

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE (ZHUHAI) TECHNOLOGY COMPANY, LTD.,
AND
INNOSCIENCE AMERICA, INC.,
Petitioner,

v.

EFFICIENT POWER CONVERSION CORPORATION,
Patent Owner.

Case IPR2023-01383
U.S. Patent 8,404,508

**PETITIONER'S MOTION TO EXCLUDE PATENT OWNER'S
UNAUTHORIZED EVIDENCE PURSUANT TO 37 C.F.R. § 42.64(c)**

Pursuant to 37 C.F.R. § 42.64(c), Petitioner moves to exclude Patent Owner's Exhibit 2008 and any reference thereto or reliance thereon.¹ Petitioner timely objected to Exhibit 2008 in Petitioner's Objections to Evidence (Paper 21).

I. Legal Standard

The PTAB rules provide that “[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.” 37 C.F.R. § 42.23(b); *see also* PTAB Consolidated Trial Practice Guide (“TPG”), 73-74 (Nov. 2019).

II. The Board Should Exclude Exhibit 2008 from its Consideration

Patent Owner filed Exhibit 2008 with its Sur-Reply (Paper 20) and relied upon Exhibit 2008 for statements made in the Sur-Reply. The Board should exclude Exhibit 2008 and the reference to it in Patent Owner's Sur-Reply.

A. Exhibit 2008 Is Improper Under 37 C.F.R. § 42.23(b)

Exhibit 2008 is excerpts of a hearing transcript from the parallel ITC investigation, not a deposition transcript of the cross-examination of a reply

¹ In an October 31, 2024 e-mail to the Board, the parties requested the Board's guidance as to whether the Board would agree to waive 37 CFR § 42.23(b). In a November 1, 2024 email, the Board referred the parties to Section II.I of the Consolidated Trial Practice Guide as to filing evidence filed with a sur-reply and to Section II.K for guidance as to the procedure for challenging the admissibility of any such evidence. *See* Ex. 1054.

witness—the only permissible sur-reply evidence. There is no dispute that Exhibit 2008 does not comply with 37 C.F.R. § 42.23(b). Patent Owner did not seek leave from the Board to include new evidence with its sur-reply before submitting and relying on new evidence. Therefore, it was indisputably improper for Patent Owner to submit new evidence with its sur-reply.

B. Rule 37 C.F.R. § 42.23(b) Should Not Be Waived

While the Board is permitted to waive the provisions of § 42.23(b), it may only do so “in the interest of resolving [a] proceeding in a just, speedy, and inexpensive manner.” *Liquidia Tech. v. United Therapeutics Corp.*, IPR2021-00406, Paper 50, 5 (PTAB March 3, 2022).

A waiver is not appropriate here because no “good cause” or any other interests support Patent Owner’s belated submission of the new evidence. *See* 37 C.F.R. § 42.5(c)(3). That is particularly clear since Patent Owner did not seek leave *before* submitting and relying on new Exhibit 2008. Patent Owner relied on new Exhibit 2008 to show that Petitioner did not object to Dr. Schubert in the parallel ITC investigation, which has no bearing on the issue of Dr. Schubert’s qualification disputed at this proceeding. Sur-Reply (Paper 20), 32. Instead of pointing to any particular experience of Dr. Schubert in previously submitted evidence, such as Dr. Shubert’s declaration (Ex. 2001) and his curriculum vitae (Appendix A), Patent Owner relied on a new Exhibit 2008 that is irrelevant to Dr.

Schubert's qualification. Allowing Exhibit 2008 does not resolve the issue in a "just, speedy, and inexpensive manner." 37 C.F.R. § 42.1(b).

Further, Patent Owner's attempt to circumvent the rules by first violating them and then asking for a waiver should be rejected. Instead of seeking permission to set aside the requirements of Rule 42.23, Patent Owner filed the evidence with its Sur-Reply, cited to and argued from it. After Petitioner objected to the new evidence, Patent Owner requested the Board to waive the requirements of 37 CFR § 42.23(b) in an email. Ex. 1054, 1-2. But a request for a tribunal to waive its rule should be made *ex ante*, not after the rule was disregarded. Such violation of a rule should not be accepted.

III. Conclusion

For the reasons stated above, Patent Owner's unauthorized Exhibit 2008 and any reference thereto or reliance thereon should be excluded from consideration when the Board issues its Final Written Decision.

Respectfully submitted,

Dated: November 27, 2024

By: /Lionel M. Lavenue/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on November 27, 2024, a copy of **Petitioner's Motion to Exclude Patent Owner's Unauthorized Evidence Pursuant to 37 C.F.R. § 42.64(c)** was served upon the below-listed counsel by electronic mail:

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Dated: November 27, 2024

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