

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIVIS, INC.,
Petitioner,

v.

NOVARAD CORP.,
Patent Owner.

IPR2023-00042 (Patent 11,004,271 B2)
IPR2023-00045 (Patent 10,945,807 B2)¹

Before MIRIAM L. QUINN, MICHAEL R. ZECHER, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

ORDER
Granting In Part Patent Owner's Request to File Exhibits
37 C.F.R. § 42.5(a)

¹ The Board exercises its discretion to mail the same Order in both of these proceedings. The parties are not authorized to use this caption format.

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On December 5, 2023, the Board held a telephone conference with the parties to discuss Patent Owner's request to file exhibits which Patent Owner intended to file with its Sur-replies in IPR2023-00042 (Paper 22) and IPR2023-00045 (Paper 22). *See* Ex. 3001. Judges Quinn, Zecher, and Raevsky participated on behalf of the Board.

In IPR2023-00042, Patent Owner requests to submit the following exhibits:

- (1) Declaration of Page Vault Representative Todd W. Price (May 19, 2023) ("Price Declaration"), which includes a copy of *Amira 5 User's Guide* (Visual Imaging 2009) ("*Amira*");
- (2) Dr. Rosenberg Supplemental Declaration (referenced as Exhibit 2008 in Paper 22); and
- (3) Dr. Mulumudi Supplemental Declaration (referenced as Exhibit 2009 in Paper 22).

In IPR2023-00045, Patent Owner requests to submit the Price Declaration and the Dr. Mulumudi Supplemental Declaration (referenced as Exhibit 2005 in Paper 22).

Price Declaration

We first address the Price Declaration. During the call, we noted that the Price Declaration is already of record in IPR2023-00042 as Exhibit 1023. Patent Owner therefore agreed that there is no need to refile the Price Declaration in the -00042 case and amended its request to file the Price Declaration solely in the -00045 case. *See* 37 C.F.R. § 42.6(d). Patent Owner explained that the copy of *Amira* in the Price Declaration is the entire reference, whereas the copy of *Amira* filed as Exhibit 1005 only includes two chapters of the reference. Patent Owner had planned to file a motion to

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exclude the incomplete version of *Amira* of Exhibit 1005, and to argue in the alternative that the Board should allow Patent Owner to file the full copy of *Amira* in Exhibit 1023. However, as the parties' arguments continued, with no objection from Petitioner to include the Price Declaration in the -00045 case, Patent Owner stated that a motion to exclude Exhibit 1005 would not be needed if the Price Declaration would be allowed in the record.

Furthermore, considering how *Amira* bears on the issues presented and developed by the parties in the -00045 case, the panel notes it will be beneficial to have the Price Declaration with a full copy of *Amira*. Consequently, because Petitioner does not object to Patent Owner's request to include the Price Declaration in the -00045 case, and it would be beneficial to the Board, we grant Patent Owner's request to submit the Price Declaration as a 2000-series exhibit in IPR2023-00045.

Drs. Rosenberg and Mulumudi Supplemental Declarations

Now we turn to whether we allow Patent Owner to file the supplemental declarations of Drs. Rosenberg and Mulumudi, cited as new evidence in the sur-reply. After hearing the parties' arguments, we deny Patent Owner's request to submit the Dr. Rosenberg Supplemental Declaration (in the -00042 case) and the Dr. Mulumudi Supplemental Declarations (in both cases).

It is well established that "[a] sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b). Although we have the authority to waive this rule, Patent Owner does not persuade us to do so for these declarations. *See id.* § 42.5(b) ("The Board may waive or suspend a

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requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.”).² On the call, Patent Owner argued that the Dr. Rosenberg Supplemental Declaration and the Dr. Mulumudi Supplemental Declarations address Petitioner’s arguments in the Reply concerning the qualifications of these declarants. We determine that it is unnecessary for Patent Owner to present new evidence of qualification of its declarations via these declarations for us to assess the merits of Petitioner’s arguments raised in the Reply. At a minimum, we are able to assess the qualifications of these declarants based on their curricula vitae already submitted by Patent Owner (IPR2023-00042, Exs. 2003 & 2005; IPR2023-00045, Ex. 2003). And the inclusion of this new evidence would raise concerns of expanding discovery and briefing unnecessarily, given that (1) we are capable of determining what weight to afford the declarants’ testimony based on the sufficiency of their testimony and (2) exclusion of evidence is determined based on a proper motion to exclude.

Should Petitioner subsequently file a proper motion to exclude Dr. Rosenberg or Dr. Mulumudi’s original declarations based on their qualifications, Patent Owner may at that time choose to file these declarations with its opposition to Petitioner’s motion to exclude. *See* 37 C.F.R. § 42.64(b)(2) (“The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.”); Consolidated Trial Practice Guide 79, *available at*

² Note that we are exercising our authority under Rule 42.5 to permit Patent Owner to file the Price Declaration.

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<https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Supplemental evidence is not filed at the time of the objection, but simply served, and is filed only in support of an opposition to a motion to exclude.”).

It is, therefore,

ORDERED that Patent Owner’s request to file the Price Declaration as a 2000-series exhibit in IPR2023-00045 is *granted*; and

FURTHER ORDERED that Patent Owner’s request to file supplemental declarations in IPR2023-00042 and IPR2023-00045 as new evidence supporting the Patent Owner Sur-reply is *denied*.

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FOR PETITIONER

Kia L. Freeman

John Curran

MCCARTER & ENGLISH, LLP

kfreeman@mccarter.com

jcurran@mccarter.com

FOR PATENT OWNER

Joseph Harmer

Jed H. Hansen

THORPE NORTH & WESTERN LLP

joseph.harmer@tnw.com

hansen@tnw.com