

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 (PATENT NO. 8,881,332)

PATENT OWNER'S OPPOSITION TO MOTION TO STRIKE

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Patent Owner opposes Petitioner's motion to strike Exhibits 2014 and 2015 because these exhibits were filed with Patent Owner's Sur-reply in response to new evidence filed by Petitioner (Exhibits 1020-1025) in Petitioner's Reply.

I. Background

On July 29, 2024, Petitioner filed its Reply. Paper 27. Petitioner included six new exhibits 1020-1025. On August 29, 2024, Patent Owner filed its Sur-reply and included Exhibits 2014 and 2015 which respond to new arguments raised in Patent Owner's reply. Both Exhibits 2014 and 2015 were publicly available.

II. The Board should Deny Petitioner's Motion to Strike

Patent Owner's Sur-reply only responds to arguments raised in Petitioner's Reply. Patent Owner responded to Petitioner's new argument regarding Petitioner's allegations that Noble failed to prove secondary considerations. Specifically, Petitioner argued that Colgate's Wisp was not commercially successful. Paper No. 27 at 27. Patent Owner responded to this argument (raised for the first time) in Petitioner's reply by providing proof that Colgate's Wisp generated significant sales and improved market share when it was released. Paper No. 28 at 23.

Thus, it is clear that Patent Owner's sur-reply was within the rules by only responding to arguments raised in Petitioner's reply. 37 C.F.R. § 42.23(d).

Petitioner misinterprets the regulations to prevent Patent Owner from ever filing new evidence other than deposition transcripts of the cross-examination of a reply witness. However, 37 C.F.R. § 42.23(b) clearly states that a sur-reply "may not" be accompanied by new evidence, not that it ***shall not*** be accompanied by new evidence. The language of the statute is permissive, not mandatory. And, as the Supreme Court has recently said in connection with interpreting the U.S. Code: "The statute says 'may.' And 'may' does not just suggest discretion, it '*clearly* connotes' it." *Biden v Texas*, _597 US 785; 142 S Ct 2528, 2541 (2022) (emphasis in original), quoting *Opati v Republic of Sudan*, 590 US 418, 140 S. Ct. 1601, 1604 (2022).¹

¹ See also https://www.americanbar.org/groups/government_public/resources/public_lawyer_career_center/Career_Articles/gruwell-article-five-tips-reading-legislation.

Where Petitioner has raised new arguments, the statute clearly states the Patent Owner may respond. Further the Board has discretion to allow rebuttal evidence. This is exactly what Patent Owner has done in addressing Petitioner's new arguments related to secondary considerations.

Accordingly, Patent Owner respectfully requests the Board deny Petitioner's motion to strike Exhibits 2014 and 2015. Or, to the extent, the Board determines that permission is required, Patent Owner hereby requests leave to file the exhibits in question, or that the Board treat this paper as the request for leave to file.

In the alternative, if the Board finds that Patent Owner should have requested permission to include Exhibits 2014 and 2015 when responding to Petitioner's new arguments, Patent Owner respectfully requests permission to include Exhibits 2014 and 2015, ex post facto.

Dated: September 20, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PATENT OWNER'S
OPPOSITION TO MOTION TO STRIKE was served on September 20, 2024 at the following

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