

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOBEBE US INC.
Petitioner,

v.

MAYBORN (UK) LIMITED
MAYBORN USA, INC.
MAYBORN GROUP LIMITED
Patent Owner.

Case IPR2023-00465
Patent 11,207,244

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION**

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****All emphasis is added, unless otherwise specified.****

On July 27, 2023, the Board's Order (Paper 14) authorized this Opposition to Petitioner's Motion to Submit Supplemental Information (Paper 16; "Mot.").

A. Petitioner's Proposed Change to Ground 1 Is Not "Relevant" or Permissible Supplemental Information

Supplemental information "must be relevant to a claim for which the trial has been instituted." 37 C.F.R. § 42.123(a)(2). Petitioner interprets "relevant" information as anything "useful in determining the patentability or unpatentability of the challenged claims." Mot. at 2 (quotes omitted). But Petitioner's proposed change to Ground 1 does not meet this standard. A new obviousness analysis that expands Ground 1 by addressing Claim 23 for the first time is not useful to the Board because it is beyond the scope of the instituted trial. *See Digital Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 22 at 9 ("We determine that the proposed supplemental information would not aid the Board in resolving the patentability challenges as crafted by Petitioner and presented in the Petition.").

The Board specifically instituted "on the unpatentability grounds asserted in the Petition," Paper 11 (Inst. Dec.) at 38, and the Petition's Ground 1 does not include Claim 23, *id.* at 6. *See also* Paper 2 (Pet.) at 5. Just as the Board cannot narrow a trial by instituting less than all grounds and claims in a petition, *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1360 (2018), it is equally true that the Board cannot expand a trial beyond a petition's identified grounds and claims. *Id.* at 1355 ("petitioner is master of its complaint"). Indeed, the Board may "only" consider a

petition to the extent it “identifies, in writing and with particularity, each claim challenged [and] the grounds on which the challenge to each claim is based.” 35 U.S.C. § 312(a)(3). Petitioner’s motion asks the Board to exceed its statutory authority and, therefore, must be denied.

Lack of relevance aside, Petitioner’s proposed expansion of Ground 1 “goes beyond merely supplementing [Petitioner’s] position—it changes it entirely.” *Am. Well Corp. v. TelaDoc Health, Inc.*, IPR2021-00748, Paper 23 at 13. In *American Well*, the Board denied a motion for supplemental information where the petitioner sought to submit revised expert testimony on motivation-to-combine. And what Petitioner proposes here is even worse. Instead of merely changing the existing analysis in Ground 1, like in *American Well*, Petitioner seeks to introduce new analysis on a claim not presently challenged in Ground 1. “This is not simply a case where Petitioner seeks to bolster a position that had already been taken.” *See Am. Well Corp.*, Paper 23 at 11. Petitioner is trying to create a new position on Claim 23 that does not exist. Changing Ground 1 in this manner is prohibited. *Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 20 at 3 (“Nor should the proposed supplemental information change any grounds of unpatentability that were authorized in this proceeding[.]”).

B. Petitioner’s Wait-and-See Approach Is Evident

Supplemental information is not a “‘wait-and-see’ opportunity to supplement

a petition after initial comments or arguments have been laid out by a patent owner.”
See Redline Detection, LLC v. Star Envirotech, Inc., 811 F.3d 435, 448 (Fed. Cir. 2015). Despite acknowledging this point of law, Petitioner is trying to violate it.

Given that Claim 23 is only challenged in Ground 2, which is unlikely to succeed, it is not hard to see why Petitioner wants a do-over on Ground 1. Petitioner’s products infringe Claim 23, and Petitioner is now faced with the possibility of losing its challenge on that claim because Claim 23 is challenged only in Ground 2, which Patent Owner’s Preliminary Response (Paper 6) debunked. *See* Paper 11 (ID) at 37 (“has not shown a reasonable likelihood”). Petitioner’s failure to challenge Claim 23 in Ground 1 is a weakness in the Petition exposed by Patent Owner’s Preliminary Response and the Board’s Institution Decision. Supplemental information is not a vehicle for fixing such weaknesses. *W. Digital*, Paper 22 at 9 (refusing supplemental information that “presents a new ground for unpatentability . . . in an attempt to correct a weakness of the Petition”). This is so even if the omission of Claim 23 from Ground 1 was “inadvertent.” Mot. at 4.

“The 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 & Dohme Corp.*, Paper 20 at 4 (citing *Redline Detection*, 811 F.3d at 443). Here, no doubt, it was. As Petitioner concedes, the Claim 23 analysis it seeks to add is consistent with “Mr. Silver’s previously held

opinion.” Mot. at 3. There is no good reason why Petitioner could not have included that analysis in the Petition from the start. *See id.* (“Petitioner has not sufficiently explained why the supplemental information could not have been presented with its original Petition”); *see also Am. Well Corp.*, Paper 23 at 13 (“such errors could have easily been identified by Petitioner prior to filing the Petition”). A failure to diligently review the Petition before filing does not entitle Petitioner to the relief it seeks. *See* 37 C.F.R. § 42.20(c) (“The moving party has the burden of proof[.]”).

