

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.

Case IPR2024-00668
Patent No. 6,671,648 B2

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
MOTION TO EXCLUDE PETITIONERS' REPLY EVIDENCE**

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I. INTRODUCTION

Patent Owner American GNC Corporation's ("PO") motion to exclude is procedurally improper and should be denied. Motions to exclude are for evidentiary objections—but PO's motion raises none. Instead, PO's motion attacks Petitioners Nintendo Co., Ltd. and Nintendo of America Inc.'s (collectively, "Petitioner") submissions as allegedly outside the scope of proper reply evidence. As it has repeatedly done in other proceedings, the Board should deny PO's procedurally improper motion to exclude.

Even if PO's motion were not procedurally deficient, it should be denied on the merits. The reply evidence PO challenges was properly submitted to respond to arguments and evidence raised in the Patent Owner Response. Furthermore, PO chose not to pursue the multiple opportunities it had to develop evidence in response to the challenged exhibits—declining to depose Petitioner's expert as to his reply declaration or to ask questions of PO's own witnesses on redirect regarding exhibits that Petitioner introduced in deposition. The Board invited the parties to "develop evidence" on the issue of whether a person of ordinary skill in the art would have found it "uniquely challenging or difficult" to have combined the teachings of the prior art in this proceeding—and that is precisely what Petitioner has sought to do with its proper reply evidence. (Institution Decision, Paper 10 at 35, 36, 38.)

Accordingly, PO's motion should be denied.

II. PATENT OWNER’S MOTION IS PROCEDURALLY IMPROPER

The sole basis for PO’s motion to exclude is that certain of Petitioner’s exhibits are, according to PO, outside the scope of proper reply evidence. But that is not a proper basis for a motion to exclude. PTAB Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) at 79 (“Nor should a motion to exclude address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply.”); 37 C.F.R. § 42.64; *Apple Inc. v. Parus Holdings, Inc.*, IPR2020-00686, Paper 37 at 41-42 (PTAB Sept. 9, 2021) (denying PO’s motion to exclude based on the argument that “testimony exceeds the proper scope of reply evidence,” because it is not “a proper basis for excluding evidence”); *Palo Alto Networks, Inc. v. Finjan, Inc.*, IPR2016-00151, Paper 51 at 23 (PTAB Mar. 15, 2017) (“[W]e have stated repeatedly that a motion to exclude is not a vehicle for arguing that Petitioner’s arguments and supporting evidence are outside the proper scope of a reply.”). PO’s motion to exclude should be denied on this basis alone.

A motion to exclude must be directed to the admissibility of evidence. *Parus*, IPR2020-00686, Paper 37 at 41. However, PO’s motion is not based on evidentiary objections. If PO wished to seek relief based on alleged new evidence accompanying Petitioner’s reply, then it should have filed a motion to strike. However, such a motion would have required PO to seek authorization from the Board within one week of Petitioner’s reply—which PO did not do. 37 C.F.R. §

42.20; CTPG at 80-81 (“[A]uthorization to file a motion to strike should be requested within one week of the allegedly improper submission.”) And indeed, PO could not prevail on moving to strike based on any evidentiary objections even if it had raised them. For example, PO had filed baseless objections to the authenticity of certain exhibits to Petitioner’s reply, but Petitioner provided a supplemental librarian declaration in response that confirmed that PO’s authenticity objections were unfounded. (EX1066.) PO did not renew any of those evidentiary objections.

III. EVEN IF IT HAD BEEN PROCEDURALLY PROPER, PATENT OWNER’S MOTION LACKS MERIT

Even if PO’s motion were procedurally proper (which it is not, as discussed above), it should be denied on the merits. PO argues that certain exhibits to Petitioner’s reply, including the reply declaration of Petitioner’s expert Dr. Young, are improper new evidence outside the scope of a reply. But the challenged exhibits to Petitioner’s reply were properly used to respond to evidence and arguments PO raised in its Patent Owner Response. Accordingly, the challenged exhibits are proper and should not be excluded from this proceeding.

A. Reply Declaration of Petitioner’s Expert Dr. Young (EX1045)

PO seeks to exclude the entirety of the reply declaration of Petitioner’s expert Dr. Young for allegedly being improper reply evidence. (Mot. at 7.) Dr. Young’s declaration is properly responsive to arguments and evidence submitted with the Patent Owner Response. None of it should be excluded.

