

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 REPLY IN SUPPORT OF MOTION TO EXCLUDE
PATENT OWNER'S UNAUTHORIZED EVIDENCE**

In its Opposition to Petitioner's Motion to Exclude (Paper 27), Patent Owner does not dispute that it knowingly violated 37 C.F.R. 42.23(b) by filing Exhibit 2008 with its Sur-Reply and relying on it, without first requesting the Board's authorization to submit it as evidence. That, alone, is sufficient reason to grant Petitioner's Motion to Exclude its untimely Exhibit 2008. No good cause or interest of justice supports allowing Patent Owner to rely on evidence submitted with its Sur-Reply in blatant violation of 37 C.F.R. 42.23(b).

Patent Owner's "good cause" argument is unavailing. There is no change of position by Petitioner between the parallel ITC investigation and this proceeding regarding Dr. Schubert's qualification. In the ITC investigation, Petitioner did not object to Dr. Schubert testifying at trial, presenting his expert testimony. As in the ITC investigation, here Petitioner does not seek to exclude Patent Owner's expert Dr. Schubert's declaration from the Board's consideration. Instead, Petitioner's Reply merely points out the lack of certain experience of Dr. Schubert relevant to the patent at issue and challenges Dr. Schubert's credibility. Reply (Paper 18), 33-34. Patent Owner cannot rely on untimely evidence to rebut this position.

Dr. Schubert presented testimony in this proceeding that he did not raise in the ITC investigation, which makes his prior experience and credibility more of an issue compared to the ITC investigation. For example, his statements relating to the functionality of the remnant islands in the D-O-G process were not presented in

the ITC investigation and directly contradict the other expert, Dr. Shealy, in this proceeding. Thus, the factual dispute here is different from that in the ITC investigation, and the Board is required to weigh the testimony of experts when they have contradicting opinions. Due to the different factual dispute at issue in this proceeding, Petitioner is allowed to question Dr. Schubert's expert credentials and ask the Board to give more weight to the other expert's testimony. Petitioner's position is consistent between this proceeding and the ITC investigation.

Nor is the consideration of new evidence Ex. 2008 in the interest of justice. The only evidence relied on by Petitioner relevant to Dr. Schubert's scant expert credentials is Dr. Schubert's CV or declaration that is in the record. Whether Petitioner sought to preclude Dr. Schubert from testifying in another proceeding is both irrelevant and supported only in untimely evidence. To rebut Petitioner's challenge of Dr. Schubert's credential, Patent Owner should have relied on evidence showing Dr. Schubert's experience, not new evidence in another proceeding with different factual dispute. Rule 42.23(b) "is not a question of who gets the last word; rather, this is a question of whether a party can **submit new evidence** with its last word, which Rule 42.23(b) specifically prohibits." *Intel Corporation v. ParkerVision, Inc.*, No. IPR2020-01265, Paper 44 at 74 n.27 (emphasis added). There is no good cause for Patent Owner's unauthorized new evidence.

Accordingly, Petitioner's Motion should be granted.

Respectfully submitted,

Dated: December 11, 2024

By: /Lionel M. Lavenue/
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Lead Counsel

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on December 11, 2024, a copy of **Petitioner's Reply in Support of Motion to Exclude Patent Owner's Unauthorized Evidence** was served upon the below-listed counsel by electronic mail:

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