UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

Padagis US LLC,
Petitioner

v.

Neurelis, Inc.,
Patent Owner

---

Case No. IPR2025-00464
Patent No. 8,895,546

---

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

# TABLE OF CONTENTS

TABLE OF CONTENTS ..... i
TABLE OF AUTHORITIES ..... ii
TABLE OF EXHIBITS ..... iv
**I.** INTRODUCTION ..... 1
**II.** PROCEDURAL HISTORY ..... 2
**III.** THE MOTION TO STRIKE SHOULD BE DENIED AS MOOT ..... 4
A. Evidence That Does Not Affect the Outcome of the Final Written Decision Should Not Be Stricken ..... 4
B. The Three Declarations Are Limited to Section 103(c) and Do Not Affect the Final Written Decision ..... 6
**IV.** THE BOARD SHOULD NOT EXPUNGE THE DECLARATIONS ..... 7
**V.** BURDENING THE THIRD PARTIES WITH DUPLICATIVE DEPOSITIONS IS NOT WITHIN THE INTERESTS OF JUSTICE ..... 8
**VI.** PATENT OWNER PROVIDED DEPOSITION DATES ..... 9
**VII.** CONCLUSION ..... 10
CERTIFICATE OF SERVICE ..... 12

# TABLE OF AUTHORITIES

**Page(s)**

**Cases**

*3M Co. v. Bay Materials, LLC,*
IPR2022-01214, Paper 77 (P.T.A.B. Jan. 16, 2024).....8

*Adobe Inc. v. Rah Color Technologies, LLC*,
IPR2019-00627, Paper No. 124 (P.T.A.B. Aug. 31, 2020).....9

*Apple Inc. v. Billjco LLC*,
IPR2022-00131, Paper 37 (P.T.A.B. May 18, 2023).....5

*Arashi Vision (U.S.) LLC v. GoPro, Inc.*,
IPR2024-01186, Paper 50 (P.T.A.B. Dec. 10, 2025).....5

*Eli Lilly & Co. v. L.A. Biomed. Res. Inst.,*
IPR2014-00752, Paper 71 (P.T.A.B. Apr. 12, 2019).....10

*Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*,
IPR2012-00001, Paper 26 (P.T.A.B. Mar. 5, 2013) (precedential).....9

*Honeywell Int'l Inc. v. Arkema Inc.*,
939 F.3d 1345 (Fed. Cir. 2019).....8

*Infineon Techs. AG v. Feinics Amatech Teoranta*,
IPR2022-00235, Paper 41 (P.T.A.B. June 12, 2023).....4

*Intuit Inc. v. Samesurf, Inc.*,
IPR2023-00339, Paper 42 (P.T.A.B. June 25, 2024).....5

*Jiangsu Favored Nanotechnology Co. v. P2I Ltd.*,
IPR2024-00380, Paper 28 (P.T.A.B. Apr. 11, 2025).....5

*Netflix Inc. v. DivX, LLC*,
IPR2020-00646, Paper No. 34 (P.T.A.B. April 26, 2021).....9

*New World Med., Inc. v. Microsurgical Tech., Inc.*,
IPR2020-01573, Paper 49 (P.T.A.B. Nov. 5, 2021).....7

*Streck, Inc. v. Ravgen*,
IPR2021-01577, Paper 62 (P.T.A.B. Apr. 18, 2023).....5

*Stride Rite Children's Grp. LLC v. Shoes by Firebug LLC*,
IPR2017-01809, Paper 64 (P.T.A.B. Jan. 16, 2019).....7

*Tesla, Inc. v. Autonomous Devices, LLC*,
IPR2024-00745, Paper 43 (P.T.A.B. Oct. 21, 2025).....5

**Statutes**

35 U.S.C. § 103(c)(2) (pre-AIA) ..... 1, 4, 6, 10

35 U.S.C. § 255 .....8

**Other Authorities**

Fed. R. Civ. P. 45(d)(3)(A)(iv) .....3

PTAB Boardside Chat, "Motions to Exclude and Motions to Strike in AIA Trials" (June 7, 2018), available at: https://www.uspto.gov/sites/default/files/documents/Boardside_Chat_Motions_to_Exclude_and_Motions_to_Strike_20180607.pdf .....4

Trial Practice Guide (Dec. 12, 2025), available at: https://www.uspto.gov/patents/ptab/trial-practice-guide..... 7, 10

