

From: [Trials](#)
To: [Davis Jr., Walter D.](#); [Trials](#)
Cc: [Innoscence-EPC-IPRs](#); [Edwards, Cory R.](#); [England, Jonathan](#); [Doshi, Dipu](#); [Soffen, Stephen](#); [Paradkar, Arun V.](#); [Mashack, Mark](#); [CM-200371-00440 EPCC-Inno-IPRS](#); [Lavenue, Lionel](#); [Sandoval, Abraham](#); [Hindman, M'Liss](#)
Subject: RE: PTAB-IPR2023-01383 - U.S. Patent No. 8,404,508
Date: Friday, November 1, 2024 3:03:59 PM
Attachments: [shield-advisory.png](#)
[chevron-light.png](#)



Counsel,

Regarding the parties' request for guidance as to whether the Board would agree to waive 37 CFR § 42.23(b), the panel will not pre-judge an issue not yet before us. Instead, we direct counsel 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.

Best Regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Davis Jr., Walter D. <Walter.Davis@BlankRome.com>
Sent: Thursday, October 31, 2024 2:26 PM
To: Trials <Trials@USPTO.GOV>
Cc: Innoscence-EPC-IPRs <Innoscence-EPC-IPRs@finnegan.com>; Edwards, Cory R. <Cory.Edwards@BlankRome.com>; England, Jonathan <jonathan.england@blankrome.com>; Doshi, Dipu <dipu.doshi@blankrome.com>; Soffen, Stephen <stephen.soffen@blankrome.com>; Paradkar, Arun V. <arun.paradkar@blankrome.com>; Mashack, Mark <Mark.Mashack@BlankRome.com>; CM-200371-00440 EPCC-Inno-IPRS <EPCC-Inno-IPRS@BlankRome.com>; Lavenue, Lionel <lionel.lavenue@finnegan.com>; Sandoval, Abraham <Abraham.Sandoval@BlankRome.com>; Hindman, M'Liss <mliiss.hindman@blankrome.com>
Subject: PTAB-IPR2023-01383 - U.S. Patent No. 8,404,508

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Dear Board,

Patent Owner seeks the guidance of the Board regarding Exhibit 2008, submitted with Patent Owner's Sur-Reply on October 16, 2024. Exhibit 2008 is the public version of the February 27, 2024, evidentiary hearing transcript for the parallel ITC investigation involving the '508 patent. This exhibit was submitted for the sole purpose of demonstrating that Petitioner did not question the qualifications of Patent Owner's expert, Dr. Schubert, in the ITC investigation, even though it does so now.

Petitioner objects to Exhibit 2008 as not complying with 37 CFR § 42.23(b): “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.” Petitioner requested that Patent Owner withdraw Exhibit 2008 and refile the Sur-Reply without Exhibit 2008 and removing the cite.

Patent Owner responded to Petitioner’s request by acknowledging the text of 37 CFR § 42.23(b) but stressing its belief that it is in the interest of justice that the Board consider the exhibit. Accordingly, rather than agree to withdraw Exhibit 2008 and refile the Sur-Reply, Patent Owner indicated that it wished to seek the guidance of the Board as to whether Patent Owner should withdraw the exhibit and re-file the Sur-Reply without it, or alternatively, whether the Board would agree to waive the cited portion of 37 CFR § 42.23(b). To the extent the Board has other guidance, Patent Owner wishes to receive that as well.

The parties have conferred, and should the Board think a call is necessary to provide guidance, the parties are available at the following times:

11/1 – 11:00 am – 4:00 pm

11/6 – 10:00 am – 4:00 pm

11/7 – 10:00 am – 4:00 pm

Best,

Walter Davis

Counsel for Patent Owner

Walter D. Davis Jr. | BLANKROME

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