

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2023-00628
(Patent 7,233,790 B2)

Before JEFFREY S. SMITH, STACEY G. WHITE, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

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

With our authorization, Petitioner filed a Motion to Submit Supplemental Information (Paper 20, “Motion”), Patent Owner filed an Opposition (Paper 22, “Opp.”), and Petitioner filed a Reply (Paper 26, “Reply”). With its Motion, Petitioner filed supplemental information in the form of Exhibit 1026, Supplemental Declaration of Mr. Wechselberger, which includes information that Petitioner contends demonstrates that the prior art asserted in the Petition’s grounds anticipates and renders obvious the limitations of claims 1 and 8 as amended. Motion 1.

Petitioner contends that the Motion satisfies the requirements of 37 C.F.R. § 42.123(a), namely: (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”; and (2) the “information must be relevant to a claim for which the trial has been instituted.” Motion 4. Petitioner contends that the supplemental information does not change the grounds of unpatentability authorized in the proceeding. Motion 5. Petitioner contends that the supplemental information does not present any new analysis of the prior art to the claims. Motion 6. Petitioner contends that the supplemental information does not rely on new prior art nor on uncited portions of the same prior art. Motion. 7.

Patent Owner contends that there is no basis for submitting supplemental information, because Mr. Wechselberger’s original declaration already addresses the amended claims. Opp. 3. Patent Owner also contends that the amended claims contain limitations that were not addressed in the Petition. Opp. 4-5. According to Patent Owner, the supplemental information is a new analysis with respect to the amended limitations. Opp. 5.

Petitioner contends that the supplemental information does not attempt to include a new analysis of the prior art. Reply 3. Petitioner contends that the supplemental information shows that the evidence and analysis cited in the Petition satisfies the limitations added to amended claims 1 and 8. Reply 4. Petitioner contends that the supplemental information does not include new analysis or citations to the prior art that were not included in the Petition. Reply 5.

We agree with Petitioner. The supplemental information is relevant to amended claims 1 and 8 and does not attempt to include a new analysis or citations to the prior art that were not included in the Petition. Therefore, we determine that the Motion satisfies the requirements of 37 C.F.R. § 42.123(a), and that the specific facts of this case warrant granting the Motion.

It is *ordered* that the Motion to submit Exhibit 1026 as supplemental information is *granted*.

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