**Regulations**

37 C.F.R. § 1.71(g) .....8

37 C.F.R. § 42.104(b)(5).....7

37 C.F.R. § 42.51(b) .....1, 8

37 C.F.R. § 42.53(d)(4).....3

37 C.F.R. § 42.53(d)(5).....1, 6

37 C.F.R. § 42.53(d)(6).....3

37 C.F.R. § 42.65(a).....7

# TABLE OF EXHIBITS

| Exhibit | Description of Exhibits |
|---|---|
| 2001 | *Clinical Superiority Findings*, U.S. FOOD & DRUG ADMIN. (Dec. 18, 2024) https://www.fda.gov/industry/designating-orphan-product-drugs-and-biological-products/clinical-superiority-findings |
| 2002 | Scheduling Order entered in *Neurelis, Inc. v. Padagis LLC*, 1:24-cv-00562, D.I. 20 (D. Del. Aug. 28, 2024) |
| 2003 | Preliminary Invalidity Contentions served in *Neurelis, Inc. v. Padagis LLC*, 1:24-cv-00562 (D. Del. Dec. 20, 2024) |
| 2004 | Markman Order entered in *Gilead Sciences, Inc. v. Lupin Ltd.*, 1:22-cv-00615-MN, D.I. 280 (D. Del. Feb. 21, 2025) |
| 2005 | Markman Order entered in *Spinal Generations, LLC v. Depuy Synthes, Inc.*, 1:22-cv-01368 (MN), D.I. 147 (D. Del. Oct. 16, 2024) |
| 2006 | Orange Book Listing for U.S. Patent No. 8,895,546 |
| 2007 | Declaration of Nicholas A. Peppas, Sc.D., dated December 6, 2018 in *Aquestive Therapeutics, Inc. v. Hale Biopharma Ventures, LLC*, IPR2019-00451, Exhibit 1041 (Jan. 29, 2019) |
| 2008 | Declaration of Daniel P. Wermeling, Pharm.D., dated January 27, 2020 in *Aquestive Therapeutics, Inc. v. Hale Biopharma Ventures, LLC*, IPR2019-00451, Exhibit 1150 (Jan. 28, 2020) |
| 2009 | NOT USED |
| 2010 | NOT USED |
| 2011 | NOT USED |
| 2012 | NOT USED |

| Exhibit | Description of Exhibits |
|---|---|
| 2013 | Scheduling Oral Order entered in *Neurelis, Inc. v. Padagis LLC*, 1:24-cv-00562, D.I. 47 (D. Del. March 11, 2025)<br>Order Granting Stipulation to Extend Certain Fact Discovery Deadlines entered in *Neurelis, Inc. v. Padagis LLC*, 1:24-cv-00562, D.I. 65 (D. Del. May 15, 2025) |
| 2014 | Jacqueline A. French, Timothy A. Pedley, *Initial Management of Epilepsy*, New England Journal of Medicine 2008; 359:166-76 ("French & Pedley 2008") |
| 2015 | Penovich et al., *Burden of Seizure Clusters on Patients With Epilepsy and Caregivers*, The Neurologist 2017; 22: 207-214 |
| 2016 | Cloyd et al., *Overcoming the Challenges of Developing an Intranasal Diazepam Rescue Therapy for the Treatment of Seizure Clusters*, Epilepsia 2021; 62:846-856 |
| 2017 | Hogan, R.E., et al., *Bioavailability and Safety of Diazepam Intranasal Solution Compared to Oral and Rectal Diazepam in Healthy Volunteers*, Epilepsia, 61:455-464 (Feb. 2020) |
| 2018 | Lindsay M. Higdon and Michael R. Sperling, *A Review of a Diazepam Nasal Spray for the Treatment Of Acute Seizure Clusters and Prolonged Seizures*, J Expert Review of Neurotherapeutics 2021; 21(11):1207-1212 |
| 2019 | Bechgaard et al., *Solubilization of Various Benzodiazepines for Intranasal Administration, a Pilot Study*, Pharmaceutical Development and Technology 1997; 2(3):293-296 |
| 2020 | Gizurarson, S., et al., *Intranasal Administration of Diazepam Aiming at the Treatment of Acute Seizures: Clinical Trials in Healthy Volunteers*, Biol. Pharm. Bull., 22(4):425-427 (Apr. 1999) |
| 2021 | Ivaturi, V.D., et al., *Bioavailability and Tolerability of Intranasal Diazepam in Healthy Adult Volunteers*, Epilepsy Res., 84:120-126 (2009) |

