

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Panasonic Corporation and Panasonic Corporation of North America, GoPro, Inc.  
Garmin International, Inc., and Garmin USA, Inc.  
Petitioners,

v.

Cellspin Soft, Inc.  
Patent Owner.

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CASE: IPR2019-00131<sup>1</sup>

Patent No. 9,258,698

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**PETITIONERS PANASONIC CORPORATION AND PANASONIC  
CORPORATION OF NORTH AMERICA'S NOTICE OF BASIS FOR  
RELIEF REQUESTED UNDER 37 C.F.R. § 42.21 PURSUANT TO THE  
DECEMBER 4, 2019 ORDER**

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<sup>1</sup> GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. were joined as parties to this proceeding. Paper 29.

## I. Specific Relief Requested

Panasonic requests authorization to file a motion to strike Patent Owner's sur-reply in its entirety and accompanying Exhibits 2026-2029 and 2031-33.<sup>2</sup> In the alternative, the motion will request that the Board strike those seven Exhibits and accord no weight to the sur-reply arguments based on the Exhibits.

## II. Bases for the Requested Relief

The sur-reply and the seven exhibits: (1) violate the PTAB's Consolidated Trial Practice Guide, November 2019's ("Consolidated Guide") proscription against submitting new evidence with a sur-reply; (2) unfairly prejudice Panasonic, and (3) attempt to circumvent the word limit for sur-replies.

*First*, Cellspin was expressly prohibited from introducing new evidence on sur-reply. *Consolidated Guide*, p. 73 ("The sur-reply *may not be accompanied by new evidence* other than deposition transcripts of the cross-examination of any reply witness.") (emphasis added). Cellspin violated that prohibition when it inappropriately submitted and argued the following new evidence:

- a new, 56-page-long declaration from its expert witness (Ex. 2026); and

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<sup>2</sup> Panasonic does not seek to strike Exhibit 2030, the transcript of the deposition Cellspin took of Panasonic's expert witness on June 13, 2019.

- six other documents comprising over 300 pages, including two technical specifications, a published patent application, and website printouts. (Exs. 2027-29 and 2031-33).

Cellspin did not seek, and the Board did not grant, authorization to file these new exhibits. For this reason alone, they should be stricken.

*Second*, the untimely new evidence unfairly prejudices Panasonic because Panasonic has no chance to cross-examine Cellspin’s expert witness on his new 56-page declaration or to address Cellspin’s additional new evidence in briefing. Cellspin’s new expert declaration would be particularly prejudicial. It amounts to a lengthy and improper attempt to retract or disavow concessions made in the expert’s deposition testimony. *E.g.*, Ex. 2026, ¶¶58-61 (purporting to address “confusion” about his deposition testimony by offering new opinions contrary to that testimony). Cellspin’s counsel had an opportunity to conduct re-direct examination during the expert’s deposition, and in fact took advantage of that opportunity; Cellspin should not be allowed a second and much belated bite at the apple in an effort to avoid the consequences of its own expert’s testimony.

The new expert declaration is the backbone of Cellspin’s sur-reply. The sur-reply repeats and cites to the declaration extensively throughout. Thus, the sur-reply should be stricken as well. *See Consolidated Guide*, p. 74 (“The Board is not

required to attempt to sort proper from improper portions of the reply or sur-reply.”) Alternatively, the Board could strike the exhibits and treat the statements in the sur-reply citing to those exhibits as unsupported attorney argument.

*Third*, Cellspin improperly deleted spaces between words in record citations throughout the sur-reply so that each citation could be counted as part of the last word of the preceding sentence. For example, the fifth sentence on page 4 ends as follows: “. . . table.’Ex.2003,6;Ex.2026,¶15.” Spaced properly, this citation would be seven words: “. . . table.’ Ex. 2003, 6; Ex. 2026, ¶15.” With proper citation spacing, the sur-reply would be approximately 400 words over the 5600 word limit. Cellspin’s attempt to manipulate the word count gives the Board further grounds for striking all or part of the sur-reply. “[D]eleting spacing between words, . . . in order to circumvent the rules on word count, may lead to a party’s brief not being considered.” *Consolidated Guide*, p.40 (emphasis added).

Dated: December 9, 2019

Respectfully submitted,

By:           / T. Vann Pearce, Jr. /          

T. Vann Pearce, Jr.  
*Lead Counsel for Petitioners Panasonic Corporation of North America and Panasonic Corporation*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing  
**PETITIONERS PANASONIC CORPORATION AND PANASONIC  
CORPORATION OF NORTH AMERICA'S NOTICE OF BASIS FOR  
RELIEF REQUESTED UNDER 37 C.F.R. § 42.21 PURSUANT TO THE  
DECEMBER 4, 2019 ORDER** was served in its entirety on December 9, 2019,  
upon the following parties via electronic service:

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