

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AROMA360, LLC,
Petitioner,

v.

AIR ESSSENTIALS, INC.,
Patent Owner.

IPR2025-00707
Patent 10,092,918 B1

Before CARL M. DEFRANCO, ERIC C. JESCHKE, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

ORDER
Granting in Part Petitioner's Motion to Strike
37 C.F.R. § 42.5

I. BACKGROUND

On October 8, 2025, we instituted trial in this *inter partes* review proceeding involving Petitioner Aroma360, LLC and Patent Owner Air Essentials, Inc. Paper 10. Patent Owner timely filed its Sur-reply (Paper 26, “PO Sur-reply”) and Revised Contingent Motion to Amend the Claims (Paper 25), along with Exhibits 2015 and 2016.

With prior authorization (Ex. 3003), Petitioner filed a Motion to Strike Exhibits 2015 and 2016 and Arguments Relying on those Exhibits. Paper 28 (“Mot.”). Patent Owner timely filed its Opposition. Paper 29 (“Opp.”).

For the reasons below, we *grant* Petitioner’s Motion to Strike as to Exhibit 2015 and related arguments, and we *grant* Petitioner’s Motion to Strike as to Exhibit 2016, but we *deny* Petitioner’s request to disregard the Sur-reply arguments relying on Exhibit 2016. We address each of Petitioner’s arguments and Patent Owner’s responses below.

II. DISCUSSION

A. Exhibit 2015

In the Motion, Petitioner argues that Exhibit 2015 should be stricken from the record and the related arguments disregarded because (1) Board rules do not allow the filing of a declaration such as Exhibit 2015 with a patent owner’s sur-reply and (2) Patent Owner cannot file Exhibit 2015 as “supplemental evidence.” *See* Mot. 1. Because we are persuaded by both of Petitioner’s arguments, we strike Exhibit 2015 and disregard the related arguments in Patent Owner’s Sur-reply.

1. Whether Exhibit 2015 is Proper Sur-reply Evidence

We first address whether Patent Owner properly filed Exhibit 2015 as evidence with its Sur-reply. Filed the same day Patent Owner filed its Sur-

reply and its Revised Motion to Amend, Exhibit 2015 was not discussed in the Revised Motion to Amend and was discussed once in the Sur-reply:

Petitioner filed an Objection to Evidence [Paper 19], wherein Petitioner objected to Exhibit 2002 under FRE 702. In response, on April 15, 2026 Patent Owner (“PO”) served supplemental evidence in response to Petitioner’s Objection to Evidence, namely, a Declaration of Micklow, each document of which is attached hereto as Exhibit 2015.

PO Sur-reply 3 (§ II). Petitioner argues that we should strike Exhibit 2015 from the record and disregard the portion of the Sur-reply discussing it (quoted above), in part, because 37 C.F.R. § 42.23(b) precludes filing such evidence with a patent owner’s sur-reply. *See* Mot. 3–4. Patent Owner responds that Rule 42.23(b) *does* allow a filing such as Exhibit 2015 because it responds to Petitioner’s Reply. Opp. 1–5. We agree with Petitioner.

Rule 42.23(b) provides, in relevant part: “A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” The *first* clause in this sentence limits a sur-reply to *only* those arguments responsive to a reply, but, contrary to Patent Owner’s position, does not allow *any* argument and evidence merely because they are responsive. *Cf.* Opp. 4–5.¹

The *second* clause in the quoted sentence from Rule 42.23(b) (following “and”) *directly contradicts* Patent Owner’s position, expressly

¹ Patent Owner quotes the prior sentence in Rule 42.23(b), which provides: “A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.” *See* Opp. 4–5. At issue here, however, are arguments and evidence relating to Patent Owner’s Sur-reply; and a “sur-reply” is expressly addressed in the portion of Rule 42.23(b) quoted above.

precluding filing with a sur-reply any “new evidence *other than* deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23(b) (emphasis added). As argued by Petitioner, Exhibit 2015 is a new declaration from Patent Owner’s declarant, Dr. Micklow, which does not fall into the second clause’s exception. Mot. 3 (“Exhibits 2015 and 2016 are not deposition transcripts. They are new declarations from Patent Owner’s expert.”); *see also* 37 C.F.R. § 42.61(a) (“Evidence that is not . . . filed in accordance with this subpart is not admissible.”).

