

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVATION MEDICAL, INC.,

Petitioner,

v.

EMKINETICS, INC.,

Patent Owner.

IPR2024-01375
Patent 11,224,742 B2
IPR2024-01378
Patent 9,002,477 B2¹

Before JOHN G. NEW, BARRY L. GROSSMAN, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

NEW, *Administrative Patent Judge*.

JOINT DECISION
Denying Patent Owner's Motions to Exclude Evidence
37 C.F.R. § 42.71(a)

¹ This Order applies to each of the above-listed proceedings. The cases have not been joined. We exercise our discretion to issue one Order to be filed in each proceeding. Unless otherwise authorized, the parties shall not use this heading style in any subsequent papers.

I. INTRODUCTION

We instituted *inter partes* review of challenged claims 1–13 of US Patent 11,224,742 B2 (IPR2024-01375, the “-01375 IPR”) and challenged claims 1–20 of US Patent 9,002,477 B2 (IPR2024-01378, the “-01378 IPR”) on March 18, 2025 (“Institution Decision” or “Dec. Inst.,” Paper 7 in both IPRs).

Patent Owner timely filed a Motion to Exclude Evidence in both the -01375 IPR and the -01378 IPR (“Mot. Exclude” Paper 20 in both IPRs). Petitioner subsequently filed Oppositions to Patent Owner’s Motion to Exclude (“Opp.” Paper 21 in both IPRs), and Patent Owner filed Replies to Petitioner’s Opposition to the Motion to Exclude (“Reply” Paper 22 in both IPRs).

In its Motions, Patent Owner seeks to exclude Exhibits 1091–1095 in both the -01375 IPR and the -01378 IPR, and Exhibits 1099 and 1100 in the -01375 IPR. Exhibits 1091–1095 are identical in each of the two *inter partes* reviews, and Exhibits 1099 and 1100 were not filed in the -01378 IPR. Moreover, because the parties’ arguments are essentially identical in each *inter partes* review, we address the Motions to Exclude Evidence from both IPRs together in this single decision.

For the reasons set forth below, Patent Owner’s Motions to Exclude are *denied*.

II. ANALYSIS

A. Legal Standard

A petitioner may file a reply brief to respond to issues raised in a patent owner’s response and in the institution decision. 37 C.F.R. § 42.23; *Consolidated Trial Practice Guide* (“CTPG”) at 7. A party may submit rebuttal evidence in support of a reply, but may not submit new evidence with or argument in reply that

it could have presented earlier, e.g. to make out a *prima facie* case of unpatentability. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015); CTPG at 73–75. For example, “gap-filling” for facts necessary to establish a *prima facie* case for unpatentability using new evidence is discountenanced. *See Genzyme Therapeutic Prods. Ltd. v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1365–69 (Fed. Cir. 2016).

As expressed in our CTPG :

A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact. A motion to exclude is not a vehicle for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents. *Nor should a motion to exclude address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply.*

CTPG at 79 (emphasis added).

Furthermore, “[i]f a party believes that a brief filed by the opposing party raises new issues, is accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply, it may request authorization to file a motion to strike.” *Id.* at 80. “In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply.” *Id.*

“The moving party has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c).

B. The contested Exhibits

All of the contested Exhibits are reprints or copies of articles from peer-reviewed professional journals. They are:

- Ex 1091: H. Sherif et al., *Posterior Tibial Nerve Stimulation as Treatment for the Overactive Bladder*, 11 ARAB J. UROLOGY 131–35 (2013).
- Ex 1092: M. Slovak et al., *Non-invasive Transcutaneous Electrical Stimulation in the treatment of Overactive Bladder*, 2 ASIAN J. UROLOGY 92–101 (2015).
- Ex 1093: M.B.S. Garcia et al., *Electrostimulation of the Posterior Tibial Nerve in Individuals with Overactive Bladder: A Literature Review*, 30 J. PHYS. THER. SCI. 1333–40 (2018).
- Ex 1094: G. Amarenco et al., *Urodynamic Effect of Acute Transcutaneous Posterior Tibial Nerve Stimulation in Overactive Bladder*, 169 J. UROLOGY 2210–15 (2003).²
- Ex 1095: Z.-f. Guo, *Transcutaneous Electrical Nerve Stimulation in The Treatment of Patients with Poststroke Urinary Incontinence*, 2014(9) CLINICAL INTERVEN. IN AGING 851–56 (2014).

