

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 REQUEST FOR DIRECTOR REVIEW OF
FINAL WRITTEN DECISION**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	ISSUES PRESENTED.....	1
III.	BACKGROUND.....	2
IV.	ARGUMENT	3
A.	The FWD Erroneously Substituted Presumptions for Evidence of Public Accessibility.....	3
B.	“Knowledge of POSA” is Not an Evidentiary Placeholder.	6
C.	The Board Sanctioned “Trial by Ambush” by Admitting Case-in- Chief Evidence as Rebuttal.....	7
V.	CONCLUSION	8

PATENT OWNER’S TABLE OF EXHIBITS

Exhibit No.	Description
2001	<i>[Reserved]</i>
2002	<i>[Reserved]</i>
2003	Certified June 19, 2025, Transcript of June 5, 2025, Deposition of Dr. Brett Wingeier
2004	Patent Owner’s Demonstratives

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.75, Patent Owner EMKinetics, Inc. (“Patent Owner”) requests Director Review of the Final Written Decision (“FWD”) dated March 16, 2026 (Paper 28). This Request addresses a fundamental breakdown of the adversarial process: the Board invalidated a patent by curing a deficient Petition through its own extra-record research and the admission of late-stage rebuttal evidence that was, in fact, case-in-chief material.

Despite citing 25 non-patent references, the Petition lacked a single declaration or record establishing their public accessibility. When Patent Owner identified this failure of proof in its Response, the Board permitted Petitioner to fill the holes in its Reply with new exhibits.

If this FWD stands, it creates an “institution-first, evidence-later” roadmap that allows petitioners to bypass the notice requirements of 37 C.F.R. § 42.104(b) and shifts the burden of proof to patent owners to disprove the status of an otherwise unexplained morass of documents. To preserve the integrity of IPR proceedings, the Director should vacate the FWD.

II. ISSUES PRESENTED

1. Whether the Board misapplied the “printed publication” standard by instituting review and finding unpatentability where the Petition provided zero

independent evidence of public accessibility for all primary references and numerous secondary references.

2. Whether the Board’s admission of evidence first introduced in a Reply—to cure a deficient Petition—violates the notice requirements of 37 C.F.R. § 42.104(b).

3. Whether the Petitioner’s generic invocation of the “knowledge of POSA” can substitute for the requisite proof of public accessibility of numerous non-patent references cited in the Petition, including to supply claim elements indisputably not present in primary references.

III. BACKGROUND

The FWD found claims 1-13 unpatentable based on two grounds. To clarify, they were *not* the same two grounds cited in the Petition, which explicitly cited the “knowledge of POSA” as a basis for both grounds. (Paper 2 at 2-3). The FWD, by contrast, disregards the grounds articulated in the Petition and, without explanation, reformulates them not to include “knowledge of POSA,” even attributing these reformulated grounds to Petitioner. (Paper 28 at 4, 77).

With respect to the primary references, which are both non-patent references, the Board incorrectly concluded that each “bears sufficient indicia of publication to conclude it was a printed publication and publicly accessible.” (Paper 28 at 73). To clarify, the Petition identified *no* such indicia and made *no*

such claim. The Petition offered no library records and no testimony regarding the prior availability or indexing of the alleged journals said to contain the references in question.

Further, in denying Patent Owner's Motion to Exclude, the Board also admitted into evidence the materials that Petitioner submitted for the first time in its Reply. (Paper 26). The Board concluded that these materials constituted neither supplemental evidence nor supplemental information. (Paper 26 at 19). Had they been, there is no dispute that their submission would have been untimely and unauthorized. The Board concluded instead that these materials constituted "rebuttal" evidence and admitted them into the record. (*Id.*). The Board then relied on this improper rebuttal evidence in the FWD in concluding that these non-patent references had in fact been published. (Paper 28 at 74).

This Request follows.

IV. ARGUMENT

A. The FWD Erroneously Substituted Presumptions for Evidence of Public Accessibility.

In an IPR, the petitioner bears the burden of proving every proposition of unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). This includes proving that a non-patent reference qualifies as a "printed publication." Here, the Petition provided *zero* independent evidence of public accessibility for

over two dozen references (Exs. 1004-05, 1008-17, 1024, 1027-28, 1030, 1035, 1037-39, 1041-43, 1085, 1088), including both primary references.

The Board’s FWD improperly filled these evidentiary gaps through *sua sponte* research and unsupported administrative notice. For example:

- **Svihra (Ex. 1004):** The FWD acknowledges “no direct evidence” of accessibility exists yet concludes Svihra was published in a journal “established in 1921” based on facts outside the record. (Paper 28 at 74).
- **Amarenco (Ex. 1005):** The Board applied a “presumption” of publication based on a “well-known publisher,” despite no witness testimony or evidence establishing the publisher’s reputation. (Paper 28 at 74).
- **Hasan (Ex. 1030):** The Board relied on this document to supply missing claim elements without making *any* finding as to its availability. (Paper 28 at 25). In fact, Hasan is a webpage printed in 2023—years after the critical date. (Ex. 1030).¹

¹ The FWD erroneously asserts that “Patent Owner does not discuss these other items [such as Hasan] in detail.” (Paper 28 at 75 (citing Ex. 1030 as an example of “these other items” supposedly not discussed in detail)). This assertion is not true. In its Surreply, Patent Owner explicitly explained why Hasan (Ex. 1030) did not qualify as prior art. (Paper 17 at 7).

