

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
Patent 8,382,186

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Submitted Electronically via the Patent Review Processing System

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

TABLE OF CONTENTS

I. INTRODUCTION1

II. YITA’S REPLY ARGUMENT REGARDING REASONABLE EXPECTATION OF SUCCESS IS A NEW THEORY THAT SHOULD BE STRICKEN2

III. YITA’S NEW OBVIOUSNESS THEORIES ON MATERIALS SHOULD BE STRICKEN7

 A. Yita’s argument that Rabbe discloses thermoplastic elastomers should be stricken.....7

 B. Yita’s reliance upon Yung’s three-layer structure and/or an individual foam layer should be stricken.8

IV. PORTIONS OF YITA’S EXHIBITS 1041, 1042 AND 1044 THAT ARE HEAVILY INCORPORATED BY REFERENCE SHOULD BE STRICKEN.....9

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Adobe Inc. v. RAH Color Techs. LLC</i> , IPR2019-00628, Paper 124 (P.T.A.B. Aug. 31, 2020).....	10
<i>Anacor Pharms., Inc. v. Iancu</i> , 889 F.3d 1372 (Fed. Cir. 2018)	7
<i>Andrea Elecs. Corp</i> , 949 F.3d 697, 706 (Fed. Cir. 2020).....	5
<i>Cisco Sys., Inc. v. C-Cation Techs.</i> , LLC, IPR2014-00454, Paper 12, 9-10 (P.T.A.B. Aug. 29, 2014).....	10
<i>Ericsson Inc. v. Intellectual Ventures I LLC</i> , 901 F.3d 1374 (Fed. Cir. 2018)	4, 5
<i>Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.</i> , 825 F.3d 1360 (Fed. Cir. 2016)	6
<i>Great West Casualty Co. v. Intellectual Ventures II LLC</i> , No. IPR2015-01706, 2020 WL 754868 (P.T.A.B. Feb. 14, 2020).....	5
<i>Haag-Streit AG v. Eidolon Optical, LLC</i> , IPR2018-01311, Paper 31 (P.T.A.B. Sept. 5, 2019).....	6
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	2, 4, 8
<i>SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018).....	1, 7
<i>Trane U.S. Inc. v. SEMCO, LLC</i> , IPR2018-00514, Paper 36 (P.T.A.B. April 17, 2019)	10
<i>Vimeo, Inc. v. Brit. Telecommunications Plc</i> , No. IPR2019-00833, 2020 WL 4529709 (P.T.A.B. Aug. 5, 2020).....	5

STATUTES

35 U.S.C. § 312(a)(3).....2

I. INTRODUCTION

Petitioner Yita LLC (“Yita”) filed 55 new exhibits with its Reply (Paper 60 (“Reply”)), including hundreds of pages of new expert testimony from Dr. Koch, Mr. Strachan, and Mr. Perreault that are improperly incorporated by reference in the Reply. Despite the prohibitions against petitioners raising new arguments and theories for the first time in a reply brief, Yita’s Reply improperly raises new arguments and theories concerning reasonable expectation of success, what Rabbe discloses to a person of ordinary skill in the art (“POSITA”), and how Yung is used in the proposed combination. Yita’s Opposition (Paper 74 (“Opposition”)) does not dispute that the vast majority of the new evidence filed with its Reply could have been filed with the Petition. Rather, the Opposition attempts to frame Yita’s improper new arguments as (1) following from Yita’s contentions in the Petition, (2) responsive to arguments raised in Patent Owner MacNeil IP LLC’s (“MacNeil”) Response, and (3) documenting the alleged state of the art. *See generally* Opposition. Yita’s attempts to explain away its new arguments are unavailing.

The Board’s rules are clear: “*Petitioner may not submit new evidence or argument in reply that it could have presented earlier . . .*” PTAB Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), 73 (emphasis added); *see also SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (explaining that “*the petitioner’s petition . . . is supposed to guide the life of the litigation*”) (emphasis added).

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