

From: [Robert Wolter](#)
To: [Trials](#); [Thomas Eschweiler](#); [Amber Davis](#); [Barbie Mahan](#); [Abdelnour, Dennis J.](#); [Nathan Smith](#); [Docketing](#)
Subject: RE: IPR2024-00291; Petitioner's Request to file motion for leave to strike/exclude declarations with sur-reply
Date: Tuesday, January 28, 2025 1:53:42 PM
Attachments: [image002.png](#)

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

In as much as the parties and Board will be discussing sanctions in an upcoming conference call relative to an order dated January 8, 2025, Patent Owner respectfully request the Board to email the order to Patent Owner. In an email dated January 7, 2025, the Board denied Patent Owner's request to file a motion for leave to file supplemental declarations and said "an order will be forthcoming." However, Patent Owner never received an order. Prior to filing its sur-reply, Patent Owner continued to check the docket for an order, and found no such order had been entered. To date an order dated January 8, 2025, still has not been entered on the docket of this proceeding. For this reason, Patent Owner represented to the Board that there is not an order prohibiting Patent Owner the opportunity file supplemental declarations to address new arguments and new evidence raised in the Petition.

Accordingly, Patent Owner respectfully requests the Board to email the order dated January 8, 2025, and referred to by Petitioner.

Best regards,

Robert L. Wolter
Partner | Registered Patent Attorney
Wolter Van Dyke Davis, PLLC
1900 Summit Tower Blvd, Suite 140
Orlando, FL 32810
(407) 926-7700 **Office**
(407) 926-7706 **Direct**
rwolter@savvyIPLaw.com



WOLTER VANDYKE DAVIS
INTELLECTUAL PROPERTY LAW

IRS Circular 230 disclosure: To insure compliance with requirements imposed by the IRS, we inform you that any U.S. Federal tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code, or (ii) promoting, marketing, or recommending to another party any transaction or matter addressed herein.

The information in this email is intended solely for the use of the individual to whom it is addressed. This message may be an attorney-client communication and may contain information that is privileged, confidential, subject to Federal Rule of Evidence 408, or otherwise exempt from disclosure under applicable law. Recipients should not file copies of this email with publicly accessible records. If the reader of this email is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any

dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone at (407) 926-7706 or email (rwolter@savvyiplaw.com), and delete the original message and any copies made. Thank You.

From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, January 28, 2025 12:17 PM

To: Robert Wolter <rwolter@savvyiplaw.com>; Thomas Eschweiler <teschweiler@epiplaw.com>; Amber Davis <adavis@savvyiplaw.com>; Barbie Mahan <bmahan@savvyiplaw.com>; Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Nathan Smith <njsmith@epiplaw.com>; Docketing <docketing@epiplaw.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: IPR2024-00291; Petitioner's Request to file motion for leave to strike/exclude declarations with sur-reply

Counsel,

Petitioner's request for permission to file a motion to strike Exhibits 2036 and 2037 is granted. Petitioner's request for permission to file a motion for sanctions will be discussed in an upcoming conference call.

Regards,

Tina Lee
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Robert Wolter <rwolter@savvyiplaw.com>

Sent: Tuesday, January 28, 2025 8:56 AM

To: Thomas Eschweiler <teschweiler@epiplaw.com>; Trials <Trials@USPTO.GOV>; Amber Davis <adavis@savvyiplaw.com>

Cc: Barbie Mahan <bmahan@savvyiplaw.com>; Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Nathan Smith <njsmith@epiplaw.com>; Docketing <docketing@epiplaw.com>

Subject: RE: IPR2024-00291; Petitioner's Request to file motion for leave to strike/exclude declarations with sur-reply

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board,

Patent Owner agrees with Petitioner that the record is clear. The Board did not issue an order prohibiting Patent Owner (PO) from filing additional declarations/evidence. Accordingly, Patent Owner filed supplemental declarations to address the multiple **new** issues, **new** arguments and **new** evidence submitted in Petitioner's Reply. The reason the parties are in this procedural dilemma is that the Petitioner chose to introduce these **new** issues, **new**

arguments and **new** evidence in its Reply beyond the boundaries of the Petition and Patent Owner's response. Patent Owner chose to address Petitioner's antics via a motion to exclude instead of bothering the Board with a motion to strike. In the meantime, Patent Owner appropriately addressed Petitioner's new evidence and new arguments.

