

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.
Petitioner

v.

SHAMROCK INNOVATIONS, LLC
Patent Owner

Case No. IPR2023-00842
Patent No. 9,535,454

**PETITIONER'S MOTION TO STRIKE
NEW SUR-REPLY ARGUMENTS**

I. INTRODUCTION

As authorized by the Board's June 7, 2024, email, Petitioner seeks to strike PO's new Sur-Reply argument that the Petition fails to show Vangemert teaches generating "a flow control signal in response to the amount of data stored in the first buffer equaling or exceeding the fill amount." *See* Paper 48, Sections III at 7-10 and V.A. at 16. at 3. The Board should strike PO's new argument because Petitioner was unable to respond to the argument in its Reply and cannot adequately address the new argument at oral argument.

II. BACKGROUND

Section VII.A.1.k of the Petition addresses the limitation of generating "a flow control signal in response to the amount of data stored in the first buffer equaling or exceeding the fill amount." Paper 2 at 28-30. The entire first paragraph of this section demonstrates how Vangemert teaches this limitation. *Id.* at 28. The Petition explains that Vangemert teaches "generating a flow control signal in the form of a buffer credit signal," which is generated "when the available buffer space is sufficient (*equal to the fill amount*) to accept the data word to be transmitted." *Id.* This paragraph also cites paragraphs 68-69 of Dr. Caloyannides's Declaration, which demonstrate how Vangemert alone teaches this limitation, even ending with the sentence "Accordingly, Vangemert discloses generating 'a flow control signal in

response to the amount of data stored in the first buffer equaling or exceeding the fill amount,’ as claimed.” EX 1003 ¶ 69. The Petition and expert declaration then present an alternative argument for this limitation relying on Copeland. *See* Paper 2 at 28 (“To the extent Vangemert is deficient, Copeland teaches”); EX 1003 ¶ 70 (“Copeland additionally teaches”).

The POR does not argue the Petition fails to show Vangemert teaches this limitation. The POR only challenges the correctness of combining Vangemert with Copeland and whether the Petition showed the claimed flow control signal passed through the second buffer. Paper 13 at ii-iii, 18-38. Moreover, instead of challenging it, PO’s expert seems to agree that Vangemert discloses this limitation:

Further, a POSITA would also understand that the buffer credit manager calculates available space, sends a buffer credit signal if sufficient space is available, and buffer control words are then sent to the transmit node via buffer control words, and that these buffer control words or “credits” enable the transmitter to send data frames.

EX 2002 (Mr. Lee Decl.), ¶ 87.

III. ARGUMENT

The Board has explained that any “arguments not presented in the Patent Owner Responses ‘will be deemed waived.’” *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00918, Paper 21 at 18 n.14 (P.T.A.B. Oct. 15, 2020) (finding waiver because “[a]rguments not presented in the Patent Owner Responses ‘will be deemed

waived”); *see also* Consolidated Trial Practice Guide, 84 Fed. Reg. 64,280 (Nov. 21, 2019) at 74 (a “sur-reply that raises a new issue or belatedly presents evidence may not be considered”; a sur-reply “may only respond to arguments raised” in the reply but “[r]espond’ . . . does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing”).

When new arguments are raised in a Sur-Reply, the proper remedy is striking the new arguments. *See, e.g., Trane U.S. Inc. v. Semco, LLC*, IPR2018-00514, Paper 36 at 8 (P.T.A.B. Apr. 17, 2019) (granting motion to strike and stating, “we cannot overlook a party’s blatant disregard of our rules and practice when doing so would unfairly prejudice another party . . . and impact the efficiency of our decision-making”). “The reason for limiting the scope of a sur-reply is simple—to promote procedural fairness and prevent sandbagging.” *Id.* at 7.

Because the POR did not contest the Petition’s assertion that Vangemert discloses generating “a flow control signal in response to the amount of data stored in the first buffer equaling or exceeding the fill amount,” PO has waived any arguments to the contrary. *Apple*, IPR2019-00918, Paper 21 at 18 n.14.