| Exhibit | Description of Exhibits |
|---|---|
| 2022 | Schrier, L., et al., *Pharmacokinetics and Pharmacodynamics of a New Highly Concentrated Intranasal Midazolam Formulation for Conscious Sedation*, Brit. J. Clin. Pharmacol., 83:721-731 (Apr. 2017) |
| 2023 | Penovich et al., *Benzodiazepines for the Treatment of Seizure Clusters*, CNS Drugs 2024; 38:125-140 |
| 2024 | Kapoor et al., *A Review of Intranasal Formulations for the Treatment of Seizure Emergencies*, Journal of Controlled Release 2016; 237: 147-159 |
| 2025 | Rabinowicz et al., *Improvement of Intranasal Drug Delivery with Intravail® Alkylsaccharide Excipient as a Mucosal Absorption Enhancer Aiding in the Treatment of Conditions of the Central Nervous System*, Drugs in R&D 2021; 21:361-369 |
| 2026 | Acorda Therapeutics, Letter to Plumiaz Clinical Trial Participants, May 20, 2016 |
| 2027 | U.S. Patent No. 6,193,985 ("Sonne") |
| 2028 | NOT USED |
| 2029 | NOT USED |
| 2030 | Written joint research agreement, titled "Master Service Agreement" (7 pages), between Particle Sciences, Inc. and Questcor Pharmaceuticals, Inc., dated April 1, 2007 **[FILED UNDER SEAL]** |
| 2031 | Asset Purchase Agreement between Hale BioPharma Ventures, LLC and Questcor Pharmaceuticals, Inc., dated June 27, 2008 **[FILED UNDER SEAL]** |
| 2032 | H.R. Rep. No. 108-425 (2004) |
| 2033 | 150 Cong. Rec. S7520-05 (2004) |

| Exhibit | Description of Exhibits |
|---|---|
| 2034 | Non-disclosure Agreement between Aegis Therapeutics, LLC and Questcor Pharmaceuticals, Inc., dated August 15, 2005 **[FILED UNDER SEAL]** |
| 2035 | Confidentiality Agreement between Particle Sciences, Inc. and Questcor Pharmaceuticals, Inc., dated January 19, 2007 **[FILED UNDER SEAL]** |
| 2036 | Email between Questcor Pharmaceuticals, Inc. and Aegis Therapeutics, LLC, dated February 15, 2007 **[FILED UNDER SEAL]** |
| 2037 | Quote No. QCR 135 between Particle Sciences, Inc. and Questcor Pharmaceuticals, Inc., dated March 28, 2007 **[FILED UNDER SEAL]** |
| 2038 | QSC-002 Project Email Thread between Aegis Therapeutics, LLC and Questcor Pharmaceuticals, Inc., dated March 26, 2007 |
| 2039 | Redline Comparison between U.S. Patent No. 11,793,786 and U.S. Patent No. 11,241,414 |
| 2040 | QC and PSI Agreement between Particle Sciences, Inc. and Questcor Pharmaceuticals, Inc., dated April 2, 2008 **[FILED UNDER SEAL]** |
| 2041 | Letter Agreement, with Term Sheet between Neurelis, Inc. and Aegis Therapeutics, LLC, dated August 28, 2007 **[FILED UNDER SEAL]** |
| 2042 | Supply Agreement Neurelis, Inc. and Aegis Therapeutics, LLC, dated May 22, 2008 **[FILED UNDER SEAL]** |
| 2043 | License Agreement Neurelis, Inc. and Aegis Therapeutics, LLC, dated May 22, 2008 **[FILED UNDER SEAL]** |
| 2044 | Transmittal Notice of Intravail from Aegis Therapeutics, dated October 2, 2008 **[FILED UNDER SEAL]** |
| 2045 | Declaration of Steven Cartt **[FILED UNDER SEAL]** |

