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Identifying Impermissible New Arguments and Their Effect on IPR Proceedings and Appeals

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I. Introduction

In *inter partes* review (IPR) proceedings, the petition and patent owner's response generally define the scope of the parties' arguments. This scope generally limits a petitioner or patent owner's ability to raise new arguments in subsequent papers, such as a reply or sur-reply, or at an oral hearing. For petitioners, a reply generally "may only respond to arguments raised in ... [a] patent owner preliminary response, patent owner response, or decision on institution,"¹ and those reply arguments are often bounded by the positions taken in the initial petition. For patent owners, arguments not raised in its patent owner response may be deemed waived if raised later,² and the sur-reply "may only respond to arguments raised in the corresponding [petitioner] reply."³ If the Patent Trial and Appeal Board (Board) determines that a party is making untimely arguments, it may decline to consider them on the merits.⁴

On appeal, some parties have also challenged the Board's consideration of new arguments under the Administrative Procedure Act (APA).⁵ The Federal Circuit will usually review the Board's determination not to consider an argument because it was untimely for abuse of discretion,⁶ and consider whether the Patent and Trademark Office (PTO) provided adequate notice to the other party and an opportunity to respond.⁷

A party also generally cannot raise new arguments on appeal to the Federal Circuit,⁸ whose review is constrained

to the record before the Board.⁹ The Federal Circuit may find an argument raised for the first time on appeal to be waived because it lacks "the benefit of the [Board]'s informed judgement" on the issue.¹⁰

In each scenario, the key question comes down to what constitutes a "new" or untimely argument. This paper reviews recent decisions addressing whether new arguments were raised during an IPR and on appeal and examines how to identify and respond to potential new arguments.

II. New Arguments Raised at the Board

During an IPR, the Board has discretion to disregard arguments that it finds untimely or exceeding the proper scope of a reply or sur-reply and "crosses the line from the responsive to the new."¹¹ That same discretion, however, can also permit the Board to consider the arguments if the APA requirements are satisfied. As the Federal Circuit recognized, "[t]he Board may control its own proceedings, consistent with its governing statutes, regulations, and practice."¹² The Board's decision whether an argument is untimely is "reviewed for an abuse of discretion" by the Federal Circuit, which is a deferential standard of review.¹³ As such, the Board's decision whether an argument is untimely will often be conclusive. Several patterns have developed that can guide practitioners when trying to determine whether a potentially new argument is untimely or permissibly responsive.

A. New Arguments Raised in Replies or Sur-Replies

Generally, a reply or sur-reply can only clarify previously presented positions or respond to arguments raised in the preceding brief.¹⁴ Arguments presenting "a new approach as compared to the positions taken in [the

petition or patent owner response, respectively],” may be impermissible.¹⁵

1. Likely impermissible new argument

a. Presenting new theories for unpatentability or patentability

The Board has explained that a party raises a new argument when it relies on a new basis for unpatentability or patentability in a reply or sur-reply that was not presented in the petition or patent owner response, respectively.¹⁶

For a petitioner, such new arguments may occur when the reply introduces a new theory, such as a new theory for obviousness,¹⁷ a new rationale for motivation to combine or modify references,¹⁸ introducing a new reference to make out a *prima facie* case,¹⁹ or relying on unidentified portions of a previously cited reference.²⁰

In *Colas Solutions, Inc. v. Blacklidge Emulsions, Inc.*,²¹ the petition presented an obviousness theory that a reference inherently disclosed the claimed “softening point” limitation.²² After the patent owner pointed out that the petitioner’s expert testimony supporting the inherency theory was flawed, the petitioner argued in its reply brief that the claim was obvious because the softening points taught in the reference mostly overlapped with the claimed range, rather than being inherent.²³ The Board found the petitioner’s overlapping ranges theory to be new and untimely because the petitioner could not identify “a single line of its original Petition articulating this theory.”²⁴ The Federal Circuit agreed, explaining that “[the petitioner’s] belated attempt to stretch [the] evidence to fit its alternative ‘overlapping ranges’ theory only underscores that this theory was an afterthought raised for the first time in its Reply,” making it untimely.²⁵

Similarly, in *Henny Penny Corp. v. Frymaster LLC*,²⁶ the petition presented an obviousness theory to modify one prior art reference to incorporate a sensor from another reference to measure impurities called total polar materials (TPMs).²⁷ Then, in its reply, the petitioner argued that the incorporation was unnecessary because the primary reference alone taught a sensor that could measure TPMs.²⁸ The Board found the reply argument untimely and declined to consider it, and the Federal Circuit affirmed.²⁹

