

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALMART INC. and CURRENT LIGHTING SOLUTIONS, LLC,
Petitioners,

v.

POWER CONCEPTS, LLC
Patent Owner.

IPR2022-00534 (Patent 10,837,628 B2)
IPR2022-00569 (Patent 10,429,041 B2)

Before KEVIN F. TURNER, JEFFREY S. SMITH, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Strike
37 C.F.R. § 42.5

Denying Patent Owner's Request to File a Motion
to Submit Supplemental Information
37 C.F.R. § 42.123(b)

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In an email to the Board on May 8, 2023, Patent Owner requested authorization to file a motion for additional discovery in IPR2022-00534 and IPR2022-00569. Ex 3006.¹ Petitioner opposed Patent Owner's request because "the discovery is being requested just over 1-month before the scheduled oral hearings for these matters." *Id.* We granted Patent Owner's request and authorized Patent Owner to file a five-page motion for additional discovery. *Id.* Patent Owner filed its five-page Motion on May 12, 2023, Petitioner filed a five-page Opposition on May 19, 2023, and Patent Owner filed a two-page Reply on May 23, 2023. Papers 26, 29, 31. We denied Patent Owner's motion for additional discovery. Paper 43.

Along with its Motion, Patent Owner filed, without authorization from the Board, two declarations (Exs. 2080 and 2086) and 25 new exhibits (Exs. 2081–2085, 2087–2106). On May 15, 2023, Patent Owner filed a Reply in support of its contingent Motion to Amend, which cites to several of the unauthorized exhibits. Paper 27, Section VI. On June 2, 2023, Patent Owner filed a Sur-Reply to the Petition, which cites to several of the unauthorized exhibits. Paper 40, Section III. Patent Owner also filed updated lists of exhibits which identify the citation information of the unauthorized exhibits. Paper 28; Paper 39.

In an email to the Board on May 17, 2023, Petitioner requested authorization to file a motion to strike the unauthorized declarations (exhibits 2080 and 2086) and the unauthorized exhibits. Ex. 3007. Petitioner also requested authorization to file a motion to strike paragraph 118 of exhibit 2111 in IPR2022-00534 and paragraph 127 of exhibit 2111 in IPR2022-00569, each of which incorporates by

¹ We reference the record in IPR2022-00534. Similar documents were filed in IPR2022-00569.

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reference exhibits 2080 and 2085. *Id.* Patent Owner opposed the request. *Id.* We granted Petitioner's request and authorized Petitioner to file a five-page motion to strike. *Id.* Petitioner filed a Motion to Strike, Patent Owner filed an Opposition to the Motion to Strike, and Petitioner filed a Sur-Reply to that Opposition. Papers 33, 38, 44 (additionally, a confidential version of the Opposition (Paper 37), for Board and parties only, was also filed).

Along with its Opposition, Patent Owner filed unauthorized exhibit 2112 and a motion to seal unauthorized exhibit 2112 and portions of its Opposition. Papers 37, 38. In an email to the Board on June 2, 2022, Petitioner requested authorization to file a motion to strike exhibit 2112 and arguments and evidence submitted in the Opposition. Ex. 3010. In another email to the Board on June 2, 2022, Patent Owner requested permission to file a motion to submit supplemental information. Ex. 3012. In an additional email to the Board on June 7, 2023, the parties agreed to expunge exhibit 2112 and to expunge Patent Owner's confidential opposition to Petitioner's motion to strike (Paper 37). Ex. 3013. The parties also agreed that the Motion to Strike applies to the exhibits cited and relied upon in Patent Owner's Sur-Reply to the Petition, which are the same as those addressed by Patent Owner's Reply to the Motion to Amend, namely, exhibits 2080–2106, paragraph 118 of exhibit 2111 in the '534 Proceeding, and paragraph 127 of exhibit 2111 in the '569 proceeding. *Id.* Per this Order, Exhibit 2112 and Paper 37 will be expunged. The Board held a conference call with the parties to discuss Patent Owner's request to file a Motion to Submit Supplemental Information on June 8, 2023.

Turning to exhibits 2080–2106, Petitioner contends that the Board only authorized Patent Owner to file a five-page motion for additional discovery, and did not authorize Patent Owner to file new declarations and exhibits with its

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motion. Paper 33, 1. Patent Owner contends that, because it was authorized to submit a five-page motion for additional discovery, its submission of 27 exhibits in support of its five-page motion for additional discovery “was authorized to substantiate its position that such discovery is in the interests of justice.” Paper 37, 1; Paper 38, 1.

Patent Owner is incorrect. We did not authorize Patent Owner to submit 27 new exhibits at this late stage of the proceedings. Patent Owner never requested permission to file the 27 exhibits, despite the opportunity to do so.² We therefore find that the 27 exhibits were unauthorized and improperly exceeded the scope of what we authorized. The 27 unauthorized exhibits are stricken on that basis.

Petitioner further contends that Patent Owner improperly relies on the unauthorized exhibits to support new arguments regarding secondary considerations in its Reply in support of the Motion to Amend, which was filed on May 15, 2023, only three days after filing the unauthorized exhibits. Paper 33, 4. Petitioner also assumes that Patent Owner will improperly rely on the unauthorized exhibits in its Sur-Reply to the Petition.³ *Id.* Petitioner contends that Dr. Bretschneider improperly relies on some of the unauthorized exhibits in his fourth declaration. *Id.* at 3, 5 (citing IPR2022-00534, Ex. 2111 ¶ 118 and IPR2022-00569, Ex. 2111 ¶ 127).

² Patent Owner, in order to submit supplemental information at this late stage of the proceedings, needed to request authorization to file a motion to submit supplemental information, which it did not do. *See* 37 C.F.R. § 42.123(b); PTAB Consolidated Trial Practice Guide at 75–76.

³ Patent Owner’s Sur-Reply does in fact rely on the unauthorized exhibits. Paper 40, 20–22; Ex. 3013.

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Patent Owner contends that its argument regarding secondary considerations in its Reply for the Motion to Amend is the same as that in its Motion to Amend. Paper 37, 3–4; Paper 38, 3–4. Patent Owner contends that Petitioner has had an opportunity, in Petitioner’s Sur-Reply, to respond to the Reply for the Motion to Amend. Paper 37, 4; Paper 38, 4. According to Patent Owner, relying on the unauthorized exhibits in the Reply for the Motion to Amend was proper because Petitioner had notice of the evidence and an opportunity to respond. Paper 37, 3; Paper 38, 3.

Our rules state that the scope of a reply is limited and “may only respond to arguments raised in the corresponding opposition.” 37 C.F.R. § 42.23(b).

Consistent with our rules, our Trial Practice Guide states

The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony. . . .

Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief. 37 C.F.R. § 42.23, except as noted above. “Respond,” in the context of § 42.23(b), does not mean proceed in a new direction with a new approach as compared to positions taken in a prior filing. While replies and sur-replies can help crystalize issues for decision, *a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered. . . .*

It is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing.

PTAB Consolidated Trial Practice Guide November 2019 (CTPG), 73–74.

Because a reply (or sur-reply) is not an opportunity to raise new arguments or present belated evidence that could have been (and should have been) provided earlier, the Board need not consider such arguments and evidence. *Id.* In view of

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