Further undermining Patent Owner’s arguments is that the Federal Circuit decisions relied on for the proposition that Exhibit 2015 should be allowed involved markedly different facts. *See* Opp. 2–3 (citing six Federal Circuit decisions). Specifically, the cited decisions all addressed whether either argument or evidence (or both) in a *petitioner’s reply* properly responded to a *patent owner’s response*; in contrast, here, Patent Owner is arguing that argument and evidence in Patent Owner’s Sur-reply should be allowed merely because they respond to the Petitioner’s Reply. *Compare Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380–81 & n.8 (Fed. Cir. 2018); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081–82 (Fed. Cir. 2015); *Ericsson Inc. v. Intell. Ventures I LLC*, 901 F.3d 1374, 1380–81 (Fed. Cir. 2018); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1329–31 (Fed. Cir. 2019); *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017), *with* Opp. 4 (“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.”). This line of argument, however, ignores the

express preclusion in Rule 42.23(b) *squarely addressing patent owner sur-replies*—that a sur-reply “may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness”—which the Federal Circuit had no reason to address in the decisions cited by Patent Owner in its Opposition here.

For these reasons, we determine that Exhibit 2015 is not properly filed sur-reply evidence under 37 C.F.R. § 42.23(b).

2. *Whether Exhibit 2015 is Properly
Filed Supplemental Evidence*

Petitioner also argues that, on the facts here, Board rules and the Trial Practice Guide do not support the *filing* of Exhibit 2015 as supplemental evidence. Mot. 1–3, 4–5. Patent Owner counters by asserting that filing Exhibit 2015 “makes information available and of record to the Board” that Patent Owner “timely served as supplemental evidence under 37 C.F.R. § 42.64(b)(2).” Opp. 1; *see also* PO Sur-reply 3 (presenting Exhibit 2015 as “supplemental evidence”). Specifically, Patent Owner appears to contend that Exhibit 2015 should be allowed into the record *because* it was served as supplemental evidence. Opp. 1. Supporting this understanding, the title of Exhibit 2015, as filed, is “Patent Owner’s Supplemental Evidence in Response to Petitioner’s Objection to Evidence.” Ex. 2015 (capitalization removed). On this issue, we are persuaded by Petitioner’s argument.

Both Petitioner and Patent Owner agree on the relevant facts. Petitioner timely objected to Patent Owner’s Exhibit 2002 (the Declaration of Dr. Micklow filed with the Patent Owner’s Response). Opp. 1; Mot. 1–2; Paper 19 (Petitioner’s Objection). In response, Patent Owner properly *served* on Petitioner as supplemental evidence the document now in the record as Exhibit 2015. Opp. 1; Mot. 2. Thus far, the process followed by

the parties tracks with Rules 42.64(b)(1) (addressing objections to evidence) and 42.64(b)(2) (addressing serving supplemental evidence in response to an objection). *See also* PTAB Trial Practice Guide (online version)² (“TPG”) § II.K (“Challenging Admissibility; Motions to Exclude; Motion to Strike”).

Patent Owner’s subsequent *filing* of Exhibit 2015 as alleged supplemental evidence, however, does not find support in our Rules or the Trial Practice Guide. As noted by Petitioner, the Trial Practice Guide makes clear that supplemental evidence is *filed* only in support of an opposition to a motion to exclude: “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. *See* 37 C.F.R. §§ 42.64(a), 42.64(b)(2).” TPG § II.K, *cited at* Mot. 1, *quoted at* Mot. 5. But here, because Petitioner has not filed a motion to exclude (which would have been due July 9, 2026 (Paper 27 at 7)), Patent Owner had no basis to *file* Exhibit 2015 as supplemental evidence. Mot. 2 (“Petitioner has not filed a motion to exclude in this proceeding that could trigger the filing of any ‘supplemental evidence.’”), 1 (arguing that “Exhibit 2015 is ‘supplemental evidence’ that can only be filed in response to a Motion to Exclude – and no such motion has been filed”).

