

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AFFORDABLE WIRE MANAGEMENT, LLC,
Petitioner,

v.

CAMBRIA COUNTY ASSOCIATION FOR THE BLIND AND
HANDICAPPED, INC.,
Patent Owner.

Case No. IPR2024-00178
U.S. Patent No. 11,349,291 B2

PETITIONER'S MOTION TO STRIKE

I. RELIEF REQUESTED

Petitioner Affordable Wire Management, LLC (“AWM”) respectfully requests that the Board strike and order Patent Owner Cambria County Association for the Blind and Handicapped, Inc. (“CAB”) to redact:

(1) the citations to Ex. 2038 and Ex. 2044 in Section VIII.D.1. of CAB’s Patent Owner Response (Paper 31, “POR”) and (2) the cited portions of CAB’s EX2038 (¶¶180-197, App. A) and EX2044 (¶10).

In the alternative, AWM seeks an order stating that the Board will not consider:

(1) the citations to EX2038 and EX2044 in Section VIII.D.1. of CAB’s POR and (2) the cited portions of EX2038 (¶¶180-197, App. A) and EX2044 (¶10).

II. BACKGROUND

CAB filed its POR on July 25, 2024. Section VIII.D.1. of CAB’s POR, titled “CAB Is Entitled To A Presumption Of Nexus Between The Evidence And The Claimed Invention Because Its Commercial Products And Systems Are Coextensive With Claims 1 and 6,” states in its entirety:

The Federal Circuit has held that “if the marketed product embodies the claimed features, and is coextensive with them, then a nexus is presumed and the burden shifts to the party asserting obviousness to present evidence to rebut the presumed nexus.” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000). As Dr. Kern has analyzed in his declaration, CAB’s Standard

System² is coextensive with at least claims 1 and 6 from the '291 Patent. EX2038, ¶¶180-197, App. A.

² CAB's Standard System for its above-ground messenger wire supported cable management system includes mid-pier kits, end-pier kits, galvanized steel messenger wire, and multi-carrier cable hangers of various configurations for supporting and separating various electrical cables within a PV array. EX2038, ¶188; EX2044, ¶10.

POR at 50. AWM promptly requested authorization to file a motion to strike on August 2, 2024, and the Board authorized the motion to strike on August 6, 2024.

III. STATEMENT OF THE REASONS FOR THE RELIEF REQUESTED

A. CAB's POR Improperly Incorporates by Reference Arguments from Its Experts' Declarations Because the POR Includes Only One Sentence Conclusions, Not Argument or Analysis

In total, Section VIII.D.1. consists of three sentences, spans just half a page, and comprises 130 words. *See* POR at 50. These three sentences contain no analysis or argument: one states a legal standard, one concludes that nexus exists because certain products are allegedly coextensive with the claims, and one states (in a footnote) the composition of CAB's alleged "Standard System." *Id.* Instead of including arguments supporting its conclusions, CAB cites only to its experts' declarations—19 paragraphs of expert declaration and a 14-page claim chart, together comprising well over 1,500 words of argument. *Id.* Noticeably missing from the POR are discussions of how CAB's "Standard System" meets each limitation of claims 1 and 6 of the '291 patent, why the alleged "Standard System" should be

defined as including the listed components, and why the “Standard System” should be adjudged “coextensive” with the claimed features. Worse, CAB’s POR was approximately 500 words under the limit—CAB could have tried to insert the required argument but affirmatively chose not to.

CAB’s mere reliance on expert argument is a textbook improper incorporation by reference. *See Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 7-10 (PTAB Aug. 29, 2014) (informative) (conclusory statements citing to expert declaration and claim charts “amounts to incorporation by reference”). The Board has repeatedly rejected this practice as violating § 42.6(a)(3). *See, e.g., IBG LLC, v. Trading Techs. Int’l, Inc.*, CBM2016-00054, Paper 38 at 2-4 (PTAB Apr. 7, 2017) (citations to expert declaration and claim chart improperly incorporated by reference nexus arguments); *CaptionCall, LLC v. Ultratec, Inc.*, IPR2015-00636, Paper 97 at 69 (PTAB Sept. 7, 2016) (finding violation of § 42.6(a)(3) where “there is no exposition as to what Patent Owner’s nexus argument is; we must go to the cited document to find out anything regarding Patent Owner’s argument.”); *ZF N. Am., Inc. v. Stoneridge Control Devices, Inc.*, IPR2023-00273, Paper 31 at 17-18 (PTAB June 12, 2024) (Patent Owner’s citation to claim charts for substantive comparisons showing nexus, without analysis, violates § 42.6(a)(3)); *PNC Bank N.A. v. USAA*, IPR2022-00076, Paper 47 at 46 n.26 (PTAB May 10, 2023) (Patent Owner stating that its expert explained why there was no motivation to combine is

improper incorporation by reference). Like the parties in the cases above, CAB merely states conclusions, relies on citations to expert declarations and claim charts for substantive argument, and asks the Board to search through exhibits to discover anything at all regarding Patent Owner’s arguments—all in violation of § 42.6(a)(3).

