

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

GRÜNENTHAL GMBH  
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,  
Patent Owner.

---

PGR2018-00092  
Patent 9,820,999 B2

---

Before TONI R. SCHEINER, GRACE KARAFFA OBERMANN, and  
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

JUDGMENT  
Denying Patent Owner's Motion to Strike  
*37 C.F.R. § 42.5*

## I. INTRODUCTION

With our prior authorization (Paper 15), Patent Owner filed a Motion to Strike (Paper 13; “Mot.”) seeking to strike portions of Petitioner’s Reply (Paper 11; “Reply”) and Dr. Robinson’s Declaration supporting Petitioner’s Reply (Ex. 1044). Mot. 1. Petitioner filed an Opposition to Patent Owner’s Motion to Strike. Paper 16 (“Opp.”). Patent Owner filed a Reply. Paper 17 (“PO Reply”).

Based on our consideration of the parties’ positions, we deny Patent Owner’s Motion to Strike for the reasons that follow.

## II. DISCUSSION

Under the Board’s rules, a petitioner’s reply “may only respond to arguments raised in the corresponding . . . patent owner response.” 37 C.F.R. § 42.23(b) (2017); *see also Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (discussing how, in *inter partes* review proceedings, a petitioner’s reply is “limited to a true rebuttal role” (citing 37 C.F.R. §§ 42.104(b)(5), 42.23(b))). A petitioner’s reply is not an opportunity to raise new theories or arguments or to submit new evidence that reasonably could have been presented in the initial petition. *See* Patent Trial and Appeal Board, Trial Practice Guide Update, 15 (August 2018), available at <https://go.usa.gov/xU7GP> (the “Updated TPG”); *see also* Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39,989 (Aug. 13, 2018) (notice).

The Updated TPG provides the option to request authorization to file a motion to strike “[i]f the party believes that a brief filed by the opposing party raises new issues, is accompanied by belatedly presented evidence, or

otherwise exceeds the proper scope of reply or sur-reply.” Updated TPG 17. Specifically, the Practice Guide states that

A motion to strike may be appropriate when a party believes the Board should disregard arguments or late-filed evidence in its entirety, whereas further briefing may be more appropriate when the party wishes to address the proper weight the Board should give to the arguments or evidence. In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply. As such, striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.

*Id.*

In this case, Patent Owner moves to strike Dr. Robinson’s Declaration (Ex. 1044) and the corresponding paragraphs of Petitioner’s Reply (Paper 11), specifically the last paragraph of Section IV.A (*id.* at 11), all of Section V (*id.* at 17–20), and all of Section VI of the Reply (*id.* at 21–23). Mot. 1. Patent Owner contends that “Exhibit 1044 and related argument are new evidence and argument regarding the alleged accessibility of Varenna 2012 (Ex. 1005) that Petitioner could have submitted with the Petition, but chose not to.” Mot. 1.

We are not persuaded by Patent Owner’s arguments. The standard is not whether Petitioner could have raised the arguments or evidence in the Petition, but whether they respond to arguments raised by Patent Owner. 37 C.F.R. § 42.23(b) (2017); Opp. 1–2. Here, Patent Owner, in its Response, argued that Petitioner had failed to demonstrate that Varenna 2012 (Ex. 1005) was publicly accessible before the priority date. Paper 10, 4–13. In its Reply, Petitioner directly rebuts that position and provides supporting evidence in the form of the Declaration of Dr.

PGR2018-00092  
Patent 9,820,999 B2

Robinson. Paper 11, 11 (citing Ex. 1044). Thus, we do not agree that Dr. Robinson's testimony and related argument is improper.

In view of the above, we determine that Patent Owner has not shown that Dr. Robinson's Declaration and corresponding portions of Petitioner's Reply should be stricken.

### III. ORDER

Accordingly, it is

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

FOR PETITIONER:

Daniel Minion  
[dminion@venable.com](mailto:dminion@venable.com)

Bruce Haas  
[bchaas@venable.com](mailto:bchaas@venable.com)

FOR PATENT OWNER:

Brent Johnson  
[bjohnson@mabr.com](mailto:bjohnson@mabr.com)

Parrish Freeman  
[pfreeman@mabr.com](mailto:pfreeman@mabr.com)