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Paper 29
Date: November 3, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WESTERN DIGITAL TECHNOLOGIES, INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

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IPR2024-01447 (Patent 8,405,134 B2)
IPR2024-01493 (Patent 10,680,167 B2)[1]

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Before JUSTIN T. ARBES, SHEILA F. McSHANE, MONICA S. ULLAGADDI, and JOHN D. HAMANN, *Administrative Patent Judges.*[2]

McSHANE, *Administrative Patent Judge*

ORDER
Conduct of the Proceeding
*37 C.F.R. § 42.5*

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[1] This Order addresses issues that are similar in these proceedings, so we exercise our discretion to issue one Order to be docketed in each. The parties are not authorized to use this caption.

[2] This is not an expanded panel of the Board; rather, the listed judges are paneled in various groups in these proceedings.

Patent Owner requested that the Board schedule a call to discuss a request to file expert declarations along with its sur-replies in these cases, with Petitioner opposing the request. *See* Ex. 3102. At our request, the parties provided a summaries of the issues. *See id*. Subsequently, a call was convened on October 29, 2025, and a transcript of the call has been entered in the record. *See* Ex. 2079.

Patent Owner alleged that in the Petition, Petitioner did not present arguments on the issue of forming crystalline MgO with a certain orientation on amorphous CoFeB, but in Reply, Petitioner submitted new exhibits and expert testimony that should have been in the Petition "in an attempt to belatedly establish a *prima facie* case of unpatentability by demonstrating a reasonable expectation of success." Ex. 3102. Patent Owner further alleged that it "would be highly prejudiced if Petitioner is allowed to make its case on a reasonable expectation of success based on evidence that was not in the Petition." *Id*.

Petitioner alleged that the reasonable expectation of success was established in the Petition, and Patent Owner's expert had the opportunity to address the teachings of the exhibits submitted in Reply. Ex. 3102.

During the October 29 call on the request, the parties' allegations, in large part, centered on whether Petitioner had submitted evidence with the Petition to establish a reasonable expectation of success, and whether the argument and evidence submitted in Reply was new. *See* Ex. 2079, 6–16.

It is apparent that the operative issue is whether some of the argument and evidence submitted in the Replies in the respective cases is proper under our rules. Our Consolidated Trial Practice Guide provides that "[i]f a party believes that a brief filed by the opposing party raises new issues, is

accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply, it may request authorization to file a motion to strike." Consolidated Trial Practice Guide, 80–81.[3] Accordingly, under these circumstances, the appropriate way to proceed is to authorize Patent Owner to file motions to strike the portions of the respective replies, exhibits, and expert testimony that Patent Owner alleges are impermissible because they should have been submitted with the Petition.[4]

The disposition of the motions to strike is anticipated to be determinative of whether Petitioner's arguments are impermissible or properly respond to Patent Owner's Responses' arguments. Therefore, we here do not discern a need for the submission of Patent Owner expert declarations with its sur-replies, so we *deny* Patent Owner's request for authorization to file expert sur-reply declarations.[5]

Patent Owner is authorized to file a motion to strike in each case, limited to 10 pages, by November 13, 2025. Patent Owner should clearly set forth in the motion the specific portions of the Reply and any exhibits that it seeks to strike. Petitioner is authorized to file an opposition, limited to 10 pages, by November 25, 2025. Patent Owner is authorized to file a reply, limited to 5 pages, by December 4, 2025.

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[3] Available at https://www.uspto.gov/patents/ptab/trial-practice-guide.
[4] Patent Owner agreed to file motions to strike. *See* Ex. 2079, 5:10–13.
[5] We note that the Board authorized a limited sur-reply expert declaration in IPR2024-01494. The circumstances in these cases here are different, however. In IPR2024-01494, the parties jointly requested leave for submission of a sur-reply declaration; here, Patent Owner's request is opposed.

It is:

ORDERED that Patent Owner's request for authorization to file expert declarations in sur-reply is *denied*; and

FURTHER ORDERED that authorization is *granted* for Patent Owner to file Motions to Strike in accordance with the direction above.

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