From:	Thomas Eschweiler
To:	Robert Wolter; Trials; Amber Davis
Cc:	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:	Monday, January 27, 2025 4:09:38 PM
Attachments:	image002.png

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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

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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,

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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.
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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

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