

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

ADVANCED MICRO DEVICES, INC.,
Petitioner,

v.

REALTEK SEMICONDUCTOR CORPORATION,
Patent Owner.

Case IPR2023-00920
U.S. Patent No. 8,006,218

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

I. INTRODUCTION

Realtek opposes AMD’s Motion to Submit Supplemental Information, Paper 11 (“Mot.”). AMD’s motion should be denied because it addresses the factors relevant to whether it should be permitted to file the motion under 37 C.F.R. § 42.123(a), not the factors governing actual supplementation. Regardless, AMD cannot show it is entitled to submit its proffered evidence because it violates the main tenant of motions to submit supplemental information: they cannot be used to change the evidence relied on in the Petition.

The Institution Decision (“ID”) explained that AMD did not meet its burden of production to show that Chiu qualifies as prior art under section 102(e). ID (Paper 10) at 29-31. AMD now improperly attempts to change, not supplement, its evidence—through new expert opinions and citations to the Chiu provisional—to overcome its strategic choice not to present the required proof and, instead, use its space to present additional grounds. AMD could and should have provided evidence and argument that Chiu qualifies as prior art in its Petition. AMD’s motion, therefore, should be denied. *Ooma, Inc. v. Deep Green Wireless LLC*, IPR2017-01541, Paper 14 at 3–4 (PTAB Jan. 23, 2018) (“Supplemental information 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”).

II. ARGUMENT

A. AMD Seeks to Change the Evidence in the Petition

AMD, as the moving party, bears the burden to demonstrate that it is entitled to relief. 37 C.F.R. § 42.20(c). In support of its motion, AMD addresses the two factors laid out in 37 C.F.R. § 42.123(a). But “[s]ection 123(a) specifies the requirements for authorization to file a motion to submit supplemental information, not the requirements to file the proffered information.” *B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, IPR2014-01510, Paper 37 at 3 (PTAB May 26, 2015). AMD does not even attempt to address the factors governing the actual supplementation, and it therefore fails to satisfy its burden.

Even if AMD had attempted to address the relevant factors, AMD’s proffered evidence violates the Board’s well-established rule that a motion to submit supplemental information may not be used to change the evidence “to refine or bolster challenges originally presented in the petition.” *American Well Corporation v. Teladoc Health, Inc.*, IPR2021-00748, Paper 23 at 6–7 (PTAB Feb. 28, 2022). As the Board has recognized, allowing Petitioners to change the evidence circumvents the statutory requirements of 35 U.S.C. § 312(a)—requiring that the petition identify with particularity the grounds and the evidence, including expert declarations, that support the grounds for the challenge. *Yamaha Golf Car Company v. Club Car, LLC*, IPR2017-02142, Paper 43 at 5 (PTAB Dec. 7, 2018).

Here, the Board found that AMD carries a burden of production to show in its Petition that Chiu qualified as prior art (ID at 29) and that AMD's evidence was insufficient to meet its burden. ID at 30. AMD now seeks to change the evidence it offered and add untimely new expert opinions and argument regarding whether Chiu is prior art. Mot. at 1. The new opinions also include citations to the Chiu provisional that purportedly disclose elements of the invention, citations not in the Petition, thereby altering the grounds of the challenge post-institution.

The Board repeatedly has rejected similar attempts to introduce new expert opinions. *Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30 at 6 (PTAB Nov. 28, 2014) (denying Petitioner's motion to introduce new expert declarations that change the evidence relied on in the Petition); *Laboratoire Francais Du Fractionnement et Des Biotechnologies S.A. v. Novo Nordisk Healthcare AG*, IPR2017-00028, Paper 22 at 4–5 (PTAB June 13, 2017) (same). The Board should do so here as well.

AMD's proffered new opinions stand in contrast to supplemental declarations that are appropriate. For example, supplemental information may be appropriate to "simply correct typographical or clerical errors in the [original declaration.]" *DraftKings Inc. v. Interactive Games LLC*, IPR2020-01110, Paper 16 at 9 (PTAB Mar. 11, 2021). Similarly, in AMD's authority, *Innovative Growers Equip., Inc. v. Pipp Mobile Storage Sys., Inc.*, IPR2022-00893, Paper 22, Petitioner was permitted

to submit a provisional application it already had relied upon in the Petition. Mot. at 2–3. Here, in contrast, AMD improperly seeks to change the evidence post-institution by submitting new expert opinion not included in the Petition concerning Chiu’s prior art status and new citations to the Chiu Provisional to support AMD’s invalidity arguments.

B. AMD Could Have Submitted the Proffered Evidence With Its Petition But Chose Not To Do So for Strategic Purposes

The Board may deny a motion to provide supplemental information if AMD had an opportunity to submit the proffered information with the Petition rather than as supplemental information. *B/E v. MAG*, IPR2014-01510, Paper 37 at 3. Here, AMD fails to show that the proffered information could not have been submitted with the Petition, which justifies denial. *Id.* at 3-4 (holding that “[t]he filing of a petition...should not be turned into a two-stage process” that first elicits a decision from the Board and then responds to that decision); *Novo Nordisk*, IPR2017-00028, Paper 22 at 4 (also denying supplemental information where Petitioner did not demonstrate that the information could not have been obtained earlier). AMD could and should have included the arguments and evidence it now seeks to add in its Petition, but chose not to.

AMD knew that Chiu was not prior art on its face and that it needed to rely on the Chiu provisional to show Chiu was prior art. Pet. at 5. The law is clear that “[a] petitioner carries a burden of production to show in its petition that the asserted

references qualify as prior art.” ID at 29 (citing *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015)). Yet, AMD strategically chose not to submit the required evidence and analysis under *Dynamic Drinkware*, conserving space so that it could submit more grounds in its Petition. AMD was nearing its word count (Pet. at 81) and would have needed to cut other arguments, or exceed the word count, if it had included the evidence it now seeks to submit. Thus, granting AMD’s motion allows AMD to circumvent the word count limitations in the procedural rules (37 CFR § 42.24).

AMD argues its evidence should be accepted because Realtek unexpectedly challenged the prior art status of Chiu. Mot. at 1, 3-4. To the contrary, Realtek only noted AMD’s complete failure to satisfy its burden. In contrast, a patent owner can actually challenge the prior art status by showing an earlier reduction to practice. *Dynamic Drinkware*, 800 F.3d at 1377. A patent owner can also challenge the adequacy of the disclosure in the provisional, as the patent owner did in AMD’s case, *Innovative Growers*, IPR2022-00893, Paper 31 at 4-5. Mot. at 3. Unlike those cases, Realtek pointed out AMD’s failure to satisfy its burden of production to show Chiu is prior art. ID at 31. Failure to meet an initial burden of production does not justify addition of evidence that should have been included in the Petition.

III. CONCLUSION

For the reasons set forth above, the Board should deny AMD’s motion.

Dated: January 11, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on January 11, 2024, a true and correct copy of the foregoing was caused to be served electronically on the following counsel of record for Petitioner at the following email addresses:

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