For example, Dr. Young’s reply declaration contains proper opinions responding to new claim construction arguments raised for the first time in its Patent Owner Response with respect to “angular rate electrical signals” and “angular rate voltage signals.” (EX1045, ¶¶ 46-54.) PO argued in its Patent Owner Response that “[a] person of ordinary skill in the art would understand the claimed angular rate electrical signals to directly measure and reflect angular rate.” (POR at 24.) Petitioner had no prior notice of this argument, and PO never proposed it in the pending district court litigation. (EX1067.) Dr. Young explained why a person of ordinary skill would *not* have understood the terms “angular rate electrical signals” and “angular rate voltage signals,” as PO newly proposed in its Patent Owner Response—and that these limitations would be anticipated or obvious over the prior art even under PO’s proposed construction. (EX1045, ¶¶ 46-54.) Such reply evidence responding to a claim construction proposed for the first time in the Patent Owner Response is clearly proper. *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023) (Petitioner “must be given the opportunity in its reply to argue and present evidence of anticipation or obviousness under the new construction”). Otherwise, Petitioner and its expert would be denied the opportunity to respond to PO’s new construction, rewarding PO for raising its new claim construction in the Patent Owner Response, without prior notice to Petitioner.

The rest of Dr. Young’s reply declaration is similarly responsive to arguments

and evidence in the Patent Owner Response. Dr. Young’s reply declaration consistently identifies the portions of the Patent Owner Response, Larson declaration, or McCall declaration it is responding to. (EX1045, ¶¶ 4-6 (responding to “Patent Owner and its expert’s arguments regarding [Dr. Young’s] background”), ¶¶ 9-18 (responding to EX2019, ¶¶ 57-58), ¶ 19 (responding to EX2019, ¶54), ¶¶ 20-27 (responding to EX2019, ¶¶ 76-80), ¶¶ 28-36 (responding to EX2019, ¶¶ 81-84), ¶¶ 37-44 (responding to identified paragraphs of EX2023), ¶ 45 (responding to EX2019, ¶ 78 and EX2023, ¶ 7), ¶¶ 46-54 (responding to new claim construction arguments in POR).) Such opinions responding to evidence and arguments presented in the Patent Owner Response are proper. *See* 37 C.F.R. § 42.23(b) (permitting a petitioner to respond to arguments in a patent owner response); *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380-81 (Fed. Cir. 2018) (“[T]he petitioner in an inter partes review proceeding may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner, or if it is used ‘to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.’” (quoting *Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1369 (Fed. Cir. 2016))).

PO argues that Dr. Young’s reply declaration is unfair or denies PO an opportunity to respond. (Mot. at 6-7.) However, PO had an opportunity to depose

Dr. Young on his reply declaration—but elected not to do so. PO also ignores the opportunity it has to respond to Dr. Young’s opinions through briefing in its sur-reply. *Proppant Express Investments, LLC v. Oren Techs., LLC*, IPR2018-00733, Paper 79 at 3-4 (PTAB Sept. 12, 2019) (citing patent owner’s opportunity to depose petitioner’s expert regarding reply declaration and to submit a sur-reply in denying motion to strike). As the Board and the Federal Circuit has repeatedly recognized, there is nothing unfair or improper about reply evidence that responds to evidence and arguments in the Patent Owner Response. *Anacor*, 889 F.3d at 1380-81; *Samsung Elecs. Co. v. Network Sys. Techs., LLC*, IPR2024-00338, Paper 64 at 25-26 (PTAB Mar. 18, 2025); *Apple Inc. v. Universal Secure Registry, LLC*, IPR2018-00813, Paper 46 at 14-15 (PTAB Oct. 8, 2019). Furthermore, PO’s argument that Dr. Young’s reply declaration provides new opinions that it will not have an opportunity to respond to is undermined by PO’s own argument that the reply declaration consistently refers back to his opening declaration. (Mot. at 3-4.) This confirms that Dr. Young’s reply opinions are consistent with the opinions provided in his opening declaration.