B. Striking the Citations to CAB’s Arguments Incorporated by Reference, as Well as the Arguments Themselves, Is the Proper Remedy Because CAB’s Violation of § 42.6(a)(3) Is Beyond Dispute

A motion to strike is the appropriate procedural vehicle to address CAB’s improper incorporation by reference. *See Consolidated Trial Practice Guide* (Nov. 2019) at 80 (“A motion to strike may be appropriate when a party believes the Board should disregard arguments or late-filed evidence in its entirety”). While a motion to strike is an exceptional remedy, that remedy is warranted where CAB’s violation of § 42.6(a)(3) is beyond dispute. *See id.* at 80-81. Moreover, AWM’s requested relief is targeted. AWM does not seek to strike entire exhibits, nor does it ask the Board to strike the entirety of CAB’s brief. Instead, AWM seeks redactions proportional to the violation: redactions to the citations to Ex. 2038 and Ex. 2044 in Section VIII.D.1. of the POR, as well as redactions to the cited portions in those exhibits. Because these citations and arguments were improperly incorporated by reference and should be disregarded, they need not remain in the record for any purpose. Accordingly, redaction is an appropriate remedy. *See Apple, Inc. v. Parus Holdings, Inc.*, IPR2020-00686, Paper 31, at 6 (PTAB June 10, 2021).

C. In the Alternative, AWM Requests an Order Stating that the Board Will Disregard CAB’s Arguments that Violate § 42.6(a)(3)

Although AWM believes CAB’s clear violation of § 42.6(a)(3) warrants redacting the improper citations and arguments, AWM proposes alternative relief in the form of an order stating the Board will disregard CAB’s citations and arguments that were improperly incorporated by reference. Disregarding arguments that are incorporated by reference is common PTAB practice. *See, e.g., Cisco*, IPR2014-00454, Paper 12 at 10; *IBG*, CBM2016-00054, Paper 38 at 4-5; *CaptionCall*, IPR2015-00636, Paper 97 at 69; *PNC Bank*, IPR2022-00076, Paper 47 at 46 n.26. Accordingly, an order stating that the Board will disregard the citations and arguments is appropriate.

IV. CONCLUSION

Without the requested relief, AWM will be prejudiced. It will be forced incur further cost, effort, and time deposing CAB’s declarants on pages of improper argument, responding in its Reply to over 1,500 words of improper argument (within a 5,600 word limit), and responding to the improper argument at the oral hearing. A timely order granting AWM’s motion to strike—at least stating that the Board will disregard CAB’s improper citations and arguments—is warranted. *Cf. IBG*, CBM2016-00054, Paper 38 at 4-5 (finding violation of § 42.6(a)(3) but declining to increase the word count of the Petitioner Reply to respond to arguments improperly incorporated by reference because those arguments “will not be considered”).

Dated: August 13, 2024

/Kevin C. Amendt/

Kevin C. Amendt (Reg. No. 69,361)
Williams S. Dixon (Reg. No. 78,346)
Matthew S. Galica (*pro hac vice*
pending)
Robert C. Sweeney (*pro hac vice*)
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.
One Financial Center
Boston, MA 02111
Telephone: 617-348-1793
Facsimile: 617-542-2241
E-mail: KCAMendt@mintz.com
WSDixon@mintz.com
MSGalica@mintz.com
RCSweeney@mintz.com

*Counsel to Petitioner Affordable Wire
Management, LLC*

CERTIFICATE OF SERVICE

I certify that a copy of Petitioner's Motion to Strike was served by electronic mail on the following counsel of record:

Daniel J. Melman
Eckert Seamans Cherin & Mellott LLC
10 Bank St.
Suite 700
White Plains, NY 10606
dmelman@eckertseamans.com
ESCMCAB-AWM@eckertseamans.com

Theodore Y. McDonough
Eckert Seamans Cherin & Mellott LLC
Gateway IV, Suite 401
100 Mulberry St.
Newark, NJ 07102
tmcdonough@eckertseamans.com
ESCMCAB-AWM@eckertseamans.com

Edward C. Flynn
Eckert Seamans Cherin & Mellott, LLC
600 Grant Street
44th Floor
Pittsburg, PA 15219
eflynn@eckertseamans.com

Dated: August 13, 2024

/Kevin C. Amendt/

Kevin C. Amendt (Reg. No. 69,361)