The Board and the Federal Circuit have also found that a petitioner’s attempt to introduce a new theory to combine or modify references can constitute an untimely argument. In *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*,³⁰ the petition relied on a combination of a first reference combined with the “azidomethyl group” of a second reference consistent with the processing conditions required by the first reference.³¹ The patent owner contended that the conditions of the second reference were not suitable for combining with the first reference.³² In its reply, the petitioner argued that it would have been

obvious to use conditions “*other than those described in [the second reference],*” citing several new references to support the obviousness theory.³³ The Board found this argument untimely and declined to consider it.³⁴ The Federal Circuit affirmed the Board’s decision not to consider the reply argument, noting that the reply presented “an entirely new rationale to explain why one of skill in the art would have been motivated to combine [the cited references].”³⁵

For a patent owner, an impermissible new argument may occur when a sur-reply introduces a new theory attacking the unpatentability grounds³⁶ or a new claim construction.³⁷ In *Google LLC v. Uniloc 2017 LLC*,³⁸ in response to the anticipation ground raised in the petition, the patent owner’s response argued that the cited reference did not teach modifying the output of a certain module in the claims.³⁹ In its sur-reply, the patent owner then argued for the first time that the module in the reference was “deactivated” and its output could not be selected.⁴⁰ The Board found this “deactivated” argument untimely because it was raised for the first time in the sur-reply, and it was not a responsive to any argument raised in the petitioner’s reply.⁴¹ Similarly, in *ProMOS Technologies, Inc. v. Samsung Electronics Co., Ltd.*,⁴² the Federal Circuit agreed with the Board that a patent owner’s claim construction argument first presented in its sur-reply was untimely and need not be considered.⁴³

The prohibition against belated arguments highlights the importance for petitioners of including applicable bases for unpatentability challenges and preempting a patent owner’s counterarguments in the petition, or, for a patent owner, identifying as many potential weaknesses in the petitioned grounds as possible in the patent owner response.

b. Relying on previously unidentified reference or portion of a reference for prima facie unpatentability

The governing statute states that an IPR petition “may be considered only if ... the petition identifies ... with particularity ... the evidence that supports the grounds for the challenge to each claim,” including the prior art references.⁴⁴ The Board has explained that a petitioner generally cannot introduce new evidence after institution that is required to establish a *prima facie* case of unpatentability, whether new references or previously uncited support in a reference.⁴⁵

In *Haag-Streit AG v. Eidolon Optical, LLC*,⁴⁶ the Board found a reply argument introducing a new reference not cited in the petition, and relying on it to establish certain claim elements, was untimely.⁴⁷ There, the petition relied on the Devonshire reference to address the claimed “resistor” limitation,⁴⁸ but in its reply, the petitioner introduced, for the first time, the Nishizawa reference to

identify the structure of the “resistor” limitation.⁴⁹ The Board found this latter argument improperly presented a new unpatentability position and declined to consider it.⁵⁰

In other cases, the Board has found a petitioner’s reply argument untimely when it cites a previously identified reference, but relies on new portions “not identified or discussed” in the petition to show unpatentability.⁵¹ In *Ariosa Diagnostics v. Verinata Health, Inc.*,⁵² the Board declined to consider the petitioner’s reply argument relying on previously unidentified embodiments of a reference to establish obviousness.⁵³ The Board noted that the petition had previously provided only a generic statement describing that reference, without discussing any of the specific embodiments that the petitioner relied on in its reply.⁵⁴ The Federal Circuit agreed, explaining that, because the reply relied on a different embodiment in the same reference than the petition, it raised an untimely argument because the theory was “meaningfully distinct” from the theory in the petition.⁵⁵ Similarly, in *MModal LLC v. Nuance Communications, Inc.*,⁵⁶ the Federal Circuit affirmed the Board’s finding that the petitioner introduced “an impermissible new argument not sufficiently made in the petition” when the petition discussed one portion of a reference (medical information and targeted information) as disclosing a particular claim element, but the reply brief relied on a different embodiment (spiculated masses portion) for the same claim element.⁵⁷

As these case examples demonstrate, the Board may decline to consider a petitioner’s new evidence not presented with the petition that it finds merely gap fills the *prima facie* case of unpatentability after institution.

