

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Aroma360, LLC,
Petitioner,

v.

AIR ESSCENTIALS, INC.
PATENT OWNER.

Case IPR2025-00706
Patent 10,583,449

**PETITIONER’S MOTION TO STRIKE EXHIBITS 2015 AND 2016
AND ARGUMENTS RELYING ON THOSE EXHIBITS**

I. RELIEF REQUESTED

Petitioner respectfully moves to strike Exhibits 2015 and 2016 and to strike or disregard Patent Owner’s arguments relying on those exhibits, specifically the arguments made at page 3 of Patent Owner’s sur-reply (“Patent Owner’s Sur-Reply”) and pages 12-15 of Patent Owner’s Corrected Revised Motion to Amend (“Patent Owner’s Revised MTA”).

Exhibit 2015 is an improper supplemental expert declaration from Dr. Gerald Micklow that Patent Owner filed with its sur-reply despite the prohibition against submitting a new declaration in a sur-reply. 37 C.F.R. § 42.23(b). Additionally, Exhibit 2015 is “supplemental evidence” that can only be filed in response to a Motion to Exclude – and no such motion has been filed. *See* Trial Practice Guide at II(K), (updated December 12, 2025) (“TPG”) (available at <https://www.uspto.gov/patents/ptab/trial-practice-guide>).

Exhibit 2016 is a second supplemental declaration from Dr. Micklow, filed with Patent Owner’s Revised MTA. But Patent Owner’s Revised MTA provides only blanket citations to the entire 33 paragraph declaration, failing to comply with the Board’s rules against improper incorporation by reference and the requirement to explain evidence. *See Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2024-00454, Paper 12 at 10 (P.T.A.B. Aug. 29, 2014) (informative); 37 C.F.R. § 42.22(a)(2) (motions require “a detailed explanation of the significance of the evidence”).

As such, neither exhibit is permitted by the rules for an IPR. Given the exhibits

should be stricken, the argument in the papers that purportedly cites to these exhibits should also be stricken.

II. BACKGROUND

Patent Owner's sur-reply identifies Exhibit 2015 as "Patent Owner's Supplemental Evidence in Response to Petitioner's Objection to Evidence." Petitioner timely objected to Dr. Micklow's original declaration, Exhibit 2002, under Federal Rule of Evidence 702. As Petitioner explained, Dr. Micklow testified during his deposition that he did not recall seeing or applying the parties' agreed claim constructions and instead applied his own understanding and thus his testimony does not help the Board understand the evidence or determine a fact in issue, is not based on sufficient facts or data, and does not reliably apply proper principles or methods. Paper 18, 1. In response to this objection, Patent Owner served "supplemental evidence" on Petitioner. Petitioner has not filed a motion to exclude in this proceeding that could trigger the filing of any "supplemental evidence."

Instead of waiting for a motion to exclude, Patent Owner filed its "supplemental evidence" with its sur-reply as Exhibit 2015. Exhibit 2015 is a supplemental declaration from Dr. Micklow that states that it was submitted to "clarify" his prior deposition testimony that Petitioner objected to. Ex. 2015 ¶¶ 2-5.

Patent Owner also filed Exhibit 2016, a "Supplemental Declaration of Dr. Gerald Micklow, PhD," which contains thirty-three paragraphs of supplemental testimony from Dr. Micklow. Patent Owner's Revised MTA relies on Exhibit 2016

to support its revised patentability arguments for substitute claims 20 and 21. All citations to Exhibit 2016 in Patent Owner's Revised MTA are identical blanket citations of "See, Exhibit 2016, Declaration of Gerald Micklow" without any pinpoint citations to specific paragraphs or any explanation of the declaration. See PO Revised MTA at 13.

