

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AROMA360, LLC,

Petitioner,

v.

AIR ESSSENTIALS, INC.,

Patent Owner.

Case IPR 2025-00707
U.S. Patent No. 10,092,918

PATENT OWNER'S RESPONSE TO PETITIONER'S
MOTION TO STRIKE EXHIBITS 2015 AND 2016

I. INTRODUCTION

Petitioner’s Motion to Strike Exhibits 2015 and 2016, and Arguments Relying on the Exhibits [Paper 28] (herein after the “Motion”) seeks an “exceptional” remedy relative to what the documents represent. *See* Trial Practice Guide at II (K), (updated December 12, 2025) (“TPG”) (available at <https://www.uspto.gov/patents/ptab/trial-practice-guide>) (“striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely”). Indeed, relative to Exhibit 2015, the exhibit is a simple, eight-paragraph declaration [Exhibit 2015], that gives responsive context to arguments made in Petitioner’s Reply [Paper 21], makes information available and of record to the Board, and was timely served as supplemental evidence under 37 C.F.R. § 42.64(b)(2) in response to Petitioner’s Objection to Exhibit 2002 [Paper 19]. To this end, no argument within the Sur-Reply [Paper 26] relies on this exhibit. Relative to Exhibit 2016, the exhibit also contains eight paragraphs of opinion “intended to ‘provide additional clarification’” to prior arguments/opinions made by Patent Owner. Paper 28, Page 3. Accordingly, for the reasons described herein, the Motion should be denied.

II. LEGAL STANDARD

The Board’s Trial Practice Guide is clear, despite Petitioner’s citation to the exact section, it conveniently omits the Guide’s express statement that “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects

will be granted rarely.” *Id.* As are the cases that discuss striking portions of replies and sur-replies, which are largely absent from Petitioner’s Motion. Accordingly, as an initial point, “[t]here is... no blanket prohibition against the introduction of new evidence during an inter partes review proceeding.” *Ancor Pharms., Inc. v. Iancu*, 889 F.3d 1372 (Fed. Cir. 2018) (headnote 8, citing to 37 C.F.R. § 42.23(b) and *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359 (Fed. Cir. 2016) for the proposition that 37 C.F.R. § 42.23(b) is **not** violated when there is a response to arguments raised in a prior portion of the proceeding). That said, rebuttal evidence is allowable if it is responsive such that it is offered “to explain, repel, counteract, or disprove the evidence of the adverse party.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081-82 (Fed. Cir. 2015). Indeed, a reply can be proper if it is responsive and simply expands on previously raised arguments. *See Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1381 (Fed. Cir. 2018). Therefore, mere expansion on a previously argued rationale is proper in a reply/sur-reply. *See id.*

That said, to Petitioner’s credit, the Board does, from time-to-time, strike evidence/arguments made in furtherance of evidence submitted, but only in exceptional circumstances. For example, in the case cited by Petitioner, the Board ***struck some arguments predicated on a newly filed declaration, but declined to strike the supplemental declaration itself from the record***, instead disregarding the patent owner's reliance on it only as to petitioner's patentability challenges to the

originally issued claims, while permitting that same declaration to stand as to the patentability of the proposed substitute claims. Paper 28, Page 3 (citing *Mallinckrodt Pharmaceuticals Ireland Ltd. v. BioVie Inc.*, IPR2018-00974, Paper 34 at 9-10 (PTAB Nov. 13, 2019) with the parenthetical that contains the factually incorrect statement “striking supplemental declaration filed with Patent Owner’s sur-reply.”). If the Board were to follow suit here, Exhibit 2015 would remain on the record, and no arguments would be struck from the sur-reply, as no arguments rely on Exhibit 2015. Further, although “[i]t is improper to incorporate by reference arguments from one document into another document 37 C.F.R. § 42.6(a)(3). One purpose of the prohibition against incorporation by reference is to ***eliminate abuses that arise from incorporation.*** *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR 2014-00454, Paper 12 at 10 (P.T.A.B. Aug. 29, 2014) (emphasis added). Further, striking of evidence/argument is favorable in the exceptional circumstances of when prior art is asserted for the first time in a reply with new theories of unpatentability presented in light of that prior art or when a response provides new arguments or theories that depart from a petition/position taken previously. *See Henny Penny Corp. v. Frymaster LLC*, 938 F. 3d 1324, 1329-31 (Fed. Cir. 2019); *see also Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F. 3d 1272, 1286-87 (Fed. Cir. 2017).

