

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3D SYSTEMS CORPORATION AND 3D SYSTEMS, INC.,

Petitioner

v.

INTREPID AUTOMATION, INC.,

Patent Owner

IPR2025-01242

U.S. Patent No. 11,338,511

**PATENT OWNER'S MOTION TO EXCLUDE
PURSUANT TO 37 C.F.R. §§ 42.64(c)**

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MOTION AND INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Intrepid Automation, Inc. (“Intrepid”) moves to exclude the following:

EX1035 Declaration of William J. Allen *Intrepid Automation, Inc. v. 3D Systems Corporation et al*, Dkt. 27-5, 24-cv-02262-AGS-DDL (SDCA);

Set forth below is the identification of where in the record the above-listed exhibit was relied upon by Petitioner 3D Systems Corporation and 3D Systems, Inc. (“3DS”), where in the record Intrepid objected to the exhibit, and Intrepid’s explanation of each objection.

ARGUMENT

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.64(c), the Federal Rules of Evidence (FRE), the Board's Rules, and the Consolidated Trial Practice Guide (2019), Intrepid respectfully moves to exclude EX1035 as inadmissible for violating 37 C.F.R. §§ 42.61 and 42.23(b) and the FRE.

3DS filed and served EX1035 on June 15, 2026 in connection with its Petitioner Reply. Paper 30. Specifically, Petitioner relied upon the declaration of Dr. William J. Allen (EX1035), who served as an expert witness for Intrepid in a concurrent trade secret litigation matter between Intrepid and 3DS. Paper 30, pp. 11-12.

Patent Owner timely objected to the exhibit on June 19, 2026, within five days of Petitioner's service of EX1035. Paper 32, pp. 1-2. Intrepid objected to EX1035 as irrelevant under F.R.E. 401/402, among other reasons.

Petitioner included EX1035 as evidence of an alleged contradiction with Patent Owner's arguments in the Patent Owner Response. Paper 30, pp. 11-12. This attempt fails because Dr. Allen's cited testimony in EX1035 does not discuss or interpret Skholnik, applies a legal standard different from anticipation or obviousness, and demonstrates an improper attempt to change invalidity theories

post-institution. Because EX1035 is not evidence of any contradiction, and does not discuss Skholnik (or Sekine for that matter) in relation to an irradiance mask, EX1035 is irrelevant and misleading.

II. STATEMENT OF REASONS FOR RELIEF REQUESTED

“[A] party may move to exclude evidence, whether as improper under the response-only regulation, under the [Consolidated] Trial Practice Guide's advice, or on other grounds.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015). Other bases for excluding exhibits exist in the Federal Rules of Evidence. See 37 C.F.R. § 42.62 (“[T]he Federal Rules of Evidence shall apply to a proceeding.”). Exercising its discretion, the Board may “exclude the ... evidence in [its] entirety, or alternatively, decline to consider the ... related evidence.” *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 79, at 3, 2013 WL 8699189 (P.T.A.B. Aug. 9, 2013).

For the reasons set forth below, EX1035 is inadmissible under the Federal Rules of Evidence and 37 C.F.R. § 42.23(b).

a. Exhibit 1035 Should Be Excluded in Whole or in Part Under F.R.E. 401 or F.R.E. 402 Because it is Irrelevant to this Proceeding.

In Ground 1, Petitioner alleges that certain claims of the '511 Patent are anticipated by Skholnik. In support, Petitioner cites page 32 of EX1035 for the

proposition that Skholnik allegedly teaches an irradiance mask. Paper 30, pp. 11-12. Yet nowhere in this cited section—or anywhere else in EX1035—does Dr. Allen discuss, interpret, or even mention Skholnik in connection with an irradiance mask. Critically, Dr. Allen never states or suggests that Skholnik describes an irradiance mask. Thus, EX1035 simply does not support Petitioner’s anticipation argument. Indeed, nothing in Dr. Allen’s testimony contradicts Intrepid’s position that Skholnik fails to teach an irradiance mask—rendering EX1035 irrelevant under F.R.E. 401.

The Federal Rules of Evidence apply to this proceeding. 37 C.F.R. § 42.62. “Irrelevant evidence is not admissible.” Fed. R. Evid. 402. The Board has excluded, as irrelevant, briefs and other documents stemming from District Court litigation when the District Court document is associated with an issue unrelated to *inter partes* review (“IPR”). *Samsung Electronics Co., Ltd. v. Huawei Technologies Co., Ltd.*, IPR2017-01487, Paper 45, p. 25 (P.T.A.B. Dec. 10, 2018). Notably, the District Court litigation matter in which Dr. Allen submitted this declaration is not a patent infringement case involving the ’511 Patent. In fact, it is not a patent case at all; it is a trade secret dispute. Dr. Allen’s testimony is not merely associated with an issue unrelated to *inter partes* review; it is testimony unrelated to *any* patent law issue. The Board gains nothing from considering EX1035, and it should be excluded under F.R.E. 401 or 402. At minimum, if the Board declines to

exclude EX1035, it should afford the exhibit no weight given that Dr. Allen did not address Skholnik or apply any standard relevant to patent invalidity.