| Exhibit | Description of Exhibits |
|---|---|
| 2046 | Declaration of Dr. Mark Mitchnick **[FILED UNDER SEAL]** |
| 2047 | Declaration of David Hale |
| 2048 | Redline Comparison between U.S. Patent Application No. 15/955,397 and U.S. Patent Application No. 17/228,514 |
| 2049 | Marc Brown *Curriculum Vitae* |
| 2050 | Joint Claim Construction Brief, *Neurelis, Inc. v. Padagis LLC et al.*, 1:24-cv-00562, D.I. 87 (D. Del. August 15, 2025) ("Joint CC Brief") |
| 2051 | Andrew Streitwieser, INTRODUCTION TO ORGANIC CHEMISTRY (4th ed. 1992) ("Streitwieser") |
| 2052 | David W. Oxtoby et al., PRINCIPLES OF MODERN CHEMISTRY (4th ed. 1999) ("Oxtoby") |
| 2053 | European Pharmacopoeia 6.0, Vol 2 (6th ed. 2007) ("PhEur 6.0") |
| 2054 | Panayiotis P. Constantinides et al., *Advances in the Use of Tocols as Drug Delivery Vehicles*, 23 PHARM RES. 243 (2006) ("Constantinides-2006") |
| 2055 | Rowe, Sheskey, & Owen, HANDBOOK OF PHARMACEUTICAL EXCIPIENTS, (6th ed. 2009) ("Rowe-2009") |
| 2056 | Afaf Kamal-Eldin, *Effect of Fatty Acids and Tocopherols on the Oxidative Stability of Vegetable Oils*, 108 EUR. J. OF LIPID SCI. & TECH. 1051 (2006) ("Kamal-Eldin-2006") |
| 2057 | Branka Rozman & Mirjana Gašperlin, *Stability of Vitamins C and E in Topical Microemulsions for Combined Antioxidant Therapy*, 14 DRUG DELIVERY 235 (2008) ("Rozman-2007") |
| 2058 | Afaf Kamai-Eldin & Lars-Ake Appelqvist, *The Chemistry and Antioxidant Properties of Tocopherols and Tocotrienols*, 31 LIPIDS 671 (1996) ("Kamai-Eldin-1996") |

| Exhibit | Description of Exhibits |
|---|---|
| 2059 | March 2009 FDA Inactive Ingredient Database |
| 2060 | Redline Comparison between U.S. Patent Application No. 12/413/439 and U.S. Patent Application No. 15/955,397 |
| 2061 | David Ward, *Optimizing Nasal Products for Systemic Delivery*, 106 ONDRUGDELIVERY 56 (2020) ("Ward-2020") |
| 2062 | C. Holvoet et al., *Inclusion Complexation of Diazepam with Different Cyclodextrins in Formulations for Parenteral Use*, 60 PHARMAZIE 598 (2005) ("Holvoet-2005") |
| 2063 | Sila-On et al., *Influence of Incorporation Methods on Partitioning Behavior of Lipophilic Drugs into Various Phases of a Parenteral Lipid Emulsion*, 9 PHARMSCITECH 684 (2008) ("Sila-On-2008") |
| 2064 | D. J. Van Drooge et al., *Incorporation of Lipophilic Drugs in Sugar Glasses by Lyophilization using a Mixture of Water and Tertiary Butyl Alcohol as Solvent*, 93 J. OF PHARM. SCI. 713 (2004) ("Van Drooge-2004") |
| 2065 | L. M. A. Monzon & L. M. Yudi, *Voltammetric Analysis of Lipophilicity of Benzodiazepine Derivatives at the Water 1,2-dichloroethan Interface*, 495 J. OF ELECTROANALYTICAL CHEM. 146 (2001) ("Monzon-2001") |
| 2066 | M. Molero-Monfort et al., *Retention-activity Relationship Studies of Benzodiazepines by Micellar Liquid Chromatography*, 13 BIOMED. CHROMATOGRAPHY 394 (1999) ("Molero-Monfort-1999") |
| 2067 | M. Molero-Monfort et al., *Micellar Liquid Chromatography for Prediction of Drug Transport*, 870 J. OF CHROMATOGRAPHY 1 (2000) ("Molero-Monfort-2000") |
| 2068 | Neurelis Patent Family Tree |
| 2069 | Declaration of Mareen Donovan, Ph.D. in Support of Defendants' Responsive Claim Construction Brief, *Neurelis, Inc. v. Padagis LLC* |

