

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVATION MEDICAL, INC.,

Petitioner,

v.

EMKINETICS, INC.,

Patent Owner

Review No. IPR2024-01378

U.S. Patent No. 9,002,477

PATENT OWNER'S SURREPLY

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No exhibits are submitted by Patent Owner with this Surreply. Patent Owner did not submit any exhibits with its Preliminary Response (Paper 6) or Response (Paper 12).

I. Introduction

Pursuant to the Board's Scheduling Order (Paper 8 at 10 ¶ 3) and the Parties' Joint Stipulation to Modify Due Dates (Paper 9 at 1), Patent Owner EMKinetics, Inc. ("Patent Owner") submits this Surreply (Paper 17) to the Reply (Paper 15) filed by Petitioner Avation Medical, Inc. ("Petitioner"), setting forth reasons why Petitioner failed to establish the unpatentability of claims 1-10 (the "challenged claims") of U.S. Patent No. 9,002,477 (the "'477 Patent").

Patent Owner focused its Response (Paper 12) on Petitioner's failure to develop its case in chief in the time allotted. In Reply, Petitioner attempts to dismiss Patent Owner's focused Response as a mere "procedural attack." (Paper 15 at 1). The applicable rules are clear about the completeness of the petition and the promptness with which any supplementation of the petition must be pursued.

Here, Petitioner asks the Board to conclude that any document bearing a date blanketly constitutes a printed publication as of the date so printed. To clarify, not all documents at issue appear to be journal articles (*see, e.g.*, Ex. 1015), and there is still no record evidence speaking to printed publication issues beyond the documents themselves. Petitioner does not cite any case supporting the broad proposition that would be required here to conclude Petitioner has met its burden. To the contrary, the cases cited by Petitioner (Paper 15 at 4-5), on closer examination, required additional evidence, not present here.

An *inter partes* review may raise grounds “only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(a). Here, the Petition relies on dozens of documents said to be patents or printed publications. While some grounds are explicitly based on only several documents said to be printed publications, other grounds are explicitly based on “the knowledge of a person of ordinary skill in the art,” which is said to be informed by dozens of patents or printed publications. Petitioner asks the Board to forgive the many individual evidentiary failings with the alleged printed publications without clarifying which ones are necessary to its case and which ones, if any, might not be. The burden of proof always remains with Petitioner, and Section 311(a) clarifies that the challenge must be based on patents or printed publications, which is entirely consistent with requiring a petitioner who opts to rely on dozens of alleged printed publications to prove that they are all printed publications.

Patent Owner respectfully requests that the Board conclude that Petitioner has not carried its statutory burden of proving the unpatentability of the challenged claims based on any of the five (5) grounds in the Petition by a preponderance of the evidence. 35 U.S.C. § 316(e).

II. Grounds 1-5 Fail Because Petitioner Has Not Shown by a Preponderance of the Evidence that the References Supporting Them Qualify as Prior Art.

In *inter partes* reviews, “the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. § 316(e). By referring to “a proposition of unpatentability,” not just “unpatentability” generally, Section 316(e) clarifies that a petitioner is required to prove each proposition necessary to establish the unpatentability of the challenged claims by a preponderance of the evidence. Section 316(e) makes no exception for propositions related to whether and how a reference might qualify as prior art. It does not, by way of further example, require the patent owner to dispute, refute, or disprove any proposition for which the evidence fails to establish unpatentability.

Further, unlike Section 314(a), which sets forth the standard for institution and which refers to mere “information,” Section 316(e) requires the petitioner to present its case in the form of “evidence.” *Compare* 35 U.S.C. § 316(e) *with* 35 U.S.C. § 314(a). In other words, “information” that is sufficient for institution under § 314(a) may not necessarily constitute proper “evidence” sufficient for cancellation of the challenged patent under § 316(e).

In limited circumstances, the Rules permit the petitioner to supplement the record with additional evidence after the petition is filed. For example, within one month of institution, the petitioner may submit supplemental information so long

as it is relevant. 37 C.F.R. § 42.123. To submit supplemental information more than one month after institution, the petitioner must also “show why the supplemental information reasonably could not have been obtained earlier.” 37 C.F.R.

§ 42.123(b). In either case, the Board’s authorization is required, and in both cases, Board authorization does not depend on what patent owner did or did not do.

Applying these principles to this case, Petitioner has not established, by a preponderance of the evidence of record, the prior art status of numerous non-patent references or the prior art knowledge they are said to reflect. Petitioner’s belated attempts to supplement the record are insufficient and untimely.

