

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADVANCED MICRODEVICES, INC.,
Petitioner,

v.

REALTEK SEMICONDUCTOR CORPORATION,
Patent Owner.

Case IPR2023-00920
Patent 8,006,218 B2

Before KRISTINA M. KALAN, KIMBERLY McGRAW, and
BRIAN D. RANGE, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION

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

Petitioner requested authorization to file a motion to submit supplemental information regarding whether the Chiu reference (Ex. 1006) can claim priority to its provisional application (Ex. 1011). Ex. 1033, 1. Patent Owner did not oppose Petitioner's request for leave to submit the motion, but did state that it opposed the motion itself. *Id.* at 1–2. Following the Board's authorization (*id.* at 1), Petitioner filed its Motion to Submit Supplemental Information. Paper 11 (“Motion” or “Mot.”) and Patent Owner filed a Response to Petitioner's Motion. Paper 13 (“Opposition” or “Opp”).

For the reasons stated below, Petitioner's motion is granted.

ANALYSIS

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion to submit supplemental information must meet the requirements 37 C.F.R. § 42.123(a), which states that: (1) a request for authorization to file such motion be made within one month of the date the trial was instituted; and (2) the supplemental information must be relevant to a claim for which the trial has been instituted. Our decision to admit supplemental information “is also informed by 37 C.F.R. Part 42, Subpart A,” which requires USPTO regulations “be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Redline Detection v. Start Envirotech, Inc.*, 811 F.3d 435, 443 (Fed. Cir. 2015) (quoting 37 C.F.R. § 42.1(b)).

With respect to the first requirement of Rule 42.123(a), trial was instituted in this proceeding on November 28, 2023. Paper 10. Petitioner requested authorization to file a motion to submit supplemental information

on December 26, 2023 (Ex. 1033). Thus, Petitioner's request was made within one month of the date the trial was instituted.

With respect to the second requirement of Rule 42.123(a), Petitioner states that the supplemental information it seeks to admit is a supplemental declaration by Dr. Vivek Subramanian addressing the prior art status of the Chiu reference (Ex. 1006), which is asserted in Grounds 2 and 3 of the Petition. Mot. 1. Petitioner asserts that the supplemental declaration explains that "the Chiu reference (EX1006) can claim priority to its provisional application (EX1011) because the provisional application provides support for at least one claim in Chiu, as well as the disclosures in Chiu relied upon in Dr. Subramanian's previous declaration (EX1003)." Mot. 1. Because the prior art status of Chiu is relevant to the claims of the '218 patent for which this trial was instituted, we determine that Petitioner has satisfied the second requirement of Rule 42.123(a).

Patent Owner argues that even if Petitioner has met the minimum requirements set forth in § 42.123(a), the Board should still deny Petitioner's motion. *See* Opp. 1–5. In particular, Patent Owner asserts that Petitioner knew that Chiu was not prior art on its face and that Petitioner needed to rely on the Chiu provisional to show Chiu was prior art. Mot. 4 (citing Pet. 5). Patent Owner contends that the proffered evidence improperly refines or bolsters the challenges set forth in the Petition and that allowing Petitioner to change its evidence circumvents the statutory requirements of 35 U.S.C § 312(a), which requires that the petition identify with particularity the grounds and evidence that support the asserted grounds. Opp. 2.

Patent Owner's arguments are not persuasive, for the reasons given below.

The relevant filing and priority dates of the '218 patent and the Chiu reference are as follows: The '218 patent was filed on November 14, 2008 and claims foreign priority to a Taiwanese patent application filed November 15, 2007. Ex. 1001, code (22), (30). The asserted prior art Chiu reference was filed on June 5, 2008 (which is before the '218 patent's actual filing date) and claims priority to US Provisional App. No. 60/976,181, filed September 28, 2007 (which is before the '218 patent's earlier priority date.) Ex. 1006, code (22), (60). Contrary to Patent Owner assertions (Opp. 4), Petitioner did not “concede” that it *needed* to rely on Chiu's September 2007 provisional filing date for Chiu to constitute prior art under pre-AIA § 102(e). Rather, cognizant that Patent Owner may claim priority to the '218 patent's November 2007 foreign priority date (*see* Pet. 4 n.1), Petitioner stated that Chiu is entitled to claim priority to its September 2007 provisional application filing date (Pet. 5).

Our Decision on Institution informed the parties that the evidence provided in the Petition is insufficient to demonstrate that Chiu is entitled to claim priority to the earlier September 2007 provisional filing date. Paper 10, 29–31. Thus, the Petition does not present sufficient evidence to show that Chiu qualifies as prior art to the '218 patent, if it is shown that the '218 patent is entitled to its November 2007 foreign priority date. However, in order to antedate Chiu's June 2008 actual filing date, Patent Owner would need to demonstrate that the '218 patent is entitled to claim priority to its earlier November 2007 foreign filing date. *See, e.g., Dynamic Drinkware, LLC v. National Graphics, Inc.* 700 F.3d 1375, 1378–81 (Fed. Cir. 2015) (discussing the patent owner's burden to demonstrate that the asserted art “is not prior art because the asserted claims . . . are entitled to the benefit of a

filing date (constructive or otherwise) prior to the filing date” of the asserted art); *Apple Inc. v. Scramoge Tech. Ltd.*, IPR2022-00351, Paper 32 at 36–38 (PTAB July 27, 2023)(discussing patent owner’s failure to present argument or evidence regarding entitlement to the benefit of the filing date of a foreign application). We see no reason to prevent Petitioner from submitting its supplemental information at this time rather than, for example, with its reply in response to Patent Owner’s response should Patent Owner rely upon the ’218 patent’s November 2007 foreign priority date.

In consideration of the foregoing, it is

ORDERED that Petitioner’s motion to submit supplemental information under 37 C.F.R. § 42.123(a) is GRANTED.

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PETITIONER:

Douglas R. Wilson
Michelle E. Armond
Joseph Li
Patrick Maloney
ARMOND WILSON LLP
doug.wilson@armondwilson.com
michelle.armond@armondwilson.com
josepher.li@armondwilson.com
patrick.maloney@armondwilson.com

PATENT OWNER:

Jason Engel
Jay Chiu
Katherine Allor
Erik Halverson
K&L GATES LLP
jason.engel.ptab@klgates.com
jay.chiu@klgates.com
katy.allor@klgates.com
erik.halverson@klgates.com

Steven Baik
WHITE HAT LEGAL
sbaik@whitehat.legal