

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUNTER'S MANUFACTURING COMPANY, INC. d/b/a
TENPOINT CROSSBOW TECHNOLOGIES,
Petitioner,

v.

RAVIN CROSSBOWS, LLC,
Patent Owner.

IPR2023-00407
Patent 9,354,015 B2

Before KEN B. BARRETT, PATRICK R. SCANLON, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

I. INTRODUCTION

Our Order (Paper 18) authorized Petitioner to file its Motion to Submit Supplemental Information (“Motion”) (Paper 19) pursuant to 37 C.F.R. § 42.123(a) and further authorized Patent Owner to file its Response (Paper 20) thereto.

Upon consideration of the papers, and for the reasons stated below, we *deny* Petitioner’s Motion.

II. ANALYSIS

A. *Legal Principles*

In practice before the Board, e.g., in the course of an *inter partes* review (“IPR”) proceeding, a party filing a motion “has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c). This is so, no matter the requested relief—including a motion to submit supplemental information under 37 C.F.R. § 42.123(a).

“Once a trial has been instituted,” 37 C.F.R. § 42.123(a) states, “a party may file a motion to submit supplemental information in accordance with the following requirements:”

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

37 C.F.R. § 42.123(a).¹

¹ The rule also has subsections (b) and (c), which pertain, respectively, to the submission of supplemental information where a party makes such a request “more than one month after the date the trial is instituted” and where the supplemental information is “not relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(b), (c).

However, beyond the timeliness and relevancy requirements, motions under § 42.123(a) are evaluated “within the overarching context of the PTAB’s regulations governing IPR and general trial proceedings.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015).

In addressing motions under § 42.123(a), the Board has relied upon a number of guiding principles that are helpful in addressing Petitioner’s Motion.

A number of these principles stem from the primacy of the petition in IPR proceedings, whereby “the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). The Federal Circuit has explained that “[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim’”; indeed, “the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)).

Likewise, the Board’s regulations require a petition to “[p]rovide a statement of the precise relief requested for each claim challenged” that identifies “[t]he specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and the patents or printed publications relied upon for each ground,” as well as “how the construed claim is unpatentable under the statutory grounds identified” in the petition

and “where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b).

In view of the fundamental role of a petition to delineate the patentability issues for the claims addressed therein, the Board has allowed supplementation, under 37 C.F.R. § 42.123(a), that merely clarifies, but does not change, an unpatentability position presented in the petition. *See MED-EL Elektromedizinische Geräte Ges.m.b.H. v. Advanced Bionics AG*, IPR2020-00190, Paper 24 at 5 (PTAB Aug. 10, 2020) (“Petitioner is merely attempting to clarify arguments made in the Petition, not change its theories of unpatentability.”); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37, 3 (PTAB Feb. 5, 2014) (granting motion for supplemental information that “does not change the grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability”). For example, the Board allowed — as proper supplemental information under 37 C.F.R. § 42.123(a) — an expert’s supplemental declaration that “largely mirror[ed] his original declaration in subject matter and provide[d] additional details on how he designed and constructed the models” of prior art embodiments, which the expert’s original declaration (accompanying the petition) already described and “discussed at length.” *Frameless Hardware Co. LLC v. C.R. Laurence Co., Inc.*, IPR2022-00356, Paper 29 at 5, 7 (PTAB Oct. 25, 2022).

On the other hand, the Board has declined to permit supplemental information that alters the arguments or evidence relied upon in the petition. *See W. Digital Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 22 at 10 (PTAB July 23, 2018) (“[P]resenting a new argument, based on a reading of

the references different from that of the Petition, is not a permissible application of [37 C.F.R. §]42.123.”); *Nissan N. Am., Inc. v. Diamond Coating Techs., LLC*, IPR2014-01548, Paper 37 at 3 (PTAB July 15, 2015) (denying supplementation that would “change the evidence on which [the petitioner] relied in making its original challenge to claims . . . for which trial was instituted,” by “includ[ing] new opinions with respect to what a person having ordinary skill in the art would understand is disclosed by [a reference]”).

