

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.,

Petitioner,

v.

SHAMROCK INNOVATIONS, INC.,

Patent Owner.

Case No. IPR2023-00842

U.S. Patent No. 9,535,454

PATENT OWNER'S RESPONSE TO MOTION TO STRIKE

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Petitioner's Motion to Strike §III and §V.A. of Patent Owner's Sur-Reply should be denied as (1) the Sur-Reply was a proper and permissible response under the rules, and (2) Petitioner failed to obtain permission for §V.A.

1. Patent Owner's Sur-Reply Was Proper, And Therefore Petitioner's Motion To Strike §III Should Be Denied.

In its Reply, Petitioner made two arguments: (1) Patent Owner (PO) "agreed" that "Vangemert alone satisfies the 'wherein the module is operable to generate a flow control signal in response to the amount of data stored in the first buffer equaling or exceeding the fill amount' limitation," and (2) Patent Owner waived any argument to the contrary because the Petition "consistently explained Vangemert alone taught the above limitation." Reply, at 3-4. PO directly responded in the Sur-Reply as permitted under the rules. 37 C.F.R. §42.23(b)(a sur-reply may "respond to arguments raised in the corresponding reply.")

PO responded to the waiver argument made in the Reply by stating that the Petition failed to allege in the first place that Vangemert "generate[d] a flow control signal in response to the amount of data stored in the first buffer equaling or exceeding the fill amount," as claimed. Sur-Reply, at 8. As explained in the Sur-Reply, the characterization of Vangemert in the Petition failed to track the actual claim language.

Petitioner's Characterization of Vangemert	Claim Language
the bit credit signal is generated <u>when the available buffer space is sufficient</u> (equal to the fill amount) to accept the data word to be transmitted (emphasis added).	the module is operable to generate a flow control signal <u>in response to the amount of data stored</u> in the first buffer <u>equaling or exceeding</u> the fill amount (emphasis added).

Sur-Reply, at 9. Having properly pointed out that the Petition failed in the first instance to allege that Vangemert met the actual claim language, the Sur-Reply then properly explained why the difference between the Petition's characterization of Vangemert and the actual claim language was material. From the Sur-Reply:

... In this context, there is a critical difference between generating a flow control signal "in response to" the action of stored data "equaling or exceeding the fill amount" and generating a flow control signal "when the available buffer space is sufficient ..." While Vangemert continually assesses the unoccupied buffer space and may generate advanced permission signals "when" (at a time that) the unoccupied space equals a certain amount, in Vangemert, the generation of such signals is not triggered by the action of stored data in the buffer reaching or crossing a threshold, as claimed. Sur-Reply, at 10 (emphasis in original).

When Petitioner advanced its waiver argument in the Reply, PO was fully within its rights to respond to that waiver argument by pointing out (i) that the Petition failed in the first instance to allege that Vangemert met the actual claim language, and (ii) that the difference between the Petition's characterization of Vangemert and the actual claim language was material. 37 C.F.R. §42.23(b)(a sur-reply may "respond to arguments raised in the corresponding reply.")

Significantly, the Motion to Strike (MTS) does not dispute that there are

material differences between the actual claim language and the Petition's characterization of Vangemert. The MTS fails to explain why -- in response to the wavier argument in the Reply -- PO is foreclosed, arguing that there was no waiver because (i) there are differences in language (between the Petition and the actual claim language), and (ii) those differences matter.

Unable to point to an allegation from the Petition that Vangemert met the actual claim language, the MTS cites a statement from the expert declaration filed with the Petition. See MTS, at 1-2. However, as explained in the Sur-Reply, PO is not obligated to respond to arguments not made in the Petition but are referenced only through citation to expert reports (see Sur-Reply, Footnote 7). Like the Petitioner in this case, the Petitioner in *3M Company v. Evergreen Adhesives, Inc.*, 860 Fed. Appx. 724 (Fed. Cir. 2021), sought to make an argument that “was not advanced in the briefing and [was] referenced only through citation to expert reports.” *Id.*, at 725. The Federal Circuit found that the Board properly rejected Petitioner's strategy “as an attempt to introduce argument by citation to its expert declaration in violation of 37 C.F.R. §42.6(a)(3), the Board's rule against incorporation by reference.” *Id.* As the Court explained:

The Board's rules concerning trial practice are set forth in 37 C.F.R. Chapter 1, Subchapter A, Part 42 (Trial Practice Before the Patent Trial and Appeal Board). Section 42.6 of the rules concerning Filing of Documents, regarding incorporation by reference, provides that “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). When promulgating §

42.6(a)(3), the Patent and Trademark Office explained that the rule “minimizes the chance that an argument would be overlooked and eliminates abuses that arise from incorporation and combination,” ..., and noted that without the rule, the Board would be forced to “play archeologist with the record” for arguments that might have been made outside the parties’ briefing. *Id.*, at 725-726 (emphasis added)(citations omitted).

Simply put, Petitioner cannot base a waiver argument on text not included in the Petition but referenced only through citation to expert reports. Petitioner’s waiver argument represents an attempt by Petitioner to retroactively incorporate a new argument from its expert report into the Petition (in violation of the rules), and through its MTS, Petitioner is now attempting to foreclose PO from responding to that new argument. Such tactics are improper and should be rejected.

In addition to its waiver argument, the Reply alleged that “PO agreed” that the same “limitation is satisfied by Vangemert alone” (Reply, 3). Again, PO responded to this argument in the Reply by explaining that the statements of PO (alleged to show PO’s agreement that the limitation in question was satisfied by Vangemert alone) said no such thing. *See*, Sur-Reply, at 10 (“None of Petitioner’s citations to the POR or PO’s expert include the critical phrase “in response to” when characterizing Vangemert.”) Again, the MTS does not dispute that there is a material difference between the actual claim language and the statements of PO identified in the Reply. The MTS fails to explain why -- in response to the mischaracterization in the Reply of PO’s prior statements -- PO is foreclosed from pointing out that PO’s

prior statements do not “agree” that the limitation in question is met by Vangemert alone as argued in the Reply.

2. Petitioner’s Motion To Strike §V.A. Of The Sur- Reply Is Improper And Should Be Denied.

While Petitioner only requested (and received) permission from the Board to file a Motion To Strike §III of the Sur-Reply (see June 6, 2024 email to Board from Petitioner and June 7, 2024 response from Board), the MTS also seeks to have §V.A. of the Sur-Reply be stricken. MTS, at 1 and 5. This is procedurally improper as Petitioner never requested authorization to file a motion to strike §V.A.

Additionally, other than a cursory mention of §V.A. in the Introduction and Conclusion, the MTS does not allege that anything about §V.A. of the Sur-Reply is improper. In any event, §V.A. of the Sur-Reply is entirely proper, as it responds directly to the argument in the Reply that “[t]he Petition relied on Vangemert to show that all other limitations of claim 1 of the ’454 patent were known, except for the claimed connectors.” Reply, at 3. §V.A. properly responded to the above argument by stating that “the Petition did not even allege that Vangemert ‘generate[d] a flow control signal in response to the amount of data stored in the first buffer equaling or exceeding the fill amount,’ as claimed” and instead relied on Copeland for such limitation. Sur-Reply, at 16. The MTS fails to explain anything improper about the above response.

For the reasons set forth above, Petitioner’s MTS should be denied.

Respectfully submitted,

Dated: June 20, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S RESPONSE TO MOTION TO STRIKE** was served via email (as consented to by counsel) on June 21, 2024 to lead and backup counsel of record for Petitioners as follows:

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