Patent Owner believes the Board should be aware of additional facts to better appreciate Petitioner's motives in seeking to strike PO's sur-reply. Petitioner was named as a defendant in the patent infringement case *Rugged Cross Hunting Blinds, LLC v. FeraDyne Outdoors, LLC et al*, Case No.: 3:22-690. Patent Owner filed its Second Amended Complaint (Ex. 2028) (the Complaint) on June 28, 2023, naming the Petitioner as a Defendant. Petitioner filed a motion to dismiss on August 28, 2023.

In the Complaint, PO included allegations of industry praise and commercial success of the PO's Austin blind and the licensed SurroundView blind. (Ex. 2028, p. 5-8).

Attached as Exhibit B to the Complaint is the very Exhibit 2032-E (this or the Article) Petitioner has attempted to introduce as evidence of prior art. (See, Ex. 2028, pp 32-33). However, for this Article (Ex. 2032-E) to be considered prior art, the effective filing date of the '535 Patent must be February 28, 2017, and not the priority date of February 29, 2016, for the '535 Patent. Therefore, Petitioner argued, for the first time in its Reply, that the specification of the provisional application does not meet the written description requirement of Section 112, and therefore the '535 Patent is not entitled to its priority date of February 29, 2016.

So, Petitioner not only knew PO would be relying upon secondary considerations in this IPR, by virtue of the allegations in the Complaint, Petitioner had actual knowledge of the Exhibit 2032-E almost six months before filing the Petition. Despite having knowledge of Exhibit 2032-E at such an early time, Petitioner failed to raise priority as an issue in the Petition and shouldn't be allowed to do so for the first time in the Reply.

In the Reply, Petitioner referred to Exhibit 2032-E (and Exhibit 1014, which was also not included in the Petition) as evidence of general knowledge of a PHOSITA as of February 28, 2017. Petitioner first uses this article under the guise of responding to PO's evidence of secondary considerations. Then Petitioner uses the article as evidence a PHOSITA would combine its primary references of Whybrew and Strength.

In summary, Petitioner knew about Exhibit 2032-E long before it filed the Petition but failed to raise priority as an issue in the Petition. Upon seeing PO's evidence of secondary considerations, which Petitioner knew was coming, Petitioner for the first time raised priority in the Reply.

In addition, Petitioner for the first time cites Exhibit 1014 as new prior art and uses it in the same manner as Exhibit 2032-E. In this instance, Petitioner twists Mr. Ransom's testimony and refers to portions of the exhibit on which Mr. Ransom was not questioned. Then Petitioner includes new testimony of its expert's interpretation of Exhibit 1014, which is completely flawed as argued by PO's expert in the sur-reply.

The above doesn't even include Petitioner's additional expert testimony regarding PO's Response and the new prior art (Exhibits 1012 and 1013) used by its expert.

Now, Petitioner seeks to strike PO's sur-reply that directly addresses this new evidence and new arguments that Petitioner first argued in its Reply. Again, PO submits these issues should be addressed via motions to exclude, and respectfully requests the Board deny Petitioner's request to file a motion to strike.

Best regards,

Robert L. Wolter
Partner | Registered Patent Attorney
Wolter Van Dyke Davis, PLLC
1900 Summit Tower Blvd, Suite 140
Orlando, FL 32810
(407) 926-7700 **Office**
(407) 926-7706 **Direct**
rwolter@savvyPLaw.com



WOLTER VANDYKE DAVIS
INTELLECTUAL PROPERTY LAW

IRS Circular 230 disclosure: To insure compliance with requirements imposed by the IRS, we inform you that any U.S. Federal tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code, or (ii) promoting, marketing, or recommending to another party any transaction or matter addressed herein.

The information in this email is intended solely for the use of the individual to whom it is addressed. This message may be an attorney-client communication and may contain information that is privileged, confidential, subject to Federal Rule of Evidence 408, or otherwise exempt from disclosure under applicable law. Recipients should not file copies of this email with publicly accessible records. If the reader of this email is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone at (407) 926-7706 or email (rwolter@savvyPLaw.com), and delete the original message and any copies made. Thank You.

From: Thomas Eschweiler <teschweiler@epiplaw.com>

Sent: Monday, January 27, 2025 4:09 PM

To: Robert Wolter <rwolter@Savvyiplaw.com>; Trials <Trials@USPTO.GOV>; Amber Davis <adavis@Savvyiplaw.com>

Cc: Barbie Mahan <bmahan@Savvyiplaw.com>; Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Nathan Smith <njsmith@epiplaw.com>; Docketing <docketing@epiplaw.com>

Subject: RE: IPR2024-00291; Petitioner's Request to file motion for leave to strike/exclude declarations with sur-reply

Dear Board:

The written record on this is clear. PO knew it could not submit these declarations without leave of the Board; PO sought leave and it was denied. PO's restatement of arguments made previously in seeking leave have already been considered.

