

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case No. IPR2024-01493
Patent No. 10,680,167

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO STRIKE**

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Petitioner (“WD”) fails to carry its burden for the “rare” relief of striking EX2080-81 or any Sur-reply argument. TPG, 80-81. WD fails to show that it is “beyond dispute” that any “issue is new or evidence is belatedly presented” or that WD would be unfairly prejudiced if the Board considers *all* the disclosures in WD’s own Parkin reference. *Id.* WD’s baseless motion should be denied.

I. THE UNDISPUTED FACTS REFUTE WD’S ASSERTIONS

“Parkin” is Patent No. 7,270,896 (“’896 Patent”). Paper 1 (“Pet.”), 2, 19. The grounds are based on this *patent* – not WD’s EX1062. 35 U.S.C. §311(b). The Petition was required to submit a “cop[y] of” the ‘896 Patent. *Id.*, §312(a)(3)(A). WD purported to do so in EX1062 but failed to include the applications in EX2080-81 that the ’896 Patent incorporates by reference. EX1062, 19:1-6.

WD’s Reply alleges that Parkin’s **Fig. 11** MgO layer formed on amorphous CoFeB. Paper 24 (“Reply”), 7 (*citing* EX2018, 134:1-138:11 where Bokor alleges Fig. 11’s crystalline(001) **layer 520 is optional**). The Petition never cited Fig. 11. This *new* Reply argument makes EX2080-81 relevant because Fig. 11’s MgO layer is “formed according to the methods described in [EX2080-81].” EX1062, 23:6-11.

Bokor’s *Reply* declaration *newly* alleged that the “***Parkin patent*** (EX1062) previously disclosed CoFeB MgO MTJs.” EX1105, ¶35 (purporting to refute secondary considerations). Bokor said Parkin Fig. 11’s crystalline(001) layer 520 allegedly being “optional” was “a basis for my opinion.” EX2085, 117:8-9; *see*

also id., 108:6-120:4. IPB introduced EX2080 (cited as EX2079 in EX2085) at deposition to impeach Bokor's assertion that Parkin says Fig. 11's MgO layer is formed on CoFeB rather than on a crystalline(001) layer. EX2085, 55:1-75:21, 100:21-108:4. Bokor admitted the application in EX2080 – which Parkin says describes its “methods” for forming Fig. 11's MgO layer – describes forming it on a crystalline(001) layer like Parkin's Fig. 11 layer 520, ***not on amorphous CoFeB as WD's Reply alleges***. EX2085, 55:1-75:21, 100:21-108:4; EX2080, 35:12-18; *see also* EX2081, 91:5-21 (same); Paper 31 (“Sur-reply”), 12-18.

Bokor reviewed EX2080-81 (EX2085, 55:5-17) but concealed that review by excluding them from his “Materials Considered” (EX1024, §III; EX1105, §II). WD then failed to serve them on IPB despite EX2080-81 being “relevant information...inconsistent with” WD's “position” (37 C.F.R. §42.51(b)(1)(iii)) that Parkin allegedly teaches that Fig. 11's MgO is formed on CoFeB (Reply, 7).

IPB's Motion to Strike showed that the Petition never cited Parkin Fig. 11 or its disclosure that “[a]n interface layer 520 of a crystalline CoFe alloy may also be used” (Parkin, 22:66-67), let alone allege this means layer 520 is optional. Paper 30 (“IPB-Mot.”), 4-7. IPB explained it was “critical” to strike WD's clearly-new argument that Fig. 11 teaches forming MgO(001) on CoFeB based on the assertion that layer 520 is “optional” – not because IPB “cannot refute” it (Paper 34, 5) – but “because it is clearly new, while Parkin and ***both*** experts refute Petitioner's other

arguments about ‘inverted’ Figs. 3 and 11.’ IPB-Mot., 5-6 (emphasis original) (citing Parkin’s disclosure in EX1062 **and** EX2080-81 that Fig. 11’s MgO layer is formed on a crystalline(001) layer – not on amorphous CoFeB).

II. WD IDENTIFIES NO UNAUTHORIZED NEW EVIDENCE

WD asserts repeatedly that IPB “flouted Board rules.” Paper 35 (“WD-Mot.”), 1-2 and 4. Yet, WD identifies no rule that IPB violated.

