

From: Greenleaf, Kevin R. <kevin.greenleaf@dentons.com>

Sent: Thursday, April 25, 2024 4:43 PM

To: Trials <Trials@USPTO.GOV>

Cc: Alison Richards <arichards@giplg.com>; Ragnar Olson <rolson@giplg.com>; David Berten <dberten@giplg.com>; Bock, Joel N. <joel.bock@dentons.com>

Subject: IPR2023-00953 // Mot. to Strike Improper New Evidence and Related Argument in Patent Owner's Sur-Reply

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Dear Board,

Petitioner moves to strike the improper new evidence and related arguments in Patent Owner's Sur-Reply. The evidence includes a newly constructed webpage allegedly using source code from the '329 patent and a declaration discussing fixes for bugs in the code of the '329 patent.

Rule 42.23(b) expressly prohibits new evidence in patent owner sur-replies. See also, Consolidated Trial Practice Guide at 73-74. Sur-replies allow patent owners "to respond to new exhibits or other new information in a petitioner's reply." PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence, 85 FR 273, 79120, 79124 (December 9, 2020). Sur-replies are unlike petitioner replies where the Board expects new evidence. *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023). Petitioner does not believe briefing or a call are required; however, Petitioner requests authorization to file a motion to strike in the alternative.

Patent owner opposes this request. With its Reply, Petitioner submitted a new declaration from Smedley disclosing a new opinion that the '329 patent does not disclose code for implementing a viewability test and that the '329 patent's code is "gobbledygook." EX1026¶ 23. Commenting on the unreliability of Smedley's Reply declaration, Patent Owner's sur-reply relies on the code already in evidence as part of the '329 patent (EX1001), and activates it such that the Board can see the code disclosed in the '329 patent operating in realtime. The Tchibirev declaration, EX2064, is not new evidence but simply explains how this was done (code cut and paste from the patent) and that a few typos were corrected (e.g. use of smart and non-smart quotes).

If necessary, the parties are available to discuss Petitioner's request at the following ET times:

- 4/26, Friday, before 11:30 am
- 4/30, Tuesday, after 1 pm
- 5/1, Wednesday, 10-1 and 2-5
- 5/2, Thursday, anytime
- 5/3, Friday, anytime

Best regards,

Kevin Greenleaf

Counsel for Petitioner

Kevin R. Greenleaf

My pronouns are: He/Him/His

+1 650 798 0381 | +1 916 838 0291

kevin.greenleaf@dentons.com | [Bio](#) | [Website](#)

Dentons US LLP

[Our Legacy Firms](#) | [Client Experience \(CX\)](#)

Dentons is a global legal practice providing client services worldwide through its member firms and affiliates. This email may be confidential and protected by legal privilege. If you are not the intended recipient, disclosure, copying, distribution and use are prohibited; please notify us immediately and delete this copy from your system. Please see [dentons.com](https://www.dentons.com) for Legal Notices.

