

From: [Trials](#)
To: [Gerrard, Sonja](#); [Trials](#)
Cc: [David H. Holman](#); [Trey Powers](#); [Kristina Caggiano Kelly](#); [Christopher Gallo](#); [Byron Pickard](#); [Rosato, Michael](#); [Mills, Jad](#); [Medley, Patrick](#)
Subject: RE: IPR2022-00817
Date: Monday, June 5, 2023 12:04:48 PM
Attachments: [image005.png](#)
[image006.png](#)
[image007.png](#)
[image008.png](#)

Counsel,

From the Board –

Petitioner's request for authorization to file a two-page brief as outlined in its June 1 email to the Board is granted. The brief must be filed within three business days of this authorization.

Patent Owner is authorized to file a two-page brief in response. Patent Owner's brief must be filed within three business days of the filing of Petitioner's brief.

No conference is necessary at this time.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Gerrard, Sonja <sgerrard@wsgr.com>
Sent: Thursday, June 1, 2023 7:28 PM
To: Trials <Trials@USPTO.GOV>
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Subject: IPR2022-00817

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Honorable Board:

Petitioner respectfully requests authorization to move to strike. The Patent Owner Sur-reply materials filed on May 24, 2023 include combined documents and untimely new evidence. Exhibits 2072 and 2073 purport to be the deposition transcripts of Petitioner's reply witnesses, however,

each reflect a combination of different documents. 37 C.F.R. § 42.6 (prohibiting combining documents). Exhibit 2072 includes the deposition transcript of Dr. Larrea along with “Exhibits” 1-9 which include schematics prepared by Patent Owner, product information sheets, and a published patent application. Exhibit 2073 includes the deposition transcript of Dr. Quackenbush along with “Exhibits” 1-4 which include incomplete portions of declarations and deposition transcripts from proceedings other than the instant IPR.

The content of Exhibits 2072 and 2073 is also improper as each includes evidence other than the deposition transcripts of a reply witness in violation of 37 C.F.R. §. 42.23(b). *See also* Consolidated Trial Practice Guide (Nov. 2019) at 73-74 (“The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.”). The Sur-reply is improper because it cites to “Exhibits” 1-9 and “Exhibits” 1-4 within Exhibits 2072 and 2073, respectively.

Patent Owner did not request authorization from the Board to combine documents, submit new evidence or otherwise suspend Board rules. Furthermore, Patent Owner did not introduce “Exhibits” 1-9 and “Exhibits” 1-4 for the purposes of testing the witness’s testimony. They were introduced without substantive questioning using the deposition process as a trojan horse to submit new evidence without providing Petitioner an opportunity to address them.

Petitioner respectfully requests the following relief:

- Expungement of Paper 34 (Patent Owner’s Sur-reply) and Exhibits 2072 and 2073.
- Exhibits 2072 and 2073 may then be re-filed omitting “Exhibits” 1-9 and “Exhibits” 1-4, respectively.
- Sur-reply may be re-filed omitting citation to the improperly submitted evidence.

To the extent briefing on this matter is considered necessary, Petitioner offers to file a 2 page brief identifying the requested relief and the corresponding basis.

Petitioner reached out to Patent Owner on May 30, 2023 requesting withdrawal of Exhibits 2072 and 2073 and the Sur-reply and re-filing of same without the improper and untimely new evidence. Patent Owner engaged in discussions but ultimately declined to withdraw the sur-reply materials, providing the argument below on June 1, 2023:

Statement from Patent Owner:

Patent Owner opposes Petitioner’s request for authorization for a motion to strike. First, Petitioner has already sought relief on this matter by filing a Motion to Exclude each of Exhibits 2072 and 2073. No further briefing is necessary, and determining the weight and admissibility of evidence is well within the Board’s purview. Patent Owner also objects to Petitioner’s characterization of Patent Owner’s sur-reply and deposition transcript Exhibits 2072 and 2073 as untimely and improper. Patent Owner introduced exhibits during the depositions of Drs. Larrea and Quackenbush for impeachment purposes and to otherwise test the veracity of their opinions, thus making the deposition exhibits a necessary part of each transcript so the Board has a full record of the testimony elicited regarding these exhibits. *See e.g., Ascend Performance Materials Operations LLC, v. Samsung SDI Co.,*

IPR2020-00349, Paper 53, at 12 (PTAB. July 15, 2021) (“if exhibits are introduced during a deposition for the purposes of testing the witness’ testimony, a party should be able to submit those exhibits with the transcript, so the Board has the full context available in order to evaluate the testimony.”) Petitioner had a full opportunity to conduct redirect examination of its witnesses, and did.

Should the Board authorize any briefing on this matter, Patent Owner respectfully requests authorization to file an opposition of equal length.

Respectfully,



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