

**From:** [Myers, Richard S.](#)  
**To:** [Trials](#); [Nguyen, Daniel](#); [Wofsy, Scott](#); [Baker, Charles](#); [Jones, Joshua L.](#); [Geloizin, Gabrielle](#)  
**Cc:** [Barnes, Thad](#); [Miller, Sam](#); [Wright, Terry](#)  
**Subject:** RE: IPR2023-01206: Billerud Aktiebolag (publ) v. Westrock MWV, LLC  
**Date:** Thursday, January 2, 2025 5:21:39 PM  
**Attachments:** [Billerud Second Objections.pdf](#)

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**RE: IPR2023-01206: Billerud Aktiebolag (publ) v. Westrock MWV, LLC**

Dear Board,

Further to our email below that we sent to you on December 23, 2024, at 2:33 p.m. Eastern Time, we respectfully request guidance in light of the impending January 22, 2025 hearing date and motion response date of January 8, 2025. Because the dates for availability in our email have passed without a response from the Board, we update that we are available for a telephone conference tomorrow, January 3, 2025. We are also available January 6 or 7, 2025.

This is a time sensitive matter because:

(1) we are requesting authorization to file a motion to strike the Motion to Exclude and Third Supplemental Declaration of Charles Klass.

(2) Patent Owner filed the Motion to Exclude on December 18, 2024. Petitioner filed a Notice of Deposition on December 20, 2024, stating that it would conduct cross examination on December 30, 2024. The cross-examination period ended December 31, 2024. **The due date for the opposition to motion to exclude evidence is due January 8, 2025.** Patent Owner stated it would not make Charles Klass available for a deposition until January 7, 2025, after the cross-examination period, and not until one day before our response is due. Thus, Petitioner is in a situation where we have to respond to what we believe and can show is an improper fourth expert declaration and Motion to Exclude without the benefit of cross-examination of evidence relied on in the motion.

In addition to our previously asserted grounds for the requested motion to strike, the Board has granted motions to strike a declaration where the witness could not be cross-examined. See *John's Lone Star Distribution, Inc. v. ThermoLife Int'l, LLC*, Case IPR2014-01201, slip op. at 2 (PTAB May 13, 2015) (Paper 31) (striking declaration where Petitioner refuses to make declarant available for cross-examination); *HTC Corp. v. NFC Tech., LLC*, Case IPR2014-01198, slip op. at 5 (PTAB Nov. 6, 2015) (Paper 41) (striking declaration where witness was not available for cross-examination).

(3) In the email of December 23, 2024, Petitioner asked to extend the due date for the opposition to motion to exclude evidence one week from January 8 until January 15, 2025. In view of the above, Petitioner also asks to extend the due date to serve demonstrative exhibits one week, from January 10, 2025 until January 17, 2025. Petitioner also requests that the date of the oral hearing be

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extended from January 22, 2025 until [January 29, 2025](#).

We respectfully request a response and/or conference with the Board as soon as possible.

Best regards,  
Richard Myers

**Richard S. Myers, Jr.**

*Member - Registered Patent Attorney*

*Direct: 615-782-2333*

*Mobile: 615-294-5307*

**STITES & HARBISON** PLLC

401 Commerce Street, Suite 800, Nashville, TN 37219

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**From:** Myers, Richard S.

**Sent:** Thursday, December 26, 2024 1:33 PM

**To:** trials@uspto.gov; Nguyen, Daniel <dnguyen@lockelord.com>; Wofsy, Scott <Scott.Wofsy@lockelord.com>; Baker, Charles <CBAKER@lockelord.com>; Jones, Joshua L. <Joshua.Jones@lockelord.com>; Gelozin, Gabrielle <Gabrielle.Gelozin@lockelord.com>

**Cc:** Barnes, Thad <TBarnes@stites.com>; Miller, Sam <smiller@stites.com>; Wright, Terry <twright@stites.com>

**Subject:** IPR2023-01206: Billerud Aktiebolag (publ) v. Westrock MWV, LLC

**RE: IPR2023-01206: Billerud Aktiebolag (publ) v. Westrock MWV, LLC**

Dear Board:

We represent the Petitioner in the above IPR. Petitioner seeks authorization from the Board to file a motion to strike Patent Owner's Motion to Exclude (Paper 42) and the Third Supplemental Declaration of Charles Klass (Exhibit 2012). As a precautionary measure, Petitioner also seeks leave to take the deposition of Charles Klass beyond December 31, 2024, and extend the deadline to respond to the Motion to Exclude to January 15, 2025.