2. Permissible explanation

a. Further explaining previously cited evidence to rebut another party’s arguments

Although new arguments are generally not permitted after institution, the Federal Circuit has explained that the Board should not “endorse an overly formalistic approach that would unduly inhibit a petitioner from responding to criticisms of issues that it properly presented in the petition.”⁵⁸ As such, a petitioner can, in its reply or other post-institution briefing, clarify its previously presented positions and respond to the patent owner’s arguments or the Board’s institution decision positions.⁵⁹

In *Ericsson Inc. v. Intellectual Ventures I LLC*,⁶⁰ in response to an evolving claim construction after institution, the petitioner’s reply argued that the difference between the “interleaving” in the cited reference and that in the claims was insubstantial, and the reference therefore rendered the claimed “interleaving” obvious.⁶¹ Although the Board characterized this as raising a new

theory,⁶² the Federal Circuit disagreed, finding that the petitioner “cite[d] no new evidence” and instead “merely expand[ed] on a previously argued rationale as to why the prior art disclosures are insubstantially distinct from the challenged claims.”⁶³ The Federal Circuit explained that the Board adopted a different construction of the interleaving limitation after institution, and the petitioner was entitled to respond to that construction.⁶⁴ The court therefore vacated the Board’s decision and remanded for the Board to consider the petitioner’s reply arguments.⁶⁵

b. Relying on previously uncited evidence to rebut others’ arguments

A petitioner’s reply may also cite to other evidence in the record that was not previously discussed to rebut a patent owner’s response arguments if “the evidence is a legitimate reply to evidence introduced by the patent owner.”⁶⁶ For example, a petitioner can cite to related portions in previously cited references to respond to the patent owner’s criticism on issues raised in the petition.⁶⁷ In *Apple Inc. v. Andrea Electronics Corp.*,⁶⁸ although petition discussed one application of an algorithm in the cited art (without sub-windows), the petitioner’s reply analyzed a different application of the same algorithm (with multiple sub-windows) to show unpatentability in response to patent owner’s arguments.⁶⁹ The Board rejected the reply argument as an impermissible new matter.⁷⁰ The Federal Circuit, however, reversed, finding that “[the petitioner’s] reply relies on the same algorithm from the same prior art reference to support the same legal argument” in the petition to show unpatentability.⁷¹ The court added that the petitioner’s reply argument also responded to the patent owner’s response argument about the cited algorithm and was therefore a permissible rebuttal.⁷²

When responding to a patent owner’s arguments, there is no “blanket prohibition” against introducing new evidence,⁷³ and a petitioner may include evidence, such as expert testimony, that is not already in the record.⁷⁴ Indeed, the Federal Circuit has recognized that “the introduction of new evidence in the course of the trial is to be expected in *inter partes* review trial proceedings,” and such evidence may be permissible if “the opposing party is given notice of the evidence and an opportunity to respond” as required by the APA.⁷⁵

In *Infinium USA L.P. v. Chevron Oronite Co. LLC*,⁷⁶ the Federal Circuit rejected the patent owner’s contention that the Board improperly relied on new arguments raised by the petitioner for the first time in its reply.⁷⁷ There, the patent owner’s response argued that one skilled in the art would not have selected certain examples over others in a cited reference because other examples were more promising.⁷⁸ The petitioner’s reply then relied on additional expert testimony, arguing that one would have selected the examples relied on in the petition because other

examples discussed by the patent owner did not perform better.⁷⁹ The Federal Circuit affirmed the Board's finding that these reply arguments and expert testimony were proper rebuttal arguments because they addressed the arguments made in the patent owner's response.⁸⁰ The court noted that, because the Board permitted the patent owner to depose petitioner's expert on the additional testimony and file a sur-reply, the patent owner had notice and opportunity to respond under the APA.⁸¹

Accordingly, a petitioner's reply is permitted to use additional arguments to further clarify issues previously raised in the petition or rebut arguments raised by the patent owner or the Board. If a reply argument also includes new evidence, the opposing party is entitled to notice and an opportunity to respond under the APA.