By conducting its own research and admitting late-stage evidence to save a deficient Petition, the Board violated due process and misapplied the *Hulu* standard, as threshold “indicia” sufficient for institution cannot substitute for the “preponderance of evidence” required for a final decision. *See Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (PTAB December 20, 2019) (precedential)); *see also Vidstream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065-66 (Fed. Cir. 2020).

To be clear, there is no record evidence supporting these assertions regarding public availability, and no witness ever claimed any familiarity with these supposedly “well-known” journals prior to these proceedings. The FWD does not include any rationale for taking administrative notice of such obscure “facts.”

Because the Board considered only some “hallmarks” for only some references, the analysis set forth in the FWD is incomplete. Neither the Board nor Petitioner ever identified any “well-established publishers” or any “hallmarks” for most of the alleged prior art on which the Petition relied. Petitioner simply identified a few items in a few exhibits but then generally asserted the remaining exhibits bear these hallmarks, too. (*See* Paper 15 at 8-10).

Yet, these other exhibits are missing some or all hallmarks said to be relevant. For example, Ex. 1015 is a single page document entitled “Abstract Reproduction Form B-1.” (Ex. 1015). It does not include any of the indicia said to

be relevant. (*Id.*). It appears to be a reproduction of a single page from an informally bound document and does not bear the name of any publisher, let alone the name of any well-known publisher. It does not bear any hallmarks of publication yet forms part of the basis of Petitioner’s challenges. (See Paper 2 at 6 (citing Ex. 1015))).

Further, Petitioner never identified any hallmarks for most of the documents said to have dates in “2006,” the same year as the critical date. (*Compare* Paper 2, Exhibit List, Exs. 1012, 1016, 1017, 1039, 1080 *with* Paper 15 at 8-11 (not referencing Exs. 1012, 1016, 1017, 1039, 1080)). This list includes secondary reference Boveja (Ex. 1080). In other words, even though the Board credited the mere face of all these exhibits, this would still not answer the question of whether these “2006” exhibits were publicly accessible before the earliest effective filing date for the challenged claims, also in 2006.

B. “Knowledge of POSA” is Not an Evidentiary Placeholder.

Here, Petitioner used “Knowledge of POSA” as a categorical umbrella to avoid its obligation to prove the prior art status of individual documents. While POSA knowledge can bridge gaps in an *obviousness* analysis, it cannot serve as a substitute for proving the *existence* or *accessibility* of the references themselves. The Board allowed Petitioner to amass 25 documents into a nebulous gloss of expert “knowledge,” even though the expert admitted no pre-litigation familiarity

with the materials. This effectively shifted the burden to Patent Owner to *disprove* the status of dozens of documents—a reversal of the statutory mandate under Section 316(e).

The burden to determine if these documents might have been published, to determine when they were published, to articulate how they qualify as prior art, individually or together, and to prove public accessibility never shifts to Patent Owner. When a petitioner chooses to rely on a score or more of documents as the basis for its challenges, it must carry its burden of proving each of those documents qualifies as prior art and cannot benefit from the holes in its own contentions in the gloss of “Knowledge of POSA” or by combining grounds or statutory categories of prior art in unstated manners. The burden never shifts to Patent Owner, and it was improper to require Patent Owner to come forth with evidence *negating* publication in the absence of publication evidence in the case-in-chief.

C. The Board Sanctioned “Trial by Ambush” by Admitting Case-in-Chief Evidence as Rebuttal.

A petition must be “complete” and identify all supporting evidence. 37 C.F.R. § 42.104(b). Here, Petitioner admitted its Petition lacked “corroborating” evidence of public accessibility (Paper 15 at 16). To cure this, it submitted new exhibits (Exs. 1091-95, 1099-1100) for the first time in its Reply.

The Board’s classification of this material as “rebuttal” is a matter of legal error. Rebuttal evidence must *explain or contradict* evidence offered by the

adverse party. Here, Patent Owner submitted no evidence in its Response; it merely pointed out Petitioner's failure to prove its case-in-chief. Providing the foundational evidence required for a *prima facie* case for the first time in a reply is not "rebuttal"—it is an untimely supplement.

Allowing this fill in the blanks strategy prejudiced Patent Owner's ability to cross-examine and develop a record. Under the Consolidated Trial Practice Guide ("CTPG"), a petitioner "may not submit new evidence ... that it could have presented earlier," especially when that evidence is "necessary to make out a *prima facie* case." CTPG at 73-74. Here, the record supports the conclusion that Petitioner could have presented this information in the Petition but simply elected not to. The FWD should be vacated to prevent incentivizing shell petitions like the one filed here.

V. CONCLUSION

The Board's decision creates a dangerous precedent that incentivizes incomplete petitions. By allowing a petitioner to request review on a bare-bones filing and then fill in the blanks with new evidence in its reply, the Board effectively truncated Patent Owner's statutory right to respond. This trial by ambush undermines the predictability and fairness of IPRs.

If allowed to stand, this FWD signals to future litigants that the burden of proving prior art status is merely a suggestion, and that the Board will use its own

research or late-stage “rebuttal” evidence to rescue a deficient case-in-chief. To preserve the integrity of the patent system and ensure compliance with 35 U.S.C. § 316(e) as well as 37 C.F.R. § 42.104(b), the Director should reaffirm that a petitioner must present its foundational evidence of public accessibility at the outset. Because the Petition here was legally and evidentially deficient on the day it was filed, the Director should vacate the FWD.

Respectfully submitted,

Date: April 15, 2026

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on April 15, 2026, a complete and entire copy of this Patent Owner's Request for Director Review was provided via email to the Petitioner by serving the email correspondence addresses of record as follows:

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