UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK INC.
Petitioner,

v.

CELLSPIN SOFT, INC.,
Patent Owner

IPR2024-00769
Patent 9,900,766

[CORRECTED] PETITIONER'S MOTION TO STRIKE PATENT OWNER'S SUR-REPLY EVIDENCE

As authorized by the Board's email of May 9, 2025, Petitioner TikTok Inc. submits this Motion to Strike Exhibits 2030-2034 filed with Patent Owner's Sur-reply based on 37 C.F.R. § 42.23(b).

I. STATEMENT OF RELEVANT FACTS

On Friday, May 2, 2025, Patent Owner filed its Sur-reply accompanied by new exhibits, namely (1) a Second Declaration of Pavan M. Gajendragad (Exhibit 2030) that, *inter alia*, purports to rebut the arguments offered by Petitioner's Reply and Mr. David Lett's Supplemental Declaration[1] and (2) four other new documents (Exhibits 2031-2034). The Sur-reply was not accompanied by a deposition transcript because Patent Owner chose not to depose Mr. Lett regarding his Supplemental Declaration.

On the next business day (Monday, May 5, 2025), counsel for Petitioner emailed counsel for Patent Owner notifying Patent Owner of Rule 42.23(b) expressly barring the introduction of "new evidence other than deposition transcripts of the cross-examination of any reply witness" with the sur-reply and

[1] The Second Declaration of Pavan M. Gajendragad repeatedly and mistakenly refers to Dr. Patrick Traynor, but Petitioner's expert is Mr. David Lett.

requesting Patent Owner withdraw new Exhibits 2030-2034. Counsel for Patent Owner refused.

In an effort to meet and confer in good faith and to avoid unnecessary motions, counsel for Petitioner again emailed counsel for Patent Owner on Thursday, May 8, 2025, requesting Patent Owner withdraw new Exhibits 2030-2034. Counsel for Patent Owner again refused, stating in a responsive email the following day that "the existing record was insufficient for Patent Owner to fully rebut" arguments in Petitioner's Reply.

On Friday, May 9, 2025, counsel for Petitioner emailed the Board seeking authorization to file a Motion to Strike, which the Board authorized Petitioner to file by May 19, 2025, but stated that "prior to filing these motions, the parties are encouraged to again meet and confer in good faith to attempt to resolve this issue by withdrawing any new exhibits that may run contrary" to Rule 42.23(b). In a third attempt to meet and confer in good faith to attempt to resolve the issue, Petitioner indicated to Patent Owner by email that Petitioner was willing to forgo filing a Motion to Strike if Patent Owner withdraws new Exhibits 2030-2034 and removes the citations in the Sur-reply to Exhibits 2030-2034. Patent Owner has not responded to Petitioner's request.

II. THE BOARD SHOULD STRIKE NEW EXHIBITS 2030-2034 FILED WITH PATENT OWNER'S SUR-REPLY

A. New Exhibits 2030-2034 Violate 37 C.F.R. § 42.23(b)

New Exhibit 2030 is a "declaration" of Mr. Gajendragad, and new Exhibits 2031-2034 are not deposition transcripts. Such new evidence violates 37 C.F.R. § 42.23(b), which expressly bars the introduction of "new evidence other than deposition transcripts of the cross-examination of any reply witness" with the Sur-reply. *See* Consolidated Trial Practice Guide ("CTPG"), 73-75 (Nov. 20, 2019); *Casper Sleep Inc. v. Werner Media Partners, LLC*, IPR2024-00474, Paper 48 (PTAB Jan. 13, 2025) (granting motion to strike sur-reply evidence that was not deposition transcripts from the proceeding); *Semiconductor Components Indus., LLC v. Greenthread LLC*, IPR2023-01242, Paper 80 (PTAB Nov. 8, 2024) (same); *Ford Motor Co. v. Safe Driving Tech. LLC*, IPR2021-01446, Paper 28 at 82–83 (PTAB Mar. 10, 2023) (new sur-reply evidence not permitted)); *Satco Prods., Inc. v. Seoul Semiconductor Co., Ltd.*, IPR2020-00836, Paper 45 at 75-77 (PTAB Oct. 22, 2021) (granting motion to strike and excluding improper sur-reply "rebuttal" evidence); *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01278, Paper 37, 31-33 (PTAB Jan. 19, 2021) (striking supplemental declaration filed with patent owner's sur-reply); *Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper 66 at 3-5 (PTAB April 20, 2020) (striking patent file

histories and non-patent literature filed with patent owner's sur-reply). Accordingly, "Rule 42.23(b) provides a blanket prohibition on a patentee filing exhibits with a Sur-reply, as Patent Owner has done here." *Netflix, Inc. v. DivX, LLC*, IPR2020-00558, Paper 50 at 33-34 (PTAB Aug. 23, 2021). This is a bright-line rule that limits Patent Owner to submitting only "deposition transcripts of the cross-examination of any reply witness" with its Sur-reply.

