

UNITED STATES PATENT AND TRADEMARK OFFICE

JIANGSU FAVORED NANOTECHNOLOGY CO., LTD.,

Petitioner,

v.

P2I LTD.,

Patent Owner.

CASE: IPR2024-00380

Patent No. 11,041,087

PETITIONER'S MOTION TO STRIKE

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

Petitioner moves to strike Exhibits 2015, 2017, and 2018 as impermissible “new evidence” submitted with Patent Owner’s sur-reply in violation of 37 C.F.R. § 42.23(b). Additionally, Petitioner moves to strike the portions of Patent Owner’s sur-reply that reference or rely upon these improper exhibits.

II. BACKGROUND

On February 4, 2025, Patent Owner filed its sur-reply to Petitioner’s reply brief. Paper 17. In addition to its sur-reply brief, Patent Owner filed Exhibits 2015, 2017, and 2018. Patent Owner did not request authorization from the Board to file new evidence with its sur-reply.

New Exhibit 2015 is a new declaration from Patent Owner’s expert Jay Senkevich. *See* Ex. 2007 (first Senkevich declaration). Petitioner deposed Dr. Senkevich on his earlier declaration on November 21, 2024. Ex. 1060 (transcript). Throughout its reply brief, Petitioner challenged Dr. Senkevich’s first declaration as conclusory. *E.g.*, Paper 14 at 1, 11, 13, 16, 18, 19.

New Exhibit 2017 appears to be a web page printed from the usnews.com website listing the “Best Chemical Engineering Programs.” Patent Owner relies on Exhibit 2017 to try to argue that MIT graduate students exceed the level of ordinary skill in the art. Paper 17 at 4-5.

New Exhibit 2018 appears to be an IEEE web page with an “author profile”

for Scott Limb. Patent Owner relies on Exhibit 2018 to try to cast doubt on whether Dr. Limb actually performed certain work Dr. Gleason described in her declaration and in her deposition in the timeframe she identified. *See* Paper 17 at 3.

The Board granted authorization for this Motion in an email dated February 11, 2025.

III. ARGUMENT

Patent Owner's filing of Exhibits 2015, 2017, and 2018 violates 37 C.F.R. § 42.23(b). That rule states, in relevant part, that "[a] sur-reply may only respond to arguments raised in the corresponding reply and ***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(b) (emphasis added). The Consolidated Trial Practice Guide ("CTPG") repeats the above-quoted language of the rule and explains that the "sur-reply practice" formalized in late 2020 "essentially replace[d] the previous practice of filing observations on cross-examination testimony." CPTG at 73-74.

Where, as here, a Patent Owner blatantly violates the rules by filing new evidence with its sur-reply brief, the Board routinely grants motions to strike. *See, e.g., Colgate-Palmolive Co. v. Noble Innovations NC L.L.C.*, IPR2023-01254, Paper 35 at 4 (PTAB Nov. 12, 2024) (collecting cases rejecting evidence improperly filed with sur-reply brief). In some instances, the Board refuses to consider the improper evidence and then treats the motion to strike as moot. *See, e.g., Guardant Health,*

Inc. v. Univ. of Washington, IPR2022-00817, Paper 47 at 48 (PTAB Oct. 10, 2023) (“That said, because in rendering this Decision, we do not rely on Exhibits 2072 or 2073, including the ‘Exhibits’ attached thereto, we dismiss the [motion to strike] as moot.”).