And, additionally, in the -01375 IPR:

- Ex 1099: H. H. Krämer et al., *Follow-up of Advanced Diabetic Neuropathy: Useful Variables and Possible Pitfalls*, 252 J. NEUROL. 315–20 (2015).
- Ex 1100: K.M. Galloway, et al., *Clinical Utility of Tibial Motor and Sensory Nerve Conduction Studies with Motor Recording from the Flexor Hallucis Brevis: A Methodological and Reliability Study*, 4(14) J. FOOT ANKLE RES. 1–9 (2011).

² Exhibit 1094 is the same article as Petitioner’s Exhibit 1005 (Amarenco), but with the journal cover, front matter, and table of contents appended. See Ex 1094, 1–8.

C. Patent Owner's arguments

Patent Owner moves to exclude Petitioner's Exhibits 1091–1095 in both the -01375 add -01378 IPRs and, additionally, Exhibits, 1099 and 1100 in the -01375 IPR (the “contested Exhibits”). Mot. Exclude 2.³ Patent Owner argues that Petitioner submitted the contested Exhibits in support of its Reply Brief (“Reply Br.”) without Board authorization, as “additional evidence responsive to [Patent Owner's] arguments that corroborates [Petitioner's] record evidence.” *Id.* (quoting Reply Br. 14). Patent Owner acknowledges that the “Rules allow for the belated submission of supplemental evidence to corroborate evidence submitted with a petition,” but “only in certain circumstances and only after certain processes are followed.” *Id.* Patent Owner contends that neither the circumstances or the requisite processes were present when Petitioner filed the contested Exhibits, and that they are consequently inadmissible. *Id.*

Patent Owner contends that the contested Exhibits constitute “late” supplemental information, as defined by 37 C.F.R. § 42.123(b). Mot. Exclude 3. Patent Owner argues that, according to § 42.123(b), any exhibit submitted 30 days after institution of trial is considered “late” and, therefore, Exhibits 1091–1095, and 1099 and 1100 are late under the Rule. *Id.* (citing 37 C.F.R. § 42.123(b)).

Patent Owner acknowledges that § 42.123 sets forth procedures by which supplemental information, including late supplemental information, may be submitted. However, Patent Owner asserts that Petitioner did not follow these procedures when submitting the contested Exhibits. Mot. Exclude 3 (citing 37

³ Because the arguments in Patent Owner's Motions to Exclude in both *inter partes* reviews are essentially identical, with the sole exception noted in this sentence, we cite herein to the page numbers of the Motion to Exclude in the -01375 IPR.

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C.F.R. § 42.123(b), (c)). Patent Owner points out, by way of example, that Petitioner did not request authorization from the Board to file a motion to submit the contested Exhibits, nor did it file such a motion. *Id.*

Furthermore, argues Patent Owner, Petitioner did not show, even in its Reply Brief, that its late submission of the Exhibits satisfied the standard set forth in § 42.123(b). Patent Owner asserts that there is no Rule allowing Petitioner to do so now in its Opposition to Patent Owner's Motion to Exclude and that any attempt to do so would be improper. Mot. Exclude 3 (citing 37 C.F.R. § 42.20(c)).

Patent Owner points to the Board's final written decision in *Toshiba Corporation v. Optical Devices*, IPR2014–01446, Paper 31 (PTAB March 9, 2016). In that decision, the Board concluded that:

[O]ur Rules expressly provide procedures for introducing supplemental evidence or supplemental information.... See 37 C.F.R. §§ 42.64(b)(2) (supplemental evidence), 42.123(a)—(c) (supplemental information). Petitioner was aware of Patent Owner's challenge to the public accessibility ... by ... the filing date of the Preliminary Response ... and certainly by no later than ... the service date ... noting objections.... Although Petitioner was aware early on of the possible need for such supplemental evidence or information in this proceeding, Petitioner made no apparent effort to take advantage of available procedures.... Petitioner has not provided any other persuasive explanation for the undue delay in submitting [the] Exhibits ..., other than that it believed it simply could wait until it filed its final substantive paper.... Accordingly, we *grant* Patent Owner's Motion to Exclude.

