

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

By: Terry M. Sanks (tsanks@firstiniplaw.com) (litigation@firstiniplaw.com)

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. IPR2024-01381
Patent No. 11,014,090

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

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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 52). In response to this consent, Petitioners' Amended Sur-Reply excluded Exhibits 1061 and 1064 and cited to existing exhibits to support statements made. Considering travel arrangements and other prior commitments, Petitioners did not properly request that Exhibits 1061 and 1064 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 these Exhibits.

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 38) 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 "not 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 ‘090 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 ‘090 Patent and Piepho to support this position.

Though Exhibit 1061 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 ‘090 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 8-10. As stated above, concern about the life of the main shaft is already taught in

the '090 Patent and Piepho. The reference to Yagi (Ex. 1060) is not new either. 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

/Terry M. Sanks/
Terry M. Sanks, Esquire
Reg. No. 45,069
BEUSSE SANKS, PLLC
612 E. Colonial Drive, Suite 250
Orlando, Florida 32803
Tel: (407) 644-8888
tsanks@firstiniplaw.com
litigation@firstiniplaw.com

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:

Mehran Arjomand
MArjomand@mofo.com

Alex S. Yap
AYap@mofo.com

MORRISON & FOERSTER LLP
707 Wilshire Blvd., Suite 6000 Los Angeles, CA 90017
Tel: 213-892-5200

- and –

Aaron G. Fountain
afountain@mofo.com
MORRISON & FOERSTER LLP
200 Clarendon Street, 21st Floor
Boston, MA 02116
Tel: 617-648-4700

-and-

Jeffrey G. Young
JeffreyYoung@mofo.com
MORRISON & FOERSTER LLP
2100 L Street, NW Suite 900
Washington, DC 20037
Tel: 202-877-1500

Attorneys for Patent Owner
Sandvik Intellectual Property AB

/Terry M. Sanks/

Terry M. Sanks
Reg. No. 45,069