| Exhibit | Description of Exhibits |
|---|---|
| | *et al.*, 1:24-cv-562, D.I. 88-28 (D. Del. August 22, 2025) ("Donovan-CC Decl.") |
| 2070 | Certified transcription of December 10-11, 2025, Volume I and II Deposition of Maureen Donovan, Ph.D. in *Padagis US LLC vs. Neurelis, Inc.*, IPR2025-00464, IPR2025-00465, IPR2025-00466 ("Donovan Transcript") |
| 2071 | *What is Log P and How Does It Predict Chemical Behavior?*, BIOLOGY INSIGHTS, (August 16, 2025), https://biologyinsights.com/what-is-log-p-and-how-does-it-predict-chemical-behavior/ ("Log P") |
| 2072 | Declaration of Dr. Marc Brown regarding U.S. Patent No. 8,895,546 |
| 2073 | NOT USED |
| 2074 | NOT USED |
| 2075 | Statutory Disclaimer for Claims 1-16 and 18-21 of '546 Patent |
| 2076 | Patent Owner Response, dated November 5, 2019 in *Aquestive Therapeutics, Inc. v. Neurelis, Inc.*, IPR2019-00451 |
| 2077 | U.S. Patent No. 12,268,664 (the "'664 Patent") |
| 2078 | Certificate of Correction for U.S. Patent No. 12,268,664 |
| 2079 | Defendants' Notice of Non-Party Subpoenas, *Neurelis, Inc. v. Padagis LLC et al.*, 1:24-cv-562, D.I. 63 (D. Del. May 13, 2025) |
| 2080 | Non-Party Inventors' Responses to Subpoenas (D. Del. May 27, 2025) |
| 2081 | Email from Board (Nov. 18, 2025) authorizing moving Due Date 1 (highlighting added) |

## I. INTRODUCTION

In its Motion to Strike (Paper 44, "Motion" or "Mot."), Petitioner requests that the Board strike the declarations of three third-party inventors: Messrs. Cartt, Mitchnick, and Hale (EX2045-EX2047). Petitioner's Motion should be denied.

First, Petitioner is silent on how these third-party inventor depositions are even relevant to its Petitioner Reply. Exhibits 2045-2047 were of narrow scope, which Petitioner agrees was limited to supporting Patent Owner's "argument that the Gwozdz prior art reference does not qualify as prior art" under 35 U.S.C. § 103(c)(2) (pre-AIA). Mot. at 2; *see* 37 C.F.R. § 42.53(d)(5)(ii) (limiting deposition "to the scope" of the declarations). Petitioner further states that due to the Board denying Patent Owner's motion for leave to correct the specification of the challenged patent, "any argument that Gwozdz should be excluded as prior art under 35 U.S.C. §103(c)(2) is now moot." Paper 43 at 1. There is no longer any reason to depose the inventors in this IPR proceeding, so the Board should deny Petitioner's Motion as moot.

Second, the declarations no longer affect the final written decision, so the Board can simply disregard them without expunging them.

Third, Petitioner has not addressed why the three declarations are subject to "routine discovery," rather than the "additional discovery" provisions of 37 C.F.R. § 42.51(b). Petitioner has also not explained why it is within the "interests of justice"

to take duplicative depositions of third-parties on a moot issue, as Petitioner already can depose these third-parties pursuant to its district court subpoena in Delaware.

Fourth, Patent Owner complied with the Board's orders and has provided deposition dates. The depositions were scheduled so that Petitioner and its co-defendants in the Delaware litigation could participate, without burdening the third-party inventors with duplicative depositions, and with sufficient time to be cross-used in the IPR proceedings. *See* EX1096.

## II. PROCEDURAL HISTORY

This Opposition is Patent Owner's first opportunity to substantially respond to Petitioner's contentions on the inventor depositions, as Petitioner has sent two emails to the Board on the matter without Patent Owner's ability to review. EX3003, EX3004. Accordingly, Patent Owner fills in missing details.

Petitioner's request to depose these third-party inventors—without any follow-through—is not unprecedented. In the Delaware litigation, Padagis filed subpoenas for Cartt, Mitchnick, and Hale on May 13, 2025. EX2079. The third-party inventors accepted service and, on May 27, 2025, responded that they were willing "to find a mutually acceptable date to conduct a video deposition." EX2080. Padagis did not follow up on its subpoenas from nearly a year ago, including through multiple case consolidations and fact-discovery extensions.

After the parties preliminarily agreed on deposition dates in this IPR proceeding, Petitioner did not file a notice of deposition. *See* 37 C.F.R. § 42.53(d)(4). Though the March 4-6 offered dates were withdrawn after the Board's February 6 Order, there was no scheduled deposition to formally cancel. Had Petitioner filed a notice of deposition and insisted on duplicative depositions, Patent Owner could have filed a motion to quash one of the notices, either in this proceeding or Delaware. *See* 37 C.F.R. § 42.53(d)(6); Fed. R. Civ. P. 45(d)(3)(A)(iv).

