

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,

Petitioner,

v.

BITMICRO, LLC,

Patent Owner.

PTAB Case No.: IPR2023-00783

Patent No. 6,496,939

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123**

I. INTRODUCTION

On January 12, 2024, Petitioner Intel Corporation (“Intel”) sought authorization from the Board to file a motion to submit supplemental information. Patent Owner BiTMICRO LLC (“BiTMICRO”) did not oppose that request. On the same day, the Board authorized Intel to file a motion. The Board later accepted Intel’s proposal to file the motion on or before January 26, 2024. Intel now moves to submit Exhibits INTEL-1046 – INTEL-1048, which are being filed concurrently with this motion.

II. ARGUMENT

A party may file a motion to submit supplemental information if it requests authorization to do so within one month of institution and the supplemental information is “relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a); *see also Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 14 (PTAB Dec. 20, 2019). Both requirements are met here. The Board authorized this filing after Intel’s timely request. And the supplemental evidence at issue is relevant because it addresses the public availability of a prior art reference relied upon in an instituted ground. *See, e.g., South-Tek Sys., LLC v. Engineered Corrosion Sols., LLC*, IPR2016-01351, Paper 17 at 4-5 (PTAB June 15, 2017) (granting motion to submit supplemental information because the exhibits at issue were “relevant to th[e] proceeding” and “provide[d] a more complete record of the

public availability” of a reference); *see also Creston Elecs., Inc. v. Intuitive Bldg. Controls, Inc.*, IPR2015-01379, Paper 27 at 4-5 (PTAB Feb. 2, 2016); *Microsoft Corp. v. Corel Software, LLC*, IPR2016-01086, Paper 25 at 4 (PTAB Jan. 31, 2017); *Seabery N. Am. Inc. v. Lincoln Glob., Inc.*, IPR2016-00840, Paper 40 at 8 (PTAB Mar. 15, 2017); *Valeo N. Am., Inc. v. Magna Elecs., Inc.*, IPR2014-01204, Paper 26 at 4-5 (PTAB Apr. 10, 2015).

A. Intel's motion is relevant to instituted grounds that involve the Supercap Manual

Intel's motion pertains to exhibits that corroborate the public availability of the Supercap Manual (INTEL-1015 at 62-103), which Intel relied on in three grounds instituted by the Board. *See* Paper 9 at 7 (noting three grounds that include the Supercap Manual), 40 (instituting review “as to all challenged claims on all grounds stated in the Petition”). The exhibits are therefore “relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a)(2); *see also South-Tek Sys.*, Paper 17 at 5 (exhibits establishing public availability of a reference involved in an instituted ground “provide[d] a more complete record” and were relevant); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (PTAB Feb. 5, 2014) (exhibits “confirm[ing] the public accessibility of references that serve as the basis of the grounds of unpatentability authorized in this proceeding” were relevant).

In its pre-institution reply, Intel cited §§ 902.03 and 1730 of the July 1998

Seventh Edition of the Manual of Patent Examining Procedure (“MPEP”) and provided a URL directed to an archived webpage (also from 1998) describing details on a patent searching system provided by the USPTO. *See* Paper 7 at 3. Intel referred to those documents to support that the Supercap Manual was publicly available before the September 1999 filing date of the challenged patent. *Id.* Exhibits INTEL-1046 and INTEL-1047 are copies of the documents. INTEL-1047 also includes a declaration regarding the archived USPTO webpage. The two exhibits are further described below.

INTEL-1046 is a copy of §§ 902.03 and 1730 of the MPEP (Seventh Edition, July 1998). Section 902.03 is entitled “Classification Information” and contains information on patent classification and patent search tools that were available to the public as of July 1998. *See* INTEL-1046 at 900-25 & 900-26. Section 1730 describes “PTO search and information resource facilities” that were open to the public in 1998 and explains that the PTO’s website at the time allowed access to the PatBib Patent Database, which “provide[d] the public with very flexible and powerful searching of the first-page bibliographic information and abstracts for all patents from January 1, 1976 to the [then] present.” *See* INTEL-1046 at 1700-11 & 1700-12.

