Trials@uspto.gov
571-272-7822

Paper No. 33
Date: March 30, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXTRACTIONTEK SALES LLC,
Petitioner,

v.

GENE POOL TECHNOLOGIES, INC.,
Patent Owner.

IPR2022-00625
Patent 9,587,203 B2

Before JEFFREY N. FREDMAN, CYNTHIA M. HARDMAN, and JAMIE T. WISZ, *Administrative Patent Judges.*

HARDMAN, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion to File Supplemental Information
37 C.F.R. § 42.123(b)

Patent Owner filed an authorized Motion to File Supplemental Information. Paper 27 ("Mot."). Petitioner opposed Patent Owner's motion. Paper 29 ("Resp."). After considering the arguments and evidence of record, we deny Patent Owner's Motion.

Together with its Sur-reply, Patent Owner filed as Exhibit 2009 the transcript of the January 13, 2023, Deposition of Mr. Fritz Chess ("Transcript") taken in the parallel proceedings, IPR2022-00832 and IPR2022-01011 ("Parallel Proceedings"). Mot. 1. Petitioner initially objected to Patent Owner's filing of Exhibit 2009 as a "violation of the rules related to a Sur-Reply," but the parties subsequently, and with Board authorization, "stipulated that the matter would be presented to the Board as Patent Owner's opposed request to file supplement evidence pursuant to 37 C.F.R. § 42.123(b)." Resp. 2.

Pursuant to 37 C.F.R. § 42.123(b), a motion to submit supplemental information filed more than one month after the trial is instituted must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information is in the interests of justice.

Patent Owner argues that we should grant its motion because "[t]he deposition resulting in the Transcript occurred nearly five months after institution of the instant proceeding," and "[t]hus, the Transcript could not have been submitted pursuant to 37 C.F.R. §42.123(a)." Mot. 1. Patent Owner further argues that it is in the interests of justice to consider the Transcript, because Patent Owner submitted the Transcript "in response to nearly five pages of new argument regarding the definition of a POSA in Petitioner's Reply (Paper 24 at pages 1-5) as well as additional arguments

regarding Buese (*id.* at pages 14, 17)." *Id.* at 3. Patent Owner contends it "would be prejudiced if this evidence were not considered—particularly if it leads to inconsistent findings on the definition of a POSA and the disclosure of Buese between this proceeding and the Parallel Proceedings." *Id.*

Petitioner contends that the Transcript "was not available earlier because on October 6, 2022, Patent Owner made a tactical decision to cancel a scheduled cross-examination deposition of Mr. Chess in this proceeding." Reply 3. Petitioner argues that permitting filing of the Transcript at this stage leaves Petitioner without recourse to address this evidence, given that Patent Owner filed the Transcript with the last brief in the sequence (i.e., with Patent Owner's Sur-reply). *Id.* at 4.

Based on the arguments and evidence of record, Patent Owner does not persuade us to permit filing of the Transcript as supplemental information. Although "[t]he Parallel Proceedings in which Mr. Chess's deposition took place involve the same parties and counsel, patents in the same family, and many of the same arguments as in this proceeding," Patent Owner did not give Petitioner notice that it was taking Mr. Chess's deposition for purposes of this case as well as for purposes of the Parallel Proceedings. *See* Reply 4 ("[T]he Notice of Deposition only identified the two parallel proceedings."). Instead, Patent Owner apparently cancelled Mr. Chess's scheduled deposition in this case, and never rescheduled it. *See id.* at 1. Accordingly, Patent Owner has not adequately demonstrated why the supplemental information reasonably could not have been obtained earlier.

Nor has Patent Owner persuaded us that consideration of the Transcript is in the interests of justice. Patent Owner argues that it

submitted the Transcript in response to alleged new argument in Petitioner's Reply. Mot. 3. The question of whether Petitioner's Reply contains improper new argument is not before us. However, even assuming, *arguendo*, that Petitioner's Reply did contain improper new argument, Patent Owner has not persuaded us that submission of the Transcript is the appropriate means of addressing such new argument.

The Board's Trial Practice Guide[1] provides guidance for situations where a party believes the opponent's brief raises new issues or otherwise exceeds the proper scope of a reply. Trial Practice Guide, 80–81. That guidance does not include Patent Owner's chosen course of filing new evidence. Indeed, the Trial Practice Guide expressly states that "[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." *See id.* at 73. Mr. Chess is not a reply witness. *See* Reply 2.

Patent Owner relies on *Paragon 28, Inc. v. Wright Medical Technology, Inc.*, IPR2019-00895, Paper 44, at 18, but that case is inapposite. Mot. 3. In *Paragon*, the Board found that "[t]he argument and evidence presented in Petitioner's Reply properly respond[ed] to issues discussed in the Institution Decision" and in the patent owner's response, and thus found that the argument and evidence newly presented with the sur-reply was permissible response. *See Paragon*, IPR2019-00895, Paper 44, at 17–18. Notably, the petitioner in *Paragon* had the opportunity to address the new evidence in a sur-sur-reply. *See id.* at 18. Here, in contrast, Patent Owner's tactical choices to not depose Mr. Chess in this case, yet file the

[1] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

Transcript from the Parallel Proceedings with its Sur-reply, leave Petitioner without recourse to address this newly introduced evidence.

For the above reasons, we deny Patent Owner's Motion.

ORDER

It is hereby:

ORDERED that Patent Owner's Motion is *denied*; and

FURTHER ORDERED that Exhibit 2009 is expunged.

For PETITIONER:

Clement Hayes
Mark Emde
BLOCK 45 LEGAL
clement@block45legal.com
mark.emde@block45legal.com

For PATENT OWNER:

Ryan R. Owens
SPEARHEAD LEGAL LLP
ryan.owens@spearheadlegal.com

Daniel C. Pierron
WIDERMAN MALEK, PL
dpierron@uslegalteam.com