Patent Owner still attempted to accommodate Petitioner after the Board's February 6 order, to no avail. On February 19, Patent Owner offered Petitioner the ability to cross-use the Delaware depositions of these third-party inventors in the IPR proceedings. EX1096. This proposal was rejected by Petitioner because "there is no guarantee that any depositions of the declarants in the litigation would occur more than a week before [Petitioner's] reply in the IPR is due." EX1097. Petitioner did not request an extension of Due Date 2 in a manner that would have accommodated the deposition dates.[1]

---

[1] Patent Owner notes that, when the shoe was on the other foot, Petitioner's expert declarant, Dr. Donovan, was unavailable for deposition prior to Patent Owner's Due Date 1 brief. Patent Owner worked with Petitioner to move dates to accommodate the witness. *See* EX2081.

As of the day of this filing (April 13, 2026), Petitioner has still not accepted the most recently offered deposition dates (April 29, May 5, and May 7). Petitioner instead filed its motion to strike.

## III. THE MOTION TO STRIKE SHOULD BE DENIED AS MOOT

The declarations at issue (EX2045-EX2047) were exceedingly narrow in scope, and the only topic on which the third-party declarants could be deposed during this IPR proceeding—whether 35 U.S.C. § 103(c)(2) is available—has been foreclosed by the Board. Petitioner's Motion should be denied as moot, because the declarations no longer affect the outcome of the final written decision.

### A. EVIDENCE THAT DOES NOT AFFECT THE OUTCOME OF THE FINAL WRITTEN DECISION SHOULD NOT BE STRICKEN

Long ago, the Board provided a "Motion to Strike Dos and Don'ts," in which it advised litigants to "Explain why it matters" and to not "[f]ail to explain the importance of what you seek to strike."[2] The Board has followed this pragmatic approach, routinely denying such motions as "moot" when "th[e] evidence … does not affect the outcome of [the] decision." *See Infineon Techs. AG v. Feinics Amatech Teoranta*, IPR2022-00235, Paper 41 at 26 n.11 (P.T.A.B. June 12, 2023).

[2] "Motions to Exclude and Motions to Strike in AIA Trials" (June 7, 2018): https://www.uspto.gov/sites/default/files/documents/Boardside_Chat_Motions_to_Exclude_and_Motions_to_Strike_20180607.pdf.

For example, a patent owner sought to strike a new prior art reference, but the Board "den[ied] this motion to strike as moot because … Petitioner does not establish unpatentability by a preponderance of the evidence even if we consider this evidence." *Arashi Vision (U.S.) LLC v. GoPro, Inc.*, IPR2024-01186, Paper 50 at 31 (P.T.A.B. Dec. 10, 2025); *see Tesla, Inc. v. Autonomous Devices, LLC*, IPR2024-00745, Paper 43 at 47 (P.T.A.B. Oct. 21, 2025) (denying motion to strike petitioner's reply "as moot" because the Board did not find petitioner's arguments persuasive on the merits); *Streck, Inc. v. Ravgen*, IPR2021-01577, Paper 62 at 89 (P.T.A.B. Apr. 18, 2023) (denying motion to strike because the Board "do[es] not rely on the portions of [the disputed exhibit] or Patent Owner's arguments about them").

In another case, a party sought to introduce new evidence on the disputed capabilities of a person of skill. Because the Board did "not rely on any of the disputed evidence in our determination of the capabilities of a person of ordinary skill in the art, we deny Petitioner's Motion to Strike as moot." *Jiangsu Favored Nanotechnology Co. v. P2I Ltd.*, IPR2024-00380, Paper 28 at 23 n.12, 29 (P.T.A.B. Apr. 11, 2025); *see Apple Inc. v. Billjco LLC*, IPR2022-00131, Paper 37 at 14-15 (P.T.A.B. May 18, 2023) (denying motion to strike "as moot" because final written decision does not rely on the challenged declaration); *Intuit Inc. v. Samesurf, Inc.*, IPR2023-00339, Paper 42 at 97-98 (P.T.A.B. June 25, 2024) (denying motion to strike district court briefing "as moot" when the Board "ha[s] not relied on [it]").

Petitioner's Motion should likewise be denied as moot, because as explained below, the third-party declarations no longer affect the final written decision.