Notably, the Board has warned that “[s]upplemental information,” under 37 C.F.R. § 42.123, “is not intended to provide a petitioner an advantageous ‘wait-and-see’ opportunity to use a patent owner’s preliminary response and our decision on institution in order to refine or bolster petitioner’s position.” *Ooma, Inc. v. Deep Green Wireless LLC*, IPR2017-01541, Paper 14 at 3–4 (PTAB Jan. 23, 2018); *see Triller, Inc. v. Tiktok Pte. Ltd.*, IPR2022-00179, Paper 18 at 3–4 (PTAB Aug. 25, 2022) (“Petitioner now seeks to provide arguments via the supplemental declaration for issues addressed by Patent Owner in its Preliminary Response or by us in the Decision on Institution. . . . We view this as unwarranted.”); *Am. Well Corp. v. TelaDocHealth, Inc.*, IPR2021-00748, Paper 23 at 6–7 (PTAB Feb. 28, 2022) (collecting cases) (“the Board has denied [motions under 37 C.F.R. § 42.123] where the petitioner sought to use the supplemental information to refine or bolster challenges originally presented in the petition, based on information in the preliminary response or institution decision.”); *Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 21 at 3 (PTAB Sept. 10, 2018) (“The provision for submitting supplemental information is not intended to offer a petitioner a routine avenue for

bolstering deficiencies in a petition raised by a patent owner in a preliminary response.”)

Further, although 37 C.F.R. § 42.123(a) does not require a movant to show that the proffered supplemental information could not have been obtained earlier — an explicit requirement of supplementation sought under 37 C.F.R. § 42.123(b) and (c) — “[t]he Board may take into account under 37 C.F.R. § 42.123(a) whether the supplemental information was reasonably available to the Petitioner at the time the Petition was filed.” *Merck Sharp & Doehm*, IPR2018-00393, Paper 21 at 4 (citing *Redline Detection*, 811 F.3d at 443); see *ClearOne, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper 32 at 8 (PTAB Feb. 15, 2019) (“We find that the circumstances presented here, namely, that Petitioner could have submitted the supplemental information with the Petition and Petitioner has not provided sufficient explanation for not doing so, warrants denying Petitioner’s Motion.”); *B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, IPR2014-01510, Paper 37 at 3 (PTAB May 26, 2015) (“Petitioner’s opportunity to have submitted the proffered information with the petition rather than as supplemental information is a permissible consideration in evaluation of a motion under [37 C.F.R. § 42.123(a)].”)

B. The Issues in Petitioner’s Motion

In the present Motion, Petitioner’s proposed supplemental information bears upon three issues: (1) the construction of the “mounted to” claim limitation in the patent at issue in this proceeding (US Patent 9,354,015 B2, “the ’015 Patent,” herein) (Ex. 1001); (2) whether US 7,836,871 B2 (“Kempf ’871”) (Ex. 1014), relied upon in the Petition, discloses particular claim limitations of the ’015 Patent (“second draw string journal” and

“second” “power cable take-up journal”); and (3) whether each of three prior art references relied upon in the Petition — US 2012/0125302 A1 (“Stanziale ’302”) (Ex. 1007), WO 2011/158062 A1 (“Stanziale ’062”) (Ex. 1011), and WO 2011/141771 A1 (“Stanziale ’771”) (Ex. 1012) (collectively, “the Stanziale references”) — discloses the ’015 Patent’s limitations of power cables being displaced “away from” respective planes of rotation of draw string journals. Motion 1, 3–5.

Relating to all three of the above-identified categories of supplemental information, Petitioner provides the proposed new “Supplemental Declaration” of its expert (Dr. Stephen A. Batzer), which accompanies the Motion as Exhibit 1029. Motion 4, 5. Further, as to the first category of supplemental information, identified above, Petitioner includes two new proposed exhibits: US Patent 9,879,936 B2 (“the ’936 Patent”) (Ex. 1027); and US Patent 10,254,073 B2 (“the ’073 Patent”) (Ex. 1028). *Id.* at 3.

It is undisputed that Petitioner’s Motion satisfies the timeliness and relevancy requirements of 37 C.F.R. § 42.123(a)(1), (2). Yet, as discussed above, these are not the only considerations that bear upon the propriety of motions for supplemental information. Below, we explain our reasons for denying the Motion, as to each of Petitioner’s three categories of proposed supplemental information.

*1. Proposed Supplementation Relating to
the Construction of the “mounted to” Limitation*

In regard to the first category of supplementation sought in the Motion, Petitioner states that the proposed new exhibits (the ’936 Patent and the ’073 Patent) (Exs. 1027, 1028) “claim the benefit of” the patent at issue in the current IPR, “under 35 U.S.C. § 120,” whereby they constitute

“related patent applications in the same patent family” — a form of “intrinsic evidence” that is “[t]he best evidence for construing a patent claim term.” Motion 3.

Petitioner maintains that the ’936 Patent and the ’073 Patent, when viewed through the lens of Dr. Batzer’s new Supplemental Declaration, show that the expression “mounted to” — employed therein and in the ’015 Patent at issue in this IPR — is “not limited to direct mounting but also include[s] mounting through intervening components” and that “[t]here is no indication that *any* of these mounted components must rotate (but only about one fixed axis).” Motion 3–4.