PO attempts to justify its new argument by alleging the Petition gave no notice that Vangemert alone teaches this limitation. But as identified in Section II above, the entire first paragraph of *the section devoted to this limitation* in the Petition

addresses how Vangemert alone teaches this limitation while citing to Dr. Caloyannides's Declaration similarly explaining how Vangemert alone teaches this limitation. *See* Paper 2 at 28; EX 1003, ¶¶ 68-69 ("Accordingly, Vangemert discloses generating 'a flow control signal in response to the amount of data stored in the first buffer equaling or exceeding the fill amount,' as claimed."). Even the introduction of the Petition's alternative argument relying on Copeland, Paper 2 at 28 ("To the extent Vangemert is deficient, . . ."), demonstrates that the Petition's initial argument for this limitation relies on Vangemert alone. PO's attempted justification is thus refuted by the plain language of the Petition and the cited expert declaration; the assertion that PO lacked notice of this argument is not credible.

The new arguments in PO's Sur-Reply about the disclosures of Vangemert or the claim requiring a "trigger" under a proper construction of the limitation could have been raised in the POR but were not. PO's failure to raise these arguments until the Sur-Reply has unfairly prejudiced Petitioner and further warrants granting this motion. *See, e.g., Trane U.S.*, IPR2018-00514, Paper 36 at 8. For example, because PO did not contest Vangemert's disclosure of this limitation in its POR, Petitioner identified PO's waiver in Petitioner's Reply, Paper 15 at 3-4, and incorporated that waiver into its strategy for addressing arguments in the Reply. Had PO made the new arguments in the POR, Petitioner could have responded to the arguments in its

Reply, deposed PO's expert about the apparent inconsistency between the expert's declaration and the new arguments, and considered PO's new positions in Petitioner's strategy for the Reply. Instead, Petitioner has been unfairly prejudiced and deprived of these opportunities by PO's new arguments in the Sur-Reply.

Consistent with the Board's typical practice, the Board should strike PO's new arguments raised for the first time in the Sur-Reply. *See, e.g., Unified Patents, LLC v. American Patents LLC*, IPR2019-00482, Paper 73 at 5 (PTAB Apr. 3, 2020) (striking new sur-reply arguments that patent owner exercised diligence to a constructive reduction to practice); *Trane U.S.*, IPR2018-00514, Paper 36 at 2 (striking new sur-reply arguments regarding objective indicia of non-obviousness); *3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, Paper 45 at 7 (PTAB Apr. 26, 2019) (striking new sur-reply arguments about disclosures of a prior art reference).

IV. CONCLUSION

For the foregoing reasons, PO has waived any argument about Vangemert's disclosure of the limitation for generating "a flow control signal," and Sur-Reply Section III at 7-10 and Section V.A. at 16 should be stricken.

Respectfully submitted,

Dated: June 14, 2024

s/ Melanie J. Reichenberger
Melanie J. Reichenberger, Reg. No. 76,144
K. Sam Brooks, Reg. No. 73,613
Michael Best & Friedrich LLP
790 North Water Street, Suite 2500
Milwaukee, WI 53202
Tel: 414.271.6560
Fax: 414.277.0656
mjreichenberger@michaelbest.com
ksbrooks@michaelbest.com

Jon R. Trembath, Reg. No. 38,344
Michael Best & Friedrich LLP
675 15th Street, Suite 2000
Denver, CO 80202
Tel: 720.240.9515
Fax: 877.398.5240
jrtrembath@michaelbest.com

Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 CFR § 42.6(e), on June 14, 2024, a copy of the foregoing **PETITIONER’S MOTION TO STRIKE NEW SUR-REPLY ARGUMENTS** was served via email (as consented to by counsel) on the following attorneys of record:

Brandon R. Theiss
Daniel H. Golub
VOLPE KOENIG
30 S. 17th Street, Suite 1800
Philadelphia, PA 19103
Email: BTheiss@vklaw.com
Email: DGolub@vklaw.com

Dated: June 14, 2024

s/ Melanie J. Reichenberger
Melanie J. Reichenberger (Reg. No. 76,144)
Counsel for Petitioner