III. ARGUMENT

Here, Patent Owner's inclusion of Exhibit 2015 (which itself is a mere eight-paragraph declaration) and Exhibit 2016 (a declaration containing a mere eight-paragraphs of substance) are ***not*** the type of filings that warrant an exceptional remedy.

A. Exhibit 2015

The inclusion of Exhibit 2015 is responsive to arguments made in the proceeding and within Petitioner's Reply, making it the type of filing the Board routinely finds allowable. *See* Paper 19; Paper 21, Pages 1-4. Indeed, within Paper 21, Pages 1-4, Petitioner dedicates an entire section and sub-sections to discussing how Patent Owner's Expert Declaration should be given no weight. In response, Exhibit 2015 states that "I submit this declaration solely to clarify the scope of my prior opinion and the basis opinions were offered." Exhibit 2015, Paragraph 2. The Exhibit, containing only an additional six (6) paragraphs, goes on to clarify points that Petitioner argued within its reply [Paper 21, Pages 1-4]. As such, the Exhibit should be seen as offered to "explain, repel, counteract, or disprove the evidence of the adverse party" or mere expansion on a previously argued rationale (*e.g.* the rationale of Dr. Micklow set forth in Exhibit 2002 and arguments predicated thereon). *Belden Inc.* 805 F.3d at 1081-82; *Ericsson Inc.*, 901 F.3d at 1381.

Therefore, to the extent that Petitioner relies heavily on arguing that Patent Owner's inclusion of Exhibit 2015 is violative of 37 CFR § 42.23(b), Patent Owner

points out that Petitioner omits the first portion of the rule, which provides that “[a] reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution[.]” as well as the corresponding case law described above. Further, despite Petitioner’s contention that clarifications (such as those in Exhibit 2015) to Dr. Micklow’s position “should have taken place during Dr. White’s deposition,” [Paper 28, Page 3] there is no such requirement in case law or code.

To this end, the Sur-Reply [Paper 26] is clear that Patent Owner does not present Exhibit 2015 for purposes of new argument, but rather for purposes of making it of record, which can and should be plainly understood as responsive to Petitioner’s Reply [Paper 21, Pages 1-4] and Objection to Dr. Micklow’s Declaration [Paper 19]. Indeed, only one paragraph in the Sur-Reply [Paper 26] mentions Exhibit 2015 and does so merely to note that it is being introduced; none of the arguments in the Sur-Reply rely upon it.

B. Exhibit 2016

Exhibit 2016 is also responsive to arguments made in the proceeding and within Petitioner’s Reply, making it the type of filing the Board routinely finds allowable. *See* Paper 21 (mentioning Gao-2 throughout). Indeed, within Paper 21, Petitioner characterizes Gao-2 at length and in light of the record, making arguments related to it in furtherance of Petitioner’s position. In response, Exhibit 2016 states

that “I submit this declaration to provide additional clarification regarding my prior opinions and to respond to certain issues raised by Petitioner and Dr. Christopher White concerning Gao-2 (Ex. 1042) and the “mixing chamber” limitations of U.S. Patent No. 10,092,918 (the “’918 Patent”).” Exhibit 2016, Paragraph 2. The Exhibit, containing only eight (8) paragraphs related to arguments made and responded to, goes on to clarify points that Petitioner argued within its reply [Paper 21 (mentioning Gao-2)] or that Patent Owner previously made. As such, the Exhibit should be seen as offered to “explain, repel, counteract, or disprove the evidence of the adverse party” or mere expansion on a previously argued rationale. *Belden Inc.* 805 F.3d at 1081-82; *Ericsson Inc.*, 901 F.3d at 1381.