A. EX2080-81 are Not Belatedly Presented New Evidence

EX2080-81 are part of the ’896 Patent. EX1062, 19:1-6; *X2Y Attenuators v. ITC*, 757 F.3d 1358, 1362-63 (Fed. Circ. 2011) (incorporated material is part of the patent); *Netflix v. Avago*, 2024 WL 3507601, 7-8 (Fed. Cir. 2024) (vacating and finding the Board erred by failing to consider “Appendix J” filed with the reply because Appendix J was incorporated in and thus “part and parcel to” the petition-filed Masters reference). WD should have filed EX2080-81 with the Petition and cannot complain they are “belatedly presented” (TPG, 80-81) given that WD’s EX1062 lacks the ’896 Patent’s **full** disclosure. 35 USC §312(a)(3)(A). EX2080-81 are not new **evidence** – they are part of Petition-cited “Parkin” (’896 Patent).

B. New Evidence Was Not Prohibited in the Motion to Strike

Even if EX2080-81 were new evidence – they are not (*supra* §II.A) – WD identifies no rule prohibiting new evidence with IPB’s Motion and the Board’s order imposed no such prohibition. Paper 29. Repeatedly alleging that IPB “flouted Board rules” does not make it so. WD cites two rules (42.7 and 42.23) but neither

prohibits new evidence with IPB’s Motion. WD’s *Cisco* case did not hold that new evidence is prohibited in *every* motion to strike. WD-Mot., 2 and 4. The *Cisco* panel denied a requested motion to strike and merely observed that if it had granted the requested motion the Board would not have provided patent owner “an opportunity to submit new evidence.” *Cisco*, IPR2016-01466, Paper 21, 3.

C. EX2080-81 Were Not New in the Sur-reply

Even if EX2080-81 were new evidence when first introduced – they were not (*supra* §II.A) – they were not new in the Sur-reply because they were cited in IPB’s Motion. IPB-Mot., 6. Moreover, because ***EX2080 was introduced at deposition to impeach Bokor*** (EX2085, 55:1-75:21, 100:21-108:4; *supra* § I) it was not unauthorized in IPB’s Sur-reply. *Ascend Performance Materials v. Samsung SDI*, IPR2020-00349, Paper 53, 11-13 (July 15, 2021) (declining to strike new sur-reply exhibits because they were used for cross-examination and “***thus constitute proper evidence to submit along with the deposition transcript***”).

WD’s assertion that IPB “knew” it needed authorization to file EX2080-81 with the Sur-reply because IPB emailed WD on November 11 misses the mark. WD-Mot., 2. IPB sent that email before its Motion to Strike – which the Board had only recently authorized – was finalized. After the Motion was filed citing EX2080-81, those exhibits were not only not new “***evidence***,” they were not “new” at all in the Sur-reply. IPB made no “concession” that authorization was required

to submit EX2080 or EX2081 with the Sur-reply. *Id.*

The facts here are nothing like *Satco*, *Voice Tech* and *American Patents* (cited WD-Mot., 1-4) where the Board struck new *evidence*. EX2080-81 are not “belatedly presented” *evidence* in the Sur-reply. They are parts of **WD’s** Parkin reference (’896 Patent) – that **WD’s expert** considered – cited to rebut WD’s *new Reply* argument that Parkin’s Fig. 11 MgO layer is formed on CoFeB and EX2080 had already been introduced at deposition. Sur-reply, 12-18; *supra* §§I and III.A.

D. WD’s Waiver Argument is Baseless

WD’s “waive[r]” argument is extraordinary. WD-Mot., 3. As the Board recognized in IPR2024-01447, IPB’s POPR in that case made no argument for the ’134 Patent MgO(001) limitations. -01447 Paper 10, 14; -01447 POR, 4 (n. 1). WD misleadingly cites a -01447 POPR argument concerning *different* limitations—in the ’134 Patent—relating to crystallized CoFeB. -01447 Paper 31, 5. Here, the Petition *never alleged* that Parkin formed Fig. 11’s MgO layer on amorphous CoFeB—whether because layer 520 was “optional” or otherwise. The Sur-reply was IPB’s *first* chance to respond to this new Reply argument. IPB-Mot., 1-6.

III. THERE IS NO BASIS TO STRIKE ANY ARGUMENT

Even if the Board were to find that IPB should not have submitted EX2080 or EX2081 and were to strike either or both *exhibits*, WD fails to establish that any Sur-reply *argument* should be struck. The Board instructed WD to “clearly set

forth in the motions the *specific portions* of the Sur-replies that it seeks to strike.” EX3103. WD failed to do so. That is *reason enough* to deny WD’s request. WD’s single sentence cites eleven Sur-reply pages without identifying any argument “relying on Exhibits 2080-2081.” WD-Mot., 1. Indeed, most of the listed Sur-reply pages (*i.e.*, pages 3, 8, 12-13, 15, 17 and 29-30) never even cite EX2080-81.

