

**From:** [Trials](#)  
**To:** [John Edmonds](#); [Trials](#)  
**Cc:** [Steve Schlather](#); [Pearce Jr., T. Vann](#); [Medina, David R.](#); [Jennifer Bailey](#); [Adam P. Seitz](#); [Karineh Khachatourian](#); [David Xue](#)  
**Subject:** RE: IPR2019-00131: Patent Owner's Request for authorization to file motion to strike  
**Date:** Wednesday, December 4, 2019 4:28:41 PM  
**Attachments:** [image002.png](#)

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Pursuant 37 C.F.R. Section 42.21, each party is required to file a notice regarding the specific relief it requests and the basis for the requested relief. The notice shall be filed on or before December 9, 2019. Once the notices are received, the Board will determine whether or not motions to strike will be authorized and, if authorized, set a briefing schedule.

Patent Owner is further required to explain the timing of its request to file a motion to strike:

Generally, authorization to file a motion to strike should be requested within one week of the allegedly improper submission. Consolidated Trial Practice Guide, 81 (November 2019).

Regards,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
Direct: 571-272-5366

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**From:** John Edmonds <jedmonds@ip-lit.com>  
**Sent:** Wednesday, December 4, 2019 12:08 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** Steve Schlather <sschlather@ip-lit.com>; Pearce Jr., T. Vann <vpearce@orrick.com>; Medina, David R. <dmedina@orrick.com>; Jennifer Bailey <jennifer.bailey@eriseip.com>; Adam P. Seitz <adam.seitz@eriseip.com>; Karineh Khachatourian <karinehk@rimonlaw.com>; David Xue <david.xue@rimonlaw.com>  
**Subject:** IPR2019-00131: Patent Owner's Request for authorization to file motion to strike

Dear Board,

Patent Owner Cellspin Soft, Inc. ("Cellspin") had asked Panasonic to make a joint request for a call on this subject, but Panasonic declined. Cellspin also requests authorization to file a motion to strike. Cellspin's motion would ask the Board to strike the second expert declaration that Panasonic submitted with its reply (Ex. 1024) as well as Exhibits 1026-1028 and 1030-1031 also submitted with Panasonic's reply. The basis for striking includes that the foregoing have improper new evidence, new theories, new approaches, and/or new issues on Reply, including in violation of 37 CFR § 42.23(b). For example and without limitation, Panasonic's Reply Brief and exhibits assert entirely new obviousness theories, where obviousness was not even a basis in Panasonic's petition or in the Board's institution decision. In addition, Cellspin's motion would ask the Board to strike Panasonic's reply brief, in whole or in part, including based upon the foregoing.

Cellspin has conferred with Panasonic, who opposes this request. Apparently there was some

time zone confusion about the parties' mutual availability for a call, should the Board wish to schedule one. The parties are mutually available on Monday, December 9 at or after 1 pm ET, or after 11 AM ET on Tuesday, December 10.

Respectfully Submitted,

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Lead counsel for Patent Owner Cellspin Soft, Inc.

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**From:** Pearce Jr., T. Vann <vpearce@orrick.com>  
**Sent:** Wednesday, December 4, 2019 10:42 AM  
**To:** trials@uspto.gov  
**Cc:** John Edmonds <jedmonds@ip-lit.com>; Steve Schlather <sschlather@ip-lit.com>; Medina, David R. <dmedina@orrick.com>; Jennifer Bailey <jennifer.bailey@eriseip.com>; Adam P. Seitz <adam.seitz@eriseip.com>; Karineh Khachatourian <karinehk@rimonlaw.com>; David Xue <david.xue@rimonlaw.com>  
**Subject:** IPR2019-00131: Request for authorization to file motion to strike

Dear Board,

Petitioners Panasonic Corporation and Panasonic Corporation of North America respectfully request authorization to file a motion to strike. The motion would ask the Board to strike the second expert declaration that Patent Owner submitted with its sur-reply (Ex. 2026) as well as Exhibits 2027-2029 and 2031-33 also submitted by Patent Owner with its sur-reply. *See* Section II.I of the Trial Practice Guide Update (August 2018) (page 14). In addition, the motion would ask the Board to strike Patent Owner's sur-reply brief in whole or in part based on its citation to these exhibits and circumventing the word count limit. *See* Section II.A.3. of the Trial Practice Guide Update (August 2018) (page 7) (citing *Pi-Net Int'l, Inc. v. JPMorgan Chase & Co.*, 600 F. App'x 774 (Fed. Cir. 2015)).

Petitioners have conferred with Patent Owner, who opposes this request. Should the Board wish to schedule a conference call, counsel for both sides are available during the afternoon of Monday December 9, or after 11 AM on Tuesday, December 10.

Respectfully Submitted,  
Vann Pearce  
Lead Counsel for Petitioners Panasonic Corporation and Panasonic Corporation

of North America

**Vann Pearce**

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