

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Casper Sleep Inc.,
Petitioner,

v.

Werner Media Partners, LLC,
Patent Owner.

U.S. Patent 10,842,301
IPR 2024-00474

PETITIONER'S MOTION TO STRIKE

Casper Sleep Inc. (“Petitioner”) respectfully files this Motion to Strike, which was authorized by the Board on December 10, 2024 (Exhibit 3001).

I. STATEMENT OF FACTS

On August 23, 2024, Werner Media Partners, LLC (“Patent Owner”) filed its Response (“POR”) (Paper 12) to the Petition that began this IPR. The POR was supported by expert declarations from Andrew Gross (Exhibit 2001) and Jeff Quinn (Exhibit 2013). Petitioner subsequently took depositions of both experts.

On November 15, 2024, Petitioner filed its Reply to Patent Owner Response (“PR”) (Paper 24). The PR was supported by expert declarations from David M. Brienza, Ph.D. (Exhibit 1075) and David Shiroff (Exhibit 1076). Patent Owner subsequently took the deposition of Mr. Shiroff only and not Dr. Brienza.

On Friday, December 6, 2024, Patent Owner filed its Sur-Reply to the PR (“POSR”) (Paper 31). The POSR was accompanied by the deposition transcript of Mr. Shiroff (Exhibit 2029), along with 16 additional Exhibits 2030–2045 (“Additional POSR Exhibits”), namely:

- (i) a second declaration from Mr. Gross that, *inter alia*, purported to rebut the opinion of Dr. Brienza on Petitioner’s cited prior art (Exhibit 2030);
- (ii) a second declaration from Mr. Quinn that, *inter alia*, purported to rebut the opinions of Dr. Brienza and Mr. Shiroff on secondary considerations (Exhibit 2033);

(iii) an Affidavit of Joseph Progar purporting to establish the experience of Mr. Gross in the bedding industry (Exhibit 2031);

(iv) a Declaration of Alan Hirschhorn, Executive Vice President of Patent Owner, purporting to summarize his interactions with Mr. Shiroff (Exhibit 2036);

(v) an Affidavit of Greg Fowler purporting to establish the experience of Mr. Gross in the bedding industry (Exhibit 2040);

(vi) a Declaration of Marc Werner, CEO of Patent Owner, purporting to explain why Patent Owner submitted certain samples tested by Element Materials Technology as part of its POR (Exhibit 2042); and

(vii) ten other new documents (Exhibits 2032, 2034, 2035, 2037–2039, 2041, and 2043–2045).

On the next business day (Monday, December 9, 2024), counsel for Petitioner emailed counsel for Patent Owner requesting Patent Owner withdraw the Additional POSR Exhibits and those portions of the POSR that rely on the Additional POSR Exhibits (the “Additional POSR Briefing,” and collectively with the Additional POSR Exhibits, the “Additional POSR Materials”). Counsel for Patent Owner refused. Later that day, counsel for Petitioner emailed the Board seeking permission to file a Motion to Strike, which the Board authorized Petitioner to file by December 17, 2024 (Exhibit 3001).

II. THE BOARD SHOULD STRIKE THE ADDITIONAL POSR MATERIALS

A. The Additional POSR Materials Violate 37 C.F.R. § 42.23(b)

There can be no doubt that the Additional POSR Materials violate 37 C.F.R. § 42.23(b), which provides:

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.

See Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”), at 73–75 (Nov. 20, 2019); *Satco Products, Inc. v. Seoul Semiconductor Co. Ltd.*, IPR2020-00836, Paper No. 45, at 75-77 (October 22, 2021); *Samsung Electronics America, Inc. v. Kannuu Pty Ltd.*, IPR2020-00738, Paper No. 100, at 9–16 (September 21, 2021); *Lenovo Holding Company, Inc. et al. v. Dodots Licensing Solutions LLC*, IPR2019-01278, Paper No. 37, at 31-33 (January 19, 2021); *Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper No. 66 (April 20, 2020). Nor can Patent Owner argue that the Additional POSR Materials are properly submitted because they respond to alleged new theories improperly raised by Petitioner in the PR. Even if that were true (which it is not), Patent Owner did not seek authorization to file a motion seeking permission to submit new evidence with the POSR. *See Clearone*, at 3–4.

B. Striking the Additional POSR Materials is the Appropriate Remedy

The Board has not hesitated to strike improperly filed Exhibits in their entirety. *See Satco*, at 75–77; *Clearone*, at 2–4. That is the appropriate remedy in this case for all Additional POSR Exhibits, each of which is not “deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23(b).

With respect to the Additional POSR Briefing, the Board notes that “striking the entirety or a portion of a party’s brief is an exceptional remedy” but:

whether an issue is new or evidence is belatedly presented may be beyond dispute, or the prejudice to a party of waiting until the close of the evidence to determine whether new issues or belatedly presented evidence has been presented may be so great, that the facts may merit considering a motion to strike.

CTPG, at 80–81.

Such exceptional criteria are present here. The Additional POSR Briefing is untimely. Indeed, striking the Additional POSR Briefing is especially appropriate since Patent Owner could have submitted the deposition transcript of Dr. Brienza with the POSR had Patent Owner chosen to depose him. *See Clearone*, at 3–4.

Moreover, unless Petitioner is given leave to depose each of Patent Owner’s six witnesses (expert witnesses Messrs. Gross and Quinn and fact witnesses Messrs. Progar, Hirschhorn, Fowler, and Werner) and time to file a sur-reply to respond to the Additional POSR Materials on the merits, Petitioner will be

extremely prejudiced by the presence of the Additional POSR Materials in the evidentiary record. Striking the Additional POSR Materials is thus the appropriate remedy. *See, e.g., Samsung*, at 16 (striking Petitioner’s improper Exhibits and arguments relying on those exhibits); *Clearone*, at 5 (striking Patent Owner’s improper Exhibits and ordering refiling of a sur-reply with citations to the offending Exhibits removed).

III. CONCLUSION

For the reasons set forth above, the Board should strike the Additional POSR Materials. In the alternative, Petitioner should be given leave to depose Messrs. Gross, Quinn, Progar, Hirschhorn, Fowler, and Werner, and be granted time to file a sur-reply to respond to the Additional POSR Materials on the merits.

Respectfully submitted,

Dated: December 17, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.205, service was made on Patent Owner as detailed below.

Date of Service December 17, 2024

Manner of Service Email to patent@assoulineberlowe.com,
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Document Served - This Petitioner's Motion to Strike

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