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Subject: IPR2023-01372 - motion to strike under 37 CFR §42.23(b) , and other matters
Date: Monday, October 21, 2024 10:43:56 AM
Attachments: [image0894bf.PNG](#)
[image12e481.PNG](#)

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Dear Honorable Board:

I am lead counsel for Patent Owner Buergofol in the above-captioned matter – IPR2023-01372. Patent Owner respectfully requests a conference call with the Board to seek authorization to file the following:

1. Motion to Strike Petitioner’s Reply

Patent Owner appreciates that striking a Petitioner’s Reply in its entirety is an extraordinary remedy that is rarely granted, but believes the facts and circumstances warrant this relief in accordance with 37 CFR §42.23(b) and the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), at pages 80-81. The facts and circumstances are summarized briefly below:

- a. Exhibits 1070-1072 - These exhibits are communications between counsel and a draft declaration prepared by Patent Owner’s counsel for the review of the lead inventor on the ‘882 patent, Dr. Stark. While Dr. Stark is no longer employed by Patent Owner, he is under a duty and obligation not to disclose confidential information, and he is obligated by the Assignment agreement for the ‘882 patent to testify and submit oaths to aid Patent Owner. The draft declaration was received by Petitioner’s counsel on or before June 26, 2024, and in receiving that declaration, reviewing it, using it, concealing it, and submitting in a public proceeding without Patent Owner’s consent, Petitioner’s counsel violated the District Court’s Order Denying In Part Plaintiff’s Motion to Prevent Contact with Former Employee, document 56, filed January 27, 2023 (the “Order”), and violated numerous other ethical (ABA Rule 4.4(b) and USPTO Rule 11.404(b)) rules.

These exhibits 1070-1072 are unrelated to the merits of this proceeding. They are submitted in an attempt to discredit the testimony of the other two inventors, who have no opportunity to address them. The PTAB and Patent Owner should not have to weed through Petitioner’s

Reply to assess what portions might be proper and what might be improper. Patent Owner kindly requests authorization to file a motion to strike Petitioner's reply in accordance with 37 CFR §42.23(b) and the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), at pages 80-81.

- b. Raising New Issues That Should Have Been in the Petition. - Petitioner's Reply presents a number of arguments regarding Patent Owner's unexpected results – Reply at pages 9-15. Patent Owner's Response introduced a declaration from Dr. Boutrid that was a verbatim repeat of the examples of the '882 patent, as required under the PTAB rules. No new evidence, other than what could have been readily obtained by Petitioner prior to submitting the Petition, and/or that is inherent in the examples, was submitted by Patent Owner. Petitioner should not now be able to criticize the '882 patent's data in Petitioner's Reply when it had every opportunity to provide this critique in the Petition. The PTAB and Patent Owner should not have to weed through Petitioner's Reply to assess what portions might be proper and what might be improper. Patent Owner kindly requests authorization to file a motion to strike Petitioner's Reply in accordance with 37 CFR §42.23(b) and the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), at pages 80-81.
- c. Raising New Issues Not Relevant to the Merits - Petitioner's Reply (pages 15-21) goes to great lengths to attempt to discredit co-inventors Dr. Boutrid and Gregor Schleicher with newly submitted documents it had prior to their scheduled depositions, but Petitioner's counsel canceled their depositions in an email sent after business hours one day before their scheduled cross-examinations. Either Petitioner's Reply's comments, to the extent they can be separated from the remainder of the reply, should be stricken, or Patent Owner's declarants should be accorded the opportunity to submit affidavits in response to Petitioner's new credibility attacks (such relief is discussed below in number 3). Patent Owner kindly requests authorization to file a motion to strike Petitioner's Reply.

2. Motion to Expunge/Seal - Patent Owner seeks authorization to immediately expunge Exhibits 1070-1072 from the public record as attorney-client privilege/work product/confidential information of Patent Owner.

Patent Owner also seeks authorization to seal Exhibits 1060-1061 as confidential business information of Patent Owner. These Exhibits should be stricken from the record (which would be moot if Patent Owner's requested relief in number 1 above is granted), or at the very least submitted under seal pursuant to the PTAB's Protective Order that the parties

have already agreed to.

3. Authorization to Submit Additional Evidence – Patent Owner further seeks authorization to submit additional evidence, in the event the relief above is not granted. Specifically, Patent Owner should be permitted to address the newly submitted non-merits based evidence and arguments presented in Petitioner’s Reply. Patent Owner seeks authorization to submit very brief declaration testimony from one or more of the declarants in these proceedings whose credibility is being attacked with the new evidence.

4. Final Request – If granted, this would essentially render moot all of the above. Given the severity of Petitioner’s misconduct in 1(a) above, coupled with Petitioner’s multiple threats of ethical sanctions set out in four separate letters, and multiple e-mails, Patent Owner requests that the Honorable Board refer this matter to Director Vidal for further consideration. Patent Owner requests that the Honorable Board refer this matter to Director Vidal for further consideration.

Patent Owner offered Petitioner the opportunity to present its position in this email, which is reproduced below:

Petitioner’s Position:

Patent Owner seeks to revisit issues the Board decided previously in its September 17th teleconference with the parties (Ex. 1057). Patent Owner’s enumerated requests are facially baseless, and in some cases, without precedent. Patent Owner seeks to deflect from its own wrongdoing by blaming petitioners for uncovering documents Patent Owner was ethically obligated to serve as inconsistent 42.51(b)(1)(iii). There is no confidentiality or privilege issue with these third-party documents or Court Order concerns. Tellingly, Patent Owner has had weeks to approach the District Court but has not done so.

As discussed on the last call, Petitioner has tried to resolve these serious ethical issues since August (Petitioner’s reply, Paper 24, pgs. 15 -20). As Patent Owner has now doubled down on its improper conduct, Petitioner is left with no choice but to formally seek authorization to file a Motion for Sanctions. As Patent Owner has been on notice of these issues for months now, including extensive written discussions and now a full merits brief, Petitioner requested that Patent Owner confirm that the safe harbor of 42.11(d)(2) was effectively satisfied for purposes of proceeding with its request for a Motion for Sanctions, but Patent Owner refused to agree. Thus, Petitioner is concerned that Patent Owner is attempting to use the Board’s resources to secure additional submissions, and if its request is denied, withdraw or correct its filings using the 21-day safe harbor it now insists upon.

Therefore, Petitioner submits that the issues presented are not yet ripe and could be simplified over the safe harbor period and that a call is presently premature.

Alternatively, should a call be deemed necessary at present, and given the significant amount of time that has passed since the August notice and significant correspondence and briefing on the same, Petitioner requests waiver of the safe harbor period and the Board's authorization to file a Motion for Sanctions.

The parties are available for a conference on Wednesday or Thursday October 23-24th between 1-4PM (EST)

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