III. ARGUMENT

A. Exhibit 2015 is Improper New Sur-Reply Evidence

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). Exhibit 2015 is not a deposition transcript. It is a new declaration from Patent Owner's expert. Patent Owner filed Exhibit 2015 with the sur-reply, listed it in the sur-reply exhibit list, and devoted Section II of the sur-reply to explaining that Patent Owner served and attached the new Micklow declaration as "supplemental evidence" in response to Petitioner's objection. PO Sur-Reply, 2-3. Rule 42.23(b) bars including, in a sur-reply, new evidence other than cross-examination deposition transcripts and does not have an exception to submit "supplemental evidence" with a sur-reply.

Moreover, Exhibit 2015 is prejudicial to Petitioner since it is intended to "clarify" Dr. Micklow's prior deposition testimony. Ex. 2015 ¶¶ 3, 5-6. Any such clarification should have taken place during Dr. White's deposition, not a post hoc declaration, to allow Petitioner an opportunity to address the testimony in its Reply.

Petitioner has no further briefing in which to address this supplemental testimony.

Petitioner deposed Dr. Micklow on his original declaration. Petitioner then used that deposition testimony to show that Dr. Micklow did not consider key patent disclosure, did not apply the parties' claim constructions, and used a non-stipulated understanding of "fluid dispersion." Reply, 1-5. Patent Owner now uses Exhibit 2015 to try and rehabilitate the admissions made by Dr. Micklow after Petitioner already filed its last brief.

Rule 42.23(b) does not permit Patent Owner to submit a new declaration with its sur-reply to explain away admissions made by its expert during his deposition. *See Mallinckrodt Pharmaceuticals Ireland Ltd. v. BioVie Inc.*, IPR2018-00974, Paper 34 at 9-10 (PTAB Nov. 13, 2019) (striking supplemental declaration filed with Patent Owner's sur-reply); *Lenovo Holding Co. v. DoDots Licensing Solutions LLC*, IPR2019-01278, Paper 37 at 31-32 (PTAB Jan. 19, 2021) (same).

Thus, the Board should strike Exhibit 2015 and disregard any portion of Patent Owner's Sur-Reply that relies on it, namely Section II of Patent Owner's Sur-Reply. *See, e.g.*, PO Sur-Reply, 3.

B. Exhibit 2015 is Not Properly Filed Supplemental Evidence

Patent Owner styled Exhibit 2015 as "supplemental evidence" under 37 C.F.R. § 42.64(b)(2). Ex. 2015, 2. But Rule 42.64(b)(2) merely permits the party relying on objected-to evidence to serve supplemental evidence within ten business days of the objection. The Trial Practice Guide confirms that supplemental evidence

“is not filed at the time of the objection, but simply served, and is filed only in support of an opposition to a motion to exclude.” TPG(II)(K) (emphasis added). Yet, no motion to exclude has been filed in this proceeding.

Patent Owner did not simply serve Exhibit 2015 and preserve it for the motion-to-exclude process. Patent Owner filed Exhibit 2015 with the Sur-Reply, included it in the Sur-Reply exhibit list, and addressed it in the Sur-Reply. PO Sur-Reply, 2-3. Patent Owner cannot use Rule 42.64(b)(2) to avoid the prohibition against submitting new expert testimony in a sur-reply.

Finally, Patent Owner’s counsel informed Petitioner’s counsel that it could file Exhibit 2015 in response to this motion to strike. To the extent Patent Owner attempts to do so, the Board should likewise strike any new submission of Exhibit 2015. Indeed, it would be bizarre if a party could moot a motion to strike by filing the very exhibit sought to be struck in opposition to that motion. Patent Owner’s counsel provided no rule supporting this theory.

Rather, the Trial Practice Guide identifies a single specific authorized use of supplemental evidence: it is filed in support of an opposition to a motion to exclude. TPG(II)(K). An opposition to a motion to strike does not authorize the filing of supplemental evidence.

