UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Avation Medical, Inc.,

Petitioner

v.

EMKinetics, Inc.,

Patent Owner

Case No. IPR2024-01378
U.S. Patent No. 9,002,477

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

I. INTRODUCTION

Patent Owner's Motion to Exclude (Paper 20) Exhibits 1091-1095 (the "Rebuttal Exhibits") is premised on a fundamental misinterpretation of the PTAB's rules and procedures. Those rules expressly allow a petitioner to submit rebuttal evidence in support of its reply. Petitioner did exactly that here—it filed the Rebuttal Exhibits with its Reply (Paper 15) to respond to arguments in Patent Owner's Response (Paper 12), within the time allowed under the schedule in this proceeding and in accordance with Board procedure. As such, Petitioner's Rebuttal Exhibits constitute proper rebuttal evidence under 37 C.F.R. § 42.23(b), the rules governing these proceedings, and Board precedent.

Patent Owner's motion ignores these rules regarding reply evidence entirely, contending instead the Rebuttal Exhibits are somehow untimely, unauthorized "supplemental information" under 37 C.F.R. § 42.123. But that rule is inapposite here—it relates to evidence a party seeks to submit after institution that "supplements" (*i.e.*, adds to) arguments on the merits. It does not govern timely rebuttal evidence submitted with a reply as part of the ordinary course of trial, as is the case here. Treating properly filed rebuttal evidence as supplemental information contradicts the Board's rules, disregards its established practice, and would effectively eliminate a party's ability to provide evidence on reply in response to arguments made during the course of the trial.

Petitioner's Rebuttal Exhibits are not improper supplemental information, but instead constitute timely, proper rebuttal evidence that is fully consistent with the Board's rules and practice. Accordingly, Patent Owner's motion should be denied in its entirety.

II. ARGUMENT[1]

A. Petitioner's Rebuttal Exhibits Are Proper Rebuttal Evidence

The challenged Rebuttal Exhibits constitute proper, timely rebuttal evidence that is expressly permitted by the Board's rules and procedures. The PTAB's Consolidated Trial Practice Guide ("CTPG") could not be clearer—a party "***may submit rebuttal evidence in support of its reply***." CTPG at 73 (emphasis added). Similarly, 37 C.F.R. § 42.23(b) indicates that a reply may be accompanied by new evidence, in contrast to a sur-reply, which may not. *See* 37 C.F.R. § 42.23(b) (replies "may only respond to arguments raised in the corresponding . . . patent owner response" while sur-replies "may only respond to arguments raised in the

[1] Patent Owner's motion seeks to exclude each of the Rebuttal Exhibits for the exact same reasons. *See, e.g.*, Paper 20 at 4-5 (addressing Exhibit 1091), 6 ("Patent Owner requests that the Board exclude Petitioner's Exhibit 1092 for the same reasons as Exhibit 1091"), 6-9 (same regarding Exhibits 1093-1095). Accordingly, Petitioner addresses the Rebuttal Exhibits together herein.

corresponding reply and may not be accompanied by new evidence"). Petitioner filed the Rebuttal Exhibits with its Reply on September 26, 2025, and explained that the exhibits are "additional evidence ***in response to the arguments in [Patent Owner's] Response*** that corroborates [Petitioner's] record evidence." *See* Paper 15 at 16 (emphasis added). The exhibits are thus quintessential rebuttal evidence, filed timely with Petitioner's Reply as explicitly permitted by the Board's rules.

Moreover, Board precedent expressly permits petitioners to file evidence on reply under the exact scenario presented here. In the precedential *Hulu* decision, the Precedential Opinion Panel ("POP") explained that if a patent 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:

> ***[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. . . .
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> ***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.

Hulu, LLC v. Sound View Innovations, LLC, IPR2018-01039, Paper 29 at 14-15 (PTAB December 20, 2019) (precedential) (emphasis added). That is exactly what happened in this case. Patent Owner argued in its Response that Petitioner did not

show various non-patent references cited in the Petition qualify as printed publications. *See* Paper 12 at 2-7. In direct response to Patent Owner's argument, Petitioner filed the Rebuttal Exhibits with its Reply to further support the printed publication status of the references challenged by Patent Owner. *See* Paper 15 at 16-18. This is the precise sequence of events contemplated and expressly allowed by *Hulu*. The Rebuttal Exhibits thus constitute permissible rebuttal evidence. *See also Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 66 at 26, 32-33 (PTAB October 5, 2021) (finding in final written decision that new evidence of public accessibility of reference submitted with petitioner's reply constituted proper rebuttal evidence and was permissible under PTAB rules).

In short, the Board's rules and precedent confirm that Petitioner's Rebuttal Exhibits are proper reply evidence submitted to respond to arguments raised in Patent Owner's Response.[2] Patent Owner's motion to exclude should therefore be denied in its entirety on this basis alone.

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[2] Notably, Patent Owner does not dispute that Petitioner's Exhibits 1091-1095 are responsive to the arguments raised in the Patent Owner Response—in fact, Patent Owner concedes as much in its motion. *See* Paper 20 at 2. Nor does Patent Owner's motion argue or suggest these exhibits are improper because Petitioner changed theories or included new theories in its Reply. Nor could it, as Petitioner

B. The Rebuttal Exhibits Are Not Supplemental Information or Supplemental Evidence

Patent Owner's motion hinges on a basic misinterpretation of the Board's procedural rules. 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). *See* Paper 20 at 2-5. Those rules, however, serve different purposes and operate at different stages of a PTAB proceeding. Neither are applicable here.

