Filed on behalf of Intuit Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner

v.

SAMESURF, INC.,
Patent Owner.

Inter Partes Review No. IPR2023-00339
Patent 9,185,145 B2

PETITIONER'S MOTION TO STRIKE EXHIBITS 2006 AND 2007

Petitioner moves to strike Exhibits 2006 and 2007, which were filed with Patent Owner's Sur-reply. Patent Owner's submission of Exhibits 2006 and 2007 violates 37 C.F.R. § 42.23(b) and the Consolidated Trial Practice Guide because these exhibits are not deposition transcripts.

I. BACKGROUND

On January 31, 2024, Patent Owner filed Exhibits 2006 and 2007 with its Sur-reply. Sur-reply (Paper 27) at 2, 7, 8. These exhibits are Petitioner's Notice of Motion and Motion to Dismiss Pursuant to Rule 12(b)(6) (Ex. 2006) and Reply in Support of Its Motion to Dismiss (Ex. 2007) from the district court case corresponding to the patent at issue in this case in the Southern District of California, Case No. 22-cv-00412-LL-KSC. Petitioner requested Patent Owner withdraw the improper exhibits on February 2, 2024; Patent Owner declined. Petitioner timely objected to Exhibits 2006 and 2007 on February 7, 2024. Petitioner's Objections to Evidence (Paper 28). Petitioner requested permission to file this Motion on February 6, 2024. On February 7, 2024, the Board authorized this Motion. Oral argument is scheduled for March 27, 2024. Scheduling Order (Paper 13) at 12.

II. THE BOARD SHOULD STRIKE EXHIBITS 2006 AND 2007 BECAUSE THEY WERE FILED CONTRARY TO THE BOARD'S RULES AND TRIAL PRACTICE GUIDE

USPTO Rule 42.23(b) expressly prohibits a patent owner from submitting new evidence with its sur-reply other than deposition transcripts of the cross-examination of any reply witness. ("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.") Likewise, the Consolidated Trial Practice Guide states that a "sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." PTAB Consolidated Trial Practice Guide (CTPG), November 2019 at 73. The Board routinely strikes such improper new evidence. *See, e.g.*, *Satco Products, Inc. v. Seoul Semiconductor Co., Ltd.*, IPR2020-00836, Paper 45 at 75-77 (P.T.A.B. Oct. 22, 2021) (striking non-patent literature as being, beyond dispute, improperly submitted new evidence); *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01278, Paper 37 at 31-33 (P.T.A.B. Jan. 19, 2021) (striking a supplemental declaration filed with patent owner's sur-reply because it constituted new evidence other than deposition transcripts of the cross-examination of any reply witness); *Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper 66 at 3-5 (P.T.A.B. April 20, 2020) (striking patent file histories and non-patent literature filed with patent owner's sur-reply because it constituted new evidence other than deposition transcripts of the cross-examination of any reply witness). Indeed, the only circumstances in which the Board has allowed other evidence with a Sur-reply has been for exhibits that were introduced at deposition. *See Ascend Performance*

Materials Operations LLC v. Samsung SDI Co., Ltd., IPR2020-00349, Paper 53 (P.T.A.B. July 15, 2021) (allowing exhibits first introduced at deposition).

Here, Exhibits 2006 and 2007 are not deposition transcript exhibits or exhibits raised during deposition; indeed Patent owner took no deposition in this case. Rather, Exhibits 2006 and 2007 are documents that were filed by Petitioner in the district court case corresponding to the patent at issue in this case, and were not previously of record in this IPR proceeding. The Board should strike these new Exhibits 2006 and 2007 because Patent Owner was not permitted to file evidence of this nature with its Sur-reply.

The facts in this case are nearly identical to those in *Satco Products*. As Patent Owner asserted in its email to the Board dated February 7, 2024, Patent Owner in that case asserted that the exhibits were not "new evidence." The Board found these arguments unpersuasive because "[t]he exhibits were not of record prior to Patent Owner filing them with its Sur-reply…[and] Patent Owner does not contend, nor do we find, that the exhibits comprise deposition transcripts." *Satco Products*, IPR2020-00836, Paper 45 at 76. The Board in that case also rejected Patent Owner's arguments both that striking the exhibits would be prejudicial and that striking

exhibits is an "exceptional remedy."[1] *Id.* Likewise, it is established case law that if a Patent Owner believes that a Reply argument necessitates a new argument or evidence in response, Patent Owner should request authorization from the Board before including new arguments or evidence in its Sur-reply. *See ParkerVision, Inc. v. Vidal*, No. 2022-1548, slip op at *20 (Fed. Cir. Dec. 15, 2023) (affirming Board position on same). As a result, the Board in this case should reach the same result as in *Satco Products*, and strike Exhibits 2006 and 2007 as improper new evidence.

III. CONCLUSION

Petitioner therefore respectfully requests that the Board grant this Motion and strike Exhibits 2006 and 2007 from the record.

Dated: February 14, 2024

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[1] The Board noted that the CTPG lists as an "extraordinary" remedy the striking of the entirety or a portion of Patent Owner's Sur-reply, not only the exhibits submitted with the Sur-reply. *Id.* at 76-77; citing CTPG at 80-81.

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on February 14, 2024, I caused a true and correct copy of the foregoing PETITIONER'S MOTION TO STRIKE EXHIBITS 2006 AND 2007 to be electronically served on Petitioner's lead and backup counsel at the following addresses:

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