UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEURENT MEDICAL INC. & NEURENT MEDICAL LTD.,
Petitioners,

v.

THE FOUNDRY, LLC,
Patent Owner.

Case No. IPR2024-00669
Patent No. 11,679,077

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

Pursuant to 37 C.F.R. § 42.64(c) and the Board's Scheduling Order (Paper 10), Patent Owner submits this Reply to Petitioner's Opposition to Patent Owner's Motion to Exclude Exhibit 1113 and paragraphs 112-115 of the Reply Declaration of Dr. Nicholas Bu-Saba (Exhibit 1098). In its Opposition, Petitioner contends Patent Owner's Motion should be denied because (1) the Motion is procedurally improper, and (2) the evidence does is not new or prejudicial, but rather responds to Patent Owner's arguments in the Patent Owner Response. Petitioner is wrong on both counts, and Patent Owner's Motion should be granted.

I. Patent Owner's Motion to Exclude is Procedurally Proper

Petitioner incorrectly asserts that Patent Owner's Motion to Exclude should be denied for procedural reasons, namely that it (1) does not challenge admissibility of the evidence, and (2) exceeds the scope of a proper motion to exclude. (Opposition at 5.) First, Patent Owner's Motion expressly sets forth that Exhibit 1113 and paragraphs 112-115 of Exhibit 1098 are ***inadmissible*** under Fed. R. Evid. 403 (Motion at 1, 3-4), and therefore Petitioner's contention that Patent Owner "does not argue" that such evidence "is inadmissible" is false. (Opposition at 5.) Second, Patent Owner's basis for inadmissibility under Fed. R. Evid. 403 is also proper. As explained in the Motion, Exhibit 1113 and paragraphs 112-115 of Exhibit 1098 are inadmissible under Rule 403 due to Petitioner's untimely submission of such evidence with the Reply. Contrary to Petitioner's Opposition, the Board addressed

such an argument in a motion to exclude following the August 2018 update to the Trial Practice Guide. (Opposition at 7); *Resmed, Inc. v. New York University*, IPR2022-00993, Paper 69 at 65-66 (P.T.A.B. Dec. 7, 2023). Petitioner's citation to *Sony Interactive Entm't LLC v. Intellectual Pixels Ltd.*, IPR2021-00237, Paper 50 (P.T.A.B. June 5, 2024) is inapposite. (Opposition at 5.) Unlike the present circumstances, in *Sony Interactive*, a patent owner argued only that the evidence was improper new evidence and did not contend, as Patent Owner does here, that the evidence was inadmissible under the federal rules. Thus, Patent Owner's Motion is proper and should not be denied on procedural grounds.

II. Exhibit 1113 and Paragraphs 112-115 in Exhibit 1098 Should be Excluded Under Fed. R. Evid. 403

As explained in Patent Owner's Motion, Petitioner's submission of Exhibit 1113 and Paragraphs 112-115 in Exhibit 1098 violates the Trial Practice Guide's express prohibition of submitting "new evidence or argument in reply that it could have presented earlier, e.g., to make out a prima facie case of unpatentability," (PTAB Consolidated Trial Practice Guide, November 2019 at 73). Petitioner's untimely evidence unduly prejudices Patent Owner, rendering it inadmissible under Fed. R. Evid. 403.

Petitioner does not dispute that Exhibit 1113 and Dr. Bu-Saba's corresponding Reply Declaration testimony could have been presented with the Petition. Rather,

Petitioner contends that Patent Owner's Motion should be denied because Exhibit 1113 and Dr. Bu-Saba's corresponding Reply Declaration testimony were properly submitted in response to the arguments in the Patent Owner Response. Petitioner is incorrect, because, as explained in the Motion and below, such evidence was "necessary to make out a prima facie case of patentability" and should not have been "introduced for the first time" with and in Petitioner's Reply.[1] *Dexcom, Inc. v. Waveform Techn., Inc.*, No. IPR2016-01679, Paper 53 at 50 (P.T.A.B. Feb. 18, 2008).

Specifically, as explained in the Motion and undisputed in the Opposition, Petitioner submitted Exhibit 1113 and Exhibit 1098, ¶¶112-115 in support of its contention in the Petition that Fang teaches "the known outcome of applying RF energy in the nasopharyngeal passage…" (Exhibit 1002, Bu-Saba Declaration at ¶185; Petition at 80-81.) Inherent in knowing the "outcome" of Fang's purported teaching is the diagnostic criteria cited by Fang. (*See* Exhibit 2003, Levine Declaration at ¶¶65-76.) But as Dr. Bu-Saba admitted, he did not consider Exhibit 1113 as part of his analysis and was unable to determine how Fang determined

[1] Petitioner wrongly contends that "PO and its declarants did not dispute Fang discloses statistically significant data that RF energy treated rhinitis symptoms." (Opposition at 3; POR at 46-49; Exhibit 2003, Levine Declaration at ¶¶65-76.)

efficacy or its basis for doing so. (POR at 49 (citing Exhibit 2002, Bu-Saba Tr. at 194:5-15, 207:2-208:21).) Thus, Petitioner improperly submitted Exhibit 1113 and Exhibit 1098, ¶¶112-115 "to fill a gap in its prima facie case" of unpatentability. *Dexcom*, IPR2016-01679, Paper 53 at 50. This new evidence should be excluded under Fed. R. Evid. 403. *Id.*

Petitioner wrongly contends Patent Owner is not unduly prejudiced by the inclusion of such evidence in this proceeding. As explained in the Motion and in Patent Owner's Sur-Reply, despite having a copy of Exhibit 1113, Petitioner did not present it to Patent Owner's expert, Dr. Levine, during cross-examination. Yet, Dr. Bu-Saba's Reply Declaration testimony on Exhibit 1113 justifies his reliance on Fang by comparing Exhibit 1113 to Dr. Levine's cross-examination testimony. (Exhibit 1098 at ¶¶112-115.) Petitioner relied on new Exhibit 1113 and Dr. Bu-Saba's corresponding testimony in its Reply knowing very well that Patent Owner was precluded submitting a declaration from Dr. Levine in response thereto with its Sur-Reply. Such gamesmanship by Petitioner is unduly prejudicial to Petitioner and should not be permitted.

Thus, Patent Owner respectfully requests the Board grant its Motion and exclude Exhibit 1113 and paragraphs 112-115 of Dr. Bu-Saba's Reply Declaration (Exhibit 1098) as inadmissible pursuant to Fed. R. Evid. 403.

Dated: April 15, 2025

Respectfully submitted,

/s/ Heath J. Briggs

Heath J. Briggs (Reg. No. 54,919)
GREENBERG TRAURIG, LLP
1144 15th St., Suite 3300
Denver, CO 80202
Phone: (303) 685-7418
Fax: (720) 904-6118
BriggsH@gtlaw.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the below date, I caused the foregoing to be served by electronic mail to the following:

David Cavanaugh
david.cavanaugh@wilmerhale.com

Gregory Lantier
gregory.lantier@wilmerhale.com

Alexis Cohen
alexis.cohen@wilmerhale.com

Joshua Stern
joshua.stern@wilmerhale.com

Alexander Nemtzow
alex.nemtzow@wilmerhale.com

Gilbert.Smolensk
Gilbert.Smolenski@wilmerhale.com

WHNeurentIPRService@wilmerhale.com

Date: April 15, 2025

/s/ Heath J. Briggs
Heath J. Briggs