B. New arguments raised at the oral hearing

The prohibition against new arguments also extends to the oral hearing. Generally, parties may not raise new arguments at the oral hearing that are not previously briefed to the Board.⁸² New arguments raised for the first time at the oral hearing may be considered untimely and waived.⁸³

In *Cablz, Inc. v. Chums, Inc.*,⁸⁴ the Federal Circuit held that a patent owner had waived its argument that a certain reference failed to disclose a "resilient cable" because it failed to raise that argument in its briefing.⁸⁵ The patent owner contended that it had preserved the argument with a statement in its patent owner response that "no reference teaches a resilient cable."⁸⁶ The court, however, found that generic statement insufficient to "preserve the particular issue of whether [a specific reference] discloses" the resilient cable element.⁸⁷ Similarly, in *Collabo Innovations, Inc. v. Sony Corp.*,⁸⁸ at the oral hearing, the patent owner challenged the Board's adoption of the petitioner's claim construction in the institution decision, but conceded that it had not previously raised that argument in its briefs.⁸⁹ The Board determined that the patent owner had waived that argument, and the Federal Circuit affirmed.⁹⁰

Like permissible responsive arguments in briefs, a party can raise responsive arguments and elaborate on previously raised positions at oral hearing.⁹¹ In *Chamberlain Group, Inc. v. One World Technologies, Inc.*,⁹² the Federal Circuit found the Board erred in finding the patent owner had waived a particular argument first raised at the oral hearing.⁹³ There, the petitioner's reply argued, for the first time, that a cited reference taught a claim limitation that required identifying multiple activities and that the claim did not include a timing limitation for that identification.⁹⁴ At the oral hearing, the patent owner responded

to petitioner's reply argument and argued that the claim required identifying multiple activities before transmitting guidance "responsive to" the identification.⁹⁵ The Board found patent owner's argument at the hearing was untimely and waived.⁹⁶ The Federal Circuit disagreed, explaining that the patent owner's argument directly responded to arguments first raised in the petitioner's reply and "tracked the arguments in its [patent owner's] response," and therefore did not raise an improper new argument.⁹⁷

As these examples show, new arguments raised for the first time at the oral hearing are generally considered untimely and waived, but such arguments may be permitted to rebut new arguments raised in the preceding brief.

III. New Arguments Raised at the Federal Circuit

The Federal Circuit generally reviews Board decisions based on the "record ... and evidence presented by the parties" to the Board.⁹⁸ As such, a party generally cannot raise an argument on appeal that was not properly presented to the Board, but the Federal Circuit retains case-by-case discretion to determine whether arguments are untimely on appeal.⁹⁹

In *Microsoft Corp. v. Biscotti, Inc.*,¹⁰⁰ the court declined to consider anticipation arguments raised by an IPR petitioner on appeal because the petitioner had not raised those arguments at the Board, either in its petition or otherwise.¹⁰¹ The court reiterated "the general rule ... that any argument not raised before the Board is waived on appeal."¹⁰²

In assessing whether an argument should be considered on appeal or has been waived, the Federal Circuit has explained that an argument not "distinctly" or "separate[ly]" argued before the Board can be waived even when a "generic" version argument was presented below.¹⁰³ In *Novartis AG v. Torrent Pharmaceuticals Ltd.*,¹⁰⁴ the court declined to consider arguments related to unexpected results of specific dosages recited in certain dependent claims, explaining that the patent owner-appellant had not "distinctly argued [the] unexpected result specific to the dependent claims [it] now raises on appeal."¹⁰⁵ The court explained that the patent owner's arguments at the Board were "untethered from any specific dosage or concentration limitation and with no discussion of any dependent claims."¹⁰⁶ Accordingly, the court found the patent owner's argument on appeal was waived.¹⁰⁷

The Federal Circuit has also declined to consider arguments raised in a patent owner's preliminary response before institution, but not then presented in the patent

owner's response during the trial stage.¹⁰⁸ In *In re NuVasive, Inc.*,¹⁰⁹ the court held that the patent owner had waived its public-accessibility argument on appeal because, although it challenged public accessibility in the preliminary response, it did not pursue that argument during the trial phase and the patent owner declined to make such argument at the oral hearing.¹¹⁰ The court, therefore, concluded that the patent owner had waived such arguments and declined to consider them on appeal.¹¹¹

IV. Practical Considerations

A. Recognizing Possible Untimely Arguments

While every case turns on its particular facts, patent owners and petitioners can take some guidance from both Board and Federal Circuit decisions determining when arguments were untimely, which often turn on whether an argument constitutes a “new” or untimely argument.¹¹²

