

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AXONICS MODULATION TECHNOLOGIES, INC.,
Petitioner,

v.

MEDTRONIC, INC.,
Patent Owner.

IPR2020-00678 (Patent 7,774,069 B2)
IPR2020-00680 (Patent 8,457,758 B2)
IPR2020-00712 (Patent 8,738,148 B2)¹

Before JAMES A. TARTAL, ERIC C. JESCHKE, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order applies to each of the listed proceedings. The parties are not authorized to use this style heading for any subsequent papers.

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In each of these proceedings, Medtronic, Inc. (“Patent Owner”) first seeks to admit the cross-examination testimony of its declarant, Dr. Mihran, as an exhibit. *See* Ex. 3001 (email from counsel for Patent Owner dated April 7, 2021). Second, Patent Owner seeks to strike portions of the Reply of Axonics Modulation Technologies, Inc. (“Petitioner”), as well as portions of the Supplemental Declaration of Petitioner’s declarant, Dr. Panescu. *Id.* Petitioner opposes Patent Owner’s requests. *Id.* We address each of these issues in turn below.

Admission of Cross-Examination Testimony

With respect to each proceeding, as explained by Patent Owner, Petitioner deposed Patent Owner’s declarant, but did not rely on that cross-examination testimony in its Reply and did not enter a transcript of that cross-examination testimony as an exhibit. *Id.* Patent Owner argues that “Petitioner should be required to file the transcript as an exhibit” *Id.* (citing 37 C.F.R. § 42.53(f)(7)). Patent Owner alternatively requests “leave to file the transcript as an exhibit with its sur-replies.” *Id.*

According to 37 C.F.R. § 42.53(f)(7), “[e]xcept where the parties agree otherwise, the proponent of the testimony must arrange for providing a copy of the transcript to all other parties,” and that the “testimony must be filed by proponent as an exhibit.” 37 C.F.R. § 42.53(f)(7). Petitioner is not a “proponent” of the cross-examination testimony of Patent Owner’s declarant because Petitioner does not rely on or cite to that cross-examination testimony in Petitioner’s Reply or elsewhere. Accordingly, Patent Owner fails to show that Petitioner should be required to file a transcript of the cross-examination testimony as an exhibit under 37 C.F.R. § 42.53(f)(7) because Petitioner is not the proponent of that evidence.

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As to Patent Owner's alternative request for leave to file the cross-examination testimony as an exhibit with its sur-reply, Patent Owner cites no rule in support of its request and otherwise fails to identify any basis for receiving leave to file the testimony as an exhibit under the circumstances presented. *See* Ex. 3001. The Patent Trial and Appeal Board Consolidated Trial Practice Guide ("CTPG")² explains that "[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." CTPG, 73; *see also* 37 C.F.R. § 42.23(b) (providing that "[a] reply may only respond to arguments raised in the corresponding opposition or patent owner response"). Patent Owner does not suggest that its declarant is a "reply witness." Indeed, Petitioner does not rely on or cite to the declarant's cross-examination testimony in its Reply, which supports that the declarant is not a "reply witness." Accordingly, Patent Owner's sur-reply may not be accompanied by a transcript of the cross-examination of its declarant.

The CTPG also states that "[s]ur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony." CTPG, 73–74. The declarant's cross-examination testimony was not introduced as evidence, and, accordingly, Patent Owner cannot "point to" that cross-examination testimony in its sur-reply. Instead, Patent Owner improperly seeks to introduce the cross-examination testimony of its declarant as new evidence. Patent Owner may not submit "new evidence" in support of a sur-reply, including "new evidence" consisting of the cross-examination testimony of

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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its own declarant. *See* 37 C.F.R. § 42.23(b). To find otherwise would, in effect, permit Patent Owner to use the cross-examination testimony as an untimely, and, therefore, improper supplemental declaration to support its sur-reply. Accordingly, we deny Patent Owner’s request for leave to file a transcript of the cross-examination testimony of its declarant as an exhibit in support of Patent Owner’s sur-reply.

Arguments and Evidence Purportedly Outside the Scope of a Reply

In each proceeding, Patent Owner argues that Petitioner improperly raises “new theories and evidence” in its Reply, and Patent Owner thus “seeks leave to file a motion to strike and requests that the Board decide this motion on an expedited basis.” Ex. 3001 (further identifying the Supplemental Declaration of Petitioner’s declarant as an example of the purportedly improper “new evidence”). Petitioner disagrees and maintains that the arguments and evidence are proper in reply to Patent Owner’s Response. *Id.*

Upon consideration, Patent Owner’s request for authorization to file a motion to strike is denied. As the CTPG explains, “[i]n most cases the Board is capable of identifying new issues . . . when weighing the evidence at the close of trial, and disregarding any new issues . . . that exceed[] the proper scope of reply or sur-reply,” and 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.” CTPG, 80–81. Patent Owner identifies an “example” of the material it seeks to strike, which Petitioner contends is responsive to Patent Owner’s claim construction arguments. Ex. 3001. We find the example provided by Patent Owner does not suggest that the exceptional remedy Patent Owner seeks is warranted. *See id.*

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Patent Owner, however, is authorized to file in each proceeding a paper titled “Patent Owner’s List of Improper Reply Arguments and Evidence,” which shall be in the form of a numbered, itemized list that provides the paper, page, and line number location only of the portions of Petitioner’s Reply and the Supplemental Declaration of Petitioner’s declarant that Patent Owner asserts exceed the scope of a proper reply or reply evidence.

We also authorize Petitioner to file in each proceeding “Petitioner’s Response to Patent Owner’s List of Improper Reply Arguments and Evidence.” If Petitioner chooses to file such a response, Petitioner shall identify, corresponding in the same numbering and itemized manner to Patent Owner’s List, what Petitioner regards as support from the Patent Owner Response (by paper, page, and line number only) and/or the Petition (by paper, page, and line number only) to show that each portion of Petitioner’s Reply or the Supplemental Declaration of Petitioner’s declarant identified by Patent Owner does not exceed the scope of a proper reply or reply evidence. Petitioner’s paper shall not contain any substantive arguments.

The propriety or impropriety of the identified portions of the replies will be addressed, to the extent necessary, in a later order or in our final written decision for each proceeding. To the extent the Panel determines that any item identified by Patent Owner warrants additional briefing, an additional order will be issued, providing such instruction to the parties.

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Accordingly, it is in each of the above identified proceedings:

ORDERED that Patent Owner's request to require Petitioner to file as an exhibit the cross-examination testimony of Patent Owner's declarant is *denied*;

FURTHER ORDERED that Patent Owner's request for leave to file as an exhibit the cross-examination testimony of Patent Owner's declarant with its sur-reply is *denied*;

FURTHER ORDERED that Patent Owner's request for leave to file a motion to strike portions of Petitioner's Reply and the Supplemental Declaration of Petitioner's declarant is *denied*;

FURTHER ORDERED that Patent Owner is authorized to file "Patent Owner's List of Improper Reply Arguments and Evidence," as described above, by April 16, 2021, and;

FURTHER ORDERED that Petitioner is authorized to file "Petitioner's Response to Patent Owner's List of Improper Reply Arguments and Evidence," as described above, by April 23, 2021.

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PETITIONER:

James Isbester

Babak Sani

KILPATRICK TOWNSEND & STOCKTON LLP

jisbester@kilpatricktownsend.com

bssani@kilpatricktownsend.com

For PATENT OWNER:

Naveen Modi

Chetan R. Bansal

Quadeer Ahmed

PAUL HASTINGS LLP

naveenmodi@paulhastings.com

chetanbansal@paulhastings.com

quadeerahmed@paulhastings.com