
From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, June 4, 2025 9:59 AM
To: Kyle Auteri; Trials
Cc: Sanders, Charles (BN); Peniza, Cecilia (DC); Wheeler, Kevin (DC); Rosen, Lauren (LA); EndyMed; Milo Eadan
Subject: RE: IPR2024-00383, -00384, -00463 | Petitioner Requesting Leave For a Motion to Strike

Counsel,

No conference call is necessary. Petitioner's request for leave to file a motion to strike is denied. Per the Director's decision in *Semiconductor Components Industries, LLC. v. Greenthread, LLC*, IPR2023-01242, -01243, -01244, Paper 94, at 4–6 n.5 (Stewart Apr. 24, 2025), a party may file a legal ruling by another tribunal relating to the challenged patent at any time before the oral hearing, though best practice is to do so as early as possible. As such, the Board will consider Exhibits 2158 and 2159, as well as the disputed portions of Exhibit 2157, and give them appropriate weight.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Kyle Auteri <KAuteri@PearlCohen.com>
Sent: Tuesday, June 3, 2025 1:00 PM
To: Trials <Trials@USPTO.GOV>
Cc: Charles.Sanders@lw.com; Cecilia.Peniza@lw.com; Kevin.Wheeler@lw.com; Lauren.Rosen@lw.com; EndyMed <endymed@PearlCohen.com>; Milo Eadan <MEadan@PearlCohen.com>
Subject: IPR2024-00383, -00384, -00463 | Petitioner Requesting Leave For a Motion to Strike

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Dear Board,

Petitioner requests leave to file a motion to strike Exhibits 2158 and 2159, and portions of Exhibits 2157 that relate to, or rely upon Exhibits 2158 and 2159, which were submitted with Patent Owner's sur-replies in IPR Nos. IPR2024-00383, -00384, -00463. The basis for the motion is as follows: Petitioner contends that Exhibits 2158 and 2159 are new evidence, which are not "deposition transcripts of the cross-

examination of any reply witness” that was submitted for the first time with Patent Owner’s sur-replies (37 C.F.R. § 42.23(b)); and, while Exhibit 2157 is a deposition transcript of the cross-examination of Petitioner’s expert, Dr. Woloszko, the portions of Exhibit 2157 that relate to, or rely upon Exhibits 2158 and 2159, are improper attempts to have Dr. Woloszko read or paraphrase portions of Exhibits 2158 and 2159 into the record.

Patent Owner opposes Petitioner’s request for leave to file a motion to strike Exhibits 2158 and 2159, and Petitioner’s expert’s deposition testimony (Exhibit 2157) addressing them. Exhibit 2158 is the public initial determination by the Administrative Law Judge (ALJ) in the U.S. International Trade Commission (ITC) finding the asserted claims of the challenged patents not invalid based in view of Petitioner’s arguments based on the Mehta reference, which is Petitioner’s primary reference in these IPRs. Exhibit 2159 is the Commission’s notice determining not to review the ALJ’s validity determinations. This precedent from another government agency issued after Patent Owner’s Response was filed and before Petitioner’s Reply was filed. These intervening legal developments were properly addressed in Patent Owner’s sur-reply and raised with Petitioner’s expert at his deposition because Petitioner’s expert offers opinions in these IPRs that were rejected by the ALJ in the ITC. See *Semiconductor Components Industries, LLC, d/b/a OnSemi et al. v. Greenthread, LLC*, IPR2023-01242, -01243, -01244, Paper 94 (Apr. 24, 2025) (reversing grant of a motion to strike on Director Review, explaining, “Although Rule 42.23(b) prohibits the filing of new evidence with a sur-reply other than deposition transcripts of the cross-examination of a reply witness, a legal ruling by another tribunal is not evidentiary in nature. Thus, it is not the type of exhibit that falls within the prohibition against new evidence. Indeed, the Board may take administrative notice of another tribunal’s legal ruling. See *generally* 5 U.S.C. § 556(e) (official notice); cf. Fed. Rule Evid. 201(b)(2) (stating that a court ‘may judicially notice a fact that is not subject to reasonable dispute because it . . . can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned’).”).

The parties are available for a call on the following dates and times:

- Wednesday, June 11, 2025 between 10AM-1PM ET
- Thursday, June 12, 2025 between 10AM-1PM ET

Thank you,
Kyle Auteri

PEARL COHEN

Kyle Auteri

Partner

Pearl Cohen Zedek Latzer Baratz LLP

Tel: +1-646-878-0824



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