Exhibit 2015, the new Senkevich declaration, is particularly egregious as Dr. Senkevich already provided a declaration in support of Patent Owner’s arguments contained in its Patent Owner Response and sat for deposition on his prior declaration. *See* Exs. 2007 (earlier declaration) and 1060 (deposition transcript). Dr. Senkevich’s new declaration purports to respond to “assertions” made by Dr. Gleason in her reply declaration (Ex. 1059). Ex. 2015 ¶ 5. But the proper way for Patent Owner to undermine Dr. Gleason’s reply declaration testimony under the Board’s rules was through effective cross-examination. P2i took the opportunity to depose Dr. Gleason regarding her reply declaration, but chose to end the deposition after less than an hour of questioning. Ex. 2016 (P2i questioned Dr. Gleason from 9:02am until 10:03am excluding a break between 9:46am and 9:53am). P2i’s questions largely focused on some work that Dr. Gleason described one of her graduate students, Scott Limb, performing in his first year of graduate school. *Id.* P2i was hoping for a “gotcha” moment because a paper the student authored relating to that work was not published until 1998—several years after he started graduate school. But Dr. Gleason explained in detail that Dr. Limb shifted his focus away

from plasma polymerization relatively early on when he discovered that an alternative technique better achieved the desired level of CF₂ group retention he was aiming for, and that he only circled back to the plasma polymerization work as he was wrapping up graduate school and working on additional publications. *Id.* at 37:15-39:14. Because P2i's "gotcha" moment fell flat, P2i resorts to trotting out new "opinions" by Dr. Senkevich that speculate wildly about the work Dr. Limb did in Dr. Gleason's lab in a feeble effort to undercut Dr. Gleason's testimony. Ex. 2015 at ¶¶ 7-16.

The rest of Dr. Senkevich's new declaration largely tries to rehabilitate his earlier testimony by addressing obvious flaws highlighted by Petitioner. For example, Dr. Senkevich tries to explain away decades-old prior art Petitioner cited to rebut his conclusory testimony that a POSA would not have known anything about pulsed plasma polymerization in 2015. *Id.* at ¶¶ 17-22. Dr. Senkevich similarly tries to explain away the fact, noted by Petitioner, that the Legein and Francesch prior art references disclosed duty cycles that overlap with the '087 patent's preferred duty-cycle range despite his earlier claims that a POSA would not have understood the duty cycles required to effectively use pulsed plasma polymerization in 2015. *Id.* at ¶ 23.

New Ex. 2017, the usnews.com webpage listing top chemical engineering programs, and new Ex. 2018, the author profile for Dr. Gleason's graduate student,

should be struck for similar reasons. These exhibits are offered in a belated attempt to attack Dr. Gleason’s reply declaration testimony which, again, Patent Owner had the chance to do during her deposition. Petitioner cannot introduce these exhibits as new evidence with its sur-reply in clear violation of the Board’s rules.

If Petitioner had a legitimate reason for introducing this new evidence, it could have sought authorization from the Board to file additional exhibits with its sur-reply. *Colgate-Palmolive*, Paper 35 at 5 (“[T]he appropriate course of Patent Owner would have been to ask the Board to do so *before* the new evidence was filed—not to file the evidence without preauthorization.”) (citing 37 C.F.R. § 42.5(b)).

Finally, in addition to striking Exhibits 2015, 2017, and 2018, Petitioner asks that the Board strike the portions of Patent Owner’s Sur-Reply (Paper 17) that rely on the improper exhibits, including p. 3, ll. 4-7; p. 4, ll. 8-16; p. 5, ll. 2-5; p. 12, ll. 11-12 and 17-19. *See, e.g., Mianyang Boe Optoelectronics Tech. Co., Ltd. v. Samsung Display Co., Ltd.*, IPR2023-00988, Paper 44 at 96-97 (PTAB Jan. 6, 2025) (noting that the Board did not rely on portions of sur-reply brief referencing untimely-filed exhibits challenged in petitioner’s motion to strike).

IV. CONCLUSION

For the reasons set forth above, Petitioner asks the Board to strike exhibits 2015, 2017, and 2018 and corresponding portions of Patent Owner’s Sur-Reply. In the alternative, the Board should at least decline to consider this untimely evidence.

Dated: February 13, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of **PETITIONER'S MOTION TO STRIKE** have been electronically served on counsel for patent owner as follows:

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