

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIANGSU FAVORED NANOTECHNOLOGY CO., LTD.,

Petitioner

v.

P2I LTD.,

Patent Owner

Case No. IPR2024-00380
U.S. Patent No. 11,041,087

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO STRIKE**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450

I. INTRODUCTION

Petitioner’s Reply (Paper 14) introduced new evidence in the form of a reply declaration from its expert, Karen Gleason, Ph.D. (Ex. 1059). Specifically, Dr. Gleason offered – for the first time – anecdotal evidence of the purported capabilities of several exceptional chemical engineers (graduate students at MIT, a top-ranked program). Ex. 1059 ¶ 13. Petitioner cited this (new) evidence in hopes of bolstering its position as to the capabilities of the relevant POSITA. Paper 14 at 16-17.

Patent Owner’s Sur-Reply (Paper 17) disputes Petitioner’s characterization of the capabilities of the POSITA and addresses the newly-presented evidence offered by Dr. Gleason. In doing so, Patent Owner also included a supplemental declaration (Ex. 2015) and exhibits (Exs. 2017, 2018).

Patent Owner acknowledges that the preferable course of action would have been to preemptively seek authorization to submit these exhibits. That said, there is sufficient basis for the Board to consider these exhibits. And the Board should do so here, for the reasons outlined below.

II. ARGUMENT

The Federal Circuit has noted that it is “confident” that in appropriate circumstances “the Board will allow an appropriate opportunity for a patent owner to submit evidence with a sur-reply.” *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023). This is such a circumstance.

37 C.F.R. § 42.123(b) permits late submission of supplemental information (and Patent Owner hereby asks the Board accept the submission of Exs. 2015, 2017, and 2018 on this basis). To do so, a party “must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” *Id.*

Exs. 2015, 2017, and 2018 could not have been submitted earlier (i.e., with Patent Owner’s Response) because they address evidence that was only introduced *afterwards* (i.e., with Petitioner’s Reply, Paper 14). It was only there – for the first time – that Petitioner’s expert introduced evidence concerning the purported capabilities of certain MIT graduate students. Ex. 1059 ¶ 13. Patent Owner’s Exs. 2015, 2017, and 2018 thus could not have been presented earlier.

In this context, it would be – and is – in the interests of justice to permit Patent Owner to introduce these exhibits with its Sur-Reply. This late-submitted evidence is appropriate to enable Patent Owner to rebut the *new* facts submitted with Petitioner’s Reply. By definition, Patent Owner could not have responded to Petitioner’s newly-submitted evidence at an earlier juncture. And precluding Patent Owner from introducing this rebuttal evidence would effectively reward Petitioner’s tactical decision to withhold (“sandbag”) its Reply evidence from its Petition.

Other panels have acknowledged that the Board may, under appropriate circumstances, “waiv[e] the rule barring new declaration evidence with a sur-reply.”

See Omega Liner Company, Inc. v. Buergofol GmbH, No. IPR2023-01372, Paper 44 p. 2-3 (Nov. 18, 2024).¹

Likewise, in other circumstances the Board has acknowledged that additional evidence may be introduced with a sur-reply, including “for the purposes of evaluating [Petitioner’s expert’s] testimony[.]” *Ascend Performance Materials Operations LLC v. Samsung SDI Co., Ltd.*, IPR2020-00349, Paper 53, p. 12 (July 15, 2021). As outlined above, such is the case here with Exs. 2015, 2017, and 2018, which were introduced in response to the newly-presented assertions of Petitioner’s expert.

And in *Canon U.S.A, Inc. v. Cellspin Soft, Inc.*, IPR2019-00127, Paper 51 (Apr. 28, 2020) the Board also declined to strike a patent owner’s sur-reply declaration where – as here – it was filed in response to the petitioner’s reply: “To

¹ The panel’s majority held that “extraordinary circumstances” were necessary to warrant deviation from 37 C.F.R. § 42.23(b) (which otherwise precludes introducing new evidence with a sur-reply). In dissent, Judge McGraw explained that “[u]nder the particular facts presented, I would permit deviation from [37 C.F.R. § 42.23(b)] and would permit Patent Owner to submit the declarations... with its sur-reply.” *Id.* at 8.

Patent Owner submits that under any standard, the particular facts of this proceeding are sufficiently “exceptional” to warrant acceptance of Exs. 2015, 2017, and 2018, for the reasons outlined above.

the extent the [] Sur-reply Declaration [] is... in response to Petitioner's Reply, it is properly part of a Sur-reply evidence and argument." *Id.*, p. 63. Again, Exs. 2015, 2017, and 2018, which were introduced in response to the newly-presented assertions of Petitioner's expert, meet this standard.²

III. CONCLUSION

For the foregoing reasons, the Board should deny Petitioner's motion to strike (Paper 22) and should permit the introduction of Exs. 2015, 2017, and 2018.

Respectfully submitted,
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Dated: February 21, 2025

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² Notably, the Board cited p. 74 of the Consolidated Trial Practice Guide (which provides that "Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief.") in support its conclusion that rebuttal evidence submitted with a sur-reply *can* be considered. *Id.*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was electronically served on February 21, 2025 on Petitioner, who has consented to service by electronic means.

Respectfully submitted,
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