Patent Owner contends that Exhibit 2015 “is *not* the type of filing[] that warrant[s] an exceptional remedy”—i.e., being stricken. Opp. 4; *see also* TPG § II.K (Motion to Strike) (“In most cases, 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 or sur-reply. As

² Available at www.uspto.gov/patents/ptab/trial-practice-guide.

such, striking the entirety or a portion of a party's brief is an *exceptional remedy* that the Board expects will be granted rarely.” (emphasis added)). We disagree. As discussed above, Patent Owner has not identified *any* basis to allow the filing of Exhibit 2015 with Patent Owner's Sur-reply in this proceeding. Moreover, the only portion of Patent Owner's Sur-reply discussing Exhibit 2015 makes no substantive arguments for which that exhibit is relied on in support. *See* PO Sur-reply 3. Indeed, Patent Owner admits as much. *See* Opp. 1 (discussing Exhibit 2015 and stating that “no argument within the Sur-Reply . . . relies on this exhibit”). Although not necessary to the analysis, striking Exhibit 2015 will not remove from consideration any substantive arguments by Patent Owner.

For these reasons, we grant Petitioner's Motion to Strike Exhibit 2015 and the related argument in Section II of Patent Owner's Sur-reply.

B. Exhibit 2016

*1. Whether Exhibit 2016 is
Proper Sur-reply Evidence*

We next address whether Patent Owner properly filed Exhibit 2016 as evidence with its Sur-reply.³ Filed the same day Patent Owner filed its Sur-reply and its Revised Motion to Amend, Exhibit 2016 was not discussed in the Revised Motion to Amend and was cited three times in the Sur-reply: (1) a general citation (with no specific paragraphs identified) on page 15 of

³ Patent Owner does not argue that Exhibit 2016 is properly filed as supplemental evidence.

the Sur-reply; (2) a citation to paragraphs 5–9 on page 16; and (3) a citation to paragraphs 5–12 on page 16.⁴

Petitioner argues that we should strike Exhibit 2016 from the record because 37 C.F.R. § 42.23(b) precludes filing such evidence with a patent owner’s sur-reply. *See* Mot. 3–4 (discussing Exhibit 2015 along with Exhibit 2016 on this issue). Patent Owner responds that Rule 42.23(b) *does* allow a filing such as Exhibit 2016 because it responds to Petitioner’s Reply. Opp. 1–2, 5–8. We agree with Petitioner.

As discussed above (*see* § II.A.1), Rule 42.23(b) *directly contradicts* Patent Owner’s position, expressly precluding filing with a sur-reply any “new evidence *other than* deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. § 42.23(b) (emphasis added). As argued by Petitioner, Exhibit 2016 is a new declaration from Patent Owner’s declarant, Dr. Micklow, which does not fall into the second clause’s exception. Mot. 3 (“Exhibits 2015 and 2016 are not deposition transcripts. They are new declarations from Patent Owner’s expert.”).

And again, the Federal Circuit decisions relied on by Patent Owner for this issue all addressed whether either argument or evidence (or both) in a *petitioner’s reply* properly responded to a *patent owner’s response*, whereas, here, Patent Owner is arguing that argument and evidence in Patent Owner’s Sur-reply should be allowed merely because they respond to the Petitioner’s Reply. *See* Opp. 2–3 (citing six Federal Circuit decisions), 6 (again citing

⁴ Although the “*Id*” beginning the third citation seemingly indicates that the citation is to the preceding Exhibit 1042, the formatting of the paragraph numbers and the subject matter discussed indicate that Patent Owner likely intended the third citation to refer to Exhibit 2016. *See* PO Sur-reply 16 (citing “Ex. 2016, ¶¶ 5-9”; “Ex. 1042, ¶ 0036”; and then “*Id*, ¶¶ 5-12”).

two of the same decisions); *see also* Opp. 5 (“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.”).