The Board has considered arguments to be “new” and untimely if they are not sufficiently identified in the petition or patent owner's response or are meaningfully distinct theories from a previously raised position.¹¹³ But, as discussed above, not all “new” arguments are automatically untimely or improper. If, a “new” argument directly responds to arguments raised by the opposing party or clarifies previously presented theory, it may not be untimely. But, if the argument proffers a materially different theory, such as to gap fill a *prima facie* unpatentability case or raise a new prior art combination or claim construction position, the Board has excluded such arguments.¹¹⁴

On appeal, the Federal Circuit may decline to consider arguments that were not properly presented to the Board, such as not raised at all below,¹¹⁵ presented only in a pre-institution preliminary response,¹¹⁶ or first raised in a sur-reply.¹¹⁷

B. Challenging Potential New Arguments at the Board and on Appeal

If a party believes the opposing side has made an untimely new argument at the Board, it can raise the issue with the Board through several available procedures, such as submitting responsive briefing, moving to strike or exclude the argument, or requesting a conference call with the Board.¹¹⁸ Parties can, for example, raise new argument challenges under either the Board's rules

prohibiting new arguments in replies and sur-replies or under the APA.

At the Board, a party should carefully review the other party's briefing, including replies and sur-replies, to identify possible new arguments that were not previously raised. If it believes there are new arguments, it should consider whether to challenge them during the IPR, rather than waiting for appeal, if it can. The Board has responded to such challenges in various ways. In some cases, it has granted a party's request and set a conference call to discuss the issue.¹¹⁹ In others, it has allowed the party challenging the new argument to file a motion to strike.¹²⁰ More recently, it has allowed the party to file listings of page and line numbers identifying where it believes the new argument is present, and the opposing party to identify reasons why the argument is not “new,” such as by identifying a portion of the patent owner response that a challenged reply argument addresses.¹²¹

On appeal, parties can review the final written decision for compliance with the APA and raise any perceived APA violations to the Federal Circuit if it did not have notice of the argument and an opportunity to respond.¹²² In some cases, APA challenges have been raised on appeal where the new argument was first raised at the IPR oral hearing¹²³ or by the Board in a final written decision below.¹²⁴ But, the Federal Circuit has also cautioned that, if a party has notice of the argument at the Board, it should raise the issue below, if an opportunity exists.¹²⁵ In *Genzyme Therapeutic Products Ltd. Partnership v. Biomarin Pharmaceutical Inc.*,¹²⁶ for example, the Federal Circuit declined to consider a patent owner's APA argument because the patent owner had not “take[n] advantage of ... [available] procedural options to seek to exclude that evidence or to respond to [the petitioner's] arguments.”¹²⁷

Parties can also challenge new arguments made for the first time on appeal, which may be waived.¹²⁸ A party should also keep in mind that, if an argument was raised below, even belatedly, the Federal Circuit may defer to the Board's decision whether to consider that argument provided the APA requirements are satisfied.¹²⁹

C. Preserving Arguments for the Board's or Federal Circuit's Consideration

To avoid new argument challenges at the Board and on appeal, parties should invest time trying to anticipate potential attacks on the unpatentability grounds in the petition and patentability arguments in the patent owner response. This will allow parties to preemptively address counterarguments, where possible, to avoid a need to gap fill positions with potentially new argument later in the



proceeding. Petitioners should try to closely link arguments in reply briefs to the criticisms raised in the patent owner response to show that they are responsive and also tie the arguments to the grounds presented in the petition to show they are not “new.” Patent owners, in the patent owner response, should also try to anticipate potential reply arguments from the petitioners and link sur-reply

arguments to the petitioner’s reply arguments where possible to show that the sur-reply arguments are not “new.”

While the line between proper responsive arguments and impermissible or untimely new arguments may not always be clear, maintaining a clear consistent theme throughout a party’s briefing will help guide parties when making such decisions.