The Petition relies on no fewer than 19 non-patent references (Exs. 1004-05, 1008-17, 1028, 1030, 1041-43, 1064-65) in asserting that the challenged claims are unpatentable. The Petition claims that these references (*e.g.*, Exs. 1004-05, 1030) disclose claimed subject matter. (*See, e.g.*, Paper 2 at 18). The Petition further claims that these references show what a person of ordinary skill in the art would have known at the time of invention. (*See generally* Paper 2 (repeatedly referring to the “knowledge of a POSA” and variations thereof in support of various propositions)). Indeed, the Petition explicitly cites the “Knowledge of POSA” as a basis for two of the four obviousness grounds (Grounds 2-5).¹ (Paper 2 at 3-4). The

¹ While the Petition asserts that one must always consider knowledge generally available to one of ordinary skill in the art (Paper 2 at 3 n.3), the Petition does not

Petition further asserts that these non-patent references inform all grounds. (*See* Paper 2 at 4-8, 17).

The fact that Petitioner is relying on numerous non-patent references under the umbrella of the “Knowledge of POSA” further distinguishes cases cited by Petitioner, in which non-patent references were considered individually and as printed publications, not evidence *en masse* of a skilled artisan’s knowledge, as in this case. Here, Petitioner avoids its statutory and evidentiary obligations to particularize its contentions and prove that all of these references qualify as prior art by, in many instances, amassing them into the “Knowledge of POSA” posited by an expert who claims no pre-litigation familiarity with any of these documents.

Petitioner’s Reply, with or without the supplemental information it seeks to add to these proceedings, does not show that it has carried its burden of proving the proposition of unpatentability that each of these 19 non-patent documents qualify as prior art by a preponderance of the evidence. In Response to the Petition, Patent Owner argued that the Petition provided no evidence of prior art status beyond copies of the references themselves, and that Petitioner failed to provide any timely supplemental evidence further tending to establish the public accessibility or other prior art status thereof. Petitioner therefore failed to carry its burden of proving that

clarify why such knowledge is an explicit basis for only some of the obviousness grounds in the Petition.

these 19 non-patent references qualify as prior art by a preponderance of the evidence. (Paper 12 at 2-7).

In Reply, Petitioner acknowledges that the Petition provided no competent evidence of prior art status beyond copies of the numerous non-patent references and, without such evidence, for the first time purports to identify certain “hallmarks” of publication supposedly present in exhibit copies. (Paper 15 at 4-11). To begin, Petitioner should have included this identification and information, to the extent it has any probative value, in the Petition pursuant to 37 C.F.R. § 42.104(b)(4), and it should be disregarded because it was not.

Even if the Board were to consider such hallmarks, where identified by Petitioner in Reply, Petitioner still has not identified any “hallmarks” for most of the alleged prior art on which the Petition relies. Petitioner identifies items in a few exhibits but then generally asserts the remaining exhibits bear these hallmarks, too. (*See* Paper 12 at 8-10). In other words, although Petitioner now relies on these items to prove public accessibility, instead of, for example, declarations by individuals having personal knowledge, Petitioner still has not identified many of these now necessary hallmarks in the record.

Notably, Petitioner did not identify in Reply any hallmarks for documents said to have dates in “2006,” the same year as the earliest effective filing date of

the challenged claims.² (*Compare* Paper 2, Exhibit List, Exs. 1012, 1017 *with* Paper 15 at 8-11 (not referencing Exs. 1012, 1017)). In other words, even if the Board were to credit just the face of these exhibits, it would still not answer the question of whether either of these exhibits were publicly accessible before the earliest effective filing date for the challenged claims, also in 2006. Petitioner’s bare assertion, in attorney argument, that these exhibits published before the earliest effective filing date has no evidentiary value.

In addition, even if the Board were to credit just the face of these exhibits, 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 by Petitioner 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 4 (citing Paper 2 § III.B (citing Ex. 1015))).

In other cases, Petitioner simply misstates the record. For instance, Ex. 1030 is a website that was printed to PDF in December 2023. (Ex. 1030). Yet, in Reply,

² Petitioner does not challenge the claimed priority date of the challenged claims in these proceedings. (*See* Petition, Paper 2 at 13).

Petitioner for the first time characterizes Ex. 1030 as an “article published ... in June 1996.” (Paper 15 at 10). This is particularly problematic for Petitioner because the Petition specifically relies on Ex. 1030 to inform the “Knowledge of POSA” and supply claim elements said to be missing in other references. (*See, e.g.*, Paper 2 at 18 (citing Ex. 1030)).