This proposed expert testimony and supporting exhibits appear to be redundant of certain testimony and its supporting exhibit that accompanied the Petition. Specifically, Dr. Batzer’s original Declaration (Ex. 1016) relied upon a different item of intrinsic evidence — US Patent 9,494,379 (“the ’379 Patent”) (Ex. 1006), which (like the newly presented Exhibits 1026 and 1027) also “claims the benefit of” the ’015 Patent that is the subject of this IPR. Ex. 1016 ¶ 135.

Further, Dr. Batzer’s original Declaration relied upon the ’379 Patent, in order to support arguments essentially identical to what Petitioner’s Motion (on pages 3–4) characterizes as being offered in the new Supplemental Declaration — i.e., that the claim limitation “mounted to” allegedly encompasses an indirect and non-rotatable connection. *See* Ex. 1016 ¶ 135 (“Fig. 14A [of the ’379 Patent] shows that the cams 440 each have their axle secured inside a mounting bracket 442, which is then secured to the limb 420. Thus, a reference to one component being ‘mounted to’ another clearly includes mounting directly or indirectly through another

component. And no reason is provided to treat this claim term differently between the '015 Patent and its child '379 Patent.”), ¶ 138 (“Additionally, the specification of the related '379 Patent discloses ‘a riser 404 mounted at the distal end 406’ and an ‘arrow rest 750 mounted to distal end 776 of the center rail 402 by fasteners 762.’ But there is no indication that such mounting necessarily allows these components to rotate about a fixed axis; indeed such movement would severely compromise the operation and accuracy of the crossbow.”) (citations omitted).

Patent Owner contends that Petitioner’s Motion is “offered to refine and bolster arguments Petitioner could have raised in its Petition” and that the Motion “is purely responsive to the POPR and the Institution Decision,” thus amounting to “an improper application of 37 C.F.R. § 42.123(a).”

Response 1. Indeed, Petitioner identifies the Board’s institution decision (Paper 13) as a motivation for its Motion. Motion 1 (“The Board encouraged further development of one claim-construction issue (‘mounted to’).” “Petitioner wishes to take the Board up on its invitation and submit supplemental information on the claim construction issue.”) Further, Dr. Batzer’s proposed Supplemental Declaration, including the discussion of the “mounted to” limitation, explicitly states that it is responding to Patent Owner’s preliminary response and the Board’s institution decision. *See* Ex. 1029 ¶¶ 3, 4, 7, 14, 17.

Patent Owner also points out that, in regard to the interpretation of the “mounted to” limitation, “the Supplemental Information consists of claim construction arguments predicated on related patents that were readily available long before Petitioner filed its Petition,” as both the '936 Patent and the '073 Patent (Exhibits 1027, 1028) had each been “granted” years

before the Petition was filed. Response 4. Moreover, Petitioner was plainly aware of these documents, prior to filing the Petition. Even if Petitioner had not encountered the '936 Patent and the '073 Patent through an investigation of the intrinsic record of the related '015 Patent (the subject of the present IPR), Petitioner would have recognized the '936 Patent and the '073 Patent as subjects of infringement allegations included in a Complaint (served on Petitioner) that also asserted infringement of the '015 Patent and the '379 Patent (which was discussed in Dr. Batzer's original Declaration, as explained above). *See* Ex. 2007 ¶¶ 6–9 (Complaint, *Ravin Crossbows, LLC v. Hunter's Mfg. Co., Inc. d/b/a TenPoint Crossbow Techs.*, No. 2:21-cv-02213-APG-EJY (D. Nev. Dec. 17, 2021)).

It is difficult to determine how essentially duplicative evidence relating to a disputed matter of claim construction, such as Petitioner offers in the Motion (regarding the “mounted to” limitation), fits into the rubric of merely clarifying an argument presented in the Petition, in a way that constitutes proper supplementation under 37 C.F.R. § 42.123 — as opposed to impermissibly changing or bolstering an argument. *See, e.g., MED-EL Elektromedizinische Geräte*, IPR2020-00190, Paper 24 at 5. Indeed, commentators have recently observed that, at least in some instances, “[a] fine line exists between bolstering a petition and supplementing it.” Matthew Johnson & Ashvi Patel, *Motions to Submit Supplemental Information: An Infrequently Utilized Procedure*, 23 Chi.-Kent J. Intell. Prop. 87, 96 (2023).

