

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CMS CEP COR LTD. AND
CMS CEP COR AMERICAS LLC
Petitioner,

v.

SANDVIK INTELLECTUAL PROPERTY AB
Patent Owner.

Patent No. 11,014,090

Inter Partes Review No. IPR2024-01381

PATENT OWNER'S MOTION ON NEW ARGUMENTS

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. EXHIBITS 1061 AND 1064 SHOULD BE STRUCK.....	1
III. PETITIONER’S SUR-REPLY ADVANCES NEW ARGUMENTS.....	2
A. Petitioner raises a new argument that the ’090 Patent and Piepho are directed to the same problem based on Ex. 1061.....	2
B. Petitioner raises a new motivation-to-combine theory	2
IV. CONCLUSION.....	3

I. INTRODUCTION

Pursuant to the Board’s authorization at the oral hearing on January 13, 2026, Patent Owner submits this motion with respect to Exhibit 1061, Exhibit 1064, Petitioner’s Sur Reply (Paper 47), and Petitioner’s Amended Sur Reply (Paper 52) (collectively, “Sur-Reply”). Because these submissions plainly violate 37 C.F.R. § 42.23(b) and the Trial Practice Guide (“TPG”), Patent Owner respectfully submits that the Board strike or, at a minimum, disregard them.

II. EXHIBITS 1061 AND 1064 SHOULD BE STRUCK

Petitioner’s Exhibit 1061 (Mr. Smith’s Fourth Declaration) is new testimony submitted with Petitioner’s Paper 47. It is not a deposition transcript of cross-examination of any reply witness. Likewise, Petitioner’s Exhibit 1064 (documentary evidence) is not a deposition transcript of cross-examination of any reply witness. Accordingly, both Exhibits 1061 and 1064 violate § 42.23(b), which dictates that a sur-reply “may not be accompanied by new evidence other than deposition transcripts.”¹ Because Exhibits 1061 and 1064 are improper new

¹ Petitioner also submitted Exhibits 1062, 1063, and 1065 in Paper 47. Each were previously submitted as Exhibits 2029, 2030, and 2022, respectively, thereby violating 37 C.F.R. § 42.6(d). Counsel for Petitioner agreed to withdraw at least Exhibits 1062, 1064 and 1065 but has not done so.

evidence submitted at the sur-reply stage—after Patent Owner’s final brief and without any opportunity to cross-examine Petitioner’s expert or address the documentary evidence—the Board should strike Exhibits 1061 and 1064. Counsel for Petitioner agreed to withdraw Exhibits 1061 and 1064 but has not done so to date.

III. PETITIONER’S SUR-REPLY ADVANCES NEW ARGUMENTS

A. Petitioner raises a new argument that the ’090 Patent and Piepho are directed to the same problem based on Ex. 1061

Petitioner’s arguments spanning pages 3–4 of Paper 47 that “the ’090 Patent and Piepho address the same problems,” including “preserving the main shaft” and “minimiz[ing] down time,” are new arguments that improperly rely upon Mr. Smith’s testimony in Exhibit 1061. This is a new theory aimed at establishing that Piepho and the ’090 Patent are analogous art. Petitioner’s Paper 52 simply removes citations to Exhibit 1061 while retaining the substance of the new arguments. *See* Paper 52, 4–5. Removal of citations to Exhibit 1061 does not cure the underlying defect—the arguments are new, and Patent Owner has not had an opportunity to address them.

B. Petitioner raises a new motivation-to-combine theory

Petitioner’s Paper 47 at pages 8–10 also newly asserts that a motivation to combine Coxhill (or Torrence—Petitioner’s argument is unclear) and Piepho arises from “increas[ing] the life of a main shaft and/or reduc[ing] down time when

performing maintenance on a main shaft assembly.” Petitioner’s Paper 52 advances the same theory. *See* Paper 52, 8–10. This is a new and untimely motivation to combine rationale, without any citation in the record where it arose. According to the TPG, § 42.23(b) does not allow Petitioner to “proceed in a new direction with a new approach as compared to the positions taken in a prior filing” and cannot raise “a new issue” or “belatedly” present evidence. *See* TPG, II.I (2025 web version, <https://www.uspto.gov/patents/ptab/trial-practice-guide> (last visited Jan. 20, 2026)). It provides as an example “new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, such as newly raised rationale to combine the prior art references that was not expressed in the petition.” That is the case here.

IV. CONCLUSION

For the foregoing reasons, the Board should grant Patent Owner’s motion.

Dated: January 20, 2026

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IPR2024-01381
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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PATENT OWNER'S MOTION ON NEW ARGUMENTS was served as of the below date via e-mail (by agreement) to the following counsel of record for Petitioner:

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Dated: January 20, 2026

/Mehran Arjomand/
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