Background

1. On December 18, 2024, Patent Owner filed the Motion to Exclude and Third Supplemental Declaration of Charles Klass.
2. On December 20, 2024, Petitioner served the attached Second Objections upon Patent Owner and, in an effort to not involve the Board, asked via email that Patent Owner withdraw the Motion to Exclude and the Third Supplemental Declaration. Patent Owner also served a notice of deposition for December 30, 2024, for Mr. Klass as a precautionary measure.

3. On December 23, 2024, Patent Owner responded to Petitioner and rejected its request to withdraw. Patent Owner also stated that Mr. Klass would not be available for deposition until January 7, 2025, which is after the December 31, 2025, deadline for cross-examination depositions.

4. Petitioner's Opposition to the Motion to Exclude is due January 8, 2025, the day after Patent Owner is making Mr. Klass available for deposition. The deposition transcript will not even be available until after the current due date.

#### Issues for the Board

As explained in the attached Second Objections, the Board should be familiar with Mr. Klass because Patent Owners previously attempted to offer his inadmissible testimony. With the current filing, Patent Owner is attempting to "backdoor" Mr. Klass's testimony to support Patent Owner's Sur-reply (Paper 38, filed on December 10, 2024), which it cannot do. Mr. Klass's Third Supplemental Declaration contains the same or similar substance as his impermissible Second Supplemental Declaration (Exhibit 2010), which Patent Owner tacitly admitted was improperly filed and was forced to withdraw.

Because Patent Holder is attempting to provide "backdoor" testimony to support its Sur-reply, Petitioner objects to Exhibit 2012 (and the Motion to Exclude generally). 37 CFR 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.") The Consolidated Trial Practice Guide also confirms 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, November 2019 at 73.) See, also, *Satco Products, Inc. v. Seoul Semiconductor Co., LTD.*, IPR2020-00836, Paper 45 at 74-77 (PTAB Oct. 22, 2021); *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01278, Paper 37 at 31-33 (PTAB 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 (PTAB 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).

Additionally, the Third Supplemental Declaration improperly relies upon and references the withdrawn Exhibit 2010 (Klass's Second Declaration). In the Third Supplemental Declaration, Mr. Klass states, in pertinent part, that Klass "stand[s] by all statements made" in the Second Supplemental Declaration. This declaration was withdrawn and Klass' and Patent Owners actions are improper.

Mr. Klass's Third Supplemental Declaration has nothing to do with the admissibility of Exhibits 1013-1015. The Board has long held that motions to exclude should not go to the weight of the evidence

and motions that do so are improper. Here, the Third Declaration's sole and obvious purpose is to address the weight of Petitioner's evidence by improperly offering new documentary evidence (i.e. charts) and testimony evidence in response to Exhibits 1013-1015 and Petitioner's Reply. At worst, the Third Declaration is a "Trojan horse" in its claim to be necessary to dispute the admissibility of Exhibits 1013-1015 and Mr. Wirens's Declaration. At best, the Third Supplemental Declaration goes to the weight of the evidence, not its admissibility.

Petitioner further objects because nothing in the Board's rules and procedures permits a party to file a declaration in support of a Motion to Exclude.

Petitioner also objects to the Motion to Exclude and all arguments that rely upon Exhibit 2012 and the statements/testimony offered therein for the same reasons as above.

Although it does not appear to apply the statements/testimony offered in Exhibit 2012 directly in argument, the Motion to Exclude places a reliance on Exhibit 2010 through reference in Exhibit 2012 and, therefore, Petitioner objects for the same reasons as above and the fact that a withdrawn exhibit cannot be used for any purpose in a proceeding.

#### Request for Relief

(1) Petitioner respectfully requests a conference with the Board and/or authorization to file a motion to strike the Motion to Exclude and Third Supplemental Declaration.

(2) Petitioner request that its due date for the opposition to motion to exclude evidence be extended one week from January 8 until January 15, 2025.

#### Availability

Counsel for Petitioner is available for a conference on December 27, 30, or 31, 2024.

Respectfully submitted,  
Richard Myers  
Lead Counsel for Petitioner

#### **Richard S. Myers, Jr.**

*Member - Registered Patent Attorney*

*Direct: 615-782-2333*

*Mobile: 615-294-5307*

#### **STITES&HARBISON** PLLC

401 Commerce Street, Suite 800, Nashville, TN 37219

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