However, in view of the Board's admonitions against proposed supplementation that responds directly to a patent owner's preliminary response or a decision instituting an IPR, we deny Petitioner's requested

supplementation regarding the “mounted to” limitation. *See, e.g., Triller*, IPR2022-00179, Paper 18 at 3–4. Further, contrary to Petitioner’s argument, we do not view statements in the institution decision (e.g., Paper 13 at 12), to the effect that the parties should consider addressing certain issues during trial, as inviting a motion under 37 C.F.R. § 42.123. *See* Motion 1 (“Petitioner wishes to take the Board up on its invitation and submit supplemental information on the claim construction issue.”) Such statements, in our institution decision, are directed to the normal briefing process and do not justify allowing supplemental information.

Our decision to deny this aspect of the Motion is also supported by the fact that, well before the filing of the Petition, Petitioner was manifestly aware of the ’936 Patent and the ’073 Patent (Exhibits 1027, 1028)—the apparent bases for the proposed supplementation regarding the “mounted to” limitation (*see* Motion 3–4). Expert testimony concerning the ’936 Patent and the ’073 Patent could have been presented with the Petition, in the same manner that Petitioner provided such essentially identical evidence based upon the ’379 Patent (Ex. 1016), as explained above. *See, e.g., ClearOne*, IPR2019-00683, Paper 32 at 8.

*2. Proposed Supplementation Relating to
the Disclosure of the Kempf ’871 Reference*

Petitioner also seeks to submit supplemental information, regarding whether the Kempf ’871 reference discloses the claim limitations of a “second draw string journal” and a “second” “power cable take-up journal” recited in the ’051 Patent. Motion 1, 4. The supplemental information, relating to the Kempf ’871 reference, is contained in Dr. Batzer’s proposed Supplemental Declaration. *Id.* at 4.

Here, again, Petitioner’s Motion and Dr. Batzer’s Supplemental Declaration explicitly address Patent Owner’s preliminary response and the Board’s institution decision. Motion 1 (“On Grounds 9–11, the Board was not persuaded (again, due to Patent Owner’s arguments) that [the Kempf ’871 reference] sufficiently disclosed a ‘second draw string journal’ and a ‘second’ ‘power cable take-up journal.’” “Petitioner believes that Patent Owner’s arguments regarding . . . the alleged absence of journals on Kempf ’871’s cam are misleading, so Petitioner wishes to submit supplemental information to further develop th[is] point[].”), 4 (addressing “Patent Owner’s argument” that “hangs on the lack of an express callout number and arrow to the cam’s outer track (receiving the bowstring 48) and to the cam’s inner track (receiving the cable 44) in Kempf ’871”); Ex. 1029 ¶¶ 3–4 (stating that “I have been asked to provide my opinion relating to several issues implicated by” Patent Owner IPR filings, including “Ravin’s Preliminary Response,” as well as the Board’s “Institution Decision”), 19 (referring to “Ravin’s Preliminary Response” and “Ravin’s argument”), 20 (“Ravin appears to make this argument only because Kempf ’871 has no express callout number and arrow pointing to the cam’s outer track (receiving the bowstring 48) and to the cam’s inner track (receiving the cable 44).”), 30 (“Thus Ravin is categorically wrong when it states in its Preliminary Response that the cam of Kempf ’871 does not have an outer track for the string.”), 34 (“Thus Ravin is categorically wrong when it states in its Preliminary Response that the cam of Kempf ’871 does not have an inner track for the cable.”)

As above (regarding the portion of the Motion related to the construction of the “mounted to” limitation), Petitioner’s explicit retorts to

Patent Owner’s preliminary response, and to the Board’s institution decision, establish a basis for denying the Motion. *See, e.g., Triller*, IPR2022-00179, Paper 18 at 3–4.

Furthermore, in explaining his proposed opinions about the disclosure of the Kempf ’871 reference, in the Supplemental Declaration, Dr. Batzer relies upon US Patent 6,267,108 (*see* Ex. 1029 ¶ 23) and US Patent 7,708,001 (*see* Ex. 1029 ¶¶ 35–38) — documents that Dr. Batzer’s original Declaration did *not* use to explicate the scope of the Kempf ’871 reference (*see* Ex. 1016 ¶¶ 111–115, 215–241). As explained below, one of these documents (US Patent 7,708,001) was an exhibit provided with the Petition (as Exhibit 1008).

As to the first of these documents, Dr. Batzer’s Supplemental Declaration states that “U.S. Patent 6,267,108, which discloses cams on a vertical bow and a crossbow” was “cite[d]” in the Kempf ’871 reference. Ex. 1029 ¶ 23. This document (US Patent 6,267,108) is not an existing or proposed supplemental exhibit, nor does it otherwise appear in the record of the present IPR.

