UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD., and
NINTENDO OF AMERICA INC.,
Petitioners,

v.

AMERICAN GNC CORPORATION,
Patent Owner

IPR2024-00667
U.S. Patent No. 6,508,122

PATENT OWNER'S MOTION TO EXCLUDE PETITIONER'S REPLY EVIDENCE

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner American GNC Corporation ("American GNC") respectfully moves to exclude new Reply Declaration EX1045, and new Reply exhibits EX1037, EX1040 and EX1057, EX1053, EX1055, EX1058, EX1059, EX1060, EX1063, EX1064, EX1065. On April 22, 2025, American GNC timely filed its objections to evidence in Petitioner Nintendo's Reply, including objections to each of these Exhibits.

Nintendo's Reply Declaration of Darrin Young (EX1045), and several of the Exhibits it cites, contains improper Reply testimony and evidence that should and could have been included in Nintendo's Petition under the applicable rules and statutes. Nintendo's late and improper presentation of the challenged testimony and evidence deprived American GNC of an opportunity to respond with rebuttal testimony and evidence. The Board should not consider this improper testimony and evidence.

The Board should grant American GNC's Motion to Exclude for the reasons set forth in American GNC's objections and herein:

I. NINTENDO'S REPLY DECLARATION AND EXHIBITS SHOULD BE EXCLUDED

With its Reply, after its expert had been deposed on his Petition Declaration (EX1002), Nintendo submitted a 47-page Reply Declaration from that expert, full of new testimony and references to new Exhibits, as well as supplementation and re-

characterizations of his prior testimony. *See generally*, EX1045. This is improper new testimony and evidence on Reply, going to issues already raised in the Petition—and offered in a transparent attempt to fill gaps and correct flaws in Nintendo's presentation.

Nintendo offers numerous Exhibits for which it provides no explanation of relevance and no citations in its Reply brief. EX1053, EX1055, EX1058, EX1059, EX1060, EX1063, EX1064, EX1065. For example, Nintendo's expert, after confirming that he addressed alleged commercially available products in his Petition Declaration, simply string-cites in his Reply Declaration Exhibits EX1053, EX1063, EX1064, and EX1065, as supposed additional examples of commercially available products. EX1045, ¶49. This is plainly improper supplementation with material that could have and should have been included in the Petition Declaration, so that it could be fairly addressed in response. Similarly, Nintendo's improper new Reply testimony lists Exhibits EX1058, EX1059, and EX1060 in a string-cite as alleged MEMS prior art. EX1045, ¶59. Neither the Reply nor the Reply Declaration show any reason these references could not have been included in the Petition Declaration, so that they could be fairly addressed in response.

Nintendo offers other Reply Exhibits supposedly evidencing background knowledge of person of skill in the art, that it failed to include in its Petition or Petition Declaration. EX1037 (Juneau), EX1040 (Clark Cover Page), EX1057

(Clark). This is also material that could have, and should have, been included before so that it could be fairly addressed in response. EX1045, ¶52.

Instead, Nintendo literally put these articles (or just their cover sheets) in front of American GNC's witnesses, asked if they remembered seeing them, and then set them aside without asking any substantive questions. *See* EX1048, 22:8-25 (EX1037); EX1046, 31:5-32:14 (EX1040). This practice does not convey or explain relevance, or provide an opportunity to respond. And it fails to change the fact that the material could and should have been included with Nintendo's Petition. Rather, this practice highlights the unfair surprise, and the inability of American GNC to properly respond to the new Reply evidence. American GNC is prohibited by the rules and schedule of these proceedings from entering Sur-Reply testimony or evidence. Waving the ***cover sheet*** from an alleged prior art reference in front of Professor Larson in a video deposition is not an opportunity to consider and respond.

In addition to the portions of the Reply Declaration improperly listing supplemental Exhibits (EX1045 at ¶¶49, 52, 59), the Declaration offers extensive sections of attempted rehabilitation of Dr. Young's cursory opening testimony. These can be identified in the Reply brief, wherever Nintendo cites one or two paragraphs of Dr. Young's Petition Declaration (EX1002), followed by page upon page of his Reply Declaration (EX1045). *See, e.g.*, Reply Br. at 2 ("(EX1002, ¶185 (*citing* Townsend, p.3); EX1045, ¶¶20-30, 61-65.)"), 9 ("EX1002, ¶¶168-175;

EX1045, ¶¶8-30" and "EX1002, ¶167; *see also* EX1045, ¶¶24-30."), 13 ("EX1002, ¶¶237-238; EX1045, ¶¶8-19, 31-35" and "EX1002, ¶237; EX1045, ¶¶31-41, 61-65"). The increased verbosity and "see also" nature of the Reply testimony, as compared to the cursory treatment of the same issues in the Petition testimony, aptly shows that Nintendo is improperly gap-filling and supplementing without leave or fair cause.

That Nintendo and Dr. Young frame this new testimony—on issues raised in the Petition—as disagreement with American GNC or Professor Larson is not the relevant test. Under the rules and precedents discussed below, Reply evidence is improper when it could and should have been included in the Petition. Gap-filling and rehabilitation are not proper justifications for new evidence presented for the first time in Reply.

