

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DBR FINANCE, INC.,
Petitioner,

v.

RUGGED CROSS HUNTING BLINDS, LLC,
Patent Owner.

IPR2024-00291
Patent 11,399,535 B2

Before KEVIN W. CHERRY, CYNTHIA L. MURPHY, and
JASON W. MELVIN, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Request to Submit
Supplemental Declarations of Experts

Patent Owner requested “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.” Ex. 3001. We denied Patent Owner’s request, and indicated that an order would be forthcoming. Ex. 3002. This order further details our denial.

A patent owner’s sur-reply “may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23. Patent Owner’s submission of supplement declarations of its experts would constitute new evidence beyond what our Rules permit.

Patent Owner argues that the submission of this new evidence should be allowed because Petitioner “raises issues” for the “first time” in its Reply. Ex. 3001. A petitioner’s reply “may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.” 37 C.F.R. § 42.23. Patent Owner contends that Petitioner’s Reply runs contrary to this rule because it raises certain issues for the first time.

Patent Owner contends that the Petitioner’s Reply includes “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.” Ex. 3001. However, Petitioner’s discussion of this prior art reference (Ex. 1014), and Mr. Ransom’s alleged description thereof, was in response to Patent Owner’s argument that Ground One could not involve knowledge of POSITA. *See* Paper 28, 27–30, Paper 17, 17, Exs. 1014, 1022, 1025,

1014; 2031. Thus, Petitioner was responding to an argument raised in Patent Owner's Response, in accordance with 37 C.F.R. § 42.23. Insofar as there is a mischaracterization of the expert's testimony (e.g., by allegedly inaccurate annotations), the Board can adequately evaluate any imprecisions by comparing Petitioner's position with testimony already of record.

Patent Owner contends that Petitioner "for the first time challenges the effective filing date and priority claim" of the challenged patent in its Reply. Ex. 3001. However, Petitioner specifically addressed the effective filing date and priority of the challenged patent in the Petition. *See* Paper 1, 12–13. Indeed, Petitioner explained that although a listed provisional application had an earlier filing date, this provisional application did "not provide support under 35 U.S.C. § 112(a) for the claimed subject matter." *Id.* at 12. And Petitioner "reserve[d] the right to challenge the priority date" of the challenged patent. *Id.* at 13. Thus, Patent Owner had ample notice and opportunity to submit evidence and arguments regarding the effective filing date of the challenged patent.

Patent Owner contends that Petitioner's Reply raises "the consideration of molecular weights of compounds relative to the teachings of the Strength reference (Ex. 1003) and coating disclosed in this reference, and Dr. Cameron should be allowed to address this issue as well." Ex. 3001. However, Petitioner's mention of molecular weights was in response to Patent Owner's argument in its Response that Strength's mesh prevents passage of water/air therethrough because a coating covers the holes and creates a solid barrier. *See* Paper 28, 9; Paper 17, 19, Ex. 1003, Ex. 2031 ¶¶ 74–77. Thus, Petitioner was responding to an argument raised in Patent Owner's Response, in accordance with 37 C.F.R. § 42.23.

Patent Owner further implies that it should now be allowed to file license agreements “for consideration by the Board relative to secondary considerations raised by Patent Owner.” Ex. 3001. Prior to institution, the parties offered no evidence of indicia of obviousness or non-obviousness. *See* Paper 1, 28–86, Paper 10, 56–57. Patent Owner (not Petitioner) injected “secondary considerations” into the picture in its Response (*see* Paper 17, 34–64), and evidence related thereto should have been introduced at that time. Indeed, the law is clear that “[w]hen the specific licenses are not in the record, it is difficult for the court to determine if ‘the licensing program was successful either because of the merits of the claimed invention or because they were entered into as business decisions to avoid litigation, because of prior business relationships, or for other economic reasons.’” *In re Cree, Inc.*, 818 F.3d 694, 703 (Fed. Cir. 2016) (quoting *In re Antor Media Corp.*, 689 F.3d 1282, 1294 (Fed. Cir. 2012)). Thus, Patent Owner may not wait until its Sur-Reply to support an argument made in the Response.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s request to submit supplemental declarations with its Sur-Reply is denied.

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