As to the second of the documents, Dr. Batzer’s Supplemental Declaration states that US Patent 7,708,001 “was cited during the prosecution of the ’015 Patent” — the subject of the present IPR. Ex. 1029 ¶ 35. Although Dr. Batzer’s original Declaration did refer to US Patent 7,708,001 (Ex. 1008), it was addressed only in regard to its role in the prosecution of Patent Owner’s ’015 Patent — but *not* in regard to how it might shed light on the disclosure of the Kempf ’871 reference. *See* Ex. 1016 ¶¶ 4, 66, 68.

Because Dr. Batzer's proposed testimony, in his Supplemental Declaration, relies upon materials different from what he used in his original Declaration to explain the teachings of the Kempf '871 reference, the Supplemental Declaration appears to change, rather than clarify, the substance of his original Declaration. Allowing supplementation of the record, with such changed evidence, would not be a proper use of 37 C.F.R. § 42.123(a). *See, e.g., MED-EL Elektromedizinische Geräte*, IPR2020-00190, Paper 24 at 5.

Moreover, the foregoing discussion reveals that the new materials (relied upon in the Supplemental Declaration for opinions about the teachings of the Kempf '871 reference) were manifestly known to Petitioner prior to filing the Petition. Permitting such supplementation, based upon materials known to a petitioner (but not used in the petition), would also run afoul of the Board's application of 37 C.F.R. § 42.123(a). *See, e.g., ClearOne*, IPR2019-00683, Paper 32 at 8.

These additional reasons support our decision to deny the portion of Petitioner's Motion that relates to the interpretation of the Kempf '871 reference.

3. Proposed Supplementation Relating to the Disclosures of the Stanziale References

Petitioner's final category of proposed supplemental information concerns the scope of the disclosures in three prior art references relied upon in the Petition: Stanziale '302 (Ex. 1007), Stanziale '062 (Ex. 1011), and Stanziale '771 (Ex. 1012). Motion 1, 5. The related supplemental information is embodied in Dr. Batzer's Supplemental Declaration (Ex. 1029). *Id.* at 5 (citing Ex. 1029 ¶¶ 40–49).

Again, this category of supplemental information is explicitly responsive to Patent Owner’s preliminary response and the Board’s institution decision. Petitioner’s Motion states that “the Board was not persuaded (in light of Patent Owner’s arguments) that the [Stanziale references] asserted in Grounds 1–4 (and perhaps 6) sufficiently disclosed” the ’015 Patent claim limitations of power cables being displaced “away from” the respective planes of rotation. Motion 1 (citing Paper 13 at 16–18, 21–22, 26). Thus, the Motion explains, “Petitioner wishes to submit supplemental information,” in order to address its position “that Patent Owner’s arguments regarding cables displacing ‘away from’ the planes of rotation . . . are misleading.” *Id.* In addition, the respective portions of Dr. Batzer’s Supplemental Declaration aim squarely at perceived errors articulated in Patent Owner’s preliminary response and the Board’s institution decision:

From Ravin’s challenges to this claim limitation in its Preliminary Response, the Board appears to have accepted that the Stanziale references insufficiently disclose the power cables displacing “away from” the respective planes of rotation. Specifically, the Board believed that the predicate factual determination for the “obvious to try” rationale was not adequately addressed.

Ex. 1029 ¶ 42; *see also id.* ¶¶ 3–4 (indicating that the Supplemental Declaration provides “opinion[s] relating to several issues implicated by,” *inter alia*, the preliminary response and the Board’s institution decision).

In view of its explicit and intentional responsiveness to Petitioner’s preliminary response and the Board’s institution decision, we regard the third aspect of Petitioner’s Motion as an improper use of 37 C.F.R. § 42.123(a). *See, e.g., Triller*, IPR2022-00179, Paper 18 at 3–4. Moreover,

we perceive no reason why the substance of Dr. Batzer's Supplemental Declaration, relating to the above-identified features of the Stanziale references, could not have been provided with the Petition. This provides an additional basis for denying the third aspect of the Motion. *See, e.g., ClearOne*, IPR2019-00683, Paper 32 at 8.

III. CONCLUSION

For the foregoing reasons, we deny Petitioner's Motion.

However, this Order does not address whether any of the proffered supplemental information would be properly submitted in a different context.

Accordingly, it is:

ORDERED that Petitioner's Motion to Submit Supplemental Information (Paper 19) is *denied*.

IPR2023-00407
Patent 9,354,015 B2

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