

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYDRITE CHEMICAL CO.,
Petitioner,

v.

SOLENIS TECHNOLOGIES, L.P.,
Patent Owner.

Case IPR2015-01592
Patent 8,962,059

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

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Pursuant to 37 CFR § 42.64(c), Patent Owner, Solenis Technologies, L.P. (“Solenis”), moves to exclude the following evidence and related testimony submitted by Petitioner, Hydrite Chemical Co. (“Hydrite”).

I. Paper 21 and Ex. 1025 Should Be Excluded Because They Contain New Evidence and Arguments That Exceed the Scope of a Proper Reply

Solenis objected to Paper 21 (“Petitioner’s Reply”) and Ex. 1025 (“Supplemental Declaration of Dr. Rockstraw”) because they contain impermissible new evidence and arguments supporting Hydrite’s *prima facie* case for unpatentability that could have been presented in a prior filing. *See* Paper 22, citing 37 CFR § 42.23(b) and Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012).

Under Rule 42.23(b), a “reply may only respond to arguments raised in the corresponding...patent owner response.” “‘Respond’ in the context of 37 C.F.R. § 42.23(b), does not mean embark in a new direction with a new approach as compared to the position originally taken in the Petition.” *Apple Inc., ZTE Corporation and ZTE (USA) Inc. v. e-Watch, Inc.*, IPR2015-00412, Paper 50 at 44 (PTAB May 6, 2016). “A Reply affords the Petitioner an opportunity to refute arguments and evidence advanced by the Patent Owner, not an opportunity to cure deficiencies in its Petition.” *Toyota Motor Corp. v. Am. Vehicular Scis. LLC*, IPR2013-00424, Paper 50 at 21 (PTAB Jan. 12, 2015).

Examples of new issues raised on reply “include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.” 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). “[A] reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply.” *Id.* The Petition must include all affirmative evidence of alleged obviousness. 37 C.F.R. § 42.22(a)(2).

Here, Paper 21 and Ex. 1025 include – for the first time – new evidence and arguments to support Hydrite’s *prima facie* case for obviousness. Because Solenis does not have an opportunity for a meaningful response (as, for example, through submission of countervailing evidence) permitting Hydrite’s belated submissions would be unduly prejudicial and unfair.

A. Paper No. 21 (“Petitioner’s Reply”)

Solenis objected to portions of Paper 21 because, among other things, it contains impermissible new evidence and arguments regarding so-called “simultaneous invention,” and deposition testimony presenting a new rationale for how one allegedly would have arrived at the claimed inventions (*see* Paper 22).

1. Simultaneous Invention

Hydrite's Reply introduces Ex. 1004 (a document from an interference proceeding between U.S. Patent No. 8,841,469 ("the 469 Patent") and U.S. Patent No. 8,962,059 ("the 059 Patent")) and Ex. 1022 ("CVEC Slides") to advance a theory of "simultaneous invention" and/or to support the proposition that one would have had "guidance" and "motivation" to arrive at the 059 patent claims (*see* Paper 21 at 1-2 & 8-9). This constitutes an entirely new argument that Hydrite could have raised, and should have raised, in its Petition and to which Solenis has no opportunity to meaningfully respond.

Hydrite did, in fact, cite Ex. 1004 in the Petition for a different purpose, *i.e.*, to identify "related matters" (*see* Paper 1 at ix-x). At no time, however, did Hydrite cite Ex. 1004 to support allegations of "simultaneous invention" and/or as evidence of "motivation" and "guidance."

Similarly, Dr. Rockstraw testified that Ex. 1022 was known to him prior to completing his original declaration, but that Hydrite's attorneys instructed him not to rely upon it (Ex. 2028 at 87:18 – 89:10).

As explained in the Trial Practice Guide, "new evidence that could have been presented in a prior filing" is improper. 77 Fed. Reg. 48767; *Butamax*TM *Advanced Biofuels LLC v. Gevo, Inc.*, IPR2013-00539, Paper 33 at 43 n.8 (PTAB

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