1. See 37 C.F.R. § 42.23(b).
2. PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 94, <https://www.uspto.gov/TrialPracticeGuideConsolidated>.
3. 37 C.F.R. § 42.23(b).
4. See, e.g., *Collabo Innovations, Inc. v. Sony Corp.*, 802 Fed. Appx. 568, 571 (Fed. Cir. 2020) (discussing the Board’s authority to consider timely arguments and find untimely arguments waived).
5. See, e.g., *Qualcomm Inc. v. Intel Corp.*, No. 2020-1589, 2021 U.S. App. LEXIS 22167, at *8 (Fed. Cir. 2021) (discussing procedural requirements under the APA).
6. See, e.g., *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016).
7. See 5 U.S.C. §§ 554(b)(3), 554(c), 556(d); see also *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015).
8. There are exceptions to this general principle, which are beyond the scope of this paper.
9. See, e.g., *In re NuVasive, Inc.*, 842 F.3d 1376, 1380 (Fed. Cir. 2016).
10. *Id.*
11. *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1368 (Fed. Cir. 2015).
12. *Dell Inc. v. Accelleron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (citing 37 C.F.R. § 42.5).
13. *Intelligent Bio-Systems*, 821 F.3d at 1367.
14. PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 74, <https://www.uspto.gov/TrialPracticeGuideConsolidated>.
15. *Id.*
16. PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 73–74, <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim.”); see also *Intelligent Bio-Systems*, 821 F.3d at 1369–70.
17. See, e.g., *Colas Sols, Inc. v. Blackledge Emulsions, Inc.*, 759 F. App’x 986, 990 (Fed. Cir. 2019).
18. See, e.g., *Intelligent Bio-Systems*, 821 F.3d at 1369–70.
19. See, e.g., *Haag-Streit AG v. Eidolon Optical, LLC*, Case IPR2018-01311, Paper 31 at 6–8 (PTAB Sept. 5, 2019).
20. See, e.g., *Ariosa*, 805 F.3d at 1367–68.
21. *Colas Sols, Inc. v. Blackledge Emulsions, Inc.*, 759 F. App’x 986 (Fed. Cir. 2019).
22. *Id.* at 988.
23. *Id.* at 988, 989–90.
24. *Id.* at 990.
25. *Id.*
26. *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324 (Fed. Cir. 2019).
27. *Id.* at 1328.
28. *Id.* at 1328–29.
29. *Id.* at 1331.
30. *Intelligent Bio-Systems*, 821 F.3d 1359.
31. *Id.* at 1364, 1369.
32. *Id.* at 1369.
33. *Id.*
34. *Id.*
35. *Id.* at 1370.
36. *Google LLC v. Uniloc 2017 LLC*, Case IPR2020-00447, Paper 24 at 13–14 (PTAB May 11, 2021).
37. *ProMOS Techs., Inc. v. Samsung Elecs. Co., Ltd.*, 809 F. App’x 825, 835 (Fed. Cir. 2020).
38. *Google*, Case IPR2020-00447, Paper 24.
39. *Id.* at 9–10.
40. *Id.* at 13–14.
41. *Id.* at 14.
42. *ProMOS*, 809 F. App’x 825.
43. *Id.* at 835.
44. 35 U.S.C. § 312(a)(3).
45. See PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 73, <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a *prima facie* case of unpatentability.”)
46. *Haag-Streit*, Case IPR2018-01311, Paper 31.
47. *Id.* at 6–8.
48. *Id.* at 4.
49. *Id.* at 4–5.
50. *Id.* at 6–8.
51. *Ariosa*, 805 F.3d at 1367.
52. *Id.*
53. *Id.* at 1367–68.
54. *Id.*
55. *Id.*
56. *MModal LLC v. Nuance Communs., Inc.*, 846 F. App’x 900 (Fed. Cir. 2021).
57. *Id.* at 906.
58. *Kingsston Tech. Co. v. SPEX Techs., Inc.*, 798 F. App’x 629, 636 (Fed. Cir. 2020).
59. See PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 73–74, <https://www.uspto.gov/TrialPracticeGuideConsolidated>.
60. *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018).
61. *Id.* at 1379–80.
62. *Id.* at 1380.
63. *Id.* at 1381.
64. *Id.* at 1380.
65. *Id.* at 1381.
66. See *Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 706–07 (Fed. Cir. 2020); see also PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 73, <https://www.uspto.gov/TrialPracticeGuideConsolidated>.
67. See *Apple*, 949 F.3d at 706.
68. *Id.*
69. *Id.* at 705–06.
70. *Id.* at 705.
71. *Id.* at 706.
72. *Id.* at 706–07.
73. *Anacor Pharm., Inc. v. Iancu*, 889 F.3d 1372, 1380 (Fed. Cir. 2018).
74. *Infineum USA L.P. v. Chevron Oronite Co. LLC*, 844 Fed. Appx. 297, 303 (Fed. Cir. 2021) (holding that the expert testimony the petitioner submitted with its reply was a proper rebuttal to the patent owner’s response).
75. *Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016).
76. *Infineum*, 844 Fed. Appx. 297.
77. *Id.* at 303–04.
78. *Id.* at 302.
79. *Id.*
80. *Id.* at 303.
81. *Id.* at 303–04.
82. PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 85–86, <https://www.uspto.gov/TrialPracticeGuideConsolidated>.
83. See *Dell*, 884 F.3d at 1369.
84. *Cablz, Inc. v. Chums, Inc.*, 708 Fed. Appx. 1006 (Fed. Cir. 2017).
85. *Id.* at 1011–12.
86. *Id.* at 1012.
87. *Id.*
88. *Collabo*, 802 Fed. Appx. 568.
89. *Id.* at 571.
90. *Id.* at 571–72.
91. *Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019) (“Parties are not barred from elaborating on their arguments on issues previously raised” at the oral argument.).
92. *Id.*
93. *Id.* at 925.
94. *Id.* at 924.
95. *Id.*
96. *Id.*
97. *Id.* at 925.