C. Exhibit 2016 is Improper Incorporation by Reference and Not Explained by Patent Owner

Exhibit 2016 is cited in Patent Owner’s Revised MTA, but each citation is a

blanket cite to all thirty-three paragraphs of Exhibits 2016. *See* PO Revised MTA at 13 (“*See*, Exhibit 2016, Declaration of Gerald Micklow” without any pinpoint citations to specific paragraphs or explanation of the declaration.). There are no pinpoint citations to specific paragraphs in Exhibit 2016 and no explanation in Patent Owner’s Revised MTA how the declaration supports the arguments made in the Revised MTA. Such an approach violates the fundamental rule that motions must provide “a detailed explanation of the significance of the evidence.” 37 C.F.R. § 42.22(a)(2).

In addition, the Board should “not consider arguments that are not made” in the Reply “but are instead incorporated by reference to the cited paragraphs” of the expert declaration. *See Cisco*, IPR2014-00454, Paper 12 at 1; 37 C.F.R. § 42.26(a)(3) (improper to incorporate arguments by reference). That is precisely the case here. Indeed, other panels have found less egregious examples to constitute improper incorporation by reference. *See, e.g., Google LLC v. MindbaseHQ*, IPR2021-01252, Paper 41 at 37 (PTAB Jan. 6, 2023) (“reliance on seven paragraphs of [expert declaration] is an improper incorporation by reference, as [party] did not discuss that testimony” in its brief).

Moreover, *Cisco* is not limited to circumstances in which a party deliberately evades page limits. *Cisco* explains that a party may not incorporate arguments by reference into an expert declaration and must provide a detailed explanation of the significance of the evidence in the paper itself. *Cisco Sys.*, IPR2014-00454, Paper

12 at 10; *see also* 37 C.F.R. § 42.22(a)(2), 42.23(a). The Revised MTA repeatedly cites Exhibit 2016 generally, without paragraph pin cites, to support patentability arguments over Sevy, Goubet, Gao, and the asserted art generally. Revised MTA, 13-15. Petitioner is prejudiced by having to speculate and guess as to how Patent Owner believes Exhibit 2016 supports its arguments. In so doing, Petitioner is deprived of the protection under the rules that a party must provide “a detailed explanation of the significance of the evidence,” which is particularly important when it comes to expert declarations. 37 C.F.R. § 42.22(a)(2).

The Board should not permit Patent Owner blanket citations to new expert declaration without any explanation how the declaration supports Patent Owner’s positions. In addition the Board should strike the portions of Patent Owner’s Revised MTA that rely on these citations. See PO Revised MTA at 12-15.

IV. CONCLUSION

Petitioner respectfully requests that the Board strike Exhibits 2015 and 2016, strike Section II of Patent Owner’s Sur-Reply that relies on Exhibit 2015, and strike the portions of Patent Owner’s Revised MTA on pages 12-15 that relies on Exhibit 2016.

Date: June 15, 2026

Respectfully submitted,

/James P. Murphy/
James P. Murphy
Reg. No. 55,474

Polsinelli, PC
1000 Louisiana Street
Suite 6400
Houston, Texas 77002
Tel: (713) 374-1631

William A. Di Bianca
Reg. No. 58,653
Jordan T. Riviello
Reg. No. 72,515
Polsinelli PC
600 Third Avenue
42nd Floor
New York, NY 10016

Joshua L. Rayes
Reg. No. 74,645
Polsinelli LLP
Three Embarcadero Center
Suite 2400
San Francisco, CA 94115

CERTIFICATE OF SERVICE UNDER 37 CFR § 42.6(e)(4)

The undersigned hereby certifies that a copy of the accompanying Petitioner's Opposition to the Motion to Amend and all accompanying exhibits have been served on June 15, 2026, via electronic mail directed to the following counsel of record for the Patent Owner:

Peter A. Matos
pmatos@malloylaw.com

W. John Eagan
johnegan@malloylaw.com

Victor Bruzos
vbruzos@malloylaw.com

Rafay Asrar
rasrar@malloylaw.com

Tyler Litwak
tlitwak@malloylaw.com
litigation@malloylaw.com

/Ericka McNeil/

Ericka McNeil

Polsinelli PC
1000 Louisiana Street
Suite 6400
Houston, Texas 77002