

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 8,881,332 B2

Before RYAN H. FLAX, TIMOTHY G. MAJORS, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

ORDER
Granting-in-Part Petitioner's Motion to Strike
37 C.F.R. §§ 42.5(a), 42.7(a)

I. INTRODUCTION

Noble Innovations NC LLC (“Patent Owner”) is the owner of U.S. Patent 8,881,332 B2 (“the ’332 patent”). Paper 11, 1. On July 26, 2023, Colgate-Palmolive Company (“Petitioner”) filed a Petition for *inter partes* review challenging the patentability of claims 1, 2, and 5–18 of the ’332 patent (claims 3 and 4 are not challenged). Paper 1, 1 (“Pet.”). On February 1, 2024, we instituted trial in this proceeding. Paper 12.

Subsequently, Patent Owner filed a Response to the Petition on May 6, 2024, to which Petitioner responded with a Reply on July 29, 2024, which was followed by a Sur-reply from Patent Owner on August 29, 2024. Papers 21, 27, and 28.

On September 13, 2024, with our authorization (via email on September 6, 2024), Petitioner filed a Motion to Strike evidence and arguments filed by Patent Owner with its Sur-reply. Paper 29 (“Motion” or “Mot.”). Patent Owner opposed this Motion on September 20, 2024. Paper 32 (“Opposition” or “Opp.”).

For the reasons below, Petitioner’s Motion is *granted-in-part* and *denied-in-part*.

II. DISCUSSION

Petitioner requests that Exhibits 2014 and 2015, and arguments relying thereon, be stricken from the record and disregarded as improper sur-reply evidence, as the exhibits are “non-patent literature,” rather than “deposition transcripts of the cross-examination of any reply witness.” Mot. 1–2 (citing, *inter alia*, 37 C.F.R. § 42.23(b); PTAB’s Consolidated Trial Practice Guide at 73 (“CTPG”)). Petitioner further argues that:

Patent Owner’s Exhibits 2014 and 2015 . . . 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.

Id. at 3.

In its Opposition, Patent Owner argues that Exhibits 2014 and 2015 are evidence supporting its Sur-reply argument “that Colgate’s Wisp generated significant sales and improved market share when it was released,” thus, the exhibits are proper evidence to accompany the Sur-reply. Opp. 2–3. Furthermore, Patent Owner argues that Petitioner’s position that new evidence is not to be submitted with a sur-reply, other than deposition transcripts, is incorrect because “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.” *Id.* at 2 (citing *Biden v Texas*, 597 U.S. 785; (2022) (for the proposition that the word “may” demands the application of discretion rather than a mandate)).

Having considered the parties’ positions and the facts presented, Petitioner is correct and Patent Owner misunderstands our rules. Our Consolidated Trial Practice Guide states that a motion to strike may be appropriate when a brief “is accompanied by belatedly presented evidence.” CTPG at 80–81. Even if a motion to strike is “an exceptional remedy that . . . will be granted rarely” (*id.* at 80), Patent Owner’s evidence here warrants that remedy.

Patent Owner’s reading of our rules, that a party might file evidence with a sur-reply other than a deposition transcript if they believe that evidence supports the arguments in its sur-reply, is incorrect. It is clear from the language of our rules, as well as our consistent application thereof, that only one form of evidence is appropriately filed (by right, without Board authorization) with a patent owner’s sur-reply: The sur-reply “may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness,” and “a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.” 37 C.F.R. 42.23(b); CTPG at 73–74; *see also Semiconductor Components Indus., LLC v. Greenthread LLC*, IPR2023-01242, Paper 80 (PTAB Nov. 8, 2024) (granting motion to strike sur-reply evidence that was not deposition transcripts from the proceeding); *Ford Motor Co. v. Safe Driving Tech. LLC*, IPR2021-01446, Paper 28 at 82–83 (PTAB Mar. 10, 2023) (new sur-reply evidence not permitted)); *Satco Prods., Inc. v. Seoul Semiconductor Co., Ltd.*, IPR2020-00836 at 1-2, 75-77 (PTAB Oct. 22, 2021) (considering motion to strike and excluding improper sur-reply “rebuttal” evidence); *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01278, Paper 37, 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). Moreover, “[i]t is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing.” CTPG at 74.

Although the Board is empowered to waive application of this rule, the appropriate course for Patent Owner would have been to ask the Board to do so *before* the new evidence was filed—not to file the evidence without preauthorization. 37 C.F.R. § 42.5(b) (providing that the Board may “waive or suspend” a requirement of part 42 of the C.F.R. and “place conditions on the waiver or suspension”). Our Consolidated Trial Practice Guide explains: “[w]here a party believes it has a basis to request relief on a ground not identified in the rules, the party should contact the Board and arrange for a conference call with the Board and opposing party to discuss the requested relief with the judge handling the proceeding.” CTPG at 75. A party seeking to introduce evidence beyond that expressly permitted by our rules should raise the issue with the panel in advance as counseled by the CTPG. Merely submitting new evidence with a sur-reply was not authorized by Board rules or guidance and, here, Patent Owner did not seek authorization to file the new evidence.

With respect to Petitioner’s request that we strike portions of Patent Owner’s Sur-reply itself, the Consolidated Trial Practice Guide notes that a reply that raises a new issue might not be considered. CTPG at 74. However, “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely,” and we are capable of disregarding any new issues exceeding the proper scope of the Sur-reply. *Id.* at 80. Here, we determine that this is not a case requiring that exceptional remedy, and no part of the Sur-reply need be stricken. We will disregard and will not consider any new evidence or arguments that exceed the proper scope of the Sur-reply.

III. CONCLUSION

Thus, we *grant-in-part* and *deny-in-part* the Motion to Strike. Specifically, we grant the Motion with respect to striking (or excluding) Exhibits 2014 and 2015, but deny the Motion with respect to striking any portion of the Sur-reply.

ORDER

Accordingly, it is hereby:

ORDERED that Petitioner's Motion is *granted* to the extent Exhibit 2014 and Exhibit 2015 are stricken and excluded from the record; and

FURTHER ORDERED that Petitioner's Motion is *denied* with respect to striking any part of Patent Owner's Sur-reply.

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