UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK, INC.,

Petitioner,

v.

CELLSPIN SOFT, INC.,

Patent Owner

IPR2024-00767

U.S. Patent No. 11,659,381

Before GREGG I. ANDERSON, CYNTHIA M. HARDMAN, and MICHAEL A. VALEK, *Administrative Patent Judges.*

PATENT OWNER RESPONSE IN OPPOSITION
TO PETITIONER'S MOTION TO STRIKE

I. INTRODUCTION

Petitioner's Motion to Strike should be denied. The Motion fails to mention key facts, fails to recognize that the various Replies submitted by Petitioner across these actions each included numerous new theories, fails to account for the entirely new Declaration submitted by its own expert in support of its own Reply, and ignores precedent which permits supplementation of the record under these circumstances.

II. RELEVANT FACTS

Notwithstanding Petitioner's incomplete and self-serving rendition of facts, it is beyond dispute that Petitioner's Reply cites to, and relies upon, the entirely *new opinions* offered in the "Supplemental" Declaration of David Lett (TTI-1048). The Reply likewise cites to, and relies upon, multiple *new fact exhibits* in support of its modified arguments. *See* TTI-1037-48. Further, Petitioner falsely suggests that Patent Owner has not responded to its email inquiries on this subject (beyond a brief initial response dated May 5). Indeed, counsel for Patent Owner offered a substantial response on May 9 via email, wherein counsel explained as follows:

> Patent Owner respectfully disagrees with your contention that the Declaration and Exhibits appended to the Sur-Reply are improper. While we understand and appreciate the fact that the default rule (37 C.F.R. § 42.23(b)) prohibits such evidence, the Board does permit the Patent Owner to respond with new evidence in "extraordinary circumstances." *See, e.g., Omega Liner v. Buergofol*, IPR 2023-01372 (Paper 44).

Here, such extraordinary circumstances exist, given the fact that Petitioner's Reply includes multiple new arguments which were not offered in the original Petition. As such, the existing record was insufficient for Patent Owner to fully rebut those arguments.

By way of example, the Reply in IPR2024-0757 filed by Petitioner includes a wholly new theory (supported by new expert opinion) relating to the conversion of messages in all Na-Takahishi combinations into a third intermediary SOAP protocol for the combination to be operable at all. This theory was not presented in the original Petition. In the same Reply, Petitioner also changed its theory relative to "segment identifiers," where it now posits that the "identifiers" within information packets satisfy the claim limitation, rather than the packets themselves (as was originally argued in the Petition). Still further, and in the same Reply, Petitioner offers a new basis for its "user identifier" argument. The new argument relies on previously unidentified portions of the specification and new interpretative argument. These are merely exemplary, as the Replies filed in each of the pending cases all include similar new arguments and evidentiary citations.

In view of the foregoing, Patent Owner disagrees with Petitioner's contention, and rejects your offer to mutually withdraw the evidence relied upon in Patent Owner's Sur-Replies.

We are available next week anytime on Wednesday, Thursday, or Friday.

III. ARGUMENT

A. The Board Should Not Strike Exhibits 2030-2034

As noted above, Patent Owner recognizes the general rule (as stated in 37 C.F.R. § 42.23(b)) which prohibits the inclusion of new evidence beyond deposition transcript excerpts. The Board does, however, permit the Patent Owner to respond with new evidence in "extraordinary circumstances." *See, e.g., Omega*

Liner v. Buergofol, IPR 2023-01372 (Paper 44). In the instant action, such extraordinary circumstances exist, as outlined below.

First, Petitioner itself bolstered the record with an entirely new declaration from its expert. *See* TTI-1048. That Declaration, standing alone, is sufficient to warrant leave to submit the Supplemental Gajendragad Declaration (Exh. 2030). As the Board will note, the Gajendragad Declaration is directed solely to rebuttal of the numerous modified, supplemental, and otherwise outright new arguments offered in the Supplemental Lett Declaration (TTI-1048). Importantly, none of these arguments were presented in the Original Petition or in the original Lett Declaration. As a result, Patent Owner had no opportunity to rebut them (because they did not previously exist) until the filing of its Sur-Reply.