PO argues that Dr. Young’s responsive opinions should have been submitted with the Petition. (Mot. at 4-7.) However, this misstates the standard, which is “not whether Petitioner could have raised the arguments or evidence in the Petition, but whether they respond to arguments raised by Patent Owner.” *Proppant*, IPR2018-

00733, Paper 79 at 3-4. Further, PO does not explain how Dr. Young or Petitioner could have anticipated the particular arguments and opinions that PO, Dr. Larson, and Mr. McCall would later raise in the Patent Owner Response. PO also appears to argue against the very concept of responsive evidence, saying that it will “always be true” that reply evidence is responsive and therefore it “would swallow the rules and precedents against belated presentation of evidence.” (Mot. at 5-6.) But responsive evidence is allowed. 37 C.F.R. § 42.23(b). And Dr. Young’s opinions are *directly* responsive to the arguments and evidence submitted with the Patent Owner Response—precisely identifying the opinions to which they are responsive. *Universal Secure*, IPR2018-00813, Paper 46 at 14-15 (petitioner’s expert reply declaration that “responds directly” to patent owner’s expert declaration “is a proper reply declaration”). Accordingly, finding Dr. Young’s opinions to be properly responsive would not render *all* reply evidence proper, as PO argues. Rather, Dr. Young’s reply opinions are squarely responsive and within the scope of proper reply evidence.

PO also argues that Dr. Young’s reply opinions are improper “gap-filling” or “rehabilitation” of Dr. Young’s opening declaration and deposition testimony. (Mot. at 3-7.) But what PO points to as gap-filling or rehabilitation is nothing more than proper responsive reply evidence. For example, PO and its expert relied on exaggerations and mischaracterizations of Dr. Young’s prior experience in the

Patent Owner Response and accompanying declarations. (POR at 7-8, 36, 38, 48, 52, 57, 61; EX2019, ¶ 80.) In his reply declaration, Dr. Young provided proper testimony responding to and clarifying the facts of his prior experience. (EX1045, ¶¶ 4-6, 26-27.) This is not improper “gap-filling” or “rehabilitation”—it is proper responsive testimony. If PO had concerns about Dr. Young’s reply declaration, it could have deposed him about it—but PO chose not to.

Accordingly, the reply declaration of Dr. Young is proper responsive evidence presented on reply, and there is no basis to exclude it from consideration in this proceeding.

B. Prior Art Patents and Publications (EX1037, EX1038, EX1040, EX1043, EX1047, EX1053, EX1057, EX1063, EX1064, and EX1065)

PO argues that certain prior art patents and publications (EX1037, EX1038, EX1040, EX1043, EX1047, EX1053, EX1057, EX1063, EX1064, and EX1065) cited by Petitioner and its expert are improper new reply evidence. (Mot. at 2-3.) However, Petitioner and its expert properly used these exhibits to respond to arguments in the Patent Owner Response. *Anacor*, 889 F.3d at 1380-81. Accordingly, even if Patent Owner’s motion were procedurally proper, it should be denied as to these exhibits.

Patent Owner introduced two declarations—from its expert Dr. Larson and one of the named inventors of the ’648 patent Mr. McCall—with its Patent Owner Response. (EX2019; EX2023.) Both made claims about the alleged difficulty or

lack of MEMS IMUs in the prior art. (*E.g.*, EX2019, ¶¶ 78, 82, 83; EX2023, ¶ 7.) The Board expressly encouraged the parties to “develop evidence on this issue at trial.” (Institution Decision, Paper 10 at 35.) Petitioner’s expert Dr. Young responded to Dr. Larson and Mr. McCall’s claims about the prior art, opining that he disagreed with those claims, and pointed out many examples of contemporaneous and publicly-available MEMS gyroscopes and IMUs. (EX1045, ¶¶ 40, 45.) In responding to and refuting the claims made by Dr. Larson and Mr. McCall about the alleged lack of MEMS IMUs in the prior art, Dr. Young cited and analyzed various prior art patents and publications, including the exhibits (EX1037, EX1038, EX1040, EX1043, EX1047, EX1053, EX1057, EX1063, EX1064, and EX1065) Patent Owner now moves to exclude.

