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|---|---|
| **From:** | Trials |
| **To:** | Robert Wolter; Thomas Eschweiler; Abdelnour, Dennis J.; Amber Davis; Barbie Mahan; Nathan Smith |
| **Cc:** | Trials |
| **Subject:** | RE: IPR2024-00291; Patent Owner"s Request to file motion for leave to submit additional expert testimony |
| **Date:** | Tuesday, January 7, 2025 12:30:46 PM |
| **Attachments:** | image002.png |

Counsel,

The Board denies Patent Owner's request to file a motion for leave to submit supplemental declarations and evidence. An order will be forthcoming. The Due Date for Patent Owner's sur-reply to Petitioner's reply is hereby extended to January 17, 2025.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

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**From:** Robert Wolter <rwolter@Savvyiplaw.com>
**Sent:** Saturday, December 28, 2024 8:58 AM
**To:** Thomas Eschweiler <teschweiler@epiplaw.com>; Trials <Trials@USPTO.GOV>
**Cc:** Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Amber Davis <adavis@Savvyiplaw.com>; Barbie Mahan <bmahan@Savvyiplaw.com>; Nathan Smith <njsmith@epiplaw.com>
**Subject:** RE: IPR2024-00291; Patent Owner's Request to file motion for leave to submit additional expert testimony

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Dear Board

Counsel for Patent Owner is available for a conference call discuss in more detail Patent Owner's request.

Best regards,

**Robert L. Wolter**
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WOLTER VANDYKE DAVIS
INTELLECTUAL PROPERTY LAW

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**From:** Thomas Eschweiler <teschweiler@epiplaw.com>
**Sent:** Friday, December 27, 2024 4:26 PM
**To:** Robert Wolter <rwolter@Savvyiplaw.com>; Trials <Trials@USPTO.GOV>
**Cc:** Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Amber Davis <adavis@Savvyiplaw.com>; Barbie Mahan <bmahan@Savvyiplaw.com>; Nathan Smith <njsmith@epiplaw.com>
**Subject:** RE: IPR2024-00291; Patent Owner's Request to file motion for leave to submit additional expert testimony

Dear Board,

The content of Petitioner's Reply to the Patent Owner's Response (PRPOR) was responsive to the Patent Owner Response (POR). None of Patent Owner's contentions provide justification for violating the PTAB Trial Guide rule of no new evidence in a sur-reply.

If the Board feels it necessary, Petitioner will be available to address these issues on a conference call.

Best regards,

Thomas G. Eschweiler

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**From:** Robert Wolter <rwolter@Savvyiplaw.com>
**Sent:** Friday, December 27, 2024 3:06 PM
**To:** Thomas Eschweiler <teschweiler@epiplaw.com>; Trials <Trials@USPTO.GOV>
**Cc:** Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Amber Davis <adavis@Savvyiplaw.com>; Barbie Mahan <bmahan@Savvyiplaw.com>; Nathan Smith <njsmith@epiplaw.com>
**Subject:** RE: IPR2024-00291; Patent Owner's Request to file motion for leave to submit additional expert testimony

Dear Board,

Petitioner's below response does not dispute that with respect to Mr. Ransom that the Ex. 1014 referred to in the response and Dr. Ellison's second report includes annotations that were not on the document as provided during the cross-examination. The Petitioner uses this annotated version (See, Ex. 1025: 15-18; and Paper 28: 28-31) ) to mischaracterize Mr. Ransom's answers to questions and the disclosure of that reference. Accordingly, Patent Owner should be allowed to address this with Mr. Ransom's opinion or observations regarding that reference. To that end, given the level of skill in the art, Mr. Ransom is a person of ordinary skill in the art. His experience is detailed in his declaration.

Regarding the proposed additional declaration of Dr. Cameron, Dr. Ellison's declaration entirely new parameters (molecular weight the 3 mil polymer coating) of associated with the prior art reference not included in his first declaration that Patent Owner should be able to reply to in the sur-reply. This is not an attempt to "back-fill" but is necessary to respond to new arguments. Of course, Dr. Ellison did not address these parameters in his initial report.

Apparently, Petitioner does not dispute that expert testimony of Dr. Cameron, or others, may allowed oo address the priority issue may be allowed in this instance at is now raised for the first time. Whether or not Petitioner has timely raised this issued and allowed to argue may be in issue to resolve in a motion to exclude, but for now, Patent Owner should be allowed to address this issue with respect to additional declarations, at least that of Dr. Cameron.