Mot. Exclude 5 (quoting *Toshiba*, Paper 31, 32–33. Patent Owner argues that we should now reach the same conclusion with respect to Petitioner's contested Exhibits.

D. Petitioner's Opposition

Petitioner argues that the challenged contested Exhibits constitute proper, timely rebuttal evidence, and that, as such, it is expressly permitted by the Board's rules and procedures. Opp. 2. Petitioner points to our CTPG, which states that a party "may submit rebuttal evidence in support of its reply." *Id.* (quoting CTPG at 73). Similarly, argues Petitioner, 37 C.F.R. § 42.23(b) indicates that a reply may be accompanied by new evidence. Opp. 2 (citing 37 C.F.R. § 42.23(b)).

Petitioner notes that it filed the contested Exhibits with its Reply Brief on September 26, 2025, and explained that the exhibits are "additional evidence responsive to [Patent Owner's] arguments that corroborates [Petitioner's] record evidence." Opp. 3 (emphasis omitted) (alterations in original) (quoting Paper 15, 14). Petitioner contends that its contested Exhibits are therefore permissible rebuttal evidence, timely filed, as expressly permitted by the Board's Rules. *Id.*

In support of its argument, Petitioner points to our precedential decision in *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (PTAB December 20, 2019) (precedential). Opp. 3. In *Hulu*, the Board explained that if a patent owner challenges a reference's status as a printed publication, a petitioner may submit additional evidence with its Reply to support the reference's prior art status:

[S]ome limited opportunities exist for the petitioner to present new evidence later, including: (1) in a reply to a patent owner preliminary response; (2) in a reply to the patent owner response; and (3) in a motion to file supplemental information. 37 C.F.R. §§ 42.108(c) 42.23, 42.123. As to the first two opportunities, the evidence must be responsive to the prior briefing....

For example, if the patent owner challenges a reference's status as a printed publication, a petitioner may submit a supporting declaration with its reply to further support its argument that a reference qualifies as a printed publication. See 37 C.F.R. §§ 42.2 (affidavit), 42.23.

Id. (quoting *Hulu*, Paper 29, 14–15).

Petitioner argues that the facts of *Hulu* parallel those of the present *inter partes* reviews. Opp. 3. Petitioner notes that Patent Owner argued in its Response that Petitioner did not sufficiently show that various non-patent references cited in the Petition qualify as printed publications. *Id.* (citing PO Resp. 4–8). Petitioner states that, in direct response to Patent Owner's argument, Petitioner filed the contested Exhibits with its Reply Brief to further support the printed publication status of the references challenged by Patent Owner. *Id.* at 3–4 (citing Reply Br. 14–16). Petitioner asserts that its contested Exhibits are thus permissible rebuttal evidence under both the Board's Rules and *Hulu*. *Id.* at 4 (citing *Hulu*, Paper 66 at 26, 32–33).

Petitioner argues that Patent Owner's motion bespeaks a misinterpretation of the Board's procedural rules. Opp. 5. According to Petitioner the motion conflates Reply evidence, which is expressly permitted under the Rules and Board precedent, with supplemental information governed by § 42.123 and supplemental evidence under § 42.64(b)(2). *Id.* (citing Mot Exclude 2–5). Petitioner asserts these latter Rules, however, serve different purposes and operate at different stages of a PTAB proceeding, and that neither are applicable to the present Motion to Exclude. *Id.*

Petitioner argues that, first, the contested Exhibits are not supplemental evidence. Opp. 5. Petitioner asserts that, under 37 C.F.R. § 42.64(b), a party may

object to evidence submitted in the proceeding, and the party relying on the objected-to evidence may respond by serving supplemental evidence. *Id.*