To the extent PO was confused, it took no action to resolve that confusion. Under the circumstances, PO's position that it was free to file these declarations in direct contravention of the Board's express holding is baseless.

As the facts before the Board on this matter are clear, Petitioner contends that striking the declarations and the sur-reply can be done by the Board *sua sponte*, and Petitioner invites the Board to do so.

Regards,

Thomas G. Eschweiler

Eschweiler & Potashnik, LLC
195 S. Main St., Suite 400
Akron, Ohio 44308
PH: (216) 502-0600
Mobile: (440) 864-1202
Email: TEschweiler@epiplaw.com



Eschweiler &
Potashnik LLC

The information contained in this e-mail communication is legally privileged, confidential and intended solely for the use of the addressee. Unauthorized use, distribution or copy of this e-mail is prohibited. If you have received this message in error, please inform us by return e-mail and delete all related e-mails.

From: Robert Wolter <rwolter@Savvyiplaw.com>
Sent: Monday, January 27, 2025 2:12 PM
To: Thomas Eschweiler <teschweiler@epiplaw.com>; Trials <Trials@USPTO.GOV>; Amber Davis <adavis@Savvyiplaw.com>
Cc: Barbie Mahan <bmahan@Savvyiplaw.com>; Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Nathan Smith <njsmith@epiplaw.com>; Docketing <docketing@epiplaw.com>
Subject: RE: IPR2024-00291; Petitioner's Request to file motion for leave to strike/exclude declarations with sur-reply

Dear Board

Patent Owner respectfully requests the Board deny Petitioner's request to file a motion to strike.

Patent Owners' position on this matter is that the subject of Petitioner's request is better resolved in a motion to exclude. Moreover, Petitioner's presentation of the procedural happenings is not entirely accurate, and its request is disingenuous (at best) because Petitioner's Reply introduced new prior art evidence, a new expanded claim construction, and for the first time raised the issue of priority.

Patent Owner requested permission to file a motion to file supplemental declarations in part because Petitioner first raised the issue of priority in the Reply for the first time and introduced two new pieces of prior art (Ex. 1014, 2032-E and 2032-F) that Petitioner has combined with the Strength and Whybrew references cited Petition. Petitioner also expanded its originally proposed claim construction in response to Patent Owner's Response and Dr. Cameron's original declaration, which further necessitated supplemental testimony regarding this new claim construction. In addition, Petitioner further introduced new evidence in its Reply to rebut Dr. Cameron's testimony, which new evidence was never presented during Dr. Cameron's cross examination. That is, Patent Owner and Dr. Cameron were not given an opportunity to address this new prior art either in the PO Response or during Dr. Cameron's cross examination.

With respect to Ex. 1014, Mr. Ransom's declaration is necessary at least because Petitioner refers to portions of the exhibit about which Mr. Ransom was never questioned, not to mention the gross mischaracterization of Mr. Ransom's testimony regarding Ex. 1014. In addition, Dr. Cameron should be permitted Ex. 1014, which is new evidence and which Petitioner's expert has interpreted.

Now, Petitioner is asking to file a motion to strike certain evidence that Patent Owner has submitted; however, any evidence submitted by Patent Owner in the Sur-reply was necessary to address all the new issues and prior art of Petitioner's Reply.

In the email dated January 7, 2025, the Board denied Patent Owners request to file a motion to file supplemental declarations and stated that an order was forthcoming; however, the Board never entered an order. To be clear, the Board's denial of Patent Owner's request to file the supplemental declarations did not address the issue of whether or not Patent Owner could file supplemental declarations. The Board simply denied the request to file a motion, and an order has not been entered. The Board did not enter an order prohibiting Patent Owner from filing supplemental declarations.

Patent Owner believes that the issues raised by Petitioner are better addressed in a motion to exclude. Of course, Patent Owner intends on filing a motion to exclude with respect to the new evidence and issues raised in Petitioner's Reply, not the least of which is Patent Owner's priority claim.

Accordingly, Patent Owner respectfully requests the Board deny Petitioner's request to file a motion to strike.

