

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW U LIFE CORPORATION,
Petitioner,

v.

AXCESS GLOBAL SCIENCES, LLC,
Patent Owner.

IPR2019-01141
Patent 6,613,356 B1

Before GEORGIANNA W. BRADEN, JENNIFER MEYER CHAGNON,
and MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion to Exclude
37 C.F.R. § 42.64(c)

I. INTRODUCTION

New U Life Corporation (“Petitioner”) filed a Petition (Paper 1) seeking an *inter partes* review of claims 1–19 of U.S. Patent No. 6,613,356 B1 (“the ’356 patent,” Ex. 1001). We instituted review. Paper 8.

After institution, Patent Owner filed a Response (Paper 11) and a contingent Motion to Amend (Paper 12). On May 12, 2020, Petitioner filed a Reply to Patent Owner’s Response (Paper 15) (“Reply”) and an Opposition to Patent Owner’s Motion to Amend (Paper 14) (“MTA Opposition”). At the same time, Petitioner filed Exhibits 1024–1031. These exhibits are cited in support of Petitioner’s arguments in both the Reply and the MTA Opposition.

After receiving preliminary guidance from the Board (Paper 16), Patent Owner withdrew its Motion to Amend on June 23, 2020. Paper 18. On the same day, Patent Owner filed a Sur-reply to Petitioner’s Reply that, *inter alia*, asserts Exhibits 1025–1031¹ are “irrelevant” and requests they be stricken because they “could have been submitted with [Petitioner’s] original petition.” Paper 17, 6–7.

Patent Owner subsequently filed a Motion to Exclude Exhibits 1024–1031 on these bases. Paper 20 (“Motion” or “Mot.”). Petitioner filed an Opposition to the Motion. Paper 22 (“Opp.”). Patent Owner replied. Paper 23 (“Mot. Reply”).

¹ Patent Owner states that it “inadvertently omitted Exhibit 1024 from the list of ‘new’ exhibits” objected to in its Sur-reply, “but the reasons for its objection apply equally to Exhibit 1024 in addition to Exhibits 1025–1031.” Mot. 1.

In this Order, we address Patent Owner’s Motion as well as the parties’ request for a prehearing conference regarding that Motion (Ex. 3001).

II. DISCUSSION

A. *Motion to Exclude*

Petitioner served Exhibits 1024–1031 on May 12, 2020, when it filed those exhibits along with its Reply and MTA Opposition. As Petitioner points out, our rules require that “[o]nce a trial has been instituted, any objection must be filed within five business days of service of evidence to which the objection is directed.” Opp. 4 (quoting 37 C.F.R. § 42.64(b)(1)); *see also* PTAB Consolidated Trial Practice Guide (2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“TPG”), 78–79. Thus, Petitioner contends the objections referenced in the Motion were waived because Patent Owner “did not object to any of the Exhibits served on May 12 until it filed its Surreply . . . six weeks later.” Opp. 5.

We agree that Patent Owner failed to timely file objections pursuant to 37 C.F.R. § 42.64(b)(1). Patent Owner does not dispute the relevant dates and, in fact, identifies the Sur-reply, which was filed more than a month after service of Exhibits 1024–1031, as the first time it raised the objections. Mot. 1. Because Patent Owner did not file these objections within five business days of being served with these exhibits, the objections were not preserved for later inclusion in a motion to exclude.

Patent Owner contends its objections were “timely under Rule 42.64, because the exhibits became irrelevant only upon withdrawal of the Motion to Amend.” Mot. Reply 2. We disagree. Petitioner’s reliance on these exhibits was not limited to its MTA Opposition. Exhibits 1024–1031 are

repeatedly cited in Petitioner’s Reply to Patent Owner’s Response to the Petition. *See* Paper 15, 13–17. Thus, at the time it filed its Reply, Petitioner made clear it was relying on these exhibits to reply both to Patent Owner’s arguments concerning the grounds and challenged claims in the Petition, as well as the issues presented in the Motion to Amend. Even if Patent Owner agreed that Exhibits 1024–1031 were relevant to the latter, it has identified no reason why it could not have timely objected to Petitioner’s reliance on those exhibits to support its arguments regarding the challenged claims in its Reply.

Patent Owner argues it was not required to make such a “contingent objection” under our rules. Mot. Reply 2. Again, we disagree. Rule 42.64(b)(1) makes clear that “*any* objection must be filed within five business days of service of evidence to which the objection is directed.” 37 C.F.R. § 42.64(b)(1) (emphasis added). This includes Patent Owner’s objections that Exhibits 1024–1031 are “irrelevant” to the grounds in the Petition and/or “could have been submitted with [Petitioner’s] original petition.” Paper 17, 6–7.

We likewise are unpersuaded by Patent Owner’s argument that “[t]he better rule is for a patent owner to simply lodge any objections upon withdrawal of a motion to amend, as [it] did here.” Mot. Reply 2. Indeed, allowing a patent owner to circumvent the “five business days” requirement of Rule 42.64(b)(1) by withdrawing its motion to amend where the petitioner has previously made clear that it was also relying on the evidence to reply to Patent Owner’s response to the petition would frustrate the Rule’s purpose in providing a framework for timely “correction in the form of supplemental evidence.” *See* 37 C.F.R. § 42.64(b)(1)–(2).

For these reasons, we determine that the objections referenced in Patent Owner's Motion were waived because they were not timely filed pursuant to 37 C.F.R. § 42.64(b)(1). We, therefore, deny the Motion without deciding the merits of those objections.

B. Prehearing Conference Request

An oral hearing has been set for September 1, 2020. Paper 21. The parties jointly requested a prehearing conference "to potentially resolve the pending Motion to Exclude Evidence (Paper 20), and thereby narrow the issues in advance of the Oral Hearing." Ex. 3001. This Order resolves that motion.

As for the parties' additional request for "guidance from the Board on issues to focus on at the Oral Hearing" (Ex. 3001), we note that Patent Owner has withdrawn its Motion to Amend and, therefore, we expect the parties to focus their arguments only on the challenged claims of the '356 patent and the grounds presented in the Petition. We leave it to the parties' discretion to craft the specifics of their oral arguments consistent with the Board's rules and TPG.

Since the issues identified in the parties' request have been addressed above, we do not see a need for a prehearing conference at this time. If either party has a different view, it may submit a new request explaining what it believes remains for discussion prior to the hearing.

III. ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner's Motion to Exclude is *denied*.

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