Justice in this case requires consideration of all evidence, including the rebuttal evidence contained in the Gajendragad Declaration and the exhibits cited therein. Indeed, this Board has the flexibility to accept evidence in the interest of justice, especially when it is required for full rebuttal. *See, e.g., Zodiac Pool Systems v. Aqua Products,* IPR2013-00159 (Paper 51) (authorizing submission of additional information).

Second, the Reply offers multiple new theories and argument which can be fully rebutted only by considering the Supplemental Gajendragad Declaration. More specifically, the Reply offers the following arguments for the first time:

1. Petitioner now asserts, with respect to "Object" being similar to "File," that filename is used as a reference (pointer) to the "file data" in the file header. Petitioner further asserts that somehow "[t]his mapping applies to CellSpin's constructions because a file is a structure for organizing data, and it has value (the picture) and an identifier (filename)." Again, this argument is not present in the original Petition, and the Supplemental Gajendragad Declaration was necessary and proper.

2. Petitioner, for the first time in its Reply, argues that the Bluetooth 2.1 connection between devices in Hiroishi purportedly "maintains its Bluetooth connection on a continuous basis." In view of the foregoing, the Supplemental Gajendragad Declaration was necessary and proper, as these theories were previously undisclosed.

3. Petitioner, for the first time in its Reply, argues that the Bluetooth 2.1 connection between devices in Khan "was maintained on a continuous basis." In view of the foregoing, the Supplemental Gajendragad Declaration was necessary and proper, as these theories were previously undisclosed.

4. Petitioner, for the first time in its Reply, argues that "Authentication" is based on using only Secure Simple Pairing. In view of the foregoing, the Supplemental Gajendragad Declaration was necessary and proper, as these theories were previously undisclosed.

5. With respect to IPR2024-00769, the original Petition for Ground One relied on the combination of Singh '906 and Singh '129. Petitioner now offers a new theory about "inherency" in its Reply. As such, the Supplemental Gajendragad Declaration was necessary and proper, as these theories were previously undisclosed.

6. Petitioner, for the first time in its Reply, argues that "WAP Gateways" were used in the prior art. As such, the Supplemental Gajendragad Declaration was necessary and proper, as these theories were previously undisclosed.

Again, Petitioner's own disregard for 37 C.F.R. § § 42.23(b) gives rise to the extraordinary circumstances here, inasmuch as the Petitioner's Reply exceeds mere response to arguments. As noted, the Reply offers multiple new theories without affording any opportunity for rebuttal short of the supplemental Gajendragad Declaration. To the extent Petitioner complains of the lack of any deposition of Mr. Gajendragad, such examination would have been wholly insufficient as a means of rebuttal, especially given the shifting theories of the Petitioner. Only the submission of counter-evidence in the form of the Gajendragad Declaration can accomplish rebuttal of these newly-crafted positions and theories of the Petitioner.

Patent Owner further points out that due process demands an opportunity to fully respond to arguments against validity, and all such grounds should be properly limited to those set forth in the Petition. As in *Hunting Titan v.*

Dynaenergetics Eurpoe, IPR2018-00600 (Paper 67 at 15), due process requires notice of all purported grounds of invalidity, and must be afforded an opportunity to respond. Here, in light of Petitioner's advancement of new theories, Patent Owner must be allowed to offer its rebuttal evidence.

Still further, and to the extent Petitioner complains of a lack of any opportunity to respond to the statements in the Gajendragad Declaration, Patent Owner responds by noting that Petitioner did not request a follow-up deposition and, in any event, the first deposition taken by Petitioner of Mr. Gajendragad was not directed to the technical merits of any argument at all, despite a full and fair opportunity for Petitioner to inquire as to those topics. Nonetheless, Patent Owner would gladly make Mr. Gajendragad available at any time upon request from Petitioner.

Finally, Petitioner misses the point, which is that it is Patent Owner who is being prejudiced by the inability to respond to the *new arguments* made by Petitioner in its Reply. To the extent new matter is introduced by Mr. Gajendragad, such is the product of the new matter offered first by Petitioner. If, on the other hand, Petitioner is correct in stating that there is nothing new in its Reply (which is plainly false), then its assertions of prejudice necessarily fail because all topics should have been explored with Mr. Gajendragad in the first instance.

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Date: May 29, 2025

Respectfully submitted,

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Counsel for Patent Owner

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on May 29, 2025, a copy of the foregoing document was served by electronic mail on the following:

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