Here again, to the extent that Petitioner relies on argument that Patent Owner’s inclusion of Exhibit 2016 is violative of 37 CFR § 42.23(b), Patent Owner points out that Petitioner omits the first portion of the rule, which provides that “[a] reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution[.]” as well as the corresponding case law described above. Further, despite Petitioner’s contention that clarifications (such as those in Exhibit 2016) to Dr. Micklow’s position “should have taken place during Dr. White’s deposition,” [Paper 28, Page 3] there is no such requirement in case law or code.

To the extent Petitioner attempts to rely on *Cisco* for the proposition that Exhibit 2016 incorporates additional arguments by reference, evades page limits, or forgoes explaining its significance, Patent Owner asserts that such an argument is outlandish. *See* Paper 28, Page 6; *contra Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR 2014-00454, Paper 12 at 10 (P.T.A.B. Aug. 29, 2014) (explaining that one purpose of the prohibition against incorporation by reference is to eliminate abuses that arise from incorporation). The Sur-Reply [Paper 26] contains two (2) citations to Exhibit 2016; accordingly, no additional arguments are necessarily incorporated by reference, and no page or word limits could be circumvented. Paper 26, Pages 15, 16.

Further, surprisingly, Petitioner contends that the sur-reply “repeatedly cites Exhibit 2016 generally, without paragraph pin cites, to support patentability arguments over Sevy, Goubet, Gao, and the asserted art generally.” Paper 19, Page 7. This is blatantly incorrect. The Exhibit does not contain any information related to Sevy, Goubet, or Gao (“Gao-2” is different from “Gao”). *See* Exhibit 2016. Further, and again, the Sur-Reply contains two (2) citations to Exhibit 2016, one of which has a citation to paragraphs 5-9, the other not requiring a specific citation because the Exhibit is a mere eight (8) paragraphs of substance and the citation to the exhibit generally should allow a reasonable reader to understand the nature of the citation. As such, no citations to specific paragraphs should be necessary, such

that the exhibit should *not* be so prejudicial to Petitioner that it must “speculate and guess as to how Patent Owner believes Exhibit 2016 supports its arguments.” Paper 28, Page 7. That said, to the extent helpful or necessary, Patent Owner seeks Board authorization or guidance to specifically point out the one citation to Exhibit 2016 that does not contain a citation to paragraphs.

IV. CONCLUSION

For the reasons set forth above, the Motion should be denied. Exhibit 2015 is an eight-paragraph declaration that does no more than clarify the scope and basis of Dr. Micklow's existing opinions; it was timely served as supplemental evidence under 37 C.F.R. § 42.64(b)(2) in response to Petitioner's Objection to Exhibit 2002, is responsive to Petitioner's Reply, and is not relied upon by any argument in the Sur-Reply. Exhibit 2016 is likewise a declaration containing eight-paragraphs of substance, offered to clarify Patent Owner's prior opinions and to respond to Petitioner's Reply arguments concerning Gao-2 and the “mixing chamber” limitations of the '918 Patent; it is cited only twice in the Sur-Reply, and those citations are readily identifiable rather than an improper incorporation by reference that would force Petitioner to “speculate and guess as to how Patent Owner believes Exhibit 2016 supports its arguments.” Both exhibits are the type of responsive rebuttal the Board routinely permits under 37 C.F.R. § 42.23(b), and neither introduces new prior art or new theories of the kind that might warrant striking. On

this record, striking, an exceptional remedy the Board grants only rarely, is unwarranted. Accordingly, denial of the Motion is respectfully requested.

Dated: June 22, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Response has been served in its entirety June 22, 2026, by causing the Response and accompany documents (if any) to be electronically mailed to the following attorneys of record for Petitioner:

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