 45. Having reviewed the opinions disclosed in Dr. Kamrin's opening report, Plaintiffs filed the instant motion to exclude Dr. Kamrin from testifying on secondary considerations of non-obviousness because he is unqualified. (Doc. No. 267.)

LEGAL STANDARD

Rule 702 provides that an expert witness may offer opinion testimony 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 of the Federal Rules of Evidence "recognizes that people develop expertise in many ways and permits an expert to testify based on 'knowledge, skill, experience, training, or education.'" *Rambus Inc. v. Hynix Semiconductor Inc.*, 254 F.R.D. 597, 604 (N.D. Cal. 2008)

(quoting Fed.R.Evid. 702) (other citations omitted). “The inquiry envisioned by Rule 702 is . . . a flexible one,” but, in *Daubert*, the Supreme Court held that the Rules also “assign to the trial judge the task of ensuring that an expert’s testimony both rests on a reliable foundation and is relevant to the task at hand.” *Daubert v. Merrell Dow Pharms. Inc.*, 509 U.S. 579, 594, 597 (1993). Expertise in one subject does not necessarily qualify an expert to testify on all issues that could arise from that subject; for example, having knowledge about finance and securities does not necessarily make one an expert “about whether a particular security was counterfeit or not.” *Rambus*, 254 F.R.D. at 604 (citation omitted).

DISCUSSION

Plaintiffs move to exclude Dr. Kamrin’s opinions on secondary considerations of non-obviousness on the grounds that (1) he is not qualified; and (2) his opinions are unreliable. (Doc. No. 267, at 7–9.)

With respect to Dr. Kamrin’s qualifications, Plaintiffs contend that Dr. Kamrin is not a toy expert and has no experience or knowledge of the toy industry that would qualify him to provide opinions on the commercial success of the accused toy products, the long-felt need for the product, failure by others in the industry, or copying. (Doc. No. 267, at 7.) Plaintiffs contend that his “scientific, technical, or other specialized knowledge” will not help the trier of fact. *Id.* at 8. Defendants argue that Dr. Kamrin is qualified to opine about secondary considerations because he meets or exceeds both parties’ definitions of the qualifications of one of ordinary skill in the art. (Doc. No. 284, at 3.) Defendants point to Dr. Kamrin’s expertise in the field of physics and his research in pneumatics involving the design of expandable containers. *Id.* at 4.

Here, Dr. Kamrin’s expertise to serve as a technical expert on issues of non-infringement and invalidity is not generally contested. The fact that he qualifies as a person of ordinary skill in

the art for purposes of rendering his non-infringement and invalidity opinions bears little relevance to whether he is also qualified to testify regarding secondary considerations related to the toy industry such as commercial success, long-felt need, failure by others in the industry, or copying. Defendants do not point to any experience in the industry that Dr. Kamrin has that would qualify him to render these opinions. Specifically, Defendants do not point to any expertise that would qualify Dr. Kamrin to testify regarding the commercial aspects of these inquiries. Indeed, according to his CV, it appears that upon the completion of his Ph.D. in 2008, Dr. Kamrin went directly to lecturing in applied mathematics at Harvard University, and from there to his current position as an Assistant Professor of Mechanical Engineering at MIT. (Doc. No. 193-13.) Dr. Kamrin's resume does not reflect any industry experience. *Id.* During his deposition, Dr. Kamrin confirmed that he has no trained knowledge on what makes a toy successful, that his expertise in this regard was based on his experience as a consumer, and that he has never worked in the industry. (Doc. No. 267-1, at 11:3–15:3.)

Moreover, given the conclusory nature of the opinions in Dr. Kamrin's opening expert report, it is nearly impossible for the Court to decipher what testimony Dr. Kamrin would intend to provide in rebuttal to Plaintiffs' secondary considerations.

The entirety of Dr. Kamrin's opinions regarding secondary considerations is as follows:

132. In forming my obviousness conclusions, I took into account asserted secondary/objective considerations. The evidence clearly and convincingly demonstrates that the claims are obvious. The claims are obvious even if Plaintiffs' secondary considerations apply.

133. I understand that Plaintiffs allege that the '066 patent is not obvious because of commercial success, industry praise, long-felt need, failure by others, and copying of the Bunch O Balloons product.