Best regards,

Robert L. Wolter
Partner | Registered Patent Attorney
Wolter Van Dyke Davis, PLLC
1900 Summit Tower Blvd, Suite 140
Orlando, FL 32810
(407) 926-7700 **Office**

(407) 926-7706 Direct
rwolter@savvyPLaw.com



WOLTER VANDYKE DAVIS
INTELLECTUAL PROPERTY LAW

IRS Circular 230 disclosure: To insure compliance with requirements imposed by the IRS, we inform you that any U.S. Federal tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code, or (ii) promoting, marketing, or recommending to another party any transaction or matter addressed herein.

The information in this email is intended solely for the use of the individual to whom it is addressed. This message may be an attorney-client communication and may contain information that is privileged, confidential, subject to Federal Rule of Evidence 408, or otherwise exempt from disclosure under applicable law. Recipients should not file copies of this email with publicly accessible records. If the reader of this email is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone at (407) 926-7706 or email (rwolter@savvyPLaw.com), and delete the original message and any copies made. Thank You.

From: Thomas Eschweiler <teschweiler@epiplaw.com>

Sent: Monday, January 27, 2025 12:01 PM

To: Trials <Trials@USPTO.GOV>; Robert Wolter <rwolter@Savvyiplaw.com>; Amber Davis <adavis@Savvyiplaw.com>

Cc: Barbie Mahan <bmahan@Savvyiplaw.com>; Abdelnour, Dennis J. <DAbdelnour@honigman.com>; Nathan Smith <njsmith@epiplaw.com>; Docketing <docketing@epiplaw.com>

Subject: IPR2024-00291; Petitioner's Request to file motion for leave to strike/exclude declarations with sur-reply

Dear Board,

Petitioner requests permission to file a motion to strike certain evidence submitted by Patent Owner (PO) on January 24, 2025, in conjunction with IPR2024-00291.

PO sent the Board an email on December 27, 2024, requesting permission to file a motion for leave to submit supplemental declarations of Dr. Cameron (PO's expert) and Mr. Ransom (one of PO's fact witnesses) with its sur-reply. (See attached email string).

Petitioner opposed PO's request on December 27, 2024. Upon consideration, the Board denied PO's request on January 7, 2025 (see attached email string). PO confirmed receipt of the Board's denial on January 8, 2025. (See attached email string).

On January 24, 2025, PO filed its sur-reply, and along with the sur-reply also filed supplemental declarations of Dr. Cameron and Mr. Ransom as Ex. 2036 and Ex. 2037, respectively, in direct contravention of the Board's order of January 8, 2025.

Petitioner hereby requests permission for leave to file a motion to strike Ex. 2036 and Ex. 2037 under 37 C.F.R. § 42.7(a), or alternatively a motion to exclude such evidence under 37 C.F.R. § 42.64(b)(1). In addition, as the sur-reply is inextricably intertwined with Exs. 2036 and 2037 due to its heavy reliance on the improper declarations, the motion will include a motion to strike, or alternatively to exclude, the sur-reply in its entirety. Lastly, if the sur-reply is not deemed tainted *in toto*, the motion may alternatively request the striking or exclusion of any arguments, assertions, conclusions or comments that rely upon, depend upon, or cite to the improper declarations.

The PTAB Trial Practice Guide, Section II, Part I, p. 80 states that a requested authorization to file a motion to strike is proper when a party believes that a brief filed by the opposing party exceeds the proper scope of reply or sur-reply. In this case, as the Board had denied PO's request to file the supplemental declarations, Petitioner submits that filing the supplemental declarations exceeds the proper scope of the sur-reply, as the PTAB Consolidated Trial Practice Guide, Section II, Part I, states: [t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. *Id.*, at 73.

Petitioner understands that a Motion to Strike evidence is an exceptional remedy, but contends the present facts present exceptional circumstances. PO had already made a request to submit the supplemental declarations, the Board had considered its reasons, and Petitioner's opposition rationale, and denied such request. Entry of such evidence after its earlier request was denied raises the same issues of prejudice to the Petitioner, and thus expungement of such evidence is the proper remedy in this instance.

Petitioner also requests permission to file a motion for sanctions under 37 C.F.R. § 42.12(a)(1) for failing to comply with an order of the Board in this proceeding.

Regards,

Thomas G. Eschweiler

Eschweiler & Potashnik, LLC
195 S. Main St., Suite 400
Akron, Ohio 44308
PH: (216) 502-0600
Mobile: (440) 864-1202
Email: TEschweiler@epiplaw.com



Eschweiler &
Potashnik LLC

The information contained in this e-mail communication is legally privileged, confidential and intended solely for the use of the addressee. Unauthorized use, distribution or copy of this e-mail is prohibited. If you have received this message in error, please inform us by return e-mail and delete all related e-mails.