INTEL-1047 is a declaration from Nathaniel E. Frank-White, Records Request Processor at the Internet Archive, the provider of the “Wayback Machine” service. Mr. Frank-White describes how archived materials are maintained at the

website archive.org. INTEL-1047 ¶¶ 3-5. Mr. Frank-White attaches the Internet Archive's capture of an archived USPTO webpage dated January 28, 1998 that includes information on the USPTO's Automated Patent System ("APS"). INTEL-1047 Ex. A. The archived webpage indicates that APS contained full text of every patent since 1971 and provided users with highly focused and refined tools for searching the various fields of a patent. *Id.* The July 1998 version of MPEP § 902.03(e) similarly describes that the APS database provided access to full text and classification information for US patents. INTEL-1046 at 900-26. The archived webpage also shows that the APS database was accessible to the public at participating libraries and search facilities, including some in California, Michigan, and Virginia. INTEL-1047 Ex. A.

INTEL-1048 is likewise relevant to the public availability of the Supercap Manual. The manual has a specific document number: "NEC Document No. CEP-1004G." INTEL-1015 at 61; INTEL-1030 at "Other Publications." INTEL-1048 was published in the Journal of Power Sources in 1998 as Qu et al., "Studies of activated carbons used in double-layer capacitors." INTEL-1048 at 99. The article refers to "NEC Publication, Document No. CEP-1004G"—the document name of the Supercap Manual—as Reference "[11]." *Id.* at 107. The article indicates that its authors were able to locate a copy of the Supercap Manual at least as early as 1998.

B. Intel's supplemental information will not delay this proceeding or prejudice BiTMICRO

Exhibits INTEL-1046 – INTEL-1048 do not interfere with the “just, speedy, and inexpensive” resolution of this proceeding. *Palo Alto*, Paper 37 at 4-5. The supplemental information requires no change to the schedule of this proceeding, nor does it impede the Board's ability to timely complete this proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). Further, the supplemental information does not prejudice BiTMICRO. BiTMICRO's response to the petition is due on March 8, 2024, which is five weeks away. Paper 10 at 11. BiTMICRO has ample time to review the exhibits and address them when filing its response, especially given the brevity of the exhibits. And BiTMICRO has been aware of INTEL-1046 and the PTO webpage included in INTEL-1047 since Intel filed its October 20, 2023 pre-institution reply citing those documents. *See* Paper 7 at 3. Moreover, INTEL-1046 – INTEL-1048 do not raise any new substantive arguments. The supplemental information merely reinforces that the Supercap Manual was publicly available before the filing date of the challenged patent. The exhibits do not change “the grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability.” *Palo Alto*, Paper 37 at 3.

III. CONCLUSION

For these reasons, Intel respectfully requests that the Board grant its motion to submit Exhibits INTEL-1046 – INTEL-1048 as supplemental information.

Dated: January 26, 2024

Respectfully submitted,

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UPDATED EXHIBIT LIST

Exhibit	Reference
INTEL-1001	U.S. Patent No. 6,496,939 (“the ’939 patent”)
INTEL-1002	File History of the ’939 patent
INTEL-1003	Declaration of Dr. Carl Sechen, Ph.D.
INTEL-1004	CV of Dr. Carl Sechen, Ph.D.
INTEL-1005	Japanese Patent Application Publication No. JPH05-108505 (“Nishida Japanese”)
INTEL-1006	Certified English translation of Japanese Patent Application Publication No. JPH05-108505 (“Nishida”)
INTEL-1007	U.S. Patent No. 5,929,603 (“Nakao”)
INTEL-1008	U.S. Patent No. 4,965,828 (“Ergott”)
INTEL-1009	Plaintiff’s Preliminary Disclosure of Asserted Claims and Infringement Contentions Appendix H, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 6:22-cv-00335-ADA (W.D. Tex.)
INTEL-1010	Plaintiff’s Preliminary Disclosure of Asserted Claims and Infringement Contentions Appendix G, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 6:22-cv-00335-ADA (W.D. Tex.)
INTEL-1011	Plaintiff BiTMICRO LLC’s Responsive Claim Construction Brief, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 6:22-cv-00335-ADA (W.D. Tex.), Dkt. 44
INTEL-1012	Defendants’ Opening Claim Construction Brief, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 6:22-cv-00335-ADA (W.D. Tex.), Dkt. 33
INTEL-1013	Defendants’ Reply Claim Construction Brief, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 6:22-cv-00335-ADA (W.D. Tex.), Dkt. 43
INTEL-1014	U.S. Patent No. 5,926,383 (“Pilukaitis”)
INTEL-1015	File History of U.S. Patent No. 5,608,684 (“Reasoner”) consisting of “SUPERCAP” (Electric Double-Layer Capacitors) User’s Manual (“Supercap Manual”)
INTEL-1016	U.S. Patent No. 5,914,869 (“Troiano”)
INTEL-1017	U.S. Patent No. 4,939,779 (“Hitchcock”)