134. Plaintiffs have not explained how the combination of claimed features differentiates from the prior art and how this differentiation led to commercial success. In

addition, Plaintiffs have not demonstrated that the success is due to the invention, as opposed marketing of the Bunch O Balloons product.

135. Moreover, the alleged copying evidence I have seen is from before the '066 patent issued. If and when Plaintiffs or their expert explains why the copying before the patent's issuance [sic] supports the obviousness of the claims, I reserve my right to respond.

136. I have not seen any evidence of industry praise for Plaintiff's Bunch O Balloons product. I have seen consumer praise and accolades from the press, but I do not consider that to be "industry" praise. In addition, I have not seen any evidence of unsuccessful efforts to solve some long-felt need.

137. If Plaintiffs or their expert address secondary considerations and/or these issues, I reserve the right to provide further opinions on secondary considerations.

(Doc. No. 267-6, at ¶¶ 132–137.)

The Court acknowledges that Dr. Kamrin provided these opinions in his opening report before having had the benefit of seeing Plaintiffs' expert's opinions.¹ However, that does not give Dr. Kamrin carte blanche to provide any undisclosed rebuttal opinions that he wants at trial. Of the opinions he did disclose, at least the portion where Dr. Kamrin states "I have seen consumer praise and accolades from the press, but I do not consider that to be 'industry' praise," raises a problem with respect to his qualifications. Because Defendants have not pointed to any industry experience or knowledge that Dr. Kamrin has to render such an opinion, his conclusion that consumer praise and accolades from the press does not qualify as industry praise would not help the trier of fact under Rule 702. To the extent Dr. Kamrin has provided technical opinions regarding the prior art, the operation of the accused products or Plaintiffs' products, or other technical opinions that may go in part to some issues of objective indicia, Dr. Kamrin is not excluded from providing those opinions. However, Defendants have presented no reliable basis

¹ While Defendants cite to the Court's DCO as not providing a deadline to serve a reply report, Rule 26(a)(2)(D) provides that, absent such a court order, "if the evidence is intended solely to contradict or rebut evidence on the same subject matter identified by another party under Rule 26(a)(2)(B) or (C)" the disclosure must be made "within 30 days after the other party's disclosure." Fed.R.Civ.P. 26(a)(2)(D). Moreover, to the extent it was unclear whether a reply would be permissible, Defendants were free to ask for leave of court to serve a reply.

for Dr. Kamrin's opinions regarding the commercial and industry aspects of the secondary considerations of non-obviousness. Therefore, these opinions must be excluded.

Moreover, Defendants significant devotion in the briefing to attacking Plaintiffs' expert's qualifications and opinions on secondary considerations are irrelevant for purposes of the instant motion. If anything, they suggest that Defendants should have brought their own motion to strike to the extent they found these opinions unreliable. *See Rambus*, 254 F.R.D. at 604-05 (“[Plaintiff’s] ‘sauce for the goose, sauce for the gander’ argument does not provide a basis for denying a meritorious motion to prevent [Plaintiff’s expert] from testifying as an expert in certain areas. At best, it suggests that perhaps [Plaintiff] should have filed a motion that copies [Defendants’] arguments.”). Defendants’ argument that Dr. Kamrin should be entitled to opine that Plaintiff’s expert has not met his burden is also without merit. To the extent there is a deficiency in Plaintiff’s expert’s opinions, that is a matter for cross-examination.

Finally, the Court notes that in accordance with the Federal Rules of Civil Procedure, the parties’ testifying experts will be limited to testifying on the opinions that have been properly disclosed in this matter. *See Fed.R.Civ.P 26(a)(2)*. Given the present disclosures before the Court, this very well may moot many of the parties’ disputes regarding the testimony to be presented at trial.

Because Dr. Kamrin’s opinions regarding the commercial and industry aspects of the secondary considerations of non-obviousness would not be helpful to the trier of fact based on his scientific and technical expertise, the Court **GRANTS** Plaintiffs’ Motion (Doc. No. 267).

CONCLUSION

For the reasons stated herein, the Court **GRANTS** Plaintiffs’ Motion to exclude the opinions of Dr. Kamrin regarding secondary considerations of non-obviousness (Doc. No. 267).

So ORDERED and SIGNED this 15th day of December, 2016.



JOHN D. LOVE
UNITED STATES MAGISTRATE JUDGE