However, argues Petitioner, Patent Owner did not file objections under § 42.64(b) to any of the evidence submitted by Petitioner with the Petition, and Petitioner did not file the Rebuttal Exhibits in response to objections. *Id.* Petitioner argues that its contested Exhibits are, therefore, not supplemental evidence. *Id.* Rather, Petitioner repeats, it submitted the contested Exhibits its Reply in response to arguments made in Patent Owner's Response. *Id.* (citing Pet. Reply 14–16). Consequently, Petitioner argues, § 42.64(b) is inapplicable in this instance. *Id.*

Petitioner next argues that the contested Exhibits are similarly not supplemental information. Opp. 6. Petitioner points to 37 C.F.R. § 42.123, under which parties may request authorization to file supplemental information following institution of trial. *Id.* According to Petitioner, supplemental information refers to information related to arguments on the merits that a party seeks to add after its initial papers and outside the normal briefing schedule. *Id.* Petitioner acknowledges that the Rules therefore require a party to request authorization and demonstrate why the information could not have been obtained earlier. *Id.* Petitioner explains that the Rules exist to regulate belated submissions intended to supplement a party's merits arguments, not rebuttal evidence that has been timely filed with an authorized brief, as were Petitioner's contested exhibits in the present cases. *Id.*

Petitioner repeats that it filed the contested Exhibits with its Reply Brief in direct response to arguments made by Patent Owner in its Response. Opp. 6. Petitioner argues that, because the Board's rules expressly allow submission of such rebuttal evidence, there was no need for Petitioner to request authorization

under § 42.123 to file the contested Exhibits with its Reply. *Id.* Petitioner contends that § 42.123 is thus inapplicable, and Patent Owner’s arguments are therefore inapposite. *Id.* (citing *Hulu*, Paper 66 at 24–26).

Petitioner also disputes Patent Owner’s reliance on *Toshiba* as inapposite. Opp. 7. According to Petitioner, the Board in *Toshiba* granted a motion to exclude two exhibits submitted with the petitioner’s Reply Brief. *Id.* (citing *Toshiba*, Paper 31 at 32–33). However, Petitioner notes, the Board found that the petitioner should have filed these exhibits earlier because “[p]etitioner was aware early on of the possible need for such supplemental evidence or information” by virtue of patent owner’s preliminary response and objections to evidence filed with the petition. *Id.* (citing *Toshiba*, Paper 31 at 33).

In the present instance, argues Petitioner, Patent Owner never filed any objection under § 42.64(b) to any of the evidence submitted by Petitioner with the Petition. Opp. 7. Consequently, Petitioner argues, it had no opportunity to file the contested Exhibits as supplemental evidence. *Id.* Furthermore, Petitioner asserts, although Patent Owner raised a printed publication argument for a single reference (Svihra, Ex 1004) in its Preliminary Response, the Board rejected Patent Owner’s argument for purposes of institution. *Id.* (citing Dec. Inst. 11–14; see Prelim. Resp. 3–7). Petitioner contends that, coupled with Patent Owner’s subsequent failure to file objections to any of Petitioner’s evidence (including the single reference mentioned in its Preliminary Response), Petitioner was not aware of any need to file supplemental information. *Id.* Petitioner argues that *Toshiba* is thus distinguishable from the present case. *Id.*

Most importantly, Petitioner contends, the *Toshiba* decision is nonprecedential, whereas the more recent *Hulu* decision is precedential and holds

that a petitioner may properly present new evidence of public accessibility on reply to respond to arguments raised in the patent owner response. Opp. 8 (citing *Toshiba*, IPR2014-01446, Paper 31 at 1; *Hulu*, IPR2018-01039, Paper 29 at 14–15; *id.* at Paper 66 at 26, 32–33). Petitioner also notes that Patent Owner has suffered no prejudice, because it had an opportunity to address this evidence in its sur-reply. *Id.* (citing PO Sur-Reply 3–14 (addressing Exhibits 1091–1095 and 1099–1100).

