

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC., SENSEONICS HOLDINGS, INC., and ASCENSIA
DIABETES CARE HOLDINGS AG,
Petitioners,¹

v.

CELLSPIN SOFT, INC.,
Patent Owner.

IPR2025-00102 (Patent 11,234,121 B2)
IPR2025-00103 (Patent 9,900,766 B2)
IPR2025-00104 (Patent 8,904,030 B2)

Before GREGG I. ANDERSON, CYNTHIA M. HARDMAN, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Granting Petitioners' Motion to Strike
37 C.F.R. § 42.5

¹ This Order addresses issues common to the identified cases. The parties are not authorized to use this caption without express authorization.

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INTRODUCTION

This decision addresses motions to strike originally filed by TikTok, Inc. (“TikTok”) in related proceedings IPR2024-00768, IPR2024-00769, and IPR2024-00770 (“the TikTok proceedings”). *See* IPR2024-00768, Paper 30; IPR2024-00769, Paper 30; IPR2024-00770, Paper 31 (collectively “Motion” or “Mot.”). That is, on May 9, 2025, TikTok requested authorization to file “motion[s] to strike new exhibits filed with (and argument referencing such exhibits from) Patent Owner’s sur-reply.” *See* IPR2025-00102, Ex. 3002, 1 (Email dated May 9, 2025, to Trials from Petitioner). We authorized the filing of a motion to strike in each case. Cellspin Soft, Inc. (“Patent Owner”) filed oppositions. *See* IPR2024-00768, Paper 31; IPR2024-00769, Paper 31 (collectively “Opposition” or “Opp.”).²

The present proceedings were previously joined with the TikTok proceedings with LifeScan, Inc., Senseonics Holdings, Inc., and Ascensia Diabetes Care Holdings Ag (collectively, “Petitioners”) serving as understudies to TikTok. In that capacity, Petitioners filed the Motion along with TikTok. The TikTok proceedings were subsequently terminated, but Petitioners and Patent Owner have agreed to adopt the record from the TikTok proceedings, including the Motion and related briefing, in the present proceedings. *See* IPR2025-00102, Paper 16, 3 n. 4 (noting the parties’ agreement to be bound by the post-institution briefing in the TikTok

² The Motion and Opposition is substantially the same for each proceeding. It appears that Patent Owner did not file its Opposition in IPR2024-00770. We understand this to be an inadvertent oversight and therefore consider the arguments in the Opposition for all three proceedings. Herein, we cite to the papers and exhibits as filed in IPR2024-00768.

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proceedings as well as the fact that the Motion to strike “remains pending and will be decided”).

We grant the Motion for the reasons stated below.

DISCUSSION

Petitioners’ Motion seeks to strike Exhibits 2030–2034. Mot. 1. There is no dispute that Exhibits 2030–2034 were introduced with the Sur-reply. *See* Mot. 1; Opp. 2. Rule 42.23(b) states that “[a] sur-reply . . . may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23(b). It is undisputed that Exhibits 2030–2034 are not “depositions of the cross-examination of any reply witness.” Mot. 1; *see generally* Opp. Rather, these exhibits, which include a second declaration from Patent Owner’s declarant Mr. Gajendragad (Ex. 2030), are new evidence that is prohibited by Rule 42.23(b).

Patent Owner was advised that Rule 42.23(b) bars the submission of new evidence with the Sur-reply prior to the filing of Petitioners’ Motion. *See* Ex. 3002. But instead of withdrawing the offending exhibits, Patent Owner urges they should be allowed notwithstanding that rule. *See generally* Opp. We disagree as explained below.

Patent Owner argues that the Rule 42.23(b) does not apply here because of “extraordinary circumstances.” Opp. 2–3 (citing *Omega Liner, Inc. v. Buergofol, GMBH*, IPR2023-01372, Paper 44 (PTAB Nov. 18, 2024)). Rule 42.23(b), however, does not provide for an exception for “extraordinary circumstances.” *See* 37 C.F.R. § 42.23(b). To the extent *Omega Liner* might be interpreted otherwise, we note that it is not a precedential decision and does not supplant the rule. Moreover, *Omega*

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Liner differs from the current cases because the patent owner there sought authorization to file its additional evidence prior to filing its sur-reply.

Omega Liner, Paper 44 at 2. Such prior authorization was not requested here. Accordingly, *Omega Liner* does not stand for the proposition that there is an “extraordinary circumstances” exception to Rule 42.23(b), particularly in circumstances like those here.