Exhibit EX1045 is testimony, delivered after Dr. Young was cross-examined on his earlier testimony. In a trial, parties are not allowed to supplement a witness's testimony after cross-examination with things that could have been said originally. Dr. Young's Reply Declaration is not re-direct, but rather restatement and supplementation. *See, e.g.*, EX1045, ¶64 (beginning with: "As I described in my opening declaration," and then supplementing with additional testimony).

II. CONSIDERING THE NEW REPLY TESTIMONY AND EXHIBITS WOULD VIOLATE THE BOARD'S RULES AND DUE PROCESS

Nintendo was obligated to put the evidence supporting its theories in its Petition, and to "state its relevance or to identify specific portions of the evidence that support the challenge." 37 C.F.R. § 42.104(b)(5); *see also* 37 C.F.R. § 42.22 ("detailed explanation of the significance of the evidence"). This requirement is ongoing, and the burden of proof never shifts to American GNC. *Id.*; 35 U.S.C. §316(e); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) ("the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable").

Nintendo may not use its Reply brief to fill gaps in the Petition's required showing of obviousness. 37 CFR § 42.23(b); Consolidated Trial Practice Guide (2019), 74 ("a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered"). Nintendo may not use Reply to add in new evidence that could have been included in its Petition, and all such evidence, including the testimony and exhibits discussed above, should be excluded. *See, e.g.*, *Id.*; *Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01447, Paper 34, pp. 44–47 (PTAB Mar. 9, 2016) ("[Section 42.23(b)], however, does not authorize or otherwise provide a means for supplementing the evidence of record."); *Toyota Motor Corp. v. Am. Vehicular Scis. LLC*, IPR2013-00424, Paper 50, p. 21 (PTAB Jan. 12, 2015)

("[Petitioner] cannot rely belatedly on this evidence in its Reply … to make up for the deficiencies in its Petition.").

The test for propriety of new evidence is whether it could have been included in the Petition. It is not enough merely to say that the new evidence replies to or disagrees with something in the response—as this will always be true and would swallow the rules and precedents against belated presentation of evidence. In other words, replying to a new issue or evidence raised in response must be permitted. But offering more support for something already presented in the Petition, merely because it has been disagreed with, cannot be permitted under the particularity and presentation requirements of the Board's rules and precedents.

As discussed above, examination of Dr. Young's Reply Declaration shows it to be in the improper "gap-filling" mode—offering more on issues he had already testified and been cross examined about. That Nintendo may not have liked how cross-examination went is not reason for the party bearing the burdens of presentation, particularity, and ultimate proof to "reply" with rehabilitation.

For example, Dr. Young testified on cross examination about "noise" as a motivation to combine, admitting that: "If I only focus on noise, maybe it's overbroad; right? …" EX2020, 64:12-23. In his Reply Declaration, he stated: "I disagree with Patent Owner that noise is an "[o]verbroad and generalized concern." EX1045, ¶63. Erasing a damaging cross-examination admission is not a proper or

permitted purpose for a Reply Declaration.

Because Nintendo instead adopted its strategy of submitting the new testimony and exhibits only on Reply, American GNC has been prevented by the Board's rules from offering rebuttal testimony. This raises fundamental fairness and due process concerns. *See, e.g., Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) ("A patent owner … is undoubtedly entitled to notice of and a fair opportunity to meet the grounds of rejection"); 5 U.S.C. § 556(d) (American GNC "is entitled to" … "submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts").

III. CONCLUSION

For the foregoing reasons, American GNC respectfully requests that its Motion be granted and that Nintendo's improper Reply Declaration EX1045, and Reply Exhibits EX1037, EX1040, EX1057, EX1053, EX1055, EX1058, EX1059, EX1060, EX1063, EX1064, and EX1065 be excluded from consideration in this IPR.

Dated: May 6, 2025

/s/ Corey Johanningmeier
Brenda Entzminger, Lead Counsel
Reg. No. 76,896
Corey Johanningmeier, Back-up Counsel
(*pro hac vice*)
Bunsow De Mory LLP
701 El Camino Real

Redwood City, CA 94063
Telephone: 650-351-7248
Facsimile: 415-426-4744
bentzminger@bdiplaw.com
cjohanningmeier@bdiplaw.com

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on May 6, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

Matthew J. Brigham (Reg. No. 44,047)
Andrew C. Mace (Reg. No. 63,342)
Patrick W. Lauppe (Admission *pro hac vice* to be requested)
Dena Chen (Admission *pro hac vice* to be requested)
Mark R. Weinstein (Admission *pro hac vice* to be requested)
Stephen Smith (Admission *pro hac vice* to be requested)
COOLEY LLP
ATTN: Patent Group
1299 Pennsylvania Avenue NW, Suite 700
Washington, DC 20004
Email: mbrigham@cooley.com
amace@cooley.com
plauppe@cooley.com
dchen@cooley.com
mweinsten@cooley.com
stephen.smith@cooley.com
Tel.: +1 (650) 843-5001
Fax: +1 (650) 849-7400

Dated: May 6, 2025

/s/ Corey Johanningmeier

Brenda Entzminger
Reg. No. 76,896
Corey Johanningmeier, Back-up Counsel
(*pro hac vice*)
Bunsow De Mory LLP
701 El Camino Real
Redwood City, CA 94063
Telephone: 650-351-7248
Facsimile: 415-426-4744
bentzminger@bdiplaw.com

Counsel for Patent Owner