Svihra (Ex. 1004), by way of further example, does not include a copyright notice, does not bear the name of a well-known publisher, and does not on its face indicate publication at all. Absent a well-known publisher, consideration of hallmarks is inappropriate under the cases cited by Petitioner. (*See* Paper 15 at 4 (quoting *Vidstream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065-66 (Fed. Cir. 2020) (conditioning consideration of hallmarks “[w]hen there is an established publisher”). The lack of hallmarks in this case distinguishes the PTAB cases cited by Petitioner. (*See, e.g.*, Paper 15 at 5 (citing *Grünenthal GmbH v. Antecip Bioventures II LLC*, PGR2018-00092, Paper 31 at 16 (PTAB December 22, 2020) (the “Rheumatology” journal, a well-known published)); *Parse Biosciences, Inc. v. 10X Genomics, Inc.*, IPR2023-00958, Paper 48 at 19-20 (PTAB February 3, 2025) (noting the additional presence of a “[p]ublished” date in concluding a single reference had been published)).

Petitioner cites no case in which the record evidence of public accessibility, particularly as to as many as 19 non-patent references, is this scant and found to be

sufficient after trial. Petitioner's assertion that courts have "found articles published in scientific journals to be publicly accessible" (Paper 15 at 4) misses the mark. The question is whether Petitioner has proved by a preponderance of the evidence that the numerous non-patent references cited in the Petition were publicly accessible. Alternatively, the question is whether a court has ever found an article, or a set of articles, to have been published in a scientific journal based solely on a newly printed copy of the putative article(s) and no other evidence. Surely if such a case were available, it would have been cited by Petitioner.

In the leading case cited by Petitioner, *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341 (Fed. Cir. 2019), the Federal Circuit did not affirm a Board finding of public accessibility based solely on the date on the face of a journal article, contrary to Petitioner's suggestion (Paper 15 at 5) and as would be necessary in this case. Rather, the Federal Circuit very much credited the Board's consideration of a declaration of a "librarian" familiar with record-keeping processes during relevant timeframe "show[ing] that the journal issue dated Mai/Juni 1996 was catalogued and shelved with the shelf call number." *Ericsson*, 941 F.3d at 1347. In this case, there is no such librarian declaration or, for that matter, any declaration by someone with personal knowledge of either the documents or how they were kept.

Petitioner also cites to *Grünenthal GmbH v. Antecip Bioventures II LLC*, PGR2018-00092 (PTAB December 22, 2020). In *Grünenthal*, unlike the present case, the petitioner article at issue had numerous “hallmarks” of publication including: (1) the name of the journal; (2) citation information reflecting the date, (3) the volume number, (4) the pertinent page numbers of the journal; (5) the dates the article was available to the public; (6) a link to the website of the journal; (7) the publisher of the journal; (8) and where readers interested in learning more about the topic could inquire. *Grünenthal*, Paper 31 at 16-17. In support, the petitioner *also* submitted a declaration of an expert who swore to both having personal knowledge of the article’s availability, and evidence that he *contemporaneously posted to social media about the article* prior to the relevant date. *Id.* at 15-16.³

Petitioner further cites to *Parse Biosciences, Inc. v. 10X Genomics, Inc.*, IPR2023-00958 (PTAB February 3, 2025), which again does not support Petitioner’s argument. In *Parse Biosciences*, the relevant publication included “specific date information, not only of publishing, but also of when the journal received and accepted the article for publication and when it was copyrighted.” In

³ While the Board stated in footnoted *dicta* that it was also persuaded by the many “indicia of publication” on the face of the article itself, it made clear that it further considered the expert’s declaration and prior social media post in its determination that the publication was publicly available, not present here.

fact, the Board distinguished this amount of supporting indicia from another case cited by the patent owner, *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Paper 41 (PTAB Apr. 23, 2015), in which the “exhibits were ‘printouts of ... webpages’ bearing a copyright [year] indication . . . which the petitioner argued was proof of [a] subset of the webpages being disseminated publicly in 2003.” *Parse Biosciences*, Paper 48 at 20. However, even with that number of indicia included on the face of the putative publication, the Board saw it necessary to analyze multiple other pieces of corroborating evidence, including numerous articles, patents, and research papers published by the very inventors of the challenged patent. *Parse Biosciences*, Paper 48 at 21-22. Petitioner in the present case makes no mention of these distinguishing facts in its Reply (Paper 15).