Exhibit	Reference
INTEL-1018	Claim Construction Order and Memorandum in Support Thereof, <i>BiTMICRO LLC v. Kioxia Am., Inc.</i> , No. 6:22-cv-00331-ADA (W.D. Tex.), Dkt. 54
INTEL-1019	Plaintiff BiTMICRO LLC's Sur-Reply Claim Construction Brief, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 6:22-cv-00335-ADA (W.D. Tex.), Dkt. 47
INTEL-1020	U.S. Patent No. 5,705,919 ("Wilcox")
INTEL-1021	Case transfer notice, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 5:23-cv-00625 (W.D. Tex.), Dkt. 56
INTEL-1022	U.S. Patent No. 5,542,042 ("Manson")
INTEL-1023	U.S. Patent No. 5,768,208 ("Bruwer")
INTEL-1024	U.S. Patent No. 5,535,328 ("Harari")
INTEL-1025	U.S. Patent No. 3,854,226 ("Divine")
INTEL-1026	U.S. Patent No. 6,629,317 ("Kirschner")
INTEL-1027	U.S. Patent No. 5,710,931 ("Nakamura")
INTEL-1028	U.S. Patent No. 5,078,134 ("Heilman")
INTEL-1029	U.S. Patent No. 6,222,356 ("Taghizadeh-Kaschani")
INTEL-1030	U.S. Patent No. 5,608,684 ("Reasoner")
INTEL-1031	U.S. Patent No. 4,974,167 ("Anderson")
INTEL-1032	U.S. Patent No. 5,914,542 ("Weimer")
INTEL-1033	U.S. Patent No. 5,444,378 ("Rogers")
INTEL-1034	U.S. Patent No. 4,559,616 ("Bruder")
INTEL-1035	U.S. Patent No. 4,327,410 ("Patel")
INTEL-1036	U.S. Patent No. 5,519,831 ("Holzhammer")
INTEL-1037	"The Art of Electronics," 2nd Edition, 1989 by Horowitz, et al. ("Horowitz")
INTEL-1038	"Principles of Physics," 2nd Edition, 1998 by Serway ("Serway")
INTEL-1039	"Computer Organization and Architecture," 4th Edition, 1996 by Stallings ("Stallings")

Exhibit	Reference
INTEL-1040	U.S. Patent No. 5,627,460 (“Bazinet”)
INTEL-1041	“Historical Introduction to Capacitor Technology,” IEEE Electrical Insulation Magazine, Vol. 26, Issue 1, January 2010, by Ho, et al. (“Ho”)
INTEL-1042	“The Illustrated Dictionary of Electronics,” 5th Edition, 1990 by Turner, et al., 157.
INTEL-1043	Summon with Proof of Service, <i>BiTMICRO LLC v. Intel Corp.</i> , No. 6:22-cv-00335-ADA (W.D. Tex.), Dkt. 9
INTEL-1044	United States District Court — National Judicial Caseload Profile
INTEL-1045	U.S. Patent No. 5,959,926 (“Jones”)
INTEL-1046	Manual of Patent Examining Procedure, 7th Edition, July 1998 §§ 902.03, 1730
INTEL-1047	Affidavit of Nathaniel E. Frank-White, Records Request Processor at the Internet Archive
INTEL-1048	“Studies of activated carbons used in double-layer capacitors,” Journal of Power Sources, Vol. 74, 1998, by Qu, et al.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing
PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION
PURSUANT TO 37 C.F.R. § 42.123(a) and Exhibits INTEL-1046 – INTEL-1048
was served in its entirety this 26th day of January, 2024 by electronic mail on the
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