Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVATION MEDICAL, INC.,

Petitioner,

v.

EMKINETICS, INC.,

Patent Owner

Review No. IPR2024-01375
U.S. Patent No. 11,224,742

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

Pursuant to 37 C.F.R. §§ 42.64, 42.123, and the Board's Scheduling Order (Paper 8 at 11-12), Patent Owner EMKinetics, Inc. ("Patent Owner") submits this Reply (Paper 22) to Petitioner's Opposition (Paper 21) to Patent Owner's Motion to Exclude (Paper 20) Exhibits 1091-1095, 1099-1100 (the "Reply Exhibits") and arguments based thereon. Patent Owner respectfully requests that the Board reject Petitioner's attempts to shift the blame for its failure to provide the Reply Exhibits earlier.

In Opposition (Paper 21), Petitioner asserts that 37 C.F.R. § 42.23(b) authorized the submission of the Reply Exhibits with its Reply (Paper 15). However, this rule provides that a reply may only respond to certain prior arguments. Specifically, it provides that "[a] reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution." 37 C.F.R. § 42.23(b). The rule further provides that a *sur-reply* "may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." *Id.* However, the rule does *not* provide that any evidence may be submitted with a reply. *Id.* It does not authorize a petitioner to file new evidence that should have been included with the petition. *See id.*

The Consolidated Trial Practice Guide[1] ("CTPG") is consistent with these observations concerning 37 C.F.R. § 42.23(b). The CTPG explains that this rule, cited by Petitioner, circumscribes which subject matter is proper in reply and which subject matter is not. CTPG at 73. Specifically, pursuant to 37 C.F.R. § 42.23(b), a reply may not "proceed in a new direction with a new approach as compared to the positions taken in a prior filing." CTPG at 74.

But what happened here is that Petitioner tried to submit evidence in Reply (Paper 15) that it should have included with its case-in-chief, *i.e.*, the Petition (Paper 2). On this topic, the CTPG flatly states, "Petitioner may not submit new evidence or argument in reply that it could have presented earlier." CTPG at 73. While the CTPG notes that "[a] party also may submit rebuttal evidence in support of its reply," it states that, in so doing, the opposing party may, among other things, move to exclude such evidence, as Patent Owner seeks here. *Id*. While Patent Owner does not specifically contend that Petitioner raised an entirely "new issue" in Reply, the CTPG notes that "[e]xamples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of [a] … claim" (*id.* at 74), which would include a *prima facie* case that a reference was publicly accessible.[2]

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[1] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated

[2] Petitioner cites *Hulu, LLC v. Sound View Innovations, LLC,* IPR2018-01039, Paper 29 at 14-15 (PTAB December 20, 2019) for the proposition that, "if a patent

With reference to Petitioner's final argument that the Motion to Exclude was procedurally improper, Petitioner notably fails to identify any "missed deadline" or other procedural mechanism by which Patent Owner should have earlier filed a motion to exclude evidence. The Board's Scheduling Order (Paper 8 at 11-12) authorized and called for all motions to exclude by November 25, 2025. Patent Owner's November 5, 2025, Motion to Exclude (Paper 20) was both timely and authorized, and thus procedurally proper.

As noted in the Motion to Exclude (Paper 20 at 2), Patent Owner timely objected to the Reply Exhibits on October 3, 2025. (Paper 16). Pursuant to 37 C.F.R. § 42.64(c), Patent Owner's Motion to Exclude (Paper 20) "identif[ied] the objections in the record" to the Reply Exhibits and thus satisfied 37 C.F.R. § 42.64(c), contrary to Petitioner's arguments. (Paper 21 at 5). Patent Owner's Motion to Exclude is directed only to the Reply Exhibits, and 37 C.F.R. § 42.64(c) does not require Patent Owner to have made any further objections. For the same reason, Petitioner's attempt to distinguish *Toshiba* fails. (Paper 21 at 7).

As discussed above, Patent Owner does *not* contend that Petitioner's Reply (Paper 15) exceeded the scope of a proper reply within the meaning of 37 C.F.R.

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owner challenges a reference's status as a printed publication, the petitioner may submit additional evidence with its reply to support the reference's prior art status." (Paper 21 at 3). While *Hulu* may be precedential, this statement in *Hulu* is, at a minimum, *dicta* and not controlling here.

§ 42.23(b). Thus, the instruction in the CTPG, cited by Petitioner (Paper 21 (citing CTPG at 79)), that motions to exclude should not address the scope of reply is inapposite. This is not such a motion. The reality is that Petitioner submitted untimely and unauthorized evidence that should have and could have been submitted with the Petition to support its case-in-chief. It is for this reason, *see, e.g.*, 37 C.F.R. § 42.123(b), that the exhibits and arguments identified in Patent Owner's Motion (Paper 20 at 9-10) should be excluded. Petitioner's Opposition (Paper 21) does nothing to disturb this conclusion.

Respectfully submitted,

Date: December 9, 2025

/David Gerasimow/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on December 9, 2025, a complete and entire copy of this Patent Owner's Reply to Petitioner's Opposition to Motion to Exclude Evidence was provided via email to the Petitioner by serving the email correspondence addresses of record as follows:

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