UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA LLC,
Petitioner

v.

MACNEIL IP LLC,
Patent Owner

Case IPR2020-01139
U.S. Patent No. 8,382,186

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO STRIKE

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I. INTRODUCTION

In the POR, MacNeil (and its declarants) made assertions that are false. Yita's Reply (supported by expert testimony and underlying evidence) showed that MacNeil's assertions are wrong and would not have dissuaded a POSA from thermoforming Rabbe's floor tray. Now MacNeil asks the Board to completely remove Yita's responsive arguments and expert testimony from the record because they demonstrate that MacNeil is wrong.

There is no basis for MacNeil's requested relief. As the Trial Practice Guide states, "striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely." TPG, 80. Here, Yita's arguments are not new theories—they "expressly follow from [Yita's] contentions raised in the Petition." *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1380 (Fed. Cir. 2018). In addition, Yita's arguments (and supporting evidence) are properly responsive to MacNeil's POR arguments and "show the state of the art at the time of the invention." *Genzyme Therapeutic Prods. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1369 (Fed. Cir. 2016).

Moreover, Yita's Reply does not incorporate arguments by reference or ask the Board to play archeologist with the record. Yita's arguments are developed in its Reply. And MacNeil cites no case where the Board granted a motion to strike based on an alleged incorporation by reference. The Board's practice has been to

leave the record intact. *Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00859, Paper 69, 5 (P.T.A.B. April 12, 2019); *Arctic Cat, Inc. v. Polaris Indus., Inc.*, IPR2015-01781, Paper 34, 2 (P.T.A.B. August 25, 2016). The Board should deny MacNeil's motion to strike.

II. YITA'S REPLY ARGUMENTS ARE PROPER.

A. Legal Principles

There is no bar on presenting new evidence with a petitioner's reply. *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380 (Fed. Cir. 2018). Indeed, the Federal Circuit has repeatedly explained that "the introduction of new evidence in the course of the trial is to be expected in inter partes review trial proceedings." *Id.*; *Genzyme*, 825 F.3d at 1366. The purpose of the trial "is to give the parties an opportunity to build a record by introducing evidence—not simply to weigh evidence of which the Board is already aware." *Genzyme*, 825 F.3d at 1367. There are many proper categories of reply arguments and evidence.

As a first example, "the petitioner's reply brief [may be] responsive to arguments originally raised in its petition." *Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 705-06 (Fed. Cir. 2020). "Parties are not barred from elaborating on their arguments on issues previously raised." *Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019). In *Ericsson*, the Federal Circuit vacated and remanded the Board's decision for failing to consider portions of the

petitioner's reply brief because the reply properly "expand[ed] the same argument made in its Petition" instead of providing a new theory. *Ericsson*, 901 F.3d at 1381. "It is unreasonable to hold petitioners to such a high standard that, if they choose to rely on one example…, they must either discuss all potential permutations… or risk waiving the opportunity to further discuss other relevant examples in their reply." *Apple*, 949 F.3d at 706. In addition to argument, evidence to support a petition's position may also be submitted after the petition stage. For example, in *VidStream LLC v. Twitter, Inc.*, the Federal Circuit concluded that "the Board acted appropriately" when it allowed a petitioner to submit additional evidence in its reply regarding the primary reference's publication date because "the Board permitted both sides to provide evidence concerning the reference date of the Bradford book, in pursuit of the correct answer." *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065 (Fed. Cir. 2020).

As a second example, a petitioner "may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner." *Anacor*, 889 F.3d at 1380-81; *see also Apple*, 949 F.3d at 705-06. Submitting new evidence does not suggest that the evidence was necessary for the prima facie case of obviousness. *See, e.g.*, *VidStream*, 981 F.3d at 1065; *Anacor*, 889 F.3d at 1380-81. Instead, "[e]vidence admitted in rebuttal to respond to the patent owner's criticisms will commonly confirm the prima facie case. That does

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