Trials@uspto.gov
571-272-7822

Paper 39
Date: October 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEBER, INC.,
Petitioner,

v.

PROVISUR TECHNOLOGIES, INC.,
Patent Owner.

IPR2020-01556 (Patent 10,625,436 B2)
IPR2020-01557 (Patent 10,639,812 B2)[1]

Before MITCHELL G. WEATHERLY, TIMOTHY J. GOODSON, and JON M. JURGOVAN, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER
Denying Authorization for Motion to Strike
37 C.F.R. §§ 42.5(a), 42.20(b)

[1] This Order addresses issues common to both listed proceedings. The parties are authorized to use this style of caption only if accompanied by a statement affirming that the identical paper is being filed in each proceeding.

By email communication on October 18, 2021, Patent Owner requested authorization to file a motion to strike portions of Petitioner's Reply and certain evidence submitted therewith, which Petitioner opposed. *See* Ex. 3001. On October 20, 2021, we held a conference call with the parties to discuss Patent Owner's request. Patent Owner argues that the complained-of portions of the Reply, and the evidence cited therein, should be stricken because they represent improper new arguments that go beyond the theories presented in the Petition. Petitioner counters that its Reply arguments were responsive to claim constructions or technical issues that Patent Owner first raised in its Patent Owner Response, and that the obviousness arguments in its Reply relied on the same references in the same way as the Petition. Having heard and considered the points the parties raised on the conference call, we determine that Patent Owner has not provided adequate justification for a motion to strike.

As an initial point, Patent Owner delayed longer than is typically expected before seeking authorization to file the motion to strike. "Generally, authorization to file a motion to strike should be requested within one week of the allegedly improper submission." Consolidated Trial Practice Guide, at 81 (Nov. 2019). Petitioner's Reply was filed October 5, 2021, and Patent Owner emailed the Board requesting authorization for a motion to strike on October 18, 2021. When asked about this issue on the conference call, Patent Owner explained that the additional time was needed to "sift through" the many new arguments in the Reply to identify the specific portions it would contest in a motion to strike. We find this explanation unconvincing. The record shows that Patent Owner was able to review and file its objections to Petitioner's evidence one week after

Petitioner's Reply.[2] Patent Owner does not explain what additional work was required that prevented it from seeking authorization for a motion to strike within one week of Petitioner's Reply. Nor did Patent Owner contact the Board to request an extension of time for authorization.

Apart from, and more significant than, the late timing of the request is that Patent Owner does not provide a persuasive explanation for why the motion to strike is appropriate in these circumstances. The Trial Practice Guide explains:

> 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 such, ***striking*** the entirety or ***a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely***. In some cases, however, whether an issue is new or evidence is belatedly presented may be ***beyond dispute***, or the prejudice to a party of waiting until the close of the evidence to determine whether new issues or belatedly presented evidence has been presented may be so great, that the facts may merit considering a motion to strike. For example, where a reply ***clearly*** relies on a new theory not included in prior briefing, and where addressing this new theory during oral hearing would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate.

Id. at 80 (emphasis added). In short, the Board's typical practice is to identify at the close of trial whether arguments or evidence were presented too late, and striking a portion of a brief during trial is reserved for the exceptional case where the violation is clear or the prejudice is great. Patent Owner has not shown that this is an exceptional case where we should depart from the usual practice of addressing these issues at the close of trial.

[2] IPR2020-01556, Paper 32; IPR2020-01557, Paper 31.

Based on our review of the complained-of portions of the Reply and the parties' arguments during the conference call, we cannot say that it is "beyond dispute" or "clear[]" that the arguments are improper new arguments. Moreover, the prejudice Patent Owner claims it will suffer if these arguments are not stricken is that it will not have the opportunity to present new evidence to rebut them with its Sur-Reply or at the hearing. That alleged prejudice is too generalized to justify a motion to strike because it is present in every case where a reply brief contains new argument. If that category of prejudice were sufficient, motions to strike would become the Board's usual approach for addressing disputes over whether replies contain new arguments, as opposed to the exceptional remedy that is reserved for rare cases.

To be clear, we have not reached a determination on whether all the arguments in Petitioner's Reply are proper. Patent Owner remains free to argue in its Sur-Reply or at the hearing that portions of the Reply should be disregarded. But for present purposes, we determine that Patent Owner has not shown that a motion to strike is the appropriate vehicle to address whether these disputed portions of the Reply are proper.

It is, accordingly:

ORDERED that Patent Owner's request for authorization to file a motion to strike is denied.

For PETITIONER:

Ralph Powers
Daniel Yonan
Donald Banowit
Kyle Conklin
Trevor O'Neill
James Buchanan
Graham Phero
STERNE KESSLER GOLDSTEIN & FOX PLLC
Tpowers-ptab@sternekessler.com
Dyonan-ptab@sternekessler.com
Dbanowit-ptab@sternekessler.com
Kconklin-ptab@sternekessler.com
Toneill-ptab@sternekessler.com
Jbuchanan-ptab@sternekessler.com
Gphero-ptab@sternekessler.com

For PATENT OWNER:

Michael Babbitt
Sarah Horton
WILKIE FARR & GALLAGHER LLP
mbabbitt@wilkie.com
shorton@wilkie.com