

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON U.S.A., INC.
Petitioner

v.

CELLSPIN SOFT, INC.
Patent Owner

U.S. Patent No. 9,258,698
Inter Partes Review No. 2019-00127

**PETITIONER CANON U.S.A., INC.'S
NOTICE OF BASIS FOR RELIEF REQUESTED UNDER 37 C.F.R. § 42.21**

Pursuant to the Board's authorization provided in an email dated December 13, 2019, Petitioner Canon U.S.A., Inc. ("Petitioner" or "Canon") submits the following Notice of Basis for Relief Requested under 37 C.F.R. § 42.21.

Specific Relief Requested. Canon requests authorization to file a motion to strike: (1) Exhibits 2026-2033, which Patent Owner Cellspin Soft, Inc. ("Patent Owner" or "Cellspin") filed with its sur-reply filed on December 3, 2019; and (2) arguments in the sur-reply that are based on these Exhibits.¹

Basis for Relief Requested. The Board's Consolidated Trial Practice Guide ("Guide") expressly prohibits a patent owner from submitting new evidence with a sur-reply, other than transcripts for cross-examination of a reply witness. *See* Guide at 73 ("The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness."). Patent Owner violated this prohibition by filing eight new exhibits with its sur-reply, none

¹ Patent Owner's updated exhibit list identified two additional exhibits in connection with its Reply: Exhibits 2024 and 2025. However, Patent Owner did not file these exhibits and has waived any right to rely on them. To the extent Patent Owner is permitted to file and rely upon Exhibits 2024 and 2025, Petitioner reserves the right to address them in its motion to strike.

of which were cross-examination transcripts.² The new exhibits include a 54-page expert declaration (Ex. 2026); printouts from Petitioner's website (Exs. 2027-2028); a patent publication (Ex. 2029); an excerpt of the prosecution history for the U.S. Patent No. 9,258,698 (Ex. 2030); and three technical references spanning hundreds of pages (Ex. 2031-2033). Patent Owner did not seek authorization to file these exhibits with its sur-reply. Thus, the exhibits should be stricken, along with any arguments in Patent Owner's sur-reply that are based on the exhibits.

In addition to violating the Guide, Patent Owner's new exhibits and sur-reply are highly prejudicial to Petitioner. Patent Owner's expert declaration (Ex. 2026) includes new opinions based on new evidence, and Petitioner will not have the opportunity to cross-examine the witness on these new opinions and evidence. The declaration also attempts to explain away or retract admissions the expert made in his deposition given after Cellspin filed its Patent Owner Response. Patent Owner's counsel had the opportunity to address those admissions through redirect examination, but chose not to. Patent Owner also relies on the declaration and several new exhibits to support its improper claim construction positions. These positions were set forth in Cellspin's Patent Owner Response, and Cellspin

² Canon offered to make its sur-reply witness available for deposition, but Cellspin declined the opportunity to take one.

should have submitted all evidence and expert testimony to support its positions at that time.

Because Patent Owner's sur-reply and accompanying exhibits violate the Guide and would prejudice Petitioner, Petitioner respectfully requests authorization to file a motion to strike. Petitioner reserves the right strike the sur-reply in its entirety given that Patent Owner's new arguments and evidence pervade the sur-reply. *See* Guide, p. 74 ("The Board is not required to attempt to sort proper from improper portions of the reply or surreply.").

Respectfully submitted,

Date: December 18, 2019

/s/ Jared W. Newton

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), 42.105(a), the undersigned hereby certifies service on the Patent Owner of a copy of this document to the following:

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Date: December 18, 2019

/s/ Jared W. Newton

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