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

IPR2024-00668
U.S. Patent No. 6,671,648

PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE PETITIONER'S REPLY EVIDENCE

The Board should grant American GNC's Motion to Exclude for the reasons set forth in American GNC's Objections (Paper 31), its Motion to Exclude (Paper 35) and herein:

I. NINTENDO'S NEW EXHIBITS AND REPLY SHOULD NOT BE CONSIDERED BY THE BOARD

As discussed in American GNC's Motion, the manner in which Nintendo introduced the new Exhibits, and the Reply Declaration discussing them, violates the particularity requirements for Petitions, as well as the prohibition of new, supplemental evidence on Reply—and it is also unduly prejudicial, and implicates due process and fundamental fairness concerns by restricting the way in which American GNC could present any Rebuttal. Mot., Paper 35, 4-7; 37 C.F.R. § 42.104(b)(5) and 37 C.F.R. § 42.22; 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"); *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) (Ramot "is entitled to" … "submit rebuttal evidence").

These are evidentiary objections to the consideration by the Board of Nintendo's cumulative and unfair new evidence—objections for which American GNC may be required to bring this Motion to preserve them under 37 C.F.R. §

42.64(c). *See, e.g.*, Objections, Paper 31 at 2:

> In addition, the exhibit is objected to as prejudicial far in excess of any probative value under FRE 403—including because it is offered with no opportunity for American GNC to provide rebuttal testimony concerning the exhibit. As such, American GNC has been denied a meaningful opportunity to respond pursuant to the requirements of Due Process and the Administrative Procedure Act.

American GNC acknowledges that the Trial Practice Guide and a number of decisions of the Board state a preference for Motions to Strike for objections about the scope of Reply evidence. But American GNC's concerns—including about particularity requirements and about the prejudice of being improperly restricted in its rebuttal—are broader.

And even with respect to American GNC's improper reply basis, the Board can and does sometimes exclude consideration of improper reply evidence on a Motion to Exclude. *See, e.g.*, *Laboratoire Francais Du Fractionnement Et Des Biotechnologies S.A. v. Novo Nordisk Healthcare AG*, IPR2017-00078, 2022 WL 1153444 at * (P.T.A.B Apr. 13, 2022) ("These arguments and evidence should have been offered in the Petition ... As such, they improperly exceed the proper scope of a reply. Accordingly, we grant Patent Owner's Motion to Exclude, which we are treating as a Motion to Strike, as to Exhibit 1094 and will not consider Petitioner's new arguments concerning the exhibit"). The Board also grants motions to exclude

new evidence on sur-reply. *See, e.g.*, *Intel Corp. v. ParkerVision, Inc.,*IPR2020-01265, Paper 44, 75 (PTAB Jan. 21, 2022); *Netflix, Inc. v. Divx, LLC,* IPR2020-00511, Paper 46, 56 (PTAB Aug. 13, 2021).

Nintendo's Opposition highlights the fact that its new Exhibits are cumulative and could and should have been included with its Petition. *See* Opp. at 9-10 (arguing that the Exhibits show "many examples of MEMS commercial products"). The fact that (low-performing) MEMS commercial products were available is conceded in the challenged patent. *See, e.g.*, EX1001, 2:56-60. If Nintendo wanted these alleged examples to be analyzed and considered in these proceedings, it had notice of the issue, and a requirement that arguments on it should be raised in its Petition with particularity.

Nintendo's Opposition also highlights the prejudice and unfairness of considering these new Exhibits now—suggesting that American GNC should have redirected its own witness's testimony when Nintendo presented the cover sheets of these surprise exhibits to Professor Larson in deposition. Opp. 11; *see* Mot. at 3; EX1048, 22:8-25, 23:1-16; EX1046, 31:5-32:14 ("I don't think so. And I just want to confirm that this is just one page; is that correct?"), 34:11-35:3. Even if such re-direct testimony were allowed, Nintendo introduced the Exhibits in surprise, with no prior record testimony on them, and gave only their cover page to Professor Larson. *See, e.g.*, EX1040; EX1043. Some of the challenged Exhibits were not presented to

American GNC's witnesses at all.

American GNC has addressed the new Exhibits in its Sur-Reply brief. Sur-Reply, 13-14. For all of the reasons given above, Nintendo should not be heard to object to American GNC's presentation regarding these new Exhibits—which were unfairly and prejudicially introduced, without the opportunity to develop and present rebuttal expert testimony specific to them, and should be excluded from consideration here.

II. 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, EX1038, EX1040 and EX1057, EX1043, EX1047, EX1053, EX1063, EX1064, and EX1065 be excluded from consideration in this IPR.

Dated: May 20, 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 20, 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
mweinstein@cooley.com
stephen.smith@cooley.com
Tel.: +1 (650) 843-5001
Fax: +1 (650) 849-7400

Dated: May 20, 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