

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLGATE-PALMOLIVE COMPANY,
Petitioner,

v.

NOBLE INNOVATIONS NC L.L.C.,
Patent Owner

IPR2023-01254
U.S. Patent No. 8,881,332

PETITIONER'S MOTION TO STRIKE

Petitioner moves to strike Exhibits 2014 and 2015, which were filed with Patent Owner's Sur-reply. Patent Owner's submission of Exhibits 2014 and 2015 violated 37 C.F.R. § 42.23(b) because these exhibits are not deposition transcripts.

I. Background

On August 29, 2024, Patent Owner filed Exhibits 2014 and 2015 with its Sur-Reply to Petitioner's Reply. *See* Paper 28 at iv, 23. After conferring with Patent Owner, on September 6, 2024, Petitioner requested authorization from the Board to file this Motion. The Board authorized this Motion on that same day, and set a deadline of September 13, 2024 to file this Motion. Oral argument is scheduled for October 31, 2024, if requested. Paper 13 at 12.

II. The Board should strike Exhibits 2014 and 2015 as improperly filed.

37 C.F.R. § 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 PTAB Consolidated Trial Practice Guide ("PTAB 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 Practice Guide, November 2019, at 73. The PTAB Practice Guide also states that a Motion to Strike

is appropriate “when a party believes the Board should disregard arguments or late-filed evidence in its entirety.” PTAB Practice Guide, November 2019, at 80; *see also* *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01278, Paper 37 at 31-33 (PTAB Jan. 19, 2021) (striking supplemental declaration filed with patent owner’s sur-reply); *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).

Exhibits 2014 and 2015 are not proper sur-reply evidence. Rather, they are non-patent literature, including a 2009 annual report (Ex. 2014) and an article from a website (Ex. 2015). The Board should strike new Exhibits 2014 and 2015, and any reference to or reliance on Exhibits 2014 and 2015 by Patent Owner should be disregarded.

When Petitioner conferred with Patent Owner regarding the filing of this Motion, Patent Owner argued that submitting Exhibits 2014 and 2015 was proper to rebut Petitioner’s arguments related to Exhibits 1020-1025 filed with Petitioner’s Reply. However, the Board has routinely held that new evidence, other than deposition transcripts of the cross-examination of any reply witness, cannot be submitted with a patent owner’s sur-reply, even if a patent owner believes they are needed to rebut arguments. *See Satco Products, Inc. v. Seoul Semiconductor Co., Ltd.*, IPR2020-00836 at 1-2, 75-77 (PTAB Oct. 22, 2021) (finding “unpersuasive”

the patent owner’s arguments that new exhibits filed with the patent owner’s sur-reply were needed to rebut petitioner’s arguments, and striking the exhibits because the exhibits did not “comprise deposition transcripts of the cross-examination of any reply witness” and “[t]hus, the exhibits were improperly submitted, without authorization and in violation of our Rules and Guidance”).

Petitioner submitted Exhibits 1020-1025 to disprove the unsupported assertions in Patent Owner’s Response that Colgate copied Patent Owner’s invention. Pet. Reply, Paper 27, at 18-22; PO Response, Paper 21, at 39. Patent Owner’s Exhibits 2014 and 2015, however, were filed as alleged evidence of commercial success of Colgate’s WISP product. *See* PO Sur-Reply at 23. In its Reply, Petitioner noted that Patent Owner’s Response included no evidence of commercial success. Pet. Reply at 18. Thus, contrary to Patent Owner’s suggestion, new Exhibits 2014 and 2015 were not necessitated by Petitioner’s Reply—they are belated evidence of alleged commercial success. While a sur-reply “can help crystalize issues for decision,” a sur-reply “that raises a new issue or belatedly presents evidence may not be considered.” PTAB Practice Guide, November 2019, at 74.

Petitioner, therefore, respectfully requests that the Board grant this Motion and strike Exhibits 2014 and 2015 from the record.

Dated: September 13, 2024

Respectfully submitted,

By: /Keith D. Harden/
Keith D. Harden
Registration No. 74,472
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a copy of the foregoing PETITIONER’S MOTION TO STRIKE was served on September 13, 2024 by electronic mail on the following counsel for Patent Owner:

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Dated: September 13, 2024

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