UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Panasonic Corporation of North America *et al.*

Petitioners

v.

Cellspin Soft, Inc.

Patent Owner

CASE: IPR2019-00131

Patent No. 9,258,698

PETITIONERS PANASONIC CORPORATION AND PANASONIC CORPORATION OF NORTH AMERICA'S OPPOSITION TO CELLSPIN'S MOTION TO STRIKE

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I. Introduction

Petitioners Panasonic Corporation and Panasonic Corporation of North America ("Panasonic") file this opposition to Patent Owner Cellspin Soft, Inc.'s ("Cellspin") motion to strike or exclude Panasonic's reply brief and Exhibits 1024, 1026-1028, and 1030-1031 (Paper 45) (the "Motion").

Cellspin's Motion is long on hyperbole but short on facts supporting its request. Cellspin identifies eleven supposedly "new" theories or matters in Panasonic's reply brief (Paper 23) (the "Reply"). But most of these same points are made, explicitly, in Panasonic's petition for *inter partes* review (Paper 1) (the "Petition"). In arguing to the contrary, Cellspin has ignored or mischaracterized the arguments in the Petition. The remaining few points are direct and proper responses to arguments made in Cellspin's patent owner response (Paper 19) (the "Response"), particularly its "teaching away" argument and unfounded claim construction positions. These are the types of arguments that are permissible in reply under Federal Circuit and Board precedent.

Accordingly, every purportedly "new" matter is not "new" at all, or else is proper rebuttal. Cellspin has not shown that it is entitled to any relief, much less the drastic step of striking the entire Reply and other accompanying evidence. And beyond its lack of substantive merit, the circumstances do not support granting Cellspin's belated tit-for-tat Motion. The Board should deny it in full.

II. Argument

A. Legal Standards

A petitioner is permitted to file a reply to a patent owner response that responds to arguments raised in the patent owner response and address issues discussed in the institution decision. 37 C.F.R. § 42.23; Patent Trial and Appeals Board Consolidated Trial Practice Guide, November 2019 ("Practice Guide") at 73. A petitioner may also submit new rebuttal evidence in support of its reply, including a new expert declaration. *Practice Guide* at 73 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077-78, 1081-82 (Fed. Cir. 2015); *Id.* at 74-75 (citing *Genzyme Therapeutic Prods., Ltd. v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1365-69 (Fed. Cir. 2016)); *Juniper Networks, Inc. v. Chrimar Sys., Inc.*, Case IPR2016-01389 (PTAB January 23, 2018) (Paper 69) at 88-89 (denying motion to strike IEEE standard document first submitted in reply).

The Federal Circuit has cautioned against the Board "parsing [a petitioner's] arguments on reply with too fine of a filter." *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1380 (Fed. Cir. 2018) (finding the Board abused its discretion in declining to consider a reply brief argument and accordingly vacating and remanding the final written decision). Precedents of the Federal Circuit and the Board provide guidance as to the proper scope of a reply. For example, an argument that "expands on a previously argued rationale as to why the prior art

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