Moreover, Dr. Allen's statements about an irradiance mask are specific to references in the field of display devices, not stereolithography. Dr. Allen cites U.S. Patent No. 9,497,447, and quotes the abstract saying, for example, "calibration of color and intensity in a display system." EX1035, pp. 22-23. Dr. Allen also discusses, in the irradiance mask section, U.S. Patent No. 7,079,157, a patent titled "Matching the edges of multiple overlapping screen images." EX1035, pp. 4 and 24. EX1035 thus presents expert testimony from a different technological context and fails to make any fact of consequence to this proceeding more or less probable. F.R.E. 401.

b. EX1035 Should Be Excluded in Whole or in Part Under 37 C.F.R. § 42.104(b)(4) for using expert testimony to supply a missing limitation.

Petitioner cites to EX1035 to supply a missing claim limitation in clear violation of 37 C.F.R. § 42.104(b)(4); *see also* July 31, 2025 Director Memorandum titled "Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in *Inter Partes* Review." The Director's July 31, 2025 memorandum specifically stated "... expert testimony... may not use used to supply a missing claim limitation." *Id.* Here, Petitioner tries to

do exactly that: Skholnik fails to teach an irradiance mask, so Petitioner attempts to fill that missing limitation with Dr. Allen’s expert testimony. EX1032 is not a “prior art patent or printed publication” because the Allen Declaration was drafted after the priority date of the ’511 Patent and does not qualify as a printed publication under MPEP § 2128. While not all evidence must qualify as a prior art patent or printed publication to enter the record, the Federal Circuit has limited such evidence only to support a motivation to combine or to demonstrate the knowledge of a person having ordinary skill in the art. *Unification Techs. LLC. V. Micron Tech. Inc.*, 2024 WL 3738401, at *7 (Fed. Cir., Aug. 9, 2024). However, neither motivation to combine nor knowledge of a person having ordinary skill in the art supports a finding of *anticipation*. Indeed, those are obviousness considerations only. Thus, EX1035 was submitted in violation of the PTAB’s evidentiary limitations, as set by the Federal Circuit and the Director’s Memorandum

c. EX1035 Should Be Excluded in Whole or in Part Under F.R.E. 401 or F.R.E. 402 Because Petitioner Uses EX1035 to Change Invalidity Grounds Post-Institution.

Additionally, EX1035 should be excluded because it is an improper attempt by Petitioner to change invalidity grounds post-institution. 37 C.F.R. § 42.23(b). The Federal Circuit has held that a petitioner may not attempt to add additional

grounds for unpatentability in a Reply. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016). Moreover, under 37 C.F.R. § 42.23(b), a “reply may only respond to arguments raised in the corresponding opposition” See also Consolidated Trial Practice Guide (2019) at 74 (“Respond, in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing.”).

In its Petition, Petitioner asserted that certain claims were *anticipated* by Skholnik. Paper 1, p. 11. In its Reply, recognizing that Skholnik fails to disclose an irradiance mask, Petitioner pivoted to arguing that an irradiance mask would have been obvious over Skholnik in view of common knowledge in the art, as allegedly reflected by the Allen declaration. Paper 30, pp. 11-12. Specifically, Petitioner argued that “many prior art publications... describe the ‘well-familiar process’ of irradiance normalization” and that “it was well known to a POSITA how to carry out irradiance normalization before the priority date of the ’511 Patent.” *Id.* These are not arguments that Skholnik itself discloses an irradiance mask; they are arguments that such knowledge was supposedly common to a POSITA. That is an unequivocal obviousness argument. See MPEP § 2144.03; *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017) (“[A] finding that a combination of prior art would

have been ‘common sense’ or ‘intuitive’ is no different than merely stating the combination ‘would have been obvious.’”).

This is a clear violation of 37 C.F.R. § 42.23(b). The *only* purpose EX1035 serves in this proceeding is to support Petitioner’s impermissible obviousness pivot—an argument that was never instituted and cannot be raised for the first time in a Petitioner Reply. Petitioner cannot use the Allen declaration to fill the gaps in what Skholnik discloses, particularly when Dr. Allen never discussed Skholnik in connection with an irradiance mask. EX1035 should be excluded.

Respectfully submitted,

MILLER JOHNSON/IRWIN IP

Dated: August 20, 2026

/Nathan P. Sportel/

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CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e), a true and correct copy of **PATENT OWNER'S MOTION TO EXCLUDE** is being served electronically on August 20, 2026, to the e-mail addresses shown below:

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