Patent Owner cannot credibly argue that the new Exhibits 2030-2034 are properly submitted to respond to alleged new theories improperly raised by Petitioner's Reply. Even if Petitioner's Reply improperly raised new theories (which it does not), Patent Owner should have requested authorization to file a motion to strike the alleged improper theories. To submit new evidence not expressly authorized by the Rules, a Patent Owner must ask the Board to waive application of Rule 42.23(b) *before* filing said evidence. *See ParkerVision, Inc. v. Vidal*, 88 F.4th 969, 981 (Fed. Cir. 2023) (criticizing the patent owner for its failure to contact the Board and request authorization for an exception to the Rules); *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023) (criticizing the patent owner for its failure to seek leave to submit an expert declaration in its sur-reply); *Casper Sleep Inc. v. Werner Media Partners, LLC*, IPR2024-00474, Paper 48, 7 (PTAB Jan. 13, 2025) (finding a patent owner's

similar arguments unpersuasive in a similar circumstance); *Clearone* at 3-4 (same). Patent Owner, however, sought no such pre-authorization.

There is no basis here to depart from the bright-line Rule barring the filing of the evidence in question, and moreover, Patent Owner failed to request leave to file a motion for an exception to § 42.23(b). Accordingly, new Exhibits 2030-2034 are improperly filed "new evidence" that the Board should strike from the record.

B. Striking New Exhibits 2030-2034 and Citations in the Sur-reply to New Exhibits 2030-2034 is the Appropriate Remedy

The Board routinely strikes such improper new evidence. *See, e.g., Satco* at 75-77 (striking improper sur-reply "rebuttal" evidence); *Lenovo* at 31-33 (striking a supplemental declaration filed with patent owner's sur-reply because it constituted new evidence other than deposition transcripts of the cross-examination of any reply witness); *Clearone* at 3-5 (PTAB April 20, 2020) (striking patent file histories and non-patent literature filed with patent owner's sur-reply because it constituted new evidence other than deposition transcripts of the cross-examination of any reply witness). Here also, the Board should strike the improperly filed new Exhibits 2030-2034. Petitioner would be extremely prejudiced and its due process rights will be violated if new Exhibits 2030-2034 were not struck, because Petitioner cannot depose Mr. Gajendragad and cannot respond to Mr.

Gajendragad's "declaration" and Exhibits 2031-2034 on the merits. Petitioner has no opportunity to address this new evidence prior to the oral argument.

Indeed, striking new Exhibits 2030-2034 is especially appropriate because Patent Owner could have submitted a deposition transcript of Mr. Lett with the Sur-reply had Patent Owner chosen to depose him. *See Clearone* at 3-4. To be clear, Patent Owner has had an opportunity to respond to all aspects of Petitioner's Reply by filing a Sur-reply. Patent Owner had the opportunity to cross-examine Mr. Lett but chose not to do so. Patent Owner cannot claim a genuine need to submit new, unauthorized, non-cross-examination evidence when it has not availed itself of the opportunities available to it to obtain and file cross-examination evidence.

Further, the Board should strike citations in the Sur-reply to new Exhibits 2030-2034 and order Patent Owner to re-file its Sur-reply without citations to the improper exhibits. *See, e.g., Samsung Electronics America, Inc. v. Kannuu Pty Ltd*., IPR2020-00738, Paper No. 100, 9-16 (September 21, 2021) (striking Petitioner's improper exhibits and arguments relying on those exhibits); *Clearone* at 5 (striking Patent Owner's improper exhibits and ordering refiling of a sur-reply with citations to the offending exhibits removed). Patent Owner should not be able to cite unauthorized new evidence in the Sur-reply.

III. CONCLUSION

For at least the reasons set forth, the Board should strike new Exhibits 2030-2034.

Respectfully submitted,

Date: May 27, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on May 27, 2025, a complete and entire copy of this Petitioner's Motion to Strike was provided by email to Patent Owner by serving the email correspondence addresses of record as follows:

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