Even if it did, we note that the panel in *Omega Liner* denied Patent Owner’s motion to file new declarations with its sur-reply, finding the “circumstances presented are not extraordinary on their face and, thus, do not support a finding that Patent Owner implicitly meets its burden here.” *Omega Liner*, Paper 44 at 3 (citing 37 C.F.R. §§ 42.20(c), 42.23(b)). So too in these cases, we find that Patent Owner has not shown that the circumstances warrant an end run on Rule 42.23(b).

Patent Owner lists six reasons it alleges support avoidance of Rule 42.23(b) because they support a finding of “extraordinary circumstances.” Opp. 3–5. For each, the alleged extraordinary circumstance is an argument from Petitioners that is not present in the original Petition” or is raised by Petitioners for the “first time” in the Reply. *Id.*

None of Patent Owner’s identified reasons are extraordinary. It is often the case that parties contend responsive arguments present new theories or otherwise exceed the proper scope of reply. Our procedures provide ample opportunity to address such concerns without violating Rule 42.23(b). First, as explained in our Trial Practice Guide,³ “[i]n most cases,

³ Patent Trial and Appeal Board Consolidated Trial Practice Guide, available at <https://www.uspto.gov/patents/ptab/trial-practice-guide#step1> (“CTPG”).

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the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply.” CTPG Section II.K; *see also id.* at Section II.I (explaining the permissible scope of reply argument and evidence). There is no reason to think this is not the case here. Moreover, Patent Owner has had an opportunity to call our attention to any arguments it believes exceed the proper scope of reply in its Sur-reply.

Second, Patent Owner could have sought authorization to file a motion to strike arguments that are newly presented in the Reply and not responsive to arguments made in the Patent Owner Response. Although striking “a portion of a party’s brief is an exceptional remedy,” if Patent Owner truly believed at the time it filed its Sur-reply that the circumstances here were extraordinary it should have sought such relief. *See* CTPG Section II.K (describing circumstances where striking arguments from a reply may be merited). In any event, it was not appropriate for Patent Owner to respond to what it perceives as Petitioner’s violation of one of our rules by willfully violating another.

For similar reasons, Patent Owner’s argument that “due process demands an opportunity to fully respond to arguments against validity, and all such grounds should be properly limited to those set forth in the Petition” is unavailing. Opp. 5 (citing *Hunting Titan, Inc. v. Dynaenergetics Europe GMBH*, IPR2018-00600, Paper 67 at 15 (PTAB July 6, 2020)). As discussed below, Patent Owner has been given an opportunity to fully respond to Petitioner’s arguments, including a chance to address any concerns it had

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about those arguments not being in the Petition or exceeding the proper scope of reply.

Patent Owner’s citation to *Hunting Titan* is inapposite. *Hunting Titan* was a decision by the Board’s Precedential Opinion Panel (“POP”) on a request for rehearing of a final written decision addressing the patentability of substitute claims in a motion to amend on grounds not advanced by the petitioner. *Hunting Titan*, 3–4. Under the particular circumstances there, the POP found the Board “should not have raised its own ground of unpatentability.” *Id.* at 4.⁴ *Hunting Titan* does not address the due process afforded under the ordinary operation of our rules, which have been found to protect due process rights of litigants. *See, e.g., Belden, Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (“[T]he rules and practices of the Board generally protect against loss of patent rights without the required notice and opportunity to respond.”). As was the case in *Belden*, “[i]f there are deficiencies in Board rules and practices, none has been established as relevant to this case.” *Id.* To the contrary, Patent Owner has had ample opportunity to respond to Petitioners’ arguments, e.g., by filing a Sur-reply to call attention to any allegedly improper reply arguments and evidence, seeking authorization to move to strike such arguments and evidence, and submitting cross-examination testimony of Petitioners’ reply declarant with its Sur-reply, consistent with our rules.

⁴ *Hunting Titan* has since been de-designated as precedential. *See* <https://www.uspto.gov/subscription-center/2024/uspto-de-designates-hunting-titan-view-final-rule-governing-motion-amend>.

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ORDER⁵

In consideration of the foregoing, it is hereby

ORDERED that Petitioner's motion to strike Exhibits 2030–2034 (IPR2024-00768, 769, and 770) is *granted*. Accordingly, these exhibits will not be considered as part of the record in IPR2025-00102, -00103, and -00104.

⁵ In addition to striking the exhibits, Petitioner requests that we “order Patent Owner to re-file its Sur-reply without citations to the improper exhibits.” Mot. 6. We do not believe this is necessary and will not rely on exhibits that have been struck from the record.

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