For these reasons, we determine that Exhibit 2016 is not properly filed sur-reply evidence under 37 C.F.R. § 42.23(b). Thus, we grant Petitioner’s Motion to strike Exhibit 2016.

*2. Whether to Strike the Arguments
Relying on Exhibit 2016*

We turn now to Petitioner’s request for us to disregard the arguments in Patent Owner’s Sur-reply relying on Exhibit 2016 (*see* PO Sur-reply 15–16). Mot. 1. In support of this request, Petitioner contends that (1) Patent Owner violated Rule 42.22(a)(2)⁵ by not adequately explaining the significance of the cited information in Exhibit 2016 in the Patent Owner Sur-reply and (2) Patent Owner violated Rule 42.6(a)(3)⁶ by asking the Board to consider arguments made in Exhibit 2016 and improperly incorporated by reference into the Patent Owner Sur-reply. *See* Mot. 6–7. Because we are not persuaded by either of Petitioner’s arguments, we will consider the three sentences at issue in the Patent Owner Sur-reply (albeit with Exhibit 2016 stricken from the record, as discussed above).

⁵ Rule 42.22(a)(2) provides, in relevant part: “Each . . . motion must be filed as a separate paper and must include: . . . (2) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.”

⁶ Rule 42.6(a)(3) provides: “***Incorporation by reference; combined documents.*** Arguments must not be incorporated by reference from one document into another document. Combined motions, oppositions, replies, or other combined documents are not permitted.”

As an initial matter, Petitioner incorrectly contends that each citation to Exhibit 2016 in Patent Owner's Sur-reply "is a blanket cite to all twelve paragraphs of Exhibits 2016." Mot. 6. This mistaken understanding is the basis for Petitioner's argument that the discussion of Exhibit 2016 in Patent Owner's Sur-reply violates both Rule 42.22(a)(2) and Rule 42.6(a)(3). *See* Mot. 1 ("Patent Owner's sur-reply provides only blanket citations to Exhibits 2015 and 2016, *thereby* failing to comply with the Board's rules against improper incorporation by reference and the requirement to explain evidence." (emphasis added)). To the contrary (and as summarized above), however, although one of the citations is to the entire declaration (PO Sur-reply 15), the other two provide specific paragraph citations (*id.* at 16). Opp. 7 (stating that Petitioner's argument that the Sur-reply lacks "paragraph pin cites" is "blatantly incorrect").

More importantly, however, and as discussed above (*see* § II.B.1), we determine that Exhibit 2016 is not properly filed sur-reply evidence under 37 C.F.R. § 42.23(b), and thus, we grant Petitioner's Motion to Strike Exhibit 2016. Because we will not consider Exhibit 2016 in this proceeding, there is no concern as to either (1) Patent Owner's Sur-reply having inadequate explanation of the significance of evidence *no longer in the record* (*see* 37 C.F.R. § 42.22(a)(2)) or (2) improperly incorporating by reference into Patent Owner's Sur-reply argument *no longer in the record* (*see* 37 C.F.R. § 42.6(a)(3)). Accordingly, we deny Petitioner's Motion to strike or disregard the arguments in Patent Owner's Sur-reply that rely on Exhibit 2016.

It is hereby:

ORDERED that Petitioner's Motion to Strike is *granted* as to Exhibit 2015;

FURTHER ORDERED that Exhibit 2015 will be stricken from the record;

FURTHER ORDERED that the panel will not consider the discussion in Section II of Patent Owner's Sur-reply, and

FURTHER ORDERED that Petitioner's Motion to Strike is *granted* as to Exhibit 2016;

FURTHER ORDERED that Exhibit 2016 will be stricken from the record; and

FURTHER ORDERED that the panel will consider the discussion on pages 15 and 16 of Patent Owner's Sur-reply relying on Exhibit 2016.

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