

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.

IPR2024-00178
Patent 11,349,291

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO STRIKE**

I. INTRODUCTION

Patent Owner Cambria County Association for the Blind and Handicapped, Inc. (“CAB”) hereby opposes the Motion to Strike (Paper 35) filed by Petitioner Affordable Wire Management, LLC (“AWM”). AWM, without sufficient justification, seeks the exceptional remedy of striking portions of CAB’s Patent Owner’s Response (Paper 31) (“POR”) directed to the coextensiveness of CAB’s Standard System with the claims of the ‘291 patent, together with portions of the Declarations of Dr. Edward C. Kern (EX2038) and Dr. Jonathan D. Putnam (EX2044), on the sole basis that the POR impermissibly incorporates these portions of the declarations. AWM’s motion should be denied.

II. ARGUMENT

A. Legal Standards.

In IPR proceedings, “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). The purpose of this prohibition is to avoid forcing the Board to “play archaeologist with the record” in searching for arguments outside of the parties’ briefing, as well as to prevent a party from doing an end-run around word count limits. Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Re-view of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,617 (Aug. 14, 2012) (citation omitted). Whether to strike a portion of a Patent Owner Response is

within the Board’s discretion. *See, e.g., Zebra Techs. Corp. v. Lone Star Scm Sys., Ltd.*, No. IPR2022-01375, 2024 WL 735915, at *18 n.9 (PTAB Feb. 22, 2024) (“arguments may not be incorporated by reference Under the particular circumstances of this case, we exercise our discretion to consider Patent Owner’s arguments ...”). “[S]triking the entirety or a portion of a party’s brief is an **exceptional remedy** that the Board expects will be **granted rarely**.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), at 80 (emphasis added).

B. CAB’s POR Does Not Improperly Incorporate Legal Arguments by Reference in Violation of 37 C.F.R. § 42.6(a)(3).

In arguing that CAB’s Standard System is coextensive with at least claims 1 and 6 of the ‘291 Patent, the POR identifies the specific components of CAB’s Standard System, and cites specific paragraphs from Dr. Kern’s and Dr. Putnam’s declarations. Paper 31, 50. The POR identifies the components of the Standard System, which are so straightforward that identifying them alone shows their coextensiveness with the claims of the patent. *Id.*, 50 n.2. No guesswork is required in relating the “galvanized steel messenger wire” of the Standard System to the claimed “messenger wire.” *Id.* Similarly, the “multi-carrier cable hangers of various configurations for supporting and separating various electrical cables ...” are readily identified as the claimed plurality of cable hangers disposed along and suspended from the messenger wire, with each cable hanger having a plurality of

cable carrying surfaces structured to support and separate the various electrical cables extending from solar panels in a PV array.

The POR does not require the Board to “search through exhibits” (Paper 35, 4) or “play archaeologist with the record.” Rather, it directs the Board, and AWM, to specific paragraphs of Dr. Kern’s declaration, which target the coextensiveness analysis and describe a short claim chart (largely consisting of annotated photographs of CAB’s Standard System). AWM would simply demand that CAB regurgitate in its POR the statements made by Dr. Kern. Surely that is not what 37 C.F.R. § 42.6(a)(3) was intended to require. *See Dexcom, Inc. v. Abbott Diabetes Care Inc.*, No. IPR2022-00605, 2023 WL 5030758, at *19 (PTAB July 10, 2023) (“not every statement made by an expert needs be repeated in a brief to avoid incorporation by reference.”).

CAB’s argument is far from a “textbook improper incorporation by reference” (Paper 35, 3) and the cases cited by AWM are all distinguishable. *See Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12, at 10 (PTAB Aug. 29, 2014) (argument on a substantive ground that “circumvent[ed] the page limits” and forced the Board “to sift through 250 pages” of a declaration); *IBG LLC, v. Trading Techs. Int’l, Inc.*, CBM2016-00054, Paper 38, at 3 (PTAB Apr. 7, 2017) (citing to the “entirety” of an exhibit including “890 pages of multiple documents”); *CaptionCall, LLC v. Ultratec, Inc.*, IPR2015-00636, Paper 97, at 69

(PTAB Sept. 7, 2016) (a single, nebulous statement that the cited declaration establishes nexus); *ZF N. Am., Inc. v. Stoneridge Control Devices, Inc.*, IPR2023-00273, Paper 31, at 17 (PTAB June 12, 2024) (citing claim charts “summarizing Patent Owner’s allegations in the district court”); *PNC Bank N.A. v. USAA*, IPR2022-00076, Paper 47, at 46 n.26 (PTAB May 10, 2023) (citing to declaration without any elaboration as to its purpose).

Finally, and contrary to AWM’s assertion (Paper 35, 2-3), CAB’s argument in the portion of the POR and declarations that AWM seeks to strike is narrow, relating only to the *presumption* of nexus to which it is entitled. The POR contains ample arguments and evidence of *actual* nexus beyond the presumption of nexus. Paper 31, 51-66.

C. Striking Portions of the POR and Portions of the Expert Declarations Is An Exceptional, and In This Case, Unjustified Remedy.

AWM admits that “a motion to strike is an exceptional remedy” (Paper 35, 4), but offers only a conclusory argument that such an exceptional remedy is warranted because “CAB’s violation of § 42.6(a)(3) is beyond dispute.” Paper 35, 4. More important, however, is whether the prejudice that would be suffered by CAB by granting the remedy AWM seeks is commensurate with the asserted violation. That prejudice is not measured by whether the asserted violation is disputed. Here, the prejudice that would result to CAB from granting such an exceptional remedy far outweighs the harm from any violation asserted by AWM

as a result of CAB citing targeted paragraphs in CAB's expert declaration. There is no requirement for the Board to go on an archaeological dig of the kind the rule is intended to prohibit. Certainly, AWM cannot protest that it is unable to discern CAB's argument or the evidentiary support for those arguments.

Notably, AWM's motion is devoid of legal authority that supports striking portions of the POR and declarations. The lone decision AWM cites, *Apple, Inc. v. Parus Holdings, Inc.*, IPR2020-00686, Paper 31 (PTAB June 10, 2021), involved new evidence improperly filed with a sur-reply to which the petitioner objected because it did not have an opportunity to respond to the new evidence. The decision did not involve incorporation by reference. Furthermore, unlike the petitioner in *Apple*, AWM has ample opportunity to respond to the POR in its Reply. There is sufficient basis for the Board to exercise its discretion and deny all of the exceptional relief sought by AWM.

III. CONCLUSION

For the reasons stated herein, CAB respectfully requests that the Board exercise its discretion and deny AWM's Motion to Strike in its entirety.

Respectfully submitted,

Dated: August 20, 2024 By: / Daniel J. Melman /
Daniel J. Melman (Reg. No. 55,451)
ECKERT SEAMANS CHERIN & MELLOTT, LLC
10 Bank St., Suite 700
White Plains, NY 10606
Email: dmelman@eckertseamans.com
Phone: 914.286.6447
Fax: 914.949.2909

CERTIFICATE OF SERVICE

I certify that on this 20th day of August, 2024, a true and correct copy of the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE** was served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

KCAmendt@mintz.com;
WSDixon@mintz.com;
RCSweeney@mintz.com;
CAB_AWM@mintz.com.

Dated: August 20, 2024 / Daniel J. Melman /
Daniel J. Melman (Reg. No. 55,451)