

Filed on behalf of: CMS Cepcor Ltd., and
CMS Cepcor Americas LLC

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CMS CEP COR LTD., and
CMS CEP COR AMERICAS LLC,
Petitioners,

v.

SANDVIK INTELLECTUAL PROPERTY AB,
Patent Owner.

Case No. IPR2024-01380
Patent No. 9,827,568

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
MOTION ON NEW ARGUMENTS**

TABLE OF CONTENTS

I.	INTRODUCTION.....	3
II.	PATENT OWNER CONSENTED TO PETITIONERS FILING AN AMENDED SUR- REPLY.....	3
III.	PETITIONERS' SUR-REPLY DOES NOT ADVANCE NEW ARGUMENTS	3
A.	Petitioners only addressed a new argument first raised by Patent Owner in its Reply...	3
B.	Petitioners have not raised a new motivation-to-combine theory.....	4
IV.	CONCLUSION	5

I. INTRODUCTION

Petitioners submit this Opposition to address Patent Owner's subject Motion. As discussed below, Patent Owner is being disingenuous in its arguments on several grounds.

II. PATENT OWNER CONSENTED TO PETITIONERS FILING AN AMENDED SUR-REPLY

First, though not stated in its Motion, Patent Owner consented to Petitioners filing an Amended Sur-Reply (Paper 46). In response to this consent, Petitioners' Amended Sur-Reply excluded Exhibits 1056 instead cited to existing exhibits to support statements made. Considering travel arrangements and other prior commitments, Petitioners did not properly request that Exhibits 1056 be removed from the record prior to the January 13, 2026 hearing, but as is clear by the record, Petitioners' Amended Sur-Reply does not included or use this Exhibit.

III. PETITIONERS' SUR-REPLY DOES NOT ADVANCE NEW ARGUMENTS

A. Petitioners only addressed a new argument first raised by Patent Owner in its Reply

Evidently, Petitioners should have filed a motion to strike Patent Owner's Reply (Paper 42) since Patent Owner's Reply should have only responded to arguments raised in the corresponding opposition. Instead, as stated herein and at the January 13th hearing, contrary to 37 C.F.R § 42.23(b), Patent Owner belatedly raised a "non-analogous art" argument in its Reply.

Nevertheless, the arguments made in the Amended Sur-Reply are not a new direction or new approach. Petitioners are simply identifying that the ‘658 Patent and Piepho address the same problem, already inherent in the exhibits, in response to Patent Owner new argument. No new evidence has been submitted stating the obvious position included in the Amended Sur-Reply. Instead, the Amended Sur-Reply cites to the precise sections in the ‘658 Patent and Piepho to support this position.

Though Exhibit 1056 included an analysis by Petitioners’ expert witness, Mr. Smith, Patent Owner’s argument is only rooted in the fact that Mr. Smith’s declaration (which arguably should have been kept as Petitioners’ work product) was disclosed to Patent Owner. Interestingly, Patent Owner takes no exception to the Cooperative Patent Classification argument which also was included in Mr. Smith’s removed declaration where the citations are directed to the “‘658 Patent and Piepho or the other discussion in Section II which found original support from Mr. Smith’s declaration that is no longer being used.

B. Petitioners have not raised a new motivation-to-combine theory

Patent Owner is wrong that a new motivation-to-combine theory has been presented. It is noted that Patent Owner’s belated non-analogous art argument is included in its “There is No Motivation to Combine” argument of its Reply, pages 9-10. As stated above, concern about the life of the main shaft is already taught in

the ‘658 Patent and Piepho. Furthermore, objecting to citing MPEP 2143.01 and prior art already on the record should not be considered as a basis to grant Patent Owner’s motion, especially considering that Patent Owner’s new arguments in its Reply are a disingenuous basis to file its Motion.

IV. CONCLUSION

Similar to where the Federal Circuit held that, in addition to all claims, the PTAB “must similarly address all *grounds* of unpatentability raised by the petitioner” if it institutes an IPR trial, *AC Techs., S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 129 U.S.P.Q.2D (BNA), Petitioners submit that the PTAB should consider all of Petitioners’ Amended Sur-Reply in view of Patent Owner failing to only respond to arguments raised in the corresponding opposition. Furthermore, Petitioners submit that the Amended Sur-Reply only responds to arguments raised in the Reply where no new evidence or arguments were made that are not already before the PTAB.

Date: January 27, 2026

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Certificate of Service

I hereby certify that, on January 27, 2026, a true and correct copy of the foregoing Petition (and accompanying exhibits) was served on the Patent Owner via electronic means (by agreement of the parties) at the addresses listed below:

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