Finally Patent Owner argues that Patent Owner’s Motion to Exclude is procedurally improper, because the Board’s rules and practices make clear that a motion to exclude is not a vehicle for disputing the scope or propriety of Reply evidence. Opp. 8 (citing CTPG at 79 (stating that “a motion to exclude [should not] address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply.”))” Petitioner argues that Patent Owner’s Motion to Exclude seeks to improperly exclude Petitioner’s contested Exhibits and arguments as “untimely and unauthorized under 37 C.F.R. § 42.123(b).” *Id.* at 9 (citing Mot. Exclude 4–5).

E. Patent Owner’s Reply to Petitioner’s Opposition

Patent Owner disputes Petitioner’s assertion that 37 C.F.R. § 42.23(b) authorized the submission of the contested Exhibits with its Reply. Reply 2 (citing Opp. 15). To the contrary, argues Patent Owner, that rule provides that a Reply may only respond to certain prior arguments. *Id.* Patent Owner argues that the Rule specifically 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.” *Id.* (quoting 37 C.F.R. § 42.23(b)). Patent Owner notes that 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, Patent Owner notes, the Rule does not provide that any evidence may be submitted with a reply, nor does it authorize a petitioner to file new evidence that should have been included with the petition. *Id.* (citing 37 C.F.R. § 42.23(b)).

Patent Owner points to the Consolidated Trial Practice Guide, which, it argues is consistent with its argument concerning 37 C.F.R. § 42.23(b). Reply 3. The CTPG explains that Rule 42.23(b) circumscribes which subject matter is proper in reply and which subject matter is not. *Id.* (citing CTPG at 73). According to Patent Owner, and pursuant Rule § 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.” *Id.* (citing CTPG at 74).

In the present case, argues Patent Owner, Petitioner submitted evidence in its Reply that should have been included in the Petition. Reply 3. Patent Owner again points to the Consolidate Trial Practice Guide, which states that, “Petitioner may not submit new evidence or argument in reply that it could have presented earlier.” *Id.* (quoting CTP 73). Patent Owner acknowledges that the Guide notes that “[a] party also may submit rebuttal evidence in support of its reply,” but argues that it also states that, in so doing, the opposing party may, among other things, move to exclude such evidence. *Id.* (quoting CTPG at 73). And although Patent Owner does not specifically contend that Petitioner raised an entirely “new issue” in its Reply, the Guide also 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, which would include a

prima facie case that a reference was publicly accessible.” *Id.* (quoting CTPG at 74).

With reference to Petitioner’s final argument that the Motion to Exclude was procedurally improper, Patent Owner contends that Petitioner notably fails to identify any “missed deadline” or other procedural mechanism by which Patent Owner should have earlier filed its Motion to exclude evidence. Reply 4. Patent Owner points out that the Board’s Scheduling Order in this *inter partes* review authorized and called for all motions to exclude to be filed by November 25, 2025. Patent Owner’s Motion to Exclude was filed in November 5, 2026 and was therefore both timely and authorized, and thus procedurally proper.

F. Analysis

We first consider the relevant Federal Regulations (i.e., “the Rules”) which govern the procedures by which the Board conducts *inter partes* reviews, as well as the relevant portions of our Consolidated Trial Practice Guide, and any controlling prior precedential decisions of the Board and our reviewing courts. We then apply these, as appropriate, to the facts of the case and the parties’ arguments.

Rule 42.23 (b) states that:

A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution. A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.

37 C.F.R. § 42.23(b). We note that, although § 42.23(b) is silent with respect to whether additional evidence may be submitted in a petitioner’s reply, it is also not

expressly prohibited as is the case for the patent owner’s sur-reply (with a single, narrowly-circumscribed, exception).

Rule 42.123(a)(2) states, as Patent Owner points out:

Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:.... The supplemental information must be relevant to a claim for which the trial has been instituted.

37 C.F.R. § 42.123(a)(2). Patent Owner argues that, because no motion to file the contested Exhibits was ever authorized by the Board, or filed by Petitioner, the Exhibits are improper supplemental evidence, and should be excluded. *See above*, Section II.C, 5–6.

Our Consolidated Trial Practice Guide states that:

A petitioner may file a reply to a patent owner response, and a patent owner may file a reply to an opposition to a motion to amend. 37 C.F.R. § 42.23.... Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability. A party also may submit rebuttal evidence in support of its reply. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015).