Best regards,

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**From:** Thomas Eschweiler <teschweiler@epiplaw.com>
**Sent:** Friday, December 27, 2024 2:33 PM
**To:** Robert Wolter <rwolter@Savvyiplaw.com>; Trials <Trials@USPTO.GOV>
**Cc:** Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Amber Davis <adavis@Savvyiplaw.com>; Barbie Mahan <bmahan@Savvyiplaw.com>; Nathan Smith <njsmith@epiplaw.com>
**Subject:** RE: IPR2024-00291; Patent Owner's Request to file motion for leave to submit additional expert testimony

Dear Board,

Petitioner opposes Patent Owner's request to file a motion for leave to submit additional evidence with its Sur-Reply.

Initially, the PTAB Consolidated Trial Practice Guide, Section II, Part I, states:

> The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Id., at 73.

Patent Owner's request to submit supplemental declarations and license agreements contravenes this prohibition.

Further, Petitioner rejects Patent Owner's assertion that Mr. Robert Ransom is an expert in this case. Instead, Mr. Ransom was proffered by the Patent Owner as a fact witness associated with secondary considerations of non-obviousness. As such, Patent Owner had the opportunity to address or otherwise repair the declarant's testimony during his deposition on re-direct, which it failed to do.

In addition, Dr. Cameron did provide her opinion regarding the priority date in her original declaration (see Ex. 2031, ¶¶ 21, 56), which she confirmed during her deposition as constituting the entirety of her analysis (see Ex. 1023, at 38-47). Patent Owner's attempt to "backfill" Dr. Cameron's conclusory analysis on this issue at this stage of the proceeding is inappropriate.

Regarding Patent Owner's argument that Petitioner raises the priority date for the first time, the original Petition attacked Patent Owner's alleged priority date, asserting the provisional application 62/301,007 failed to comply with 35 U.S.C. § 112(a) (see Paper 1, at 12-13). Petitioner addressed the issue in greater detail in response to Patent Owner making the priority date an issue in its POR by proffering evidence of secondary considerations that is unavailable (as prior art) if the priority date is February 2017, rather than February 2016. Thus, Petitioner addressed the issue properly in response to the POR.

Lastly, Patent Owner's request to enter the License Agreements is improper as untimely and prejudicial. As early as the Institution Decision issued in June 2023, Patent Owner knew secondary consideration evidence was needed, and failed to submit such evidence in a timely fashion for strategic advantage. Only after Petitioner has attacked the weight of the testimony due to a failure to make the License Agreements of record is Patent Owner requesting entry. Entering the licenses at this stage of the proceeding prejudices the Petitioner, as the trial schedule does not allow for declarants associated with the licenses to be deposed yet again, nor does the schedule allow for Petitioner to respond to the new evidence. Patent Owner made the strategic decision to withhold licenses and offer only conclusory declarant testimony regarding them; Petitioner made Patent Owner's failure to proffer evidence a centerpiece of its deposition and response strategy. Patent Owner should not be allowed a do-over, which would require re-deposing all four declarants who discussed licensing, while adding unnecessary cost and rendering large portions of the prior depositions moot.

The rules prohibit entry of additional evidence at this juncture of the trial for this very reason, and thus Petitioner requests the Board to reject Patent Owner's request in total.

Best regards,

Thomas G. Eschweiler

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**From:** Robert Wolter <rwolter@Savvyiplaw.com>
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**To:** Trials <Trials@USPTO.GOV>
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**Subject:** IPR2024-00291; Patent Owner's Request to file motion for leave to submit additional expert testimony

Dear Board,

Patent Owner requests permission to file a motion for leave to submit with its sur-reply, supplemental declarations of Patent Owner experts Dr. Cameron and Mr. Robert Ransom, which the Board may permit pursuant to 35 §42.25(b). See, *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023). More specifically, with its reply, Petitioner submitted the declaration of its expert, Dr. Ellison, that raises issues that were first raised in the cross-examination of Dr. Cameron and Mr. Robert Ransom (both experts for Patent Owner) and which are also now raised in Petitioner's Reply. Dr. Ellison's declaration and the Reply include mischaracterizations of the Patent Owner's expert testimony of Mr. Ransom with respect to a prior art reference (Ex. 1014) to the point of including annotations in a drawing that are not in the original prior art reference or considered by Mr. Ransom during his cross-examination. This reference was not cited in the Petition and Dr. Cameron will need to address Petitioner's expert declaration in that regard. In addition, Petitioner for the first time challenges the effective filing date and priority claim relative to the '535 Patent to introduce new prior art (including Ex. 1014). Dr. Cameron will need to address, this address raised for the first time by Petitioner. In addition, Petitioner and Dr. Ellison now raise the consideration of molecular weights of compounds relative to the teachings of the Strength reference (Ex. 1003) and coating disclosed in this reference. Accordingly, Dr. Cameron shall address this issue as well.

In addition, PO will be seeking leave to file license agreements to file under seal and referred

to in the PO Response and Petitioner Reply, for consideration by the Board relative to secondary considerations raised by Patent Owner.

Best regards,

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