C. Giving Petitioner a Post-Institution Do-Over Would Be Prejudicial

Patent Owner “has no ‘burden’ to do anything to defend the validity of its patent other than hold the patent challenger to its own burden of persuasion.” *E.I. du Pont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1008 (Fed. Cir. 2018). But Patent Owner did more than sit idly by; it mounted a vigorous defense against Ground 2 that the Board embraced. *See* Paper 6 (POPR) at 39-41; Paper 11 (ID) at 35. The present record is advantageous to Patent Owner on Claim 23, and Petitioner wants to neutralize Patent Owner’s advantage by revising the Petition. Empowering Petitioner to do so because Petitioner somehow forgot to double-check the Petition is utterly prejudicial.

Petitioner’s arguments that “[Patent Owner] would not be prejudiced” miss the point. Mot. at 5. The focus should not be on whether the supplemental information “change[s] the substance of [Patent Owner’s] underlying arguments.”

Id. The focus should be on Petitioner. It is Petitioner who bears the burden of proof, *see* 35 U.S.C. § 316(e), and it is Petitioner who must abide the statutory requirement to identify the claims and grounds of its challenge “with particularity,” 35 U.S.C. § 312(a)(3), in the Petition. *See also Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“While the Board’s requirements are strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.”). The fact that Patent Owner has not yet filed its Response brief or deposed Petitioner’s expert is likewise not dispositive. *See* Mot. at 5. After all, that is true in virtually every case where a petitioner seeks entry of supplemental information within one month of the Board’s institution decision.

D. Allowing Petitioner to Substantively Change the Petition Is Unjust and Defies the Spirit of the Applicable Statutes and Rules

As discussed, it is black-letter statutory law that a petition must identify with “particularly” the claims and grounds for which *inter partes* review is sought. 35 U.S.C. § 312(a)(3). The Board’s rules likewise require all petitions to include a “precise” statement of relief that “must identify,” among other things, “[t]he claim” and “[t]he specific statutory grounds . . . on which the challenge to the claim is based.” 37 C.F.R. § 42.104(b)(1)-(2). These requirements stem from “the expedited nature of IPRs,” which “bring[s] with it an obligation for petitioners to make their case in their petition to institute.” *Intelligent Bio-Systems*, 821 F.3d at 1369. Accordingly, a petitioner’s ability to change its petition is limited to “clerical or

typographical mistake[s].” 37 C.F.R. 42.104(c). Petitioner seeks to defy both the spirit and express provisions of the applicable statutes and rules by shoehorning an improper substantive change to Ground 1 of its Petition into the form of supplemental information. The Board should not oblige. *See Am. Well Corp.*, Paper 23 at 13 (“Denying entry of supplemental information that effectively changes the evidence originally relied upon in a petition—whether inadvertent or not—is in accord with the statutory requirement that a petition must identify, with particularity, the evidence supporting the challenge to each claim.”).

Petitioner’s claim that its request supports “the public interest” is wrong. Mot. at 6. The public interest is not served by breaking the rules arbitrarily, nor is the Board’s policy goal of securing “the just, speedy and inexpensive resolution of every proceeding.” 37 C.F.R. §42.1(b). Patent owners should not have to face revised petitions every time a petitioner says it forgot to include a critical analysis.

While the statutes and rules do not allow petitioners to add new claims to the grounds of their as-filed petitions, the Board has the discretionary power to institute follow-on petitions that challenge the same claims of a patent already challenged by the same petitioner. That option would have been available to Petitioner had Petitioner not waited until the very last day of the one-year deadline to file its Petition. Petitioner cannot reasonably complain that it is foreclosed from adding Claim 23 to Ground 1 when another viable option existed to challenge that claim but

for Petitioner's decision to delay filing.

E. *Redline Detection* Is Binding and Applicable Precedent That Precludes Petitioner's Requested Relief

In *Redline Detection*, the Federal Circuit found no error in the Board's decision to deny a petitioner's supplemental information in the form of an expert declaration supporting the subset of grounds instituted from the petition. *Redline Detection*, 811 F.3d at 441-45. Rather than submitting the petition with a declaration covering all twelve identified grounds, the petitioner opted for the "cost-effective" approach of preparing a declaration only on the instituted grounds. IPR2013-00106, Paper 24 at 2-4. The Board denied the motion for supplemental information because the expert declaration could have and should have been submitted with the petition. *See id.* at 4 ("Redline has not alleged that any of the arguments or evidence in the newly submitted declaration is information that reasonably could not have been submitted with the Petition.").

Petitioner's "inadvertent omission" excuse here is not materially different from the "cost-effective" pretext that the Board saw through and dismissed in *Redline Detection*. Just as the petitioner in *Redline Detection* could have borne the cost of an expert declaration from the outset of the proceeding, so too could Petitioner have borne the cost of properly vetting the Petition. In either case, supplemental information is not a tool for correcting substantive errors that could have easily been avoided.

Respectfully submitted,

Date: August 4, 2023

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CERTIFICATE OF COMPLIANCE

I hereby certify that this Opposition to Petitioner's Motion to Submit Supplemental Information, excluding the parts of the brief exempted by 37 C.F.R. § 42.24, complies with the page limits provided by the Board in Paper No. 14 (July 27, 2023), which stated: "Patent Owner is authorized to file an opposition to the motion not to exceed 7 pages due Friday August 4, 2023."

Respectfully submitted,

Date: August 4, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on August 4, 2023, a complete and entire copy of this Opposition to Petitioner's Motion to Submit Supplemental Information was provided via email, to the Petitioner by serving the email correspondence address of record as follows:

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