98. *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1329 (Fed. Cir. 2017).
99. *Id.*
100. *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052 (Fed. Cir. 2017).
101. *Id.* at 1074–75.
102. *Id.* at 1075.
103. *Novartis*, 853 F.3d at 1329–30.
104. *Id.*
105. *Id.* at 1330.
106. *Id.* at 1329.
107. *Id.* at 1330.
108. *See, e.g., Finjan, Inc. v. Cisco Sys., Inc.*, 837 Fed. Appx. 799, 812 n.10 (Fed. Cir. 2020).
109. *In re NuVasive*, 842 F.3d 1376.
110. *Id.* at 1380–81.
111. *Id.* at 1381.
112. *See* PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 73–74, <https://www.uspto.gov/TrialPracticeGuideConsolidated>.
113. *See Apple*, 949 F.3d at 705–06.
114. *See* PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), at 73–74, <https://www.uspto.gov/TrialPracticeGuideConsolidated> (discussing examples of untimely or “new” arguments).
115. *Microsoft*, 878 F.3d at 1075.
116. *In re NuVasive*, 842 F.3d at 1380–81.
117. *ProMOS*, 809 Fed. Appx. at 835 (declining to consider on appeal the claim construction argument the patent owner first raised in its sur-reply).
118. *See, e.g., Securus Techs., Inc. v. Global Tel*Link Corp.*, 685 Fed. Appx. 979, 985 (Fed. Cir. 2017) (noting that the patent owner did not “avail[] itself of the procedures for filing a sur-reply, a motion to strike, or a conference call to challenge [the] allegedly improper argument”); *Belden*, 805 F.3d at 1081 (listing potential procedural options for responding to alleged new arguments).
119. *Securus Techs. Inc. v. Global Tel*Link Corp.*, IPR2016-00996, Paper 20 at 2 (PTAB Mar. 29, 2017) (noting that the judges held a conference call upon the patent owner’s request regarding potential new arguments raised in the petitioner’s reply).
120. *See, e.g., Haag-Streit*, Case IPR2018-01311, Paper 31 (granting in part the patent owner’s motion to strike petitioner’s reply for raising new theories of invalidity).
121. *See, e.g., Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, Case IPR2018-01558, Paper 31 at 2, 54 (PTAB Jan. 23, 2020) (noting that the patent owner filed a paper identifying new arguments and evidence in the petitioner’s reply and the petitioner filed a response).
122. *Dell Inc. v. Accelaron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016) (discussing APA procedural requirements).
123. *See, e.g., id.*
124. *See, e.g., Qualcomm*, 2021 U.S. App. LEXIS 22167, at *21 (remanding IPR decisions because the Board failed to provide the patent owner a notice and opportunity to respond to its *sua sponte* claim construction).
125. *See, e.g., Securus*, 685 Fed. Appx. at 985 (“[I]t is incumbent upon the party complaining of some procedural violation—such as the inclusion of improper rebuttal in a reply brief—to first raise the issue below.”)
126. *Genzyme*, 825 F.3d 1360.
127. *Id.* at 1368.
128. *See Microsoft*, 878 F.3d at 1075.
129. *Dell*, 884 F.3d at 1369 (Fed. Cir. 2018) (“We do not direct the Board to take new evidence, or, even, to accept new briefing. The Board may control its own proceedings, consistent with its governing statutes, regulations, and practice.”).