The Sur-reply properly refutes new arguments in WD’s Reply. That distinguishes *ZyXEL*, *Parkervision* and *American Patents* (*cited* WD-Mot., 2-4). WD’s Reply alleged Parkin discloses MgO(001) formed on CoFeB. Reply, 5-7. Bokor said the basis for his supporting testimony was that Parkin allegedly says *Fig. 11’s interface layer 520 is “optional.”* EX2085, 117:14-119:16; IPB-Mot., 5. It is undisputed that the Petition never cited Parkin Fig. 11 or its interface layer 520. IPB-Mot., 1-7. The Sur-reply pages WD identifies refute the Reply’s and Bokor’s new arguments that Parkin Fig. 11’s MgO(001) forms on amorphous CoFeB. WD’s suggestion that that it was improper for the Sur-reply to refute these *new* arguments that appeared for the first time in Reply is extraordinary.

EX2080-81 are relevant to the Reply’s new arguments because those applications describing Parkin’s “methods” used to form Fig. 11’s MgO layer. EX1062, 17:21-28, 23:6-11. But no Sur-reply argument relies *exclusively* on EX2080-81. The Sur-reply explains that in *EX1062* Parkin characterizes those methods (*id.*, 3:24-41) as forming MgO on a crystalline(001) layer which refutes

WD's Reply arguments. Sur-reply, 3, 13-18. The Sur-reply's arguments are also supported by *admissions from WD's own expert* about how Parkin says Fig. 11's MgO layer is formed. *Id.*, 14-18. EX2080-81 clearly refute WD's new Reply arguments that Parkin forms an MgO layer on amorphous CoFeB rather than on a crystalline(001) layer. But those new Reply arguments are also refuted by *other* indisputably proper Sur-reply cited evidence that WD does not even allege should be struck. WD establishes no reason to strike any Sur-reply *argument*.

IV. WD'S "PREJUDICE"/"APA VIOLATION" ARGUMENTS FAIL

WD's allegation that IPB "sandbagged" WD is *projection*. WD-Mot., 4. WD tried to sandbag IPB by making new arguments in Reply. IBP-Mot., 1-10. It is *undisputed* that the Petition never cited Parkin Fig. 11, its layer 520, or alleged layer 520 is "optional." *Id.*, 1-7. All IPB did was explain to the Board that *WD's improper new* Parkin Reply arguments are refuted by Parkin and admissions from WD's own expert. Sur-reply, 12-18.² The Board can and should moot WD's Motion by granting *IPB's* Motion to Strike WD's new Reply arguments.

WD's assertion that considering EX2080-81 would violate the APA because WD was "deprived of the opportunity" to address them (WD-Mot., 4-5) is

² This is nothing like *Am. Patents* (cited WD-Mot., 4) where the sur-reply newly argued diligence to antedate a reference. *Am. Patents*, 2020 WL 1656238 at 2-3.

frivolous. *Nike* and *Dell* are nothing like this case. *Id.* Those cases found the APA required providing the *patent owner* the ability to respond to new arguments. *Dell*, 818 F.3d at 1301 (faulting the Board for crediting a new petitioner argument made at oral hearing); *Nike*, 955 F.3d at 54 (faulting the Board for relying on portions of a prior art reference the petitioner did not cite). As the Petitioner, **WD** had complete control of what arguments it advanced and when. *SAS Inst. v. Iancu*, 584 US 357, 366-367 (2018) (**WD's petition** “guide[s] the life of the” IPR).

WD never disputes EX2080-81 are incorporated in **WD's own** Petition-cited Parkin reference (EX1062, 23:6-11) and that **WD's own expert** reviewed EX2080-81 before forming his opinions (EX2085, 55:5-17). EX3103. WD had the opportunity to address EX2080-81 in the Petition, again in the Reply, and again by redirecting Bokor on these disclosures at deposition. WD repeatedly **chose** to not address these teachings in its own Parkin reference. WD's request that the Board ignore disclosure in Parkin that is highly relevant to WD's new Parkin-based Reply arguments is baseless. Justice compels that the Board consider **all** Parkin's teachings if the Board does not strike WD's new Parkin-based Reply arguments. WD also could have requested “further merits briefing ...to address the merits of any newly-raised arguments or evidence.” TPG, 80. WD did not do so because it has no response on the “merits” given that Parkin and WD's own expert refute WD's new Reply arguments. The Board should deny WD's baseless motion.

Respectfully submitted,

Date: December 12, 2025

/Richard Giunta/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on December 12, 2025, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Petitioner, upon the following:

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