### B. THE THREE DECLARATIONS ARE LIMITED TO SECTION 103(C) AND DO NOT AFFECT THE FINAL WRITTEN DECISION

Patent Owner presented multiple independent reasons why Gwozdz (EX1009) does not qualify as prior art (in addition to substantive non-obviousness). Paper 28. These include *inter alia* that: (i) Gwozdz cannot obtain priority to its own provisional, so it does not pre-date the challenged patents; and (ii) Gwozdz does not qualify as prior art under 35 U.S.C. § 103(c)(2).

The three inventor declarations are relevant solely to a portion of this last argument: support for the existence of a joint research agreement under 35 U.S.C. §§ 103(c)(2)(A)-(B) (pre-AIA). Paper 28 at 18-25. Thus, any IPR depositions would be limited to this narrow scope. *See* 37 C.F.R. § 42.53(d)(5)(ii) ("scope of the examination is limited to the scope of the direct testimony"). Since advancing this argument, the Board twice has rejected Patent Owner's attempt to amend the specification to comply with 35 U.S.C. § 103(c)(2)(C). *See* Papers 36 and 39. Petitioner asserts that due to the Board denying Patent Owner's motion, "any argument that Gwozdz should be excluded as prior art under 35 U.S.C. §103(c)(2) is now moot." Paper 43 at 1. Thus, the declarations do not affect the final written decision to be issued by the Board, so the Motion should be denied as moot.

## IV. THE BOARD SHOULD NOT EXPUNGE THE DECLARATIONS

In view of the Board's orders concerning the certificates of correction, the Board can simply give the declarations no weight. The Board should not expunge them. The purpose of a motion to strike is "when a party believes the Board should disregard arguments or late-filed evidence in its entirety." *See* Trial Practice Guide § II.K (Dec. 12, 2025). Similar regulations allow the Board to give "no weight" to materials no longer needed for a final written decision. *See, e.g.,* 37 C.F.R. § 42.104(b)(5); 37 C.F.R. § 42.65(a).

Even Petitioner's cited cases hold that when granting a motion to strike a declaration, the appropriate remedy is for the Board to "not consider the affidavit" in a final written decision—not to expunge it. *See New World Med., Inc. v. Microsurgical Tech., Inc.*, IPR2020-01573, Paper 49 at 5 & n.3 (P.T.A.B. Nov. 5, 2021) ("Although Petitioner further requests that we expunge [the declaration], we decline to do so in interest of a complete record upon any appeal."); *Stride Rite Children's Grp. LLC v. Shoes by Firebug LLC*, IPR2017-01809, Paper 64 at 20-22 (P.T.A.B. Jan. 16, 2019) ("accord[ing] no weight" to declaration on a live issue where the declarant refused to be deposed, but not expunging it from the record). Expunging Exhibits 2045-2047 now would only mar the record for later Director review or appeal, which Patent Owner reserves the right to pursue after the final written decision. *See 3M Co. v. Bay Materials, LLC,* IPR2022-01214, Paper 77 at

40 (P.T.A.B. Jan. 16, 2024) ("Rather than striking any material from the record, we adopt a practical approach that preserves the record for appeal ….")

## V. BURDENING THE THIRD PARTIES WITH DUPLICATIVE DEPOSITIONS IS NOT WITHIN THE INTERESTS OF JUSTICE

Petitioner focuses its brief on declarants being made available under the procedures of "routine" discovery. *See, e.g.,* Mot. at 5. But "routine" discovery is only available for declarations "prepared for the proceeding." 37 C.F.R. § 42.51(b)(1)(ii) (emphasis added). Here, the inventor declarations were prepared for purposes of obtaining a certificate of correction from the Director under 35 U.S.C. § 255 and 37 C.F.R. § 1.71(g), which would necessarily be outside the context of this proceeding. *See Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345 (Fed. Cir. 2019). For example, Patent Owner emailed the Board for authorization to seek leave to file the certificate of correction on December 4, 2025 (EX3002) and filed the motion for leave December 23, 2025 (Paper 26). The inventors signed their declarations December 23-24, while Patent Owner was awaiting the Board's ruling.