CTPG 73. The CTPG continues:

It is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing, for example newly cited prior art references intended to “gap-fill” by teaching a claim element that was not present in the prior art presented with the petition. *See Genzyme Therapeutic Prods. Ltd. v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1365–69 (Fed. Cir. 2016) (*proper for Board to rely on prior art references submitted with petitioner’s reply to establish the state of the art at the time of the invention in response to patent owner arguments*).

Id. at 74–75 (emphasis added).

The issue argued in *Genzyme* was whether the Board’s reliance on evidence submitted by the petitioner subsequent to the Board’s institution decision provided sufficient notice and due process to satisfy the requirements of the Administrative Procedures Act (“APA”). *Genzyme*, 825 F.3d at 1365–66. Such is not the direct issue in the *inter partes* reviews presently before us. But we note that the *Genzyme* court expressly observed that “the introduction of new evidence in the course of the trial is to be expected in *inter partes* review trial proceedings and, as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible under the APA” *Id.* at 1366. The court continued: “The development of evidence in the course of the trial is in keeping with the oppositional nature of an *inter partes* review proceeding. ‘The parties present their evidence up front, the patent owner offers any amendments, and the PTO simply decides whether the challenger has met his burden of proving invalidity.’” *Id.* at 1367 (quoting S. Rep. No. 111–18, at 57 (2009) (views of Sens. Kyl, Feingold, and Coburn)).

However, the court continued, “the substance of [patent owner’s] argument is to challenge the propriety of the Board’s use, for any purpose, of a reference that was not part of the combinations set forth in the institution decisions.” 825 F.3d at 1368. And the court concluded, “[t]his court has made clear that the Board may consider a prior art reference to show the state of the art at the time of the invention, regardless of whether that reference was cited in the Board’s institution decision.” *Id.* at 1369.

We acknowledge that Patent Owner’s arguments are narrower and more technical than those addressed in *Genzyme*. Patent Owner contends that the contested Exhibits are improper, and should be excluded, because their submission

was not preceded by a Board-authorized motion by Petitioner to file supplemental information. Furthermore Patent Owner points out that Petitioner impermissibly filed the contested Exhibits with its Reply Brief. Nevertheless, *Genzyme* unequivocally establishes that reply rebuttal evidence, including that relating to the state of the prior art, is permissible.

Petitioner argues that it filed these Exhibits in direct response to an issue that was raised by Patent Owner in its Response Brief, *viz.*, that the exhibits upon which Petitioner's Grounds were based were not printed publications for the purposes of § 103, because they were not, in fact, publicly available. Petitioner argues that it sought to employ the contested Exhibits to show that the references from the prior art forming the basis of Petitioner's Grounds of unpatentability (the "principal references"⁴), as presented in its Petition, were indeed printed publications for the purposes of 35 U.S.C. § 103. Reply 15–16. Petitioner filed the contested Exhibits as a means of demonstrating that other prior art references recognized Petitioner's principal references by the fact that they were cited in detail in the contested Exhibits and were therefore, inferentially, publicly available. *Id.*

We will address the merits of Patent Owner's arguments that the references in question were not printed publications in our forthcoming Final Written Decisions in the two proceedings. For the purposes of Patent Owner's Motion to

⁴ The principal references in the -01375 IPR are Svihra (Ex.1004), Amarenco (Ex 1005), Mann (Ex.1084), and Ponsford (Ex.1085). The principal references in the -01378 IPR are Svihra (Ex.1004), Amarenco (Ex 1005), Mann (Ex.1084), DiLorenzo (Ex.1054), Gerber (Ex.1055) and Bourget (Ex.1056). See Inst. Dec. 01375 IPR 6; Inst. Dec. 01375 IPR 6–7.

Exclude the contested Exhibits, the issue before us is whether Petitioner required authorization by the Board to file a Motion to submit the Exhibits prior to submitting them with their Reply Brief.

We conclude that Petitioner did not require prior authorization from the Board, and a subsequent Motion, for the Exhibits to be filed. We find the Board's precedential decision in *Hulu* to be dispositive of Patent Owner's Motion to Exclude.

