

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAINTEQ, LLC,
Petitioner,

v.

ORTHOCISION, INC.,
Patent Owner.

IPR2022-00335
Patent 10,426,539 B2

Before JAMES A. WORTH, MICHAEL L. WOODS,
and MICHAEL A. VALEK, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Strike,
Authorizing Patent Owner to File a Revised Reply,
Authorizing Patent Owner to File a Revised Appendix A, and
Extending Petitioner's Deadline to File a Sur-Reply
37 C.F.R. § 42.5

I. INTRODUCTION

Petitioner, PainTEQ, LLC, filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of U.S. Patent No. 10,426,539 B2 (Ex. 1001, “the ’539 patent”). *See* Pet. 1. We instituted review of the ’539 patent on all claims and all grounds. Paper 7, 20.

After institution, Patent Owner filed a Motion to Amend (Paper 9, “Motion to Amend”) and we provided Preliminary Guidance (Paper 16, “Preliminary Guidance”) to the Motion to Amend at Patent Owner’s request. In response to our Preliminary Guidance, Patent Owner filed a Revised Motion to Amend (Paper 17, “Revised Motion to Amend” or “RMTA”), which Petitioner opposed (Paper 19, “RMTA Opposition” or “RMTA Opp.”). In response to the RMTA Opposition, Patent Owner filed a RMTA Reply (Paper 22, “RMTA Reply”) and Appendix (Paper 23, “Appendix” or “App.”).

With our permission, Petitioner filed a Motion to Strike (Paper 24, “Motion” or “Mot.”) requesting that we strike the Appendix from the record. Patent Owner filed an Opposition to the Motion (Paper 25, “Opposition” or “Opp.”).

II. ANALYSIS

a. The Board’s Guidance on Motions to Strike

The Board’s Consolidated Trial Practice Guide¹ (“CTPG” or “Guidance”), issued in November 2019, addresses motions to strike. *See* CTPG 80–81. Specifically, our Guidance provides,

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

If a party believes that a brief filed by the opposing party raises new issues, is accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply, it may request authorization to file a motion to strike. . . .

A motion to strike may be appropriate when a party believes the Board should disregard arguments or late-filed evidence in its entirety 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. . . . When authorized, the Board expects that it will decide a motion to strike as soon as practicable, and preferably before oral hearing, so that the parties need not devote time during the hearing to addressing improper arguments.

Id. (emphasis added)

b. Petitioner's Position

In its Motion, Petitioner argues that the Appendix should be stricken for two reasons, (1) for improperly extending the page count of Patent Owner's Reply and (2) for being untimely. *See* Mot. 2–3.

As to (1), Petitioner argues that Patent Owner exceeded the *twelve-page page limit* set forth under our Rules by bifurcating its arguments in a Reply and Appendix. *See id.* at 2 (referencing 37 C.F.R. § 42.24(c)(3)). Petitioner submits that “[c]ollectively, these two documents comprise *nineteen pages*.” *Id.* (emphasis added).

Petitioner explains that under the Board’s current motion to amend practice, “these types of claim charts are included within the body of the brief and count toward the prescribed page/word limits.” *Id.* In support of this argument, Petitioner cites to 37 C.F.R. § 42.121(b), which expressly authorizes patent owners to file claim listings in an appendix to a motion to amend. *Id.* at 3. Petitioner explains that “there is no provision in the Federal Register authorizing a patent owner to file a claim chart establishing the written support for a patent claim in an appendix.” *Id.*

As to (2), Petitioner further explains that the Appendix was filed late. *Id.* Petitioner explains that the Appendix was filed on February 24, 2023, which was past the Board’s deadline. *See id.*

c. Patent Owner’s Position

Patent Owner opposes the Motion. Opp. 1. Patent Owner argues that the Appendix “does not substantively change the originally provided Claim Chart, and provides corrections to inadvertent clerical errors in the claim chart.” *Id.* Patent Owner explains that the Appendix “includes a handful of corrections in the left column of the chart (references to the claim elements) intended to removes [sic] inconsistencies with the amended claims submitted in the [Revised Motion to Amend, or ‘RMTA’].” *Id.*

In Patent Owner’s RMTA Reply, Patent Owner explains,

Patent Owner provides a revised Claim Chart identifying support for the Revised Substitute Claims as Appendix A to this paper. The support provided in the Claim Chart has not changed, but the claim limitation listing has been corrected to eliminate clerical errors pointed out by Petitioner in the Opposition (Paper No. 19).