Petitioner did not address how depositions of these third-parties would be in the interest of justice. *See* 37 C.F.R. § 42.51(b)(2)(i). As described above, the inventor depositions no longer affect the final written decision after the Board denied the motion for leave. It is overly burdensome to require each third-party inventor to sit for two depositions—one in district court and one in the IPR proceedings—particularly when questions concerning their IPR declarations could be covered in

the district court deposition. *See generally Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (P.T.A.B. Mar. 5, 2013) (precedential). A single deposition for each third-party inventor would reduce the burden on the third parties. The most recently offered (and rejected) dates of April 29, May 5, and May 7 would have accomplished this goal, allowing co-defendants in the district court to participate. Patent Owner has not outright refused cross examination of these third parties, it only sought to limit examination to reasonable means. EX1098.

## VI. PATENT OWNER PROVIDED DEPOSITION DATES

Despite the fact that the inventor declarations no longer affect a final written decision[3], Patent Owner sought to avoid the need for further briefing on this issue by balancing schedules—presenting the witnesses for a joint IPR/district court deposition so that other defendants could participate, while still being nearly three weeks before Due Date 5 and over five weeks before the hearing in this proceeding. *See* Paper 33. There is still ample time to take the depositions and, if needed, for

[3] This contrasts with Petitioner's cited cases, where declarations pertained to live issues for the Board to address. *See Adobe Inc. v. Rah Color Technologies, LLC*, IPR2019-00627, Paper No. 124 at 20-23 (P.T.A.B. Aug. 31, 2020); *Netflix Inc. v. DivX, LLC*, IPR2020-00646, Paper No. 34 at 5 (P.T.A.B. April 26, 2021).

Petitioner to request a supplemental reply brief limited to the § 103(c)(2) issue.[4] *See* Trial Practice Guide § II.K (stating that in lieu of a motion to strike, "a party may request authorization for further merits briefing … to address the merits of any newly-raised … evidence"); *Eli Lilly & Co. v. L.A. Biomed. Res. Inst.,* IPR2014-00752, Paper 71 at 2 (P.T.A.B. Apr. 12, 2019) (modifying schedule to include supplemental petitioner's reply). Petitioner still has not accepted the dates.

Petitioner points to "the differing protective orders in place in the IPR and the underlying litigation" (Mot. at 4), but does not explain how this matters. This concern is unfounded: the co-defendants in district court have requested and received production of the full scope of IPR materials; and Patent Owner offered cross-use of the district court depositions in the IPR proceedings. EX1096.

## VII. CONCLUSION

For the reasons discussed above, Patent Owner requests that the Board outright deny Petitioner's motion to strike Exhibits 2045-2047 or, in the alternative, that the Board at least decline to expunge Exhibits 2045-2047 from the record.

[4] Patent Owner would forgo a supplemental sur-reply brief were Petitioner's supplemental reply appropriately limited to the mooted Section 103(c)(2) issues.

Date: April 13, 2026

Respectfully submitted,

*/Michael Sitzman/*

Michael Sitzman (Reg. No. 42,150)
MCDERMOTT WILL & SCHULTE LLP
415 Mission St Suite 5600
San Francisco, CA 94105-2616
Tel: (628) 218-3917
msitzman@mwe.com

*Counsel for Patent Owner Neurelis, Inc.*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing PATENT OWNER'S OPPOSITION TO MOTION TO STRIKE was served on counsel of record for the Petitioner by filing this document through PTAB P-TACTS and by sending the same via electronic mail to the following addresses:

James P. Murphy
Reg. No. 55,474
Polsinelli PC
1000 Louisiana Street
Suite 6400
Houston, Texas 77002
Tel: (713) 374-1600
jpmurphy@polsinelli.com

Corey Casey
Reg. No. 66,950
Polsinelli PC
900 West 48th Place
Suite 900
Kansas City, Missouri 64112
Tel: (816) 572-4439
ccasey@polsinelli.com

Mark Deming
Reg. No. 69,263
Polsinelli PC
150 N. Riverside Plaza Suite 300
Chicago, IL 60606
mdeming@polsinelli.com

Chad A. Landon
*Provisionally Recognized Pro Hac Vice*
Polsinelli PC
1401 I St. NW Suite 800
Washington, DC 20005
clandmon@polsinelli.com

Dated: April 13, 2026

*/Michael Sitzman/*

Michael Sitzman (Reg. No. 42,150)
MCDERMOTT WILL & SCHULTE LLP
415 Mission St Suite 5600
San Francisco, CA 94105-2616
Tel: (628) 218-3917
msitzman@mwe.com

*Counsel for Patent Owner Neurelis, Inc.*