

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVATION MEDICAL, INC.,

Petitioner,

v.

EMKINETICS, INC.,

Patent Owner

Review No. PGR2024-00043

U.S. Patent No. 11,844,943

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE**

Pursuant to 37 C.F.R. §§ 42.64, 42.223, and the Board’s Scheduling Order (Paper 9 at 11-12), Patent Owner EMKinetics, Inc. (“Patent Owner”) submits this Reply (Paper 24) to Petitioner’s Opposition (Paper 23) to Patent Owner’s Motion to Exclude (Paper 22) Exhibits 1085-90 and arguments based thereon. In Opposition (Paper 23), Petitioner asserts that 37 C.F.R. § 42.23(b) authorized the submission of Exhibits 1085-90 with its Reply (Paper 12).

However, this rule provides that a reply may only respond to certain prior arguments. Specifically, it 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.” 37 C.F.R. § 42.23(b). The rule further provides that a *sur-reply* “may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” *Id.* However, the rule does *not* provide that any evidence may be submitted with a reply. *Id.* It certainly does not authorize a petitioner to file new evidence that should have been included with the petition. *See id.*

The Consolidated Trial Practice Guide¹ (“CTPG”) is consistent with these observations concerning 37 C.F.R. § 42.23(b). The CTPG explains that this rule, cited by Petitioner, circumscribes which subject matter is proper in reply and

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>

which subject matter is not. CTPG at 73. Specifically, pursuant to 37 C.F.R.

§ 42.23(b), a reply may not “proceed in a new direction with a new approach as compared to the positions taken in a prior filing.” CTPG at 74.

But what happened here is that Petitioner tried to submit evidence in Reply (Paper 12) that it should have included with its case-in-chief, *i.e.*, the Petition (Paper 2). On this topic, the CTPG flatly states, “Petitioner may not submit new evidence or argument in reply that it could have presented earlier.” CTPG at 73. While the CTPG notes that “[a] party also may submit rebuttal evidence in support of its reply,” it states that, in so doing, the opposing party may, among other things, move to exclude such evidence, as Patent Owner seeks here. *Id.* While Patent Owner does not specifically contend that Petitioner raised an entirely “new issue” in Reply, the CTPG notes that “[e]xamples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of [a] ... claim” (*id.* at 74), which would include a *prima facie* case that a reference was publicly accessible.²

² Petitioner cites *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 14-15 (PTAB December 20, 2019) for the proposition that, “if a patent owner challenges a reference’s status as a printed publication, the petitioner may submit additional evidence with its reply to support the reference’s prior art status.” (Paper 23 at 3). While *Hulu* may be precedential, this statement in *Hulu* is, at a minimum, *dicta* and not controlling here.

Here, Petitioner does not assert that it could not have submitted Exhibits 1085-90 much earlier in these proceedings. There is no reason, for example, that the attorney declaration at issue (Ex. 1090) could not have been submitted with the Petition. There is no reason, by way of further example, that the recently obtained digital documents that constitute Exhibits 1085-89 could not have been submitted with the Petition. Petitioner offers no such reasons in opposing the Motion.

Petitioner cannot cast evidence it should have submitted with the Petition as reply evidence. The purpose of proper rebuttal evidence would be to challenge new issues raised, or possibly evidence submitted, by Patent Owner in its Response to the Petition. *See* 37 C.F.R. 42.23(b). Here, Patent Owner did not submit any new evidence with its Response (Paper 11), so that cannot be the basis for inclusion. Patent Owner also did not raise a new issue that would allow such rebuttal evidence. Rather, Patent Owner argued in its Response (Paper 11) that Petitioner's case-in-chief, *i.e.*, the Petition (Paper 2), failed to establish the public accessibility of numerous references, *e.g.*, certain relied-upon documents even lacked the hallmarks necessary to make out a *prima facie* case of public accessibility. This is not a new issue. It is instead points out a failure to carry the burden of proof in the case-in-chief. This argument sounds entirely in evidence and the orderly presentation of evidence at trial and is thus appropriate for a motion to exclude.

With reference to Petitioner's final argument that the Motion to Exclude was procedurally improper, Petitioner notably fails to identify any "missed deadline" or other procedural mechanism by which Patent Owner should have earlier filed a motion to exclude evidence. The Board's Scheduling Order (Paper 9 at 11-12) authorized and called for all motions to exclude by October 8, 2025. Patent Owner's October 8, 2024, Motion to Exclude (Paper 2) was both timely and authorized, and thus procedurally proper.

As discussed above, Patent Owner does *not* contend that Petitioner's Reply (Paper 12) exceeded the scope of a proper reply within the meaning of 37 C.F.R. § 42.23(b). Thus, the instruction in the CTPG, cited by Petitioner (Paper 23 (citing CTPG at 79)), that motions to exclude should not address the scope of reply is inapposite. This is not such a motion. The reality is that Petitioner submitted untimely and unauthorized evidence that should have and could have been submitted with the Petition to support its case-in-chief. It is for this reason, *see, e.g.,* 37 C.F.R. § 42.233(b), that the exhibits and arguments identified in Patent Owner's Motion (Paper 22 at 9) should be excluded. Petitioner's Opposition (Paper 23) does nothing to disturb this conclusion.

Respectfully submitted,

Date: October 22, 2025

/David Gerasimow/

David Gerasimow, Reg. No. 57,512

The Law Offices of

David A. Gerasimow, P.C.

153 W. Ohio St., Ste. 407

Chicago, IL 60654

T: 312-919-4254

E: dave@gerasimowlaw.com

Eran Steinberg, Reg. No. 53,637

137 Granville Way

San Francisco, CA 94127

T: 415-902-7026

E: venture@erasteinberg.com

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on October 22, 2025, a complete and entire copy of this Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Exclude Evidence was provided via email to the Petitioner by serving the email correspondence addresses of record as follows:

Todd R. Tucker, Reg. No. 40,850
Kyle T. Deighan, Reg. No. 75,525
Brynna M. W. Wasserman, Reg. No. 76,700
CALFEE, HALTER & GRISWOLD LLP
The Calfee Building
1405 East Sixth Street
Cleveland, OH 44114
ttucker@calfee.com
kdeighan@calfee.com
bwasserman@calfee.com

Date: October 22, 2025

/David Gerasimow/
David Gerasimow, Reg. No. 57,512
The Law Offices of
David A. Gerasimow, P.C.
153 W. Ohio St., Ste. 407
Chicago, IL 60654
T: 312-919-4254
E: dave@gerasimowlaw.com