As the very cases cited by Petitioner demonstrate, Petitioner’s suggestion that courts routinely invalidate patents on such scant evidence of public accessibility is untrue and, at a minimum, not supported by the cases identified by Petitioner. In this case, on Institution, the Board undertook research, not performed or provided by Petitioner, to ascertain whether Svihra might have published and by whom. (Paper 7 at 13). This should have suggested to Petitioner that, while there may have been sufficient information supporting institution, the record should be supplemented with evidence to prove these contentions, not just for Svihra but all

non-patent references. But as it stands, the evidence of record is insufficient to establish the non-patent references cited in the Petition as prior art.

In sum, and contrary to Petitioner's assertion (Paper 15 at 8, 10), all the references said to supply claimed subject matter and inform the "Knowledge of POSA" do not "include sufficient indicia of publication." 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 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.

In Petitioner's terms, the Petition contained no evidence "corroborating" public accessibility. In this regard, Petitioner does not dispute that the declarations submitted with the Petition, whether the attorney declaration (Ex. 1053) or expert declaration (Ex. 1003), do not provide any evidence concerning public accessibility *at the relevant time* from someone having personal knowledge. Petitioner dismisses its declarants' lack of personal knowledge by irrelevantly claiming that "personal knowledge that a reference was actually accessed is not necessary to provide public accessibility." (Paper 15 at 13). The proper question is

whether any competent evidence of public accessibility exists in the record. No such evidence is present or has been identified here. Unlike the above-mentioned cases, the record contains no declaration submitted by any librarian or research database custodian. The expert declaration (Ex. 1003) is not made from any personal knowledge of the references aside from recent litigation-inspired review of the same. Nor does the expert claim to be an expert in matters of publication.

Notably, Petitioner did not submit any timely supplemental evidence to bolster its case of public accessibility. In Reply, Petitioner does not explain why it failed to take advantage of opportunities to provide timely supplemental evidence, 37 C.F.R. § 42.64(b), or supplemental information, 37 C.F.R. § 42.123, provided for by Rule. In *Ericsson*, cited by Petitioner, the petitioner at least obtained the Board's authorization to file supplemental evidence out of turn, which in turn was based on a showing by the petitioner that the supplemental evidence could not have been obtained earlier. *Ericsson*, 941 F.3d at 1345. While the Federal Circuit found no abuse of discretion by the Board in allowing the supplemental evidence out of turn, it certainly did not endorse it.

Here, without filing a motion or otherwise seeking the Board's leave, Petitioner improperly "submits further evidence of public accessibility" with its Reply. (Paper 12 at 16-18). These new exhibits (Exs. 1087, 1091-95, 1098) and declaration (Ex. 1096) are filed out of turn and should be disregarded as untimely

along with arguments based thereon. In the *Parse Biosciences* matter, cited by Petitioner in Reply (Paper 15), the Board excluded supplemental evidence submitted in reply as the petitioner “clearly missed the deadline.” This evidence, if truly necessary “corroborating” evidence, should not be considered at this time.

Petitioner nonetheless seeks to bolster the case of public accessibility of multiple references in Reply, including the primary references (Svihra (Ex. 1004); Amarenco (Ex. 1005) forming the basis of Grounds 1-5). (Petition, Paper 2 at 3-4; Reply, Paper 15 at 16-18). And, given Petitioner’s further reliance on Hasan (Ex. 1030) to disclose claimed subject matter not shown in Svihra or Amarenco, Petitioner also attempts to supplement the record regarding that document’s specific prior art status at this late juncture. (Paper 2 at 18). Yet, there can be no better proof of Petitioner’s failure to carry its burden than its untimely attempt to fill the holes in Reply more than a year after the Petition was filed. The attorney argument concerning public accessibility provided in the Reply should be afforded little or no weight. *See, e.g.*, Paper 15 at 6 (asserting, unlike the Board, that “Bratisl Lek Listy” is a “well-established” journal).

For at least these reasons, Petitioner has failed to carry its statutory burden of proving the unpatentability of the claims challenged in Grounds 1-5.

III. Conclusion

Patent Owner focused its Response to the Petition on dispositive evidentiary deficiencies. The Rules do not require Patent Owner to address every other issue raised by the Petition, and Petitioner cites no such rule.

For at least the foregoing reasons, Patent Owner EMKinetics, Inc. respectfully requests that the Board issue a Final Written Decision determining that Petitioner Avation Medical, Inc. has not carried its burden of establishing the unpatentability of claims 1-10 of U.S. Patent No. 9,002,477.

Respectfully submitted,

Date: October 31, 2025

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S SURREPLY complies with the type-volume limitation in 37 C.F.R. § 42.24(c)(4). According to the word-processing system's word count, the brief contains 3,394 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on October 31, 2025, a complete and entire copy of this Patent Owner's Surreply was provided via email to the Petitioner by serving the email correspondence addresses of record as follows:

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