RMTA Reply 2.

Patent Owner does not dispute that the Appendix was filed late. *See* Opp. 1–2.

d. Our Analysis

The facts before us present a rare instance in which we grant Petitioner’s request for an exceptional remedy, namely, striking Patent Owner’s Appendix. *See* CTPG 81.

First, it is undisputed that Patent Owner filed the Appendix late, nor has Patent Owner asserted that there is good cause to excuse the late action. *See* 37 C.F.R. § 42.5(c).

Second, to the extent Patent Owner contends that the Appendix is not a new document but merely corrects a handful of clerical errors in the prior document, it could have and should have sought authorization before filing it. *See* 37 C.F.R. § 42.6(d) (“document already in the record of the proceeding must not be filed again, not even as an exhibit or an appendix, without express Board authorization.”).

Third, and most importantly, the Appendix presents a claim chart that is different from the claim chart provided in the Revised Motion to Amend. *Compare* App. (claim limitations 32.d, 32.e, 34), *with* RMTA 4–10 (claim limitations 32.d, 32.e, 34). Patent Owner provided these changes in response to arguments made by Petitioner. *See, e.g.*, RMTA Opp. 4 (“the limitations recited in the RMTA’s claim chart differ from the limitations set forth in the Appendix A.”). In its Reply, Patent Owner should have responded directly to Petitioner’s argument, rather than simply submitting a new Appendix while simultaneously discounting the changes as merely clerical in nature. *See* RMTA Reply 2. In responding to Petitioner’s arguments in this manner, we agree with Petitioner that Patent Owner has

effectively included arguments in its Appendix. *See* Mot. 2. In other words, Patent Owner has effectively incorporated arguments by reference from the Appendix into the Reply. This is not permitted under our Rules. *See* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Moreover, because Patent Owner improperly uses the Appendix to respond to arguments raised by Petitioner, we consider the Reply *and* Appendix to be limited to the twelve-page page limit mandated in our Rules. *See* 37 C.F.R. § 42.24(c)(3) (“Replies to oppositions to motions to amend: 12 pages.”) For this reason, Petitioner is correct that the combined Reply and Appendix is nineteen pages and exceeds the limit. Mot. 2. Allowing Patent Owner to evade this page limit by bifurcating its arguments in a brief and appendix “would establish a precedent for gaming the rules governing the page/word limits in AIA proceedings,” as pointed out by Petitioner. *Id.*

Accordingly, we strike the Appendix (Paper 23) from the record.

We recognize, however, that striking a portion of a party’s brief is an exceptional remedy, which we do not take lightly. With this in mind, we determine that it would be in the interests of justice to allow Patent Owner to file a revised reply to Petitioner’s opposition to Patent Owner’s revised motion to amend, if such revised reply is filed on or before March 8, 2023. If Patent Owner files a Revised Reply, Patent Owner’s revisions shall be limited to addressing Petitioner’s argument that “the limitations recited in the RMTA’s claim chart differ from the limitations set forth in the Appendix A.” RMTA Opp. 4.

Patent Owner may also file a Revised Appendix A, *as an exhibit*, not a paper, if also filed on or before March 8, 2023. If Patent Owner files a Revised Appendix A, Patent Owner shall use strike-through to indicate the original language to be removed and underline to indicate the new language to be added.

In fairness to Petitioner, we also extend Petitioner's deadline for filing a sur-reply from March 16, 2023, to March 20, 2023. *See* Paper 18, 6

No other deadlines are modified in this Order.

III. ORDER

Accordingly, it is

ORDERED that Petitioner's Motion to Strike (Paper 24) is granted;

FURTHER ORDERED that the Appendix (Paper 23) is stricken from the record;

FURTHER ORDERED that Patent Owner may file a revised reply to Petitioner's opposition to Patent Owner's revised motion to amend, if such revised reply is filed on or before March 8, 2023, and if such revisions are limited to and in response to Petitioner's argument identifying inconsistencies in the original RMTA claim chart;

FURTHER ORDERED that Patent Owner may file a revised Appendix A as an exhibit, if it includes strike-through to indicate the original language to be removed and underline to indicate the new language to be added, and if filed on or before March 8, 2023; and

FURTHER ORDERED that Petitioner's deadline for filing a sur-reply to the revised motion to amend is extended to March 20, 2023.

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