Dr. Young’s declaration made explicit that he was using the challenged exhibits to respond to specific claims by Dr. Larson and Mr. McCall. For example, Dr. Young opined that specific claims (quoted from EX2019, ¶ 78 and EX2023, ¶ 7) in Dr. Larson and Mr. McCall’s declarations “are undermined by the fact that MEMS IMUs existed and were disclosed in the prior art to the ’648 patent” before providing his analysis regarding the Hulsing (EX1043 and EX1047) and Minor (EX1038) references. (EX1045, ¶ 45.) Further, Dr. Young opined that he disagreed with Mr. McCall’s claim that building a “commercially and technically viable gyroscope from silicon MEMS technology” was seen as a “significant technical challenge” prior to

the '648 patent before citing to the Clark (EX1040 and EX1057), Juneau (EX1037), and Crossbow DMU-6X and DMU-VGX references (EX1053) as some of the “many examples of commercially and technically viable gyroscopes from silicon MEMS technology” in the prior art. (EX1045, ¶ 40.) Additionally, in responding to Dr. Larson’s claims about MEMS technology being in its “infancy,” Dr. Young provided many examples of MEMS commercial products (EX1053, EX1063, EX1064, and EX1065) available prior to the '648 patent. (EX1045, ¶ 33.)¹

Petitioner’s reply used the challenged prior art patents and publications for a further proper responsive purpose—showing not only that Dr. Larson and Mr. McCall’s opinions about the prior art were incorrect, but that they lacked knowledge of relevant prior art. In depositions of Dr. Larson and Mr. McCall, Petitioner showed

¹ PO argues that Petitioner “provides no explanation of relevance and no citations in its Reply brief” for certain exhibits (EX1053, EX1063, EX1064, EX1065). (Mot. at 2.) But as discussed, Petitioner’s reply and Dr. Young’s reply declaration showed the relevance of these exhibits. (Reply at 7 (“[Dr. Larson] also admitted that he was unaware of relevant prior art, including an article that discusses ‘a practical MEMS Inertial Measurement Unit (IMU).’” (citing, *e.g.*, EX1045, ¶ 45)); Reply at 7-8 (“[T]here were many examples of MEMS sensors in IMUs in the prior art.” (citing, *e.g.*, EX1045, ¶¶ 33, 36, 45).)

the witnesses challenged exhibits or excerpts thereof, and the witnesses testified that they had never seen the art before. (EX1046, 31:12-32:15 (EX1040), 34:14-35:3 (EX1043); EX1048, 22:8-25 (EX1037), 23:1-16 (EX1038).) Petitioner has thus shown that when Dr. Larson and Mr. McCall made their claims about the lack or difficulty of MEMS IMUs or gyroscopes in the prior art, they were not aware of relevant examples of prior art that disclosed such systems—undermining Dr. Larson and Mr. McCall’s claims and indicating that their declarations should be given little if any weight.

PO argues that Petitioner’s responsive use of the challenged prior art patents and exhibits is unfair or denies PO an opportunity to respond. (Mot. at 2-3.) But PO ignores the multiple opportunities it had to develop evidence regarding the challenged exhibits and chose *not* to pursue those opportunities. PO could have deposed Petitioner’s expert regarding the challenged exhibits after his reply declaration had been submitted. But PO chose not to depose Petitioner’s expert regarding his reply declaration. PO also could have asked Dr. Larson or Mr. McCall questions on redirect about the challenged exhibits introduced at their depositions. Instead, PO chose not to ask any questions on redirect. Accordingly, PO’s complaints about fairness or lack of an opportunity to respond ring hollow, since PO did not take advantage of the opportunities it had to develop evidence about the challenged exhibits.

PO argues that the challenged prior art patents and publications could have been provided with the Petition. (Mot. at 4-6.) But as discussed above, this is not the standard for determining proper reply evidence. *Proppant*, IPR2018-00733, Paper 79 at 3-4. The challenged prior art patents and publications were used to respond to specific claims made by Dr. Larson and Mr. McCall in the declarations they submitted with the Patent Owner Response. Petitioner and its expert simply did not have these declarations at the time of the Petition, and they should not be expected to have anticipated Dr. Larson and Mr. McCall's inaccurate statements about the prior art.

IV. CONCLUSION

Based on the above arguments and evidence, PO's motion to exclude should be denied.

Dated: May 13, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE PETITIONERS' REPLY EVIDENCE** and related documents, are being served via electronic mail on the 13th day of May, 2025, upon Patent Owner by serving Patent Owner's counsel of record in this proceeding as follows:

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