In *Hulu*, the Board held that “[w]hile the petitioner must submit evidence sufficient to meet the reasonable likelihood standard, some limited opportunities exist for the petitioner to present new evidence later, including: ... in a reply to the patent owner response.” *Hulu*, Paper 29, 14 (citing 37 C.F.R. §§ 42.2 (affidavit), 42.23). The Board additionally stated that “the evidence must be responsive to the prior briefing,” and explains, “For example, if the patent owner challenges a reference's status as a printed publication, a petitioner may submit a supporting declaration with its reply to further support its argument that a reference qualifies as a printed publication.” *Id.* at 15 (emphasis added).

The emphasized portion of the preceding passage frames precisely the issue presently before us. In its Response Briefs, Patent Owner contends that the principle references are not printed publications for the purposes of § 103 because, Patent Owner alleges, they were not publicly available. See PO Resp. Brs. 4–8 (-01375 IPR); 2–6 (-01378 IPR). Indeed, in the -01378 IPR, this argument constates Patent Owner's entire responsive case against the Petition.

In view of *Hulu*, we conclude that, because the contested Exhibits were submitted with Petitioner's Reply Brief in support of rebuttal arguments responsive to an argument raised by Patent Owner in its Response Brief, and not in an attempt

to bolster of “gap fill” its principal cases that the challenged claims are obvious, the filing of the contested Exhibits was permissible as rebuttal evidence to an argument raised by Patent Owner in its Response Briefs.

Finally, we find Patent Owner’s reliance on *Toshiba* to be not helpful to Patent Owner’s arguments. See Section II.C at 6, above. In the *Toshiba* decision, the Board granted the patent owner’s motion to exclude evidence that was submitted with its reply, because: (1) the petitioner in that case submitted the relevant challenged exhibits for the first time with its Reply Brief, without authorization; and (2) the petitioner’s challenged exhibits “were introduced for purposes of responding to Patent Owner’s arguments in its Response pursuant to 37 C.F.R. § 42.23.” *Toshiba*, Paper 31 at 32. The Board observed that “[p]etitioner was aware of [p]atent [o]wner’s challenge to the public accessibility of the [exhibit] by the filing date of the Preliminary Response and certainly by no later than the service date of the exhibit noting objections to Exhibits 1005 and 1012.” *Id.*

In *Toshiba*, the Board granted patent owner’s motion to exclude, holding that “[a]lthough Petitioner was aware early on of the possible need for such supplemental evidence or information in this proceeding, Petitioner made no apparent effort to take advantage of available procedures.” *Toshiba*, Paper 31 at 33 (citing, e.g., *Avocent Huntsville Corp. v. Cyber Switching Patents, LLC*, IPR2015-00690, Paper 28 at 5–7 (PTAB Oct. 2, 2015) (holding that “[s]upplemental evidence, served in response to an evidentiary objection, is offered solely to support admissibility of the originally filed evidence and to defeat a motion to exclude that evidence, and not to support any argument on the merits (i.e., regarding the patentability or unpatentability of a claim.”)).

We can distinguish *Toshiba* from the case presently before us. First, Petitioner's contested Exhibits were not submitted by Petitioner in response to evidentiary objections, or to defeat a motion to exclude. As such, they are not supplemental information under Rule 42.123, or supplemental evidence under Rule 42.64(b)(2). See *Avocent*, Paper 28 at 5–7. Rather, they are rebuttal evidence that Petitioner used to support its reply to an argument raised in Patent Owner's Response. Equally importantly, *Toshiba* was entered more than three years before *Hulu* and, unlike *Hulu*, is a nonprecedential Board decision. To the extent, then, that the decisions are in conflict (and we do not believe they are), *Hulu* necessarily supersedes *Toshiba*, and determines the outcome of Patent Owner's Motion to Exclude.

Patent Owner's Motion to Exclude is consequently denied.

III. CONCLUSION

For the reasons set forth above, Patent Owner's Motions to Exclude Exhibits 1091-1095 in both the -01375 and -01378 IPRs, and Exhibits 1099-1100 in the -01375 IPR, are *denied*.

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