First, the challenged Rebuttal Exhibits are not supplemental evidence. 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. But ***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. Petitioner's Rebuttal Exhibits thus are not supplemental evidence. Instead, Petitioner submitted these exhibits on reply in response to arguments made in Patent Owner's Response. *See* Paper 15 at 16-18. Section 42.64(b) is thus inapplicable here.

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submitted these exhibits for the explicit, limited purpose of responding to Patent Owner's arguments. *See* Paper 15 at 16.

Second, the challenged exhibits are not supplemental information. According to 37 C.F.R. § 42.123, parties may request authorization to file supplemental information following institution of trial. 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. The rules require a party to request authorization and demonstrate why the information could not have been obtained earlier. The provisions exist to regulate belated submissions intended to supplement a party's merits arguments, ***not*** rebuttal evidence timely filed with an authorized brief as is the case with the challenged exhibits here.

As explained above, Petitioner filed the Rebuttal Exhibits in its Reply to directly respond to arguments made by Patent Owner in its Response. *See supra*, § II.A. Because the Board's rules expressly allow for this type of rebuttal evidence, there was no need for Petitioner to request authorization under § 42.123 to file the Rebuttal Exhibits with its Reply. Simply put, § 42.123 is inapplicable and Patent Owner's arguments on this front—*e.g.*, that the Rebuttal Exhibits are "late" supplemental information, that Petitioner did not request authorization to file a motion to submit these exhibits, that Petitioner did not show its submission of the exhibits satisfied Section 42.123(b)—miss the mark. *See Hulu*, IPR2018-01039, Paper 66 at 24-26 (rejecting patent owner's contentions that because petitioner did not submit supplemental information, public accessibility evidence submitted with

petitioner's reply was untimely, and finding evidence proper rebuttal evidence on reply).

Patent Owner's citation to *Toshiba* further illustrates Patent Owner's confusion. *See* Paper 20 at 4-5. In *Toshiba*, the Board granted a motion to exclude two exhibits submitted with the petitioner's reply. *See Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01446, Paper 31 at 32-33 (PTAB March 9, 2016). There, however, 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. *See id.* at 33. Here, by contrast, ***Patent Owner never filed objections under § 42.64(b) to any of the evidence submitted by Petitioner with the Petition***. Thus, Petitioner had no opportunity to file the Rebuttal Exhibits as supplemental evidence. Moreover, although Patent Owner raised a printed publication argument for one (and only one) reference in its preliminary response, the Board rejected Patent Owner's argument for purposes of institution. *See* Paper 7 at 11-14. Coupled with Patent Owner's subsequent failure to file objections to ***any*** of Petitioner's evidence (let alone the one reference mentioned in its Preliminary Response), Petitioner was not aware of any need to file supplemental information. *Toshiba* is thus distinguishable from the present case.

In any event, *Toshiba* is a nonprecedential panel decision that issued in 2016. *See Toshiba*, IPR2014-01446, Paper 31 at 1. The more-recent, precedential *Hulu* decision, by contrast, clearly holds that a petitioner may properly present new evidence of public accessibility on reply to respond to arguments raised in the patent owner response. *See Hulu*, IPR2018-01039, Paper 29 at 14-15; *see also Hulu*, IPR2018-01039, Paper 66 at 26, 32-33. Accordingly, Patent Owner's reliance on *Toshiba* is misplaced.

Finally, even if the Rebuttal Exhibits were somehow not deemed permissible rebuttal evidence, Patent Owner suffered no prejudice because it had an opportunity to address this evidence in its sur-reply. *See* Paper 17 at 3-14 (addressing Exhibits 1091-1095). As Patent Owner has already been afforded a chance to substantively address these exhibits, there is no basis for excluding them. The Board should deny Patent Owner's motion.

C. Patent Owner's Motion Is Procedurally Improper

Patent Owner's Motion to Exclude also fails because it is procedurally improper. The Board's rules and practice make clear that a motion to exclude is not a vehicle for disputing the scope or propriety of reply evidence. For example, the PTAB's Consolidated Trial Practice Guide explains that "***a motion to exclude [should not] address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply***." *See* CTPG at 79 (emphasis added). Patent

Owner's motion does just that—it seeks to exclude Petitioner's Rebuttal Exhibits and arguments as "untimely and unauthorized under 37 C.F.R. § 42.123(b)." *See* Paper 20 at 3-5. This is inappropriate.

Patent Owner's arguments fall outside the proper scope of a motion to exclude. Rather than identify any evidentiary basis for exclusion, Patent Owner repackages its disagreement with Petitioner's reply evidence as an evidentiary motion. That tactic is inconsistent with the Board's Consolidated Trial Practice Guide and the purpose of motions to exclude. Because Patent Owner's motion does not identify any evidentiary defect, relies on the wrong procedural vehicle, and seeks relief contrary to Board practice, it should be denied.

III. CONCLUSION

Petitioner's Rebuttal Exhibits constitute timely rebuttal evidence properly submitted in response to arguments raised in Patent Owner's Response, in accord with the PTAB's rules and precedent. Patent Owner's Motion to Exclude (Paper 20) ignores the Board's clear rules permitting rebuttal evidence on reply, attempts to apply other rules that have no bearing on the present issue, and is procedurally improper. Accordingly, Patent Owner's Motion to Exclude should be denied in its entirety.

Dated: December 2, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE** was served by email to Patent Owner by serving the email correspondence addresses of record as follows:

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