

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.; INSTAGRAM, INC.; WHATSAPP LLC;
META PLATFORMS TECHNOLOGIES, LLC; AND GIPHY, INC.,
Petitioner,

v.

VOCALIFE LLC,
Patent Owner.

IPR2023-00923
Patent 7,266,682 B2

Before KARL D. EASTHOM, JEFFREY S. SMITH, and DAVID C.
MCKONE, *Administrative Patent Judges*

Opinion for the Board filed by *Administrative Patent Judge* SMITH

Opinion Dissenting-in-part filed by *Administrative Patent Judge* MCKONE.

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 21, “Motion”), Patent Owner filed an Opposition (Paper 25, “Opp.”), and Petitioner filed a Reply (Paper 27, “Reply”). With its Motion, Petitioner filed (as supplemental information) Exhibits 1016–1028 containing information that “relates exclusively to the prior art status of Exhibit 1005 (‘Handley’) and Exhibit 1007 (‘PacketCable’) and is relevant to the obviousness grounds for which trial was instituted.

Motion 1. For the following reasons, we *grant* the Motion.

The Motion moves to file the supplemental information (Ex. 1016–1028) “[i]n response to Patent Owner’s challenge to the sufficiency of Petitioner’s evidence as expressed in its Patent Owner’s Preliminary Response.” Motion 2. According to Petitioner, “[e]ach exhibit submitted with this Motion is relevant . . . to the public accessibility of Handley and PacketCable.” Motion 3. Petitioner contends that “the supplemental information does not change “the grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability.” Motion 7.

In other words, Petitioner contends that the supplemental evidence meets both requirements for filing supplemental information under 37 C.F.R. § 42.123(a), namely: (1) a “request for authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted” and (2) “the supplemental information [is] relevant to a claim for which the trial has been instituted.” Motion 3 (quoting 37 C.F.R. § 42.123(a)).

Patent Owner challenges the Motion as to Exhibits 1016–1018 and 1020–1028 related to Handley. Opp. 4. Patent Owner contends that the Motion seeks to introduce a first category of evidence including documents (Exs. 1027 and 1028) and supporting declarations (Ex. 1016–1018) to replace

Handley, and a second category of evidence (Ex. 1016) to show a theory of public accessibility that is not in the Petition. Opp. 1, 4. According to Patent Owner, Petitioner's supplemental evidence changes the grounds of unpatentability and supporting evidence. Opp. 6. Patent Owner contends that Petitioner's supplemental evidence could have been included in the Petition. Opp. 8. Patent Owner contends that Petitioner's wait and see approach warrants denial of the Motion. Opp. 10. Patent Owner contends that granting the Motion would be prejudicial and create delay. Opp. 11. Patent Owner contends that Petitioner's case law is inapposite. Opp. 13.

Petitioner contends that the supplemental information "confirms that EX1005, the author formatted submission of Handley, was published in Computer Networks on February 11, 1999." Reply 1. Petitioner contends that the supplemental information is not swapping in new references, because "the teachings in EX1027 and EX1028 are, in any event, the same." Reply 2. Petitioner contends that it is not changing its theory of public accessibility, and is providing "supplemental evidence of Petitioner's same theory—that the relevant teachings of EX1005 were disclosed in a printed publication before the '682 Patent's earliest priority date," and that the grounds all stay the same. Reply 2–3. Petitioner contends that it is not taking a wait and see approach, because its position is already well laid out in the Petition. Reply 4. Petitioner contends that granting the Motion would not prejudice Patent Owner, because Patent Owner has been aware of Petitioner's positions, grounds, and theories since the first filing. Reply 5.

We agree with Petitioner that Exhibits 1016–1018 and 1020–1028 confirm that Exhibit 1005 was publicly accessible by February 11, 1999. For example, Dr. Jon Crowcroft testifies that he is a co-author of Exhibit 1005 and that Exhibit 1005 was publicly accessible by at least February 11, 1999 on his

UCL academic website and FTP server. Ex. 1016 ¶¶ 6, 13–14, 20. He further testifies that Exhibit 1005 was published in Computer Networks on February 11, 1999 as shown in Exhibits 1027 and 1028. Ex. 1016 ¶¶ 15–16.

We also agree with Petitioner that Exhibits 1027 and 1028 are not new documents that replace Exhibit 1005. Rather, these exhibits are supplemental information that provide evidence as to the public availability of Exhibit 1005. To the extent that Exhibits 1005, 1027, and 1028 have minor differences as shown by Exhibit 2003, the differences do not bear on the subject matter of Exhibit 1005 relied on in the Petition. Dr. Crowcroft testifies that “the technical substance of EX1005, 1027, and 1028 are identical.” Ex. 1016 ¶ 16. Dr. Crowcroft testifies that “it is common practice for editors and publishers to edit citations, grammar, and non-substantive text. This is what happened with EX1005 . . . where, after going through the formal publication process, it was subsequently published in Computer Networks . . . on February 11, 1999.” Ex. 1016 ¶ 18. Dr. Crowcroft testifies that “the version published as EX1028 . . . is identical to EX1005 for all intents and purposes.” Ex. 1016 ¶ 18.

In addition to Dr. Crowcroft’s testimony, Dr. Houh testifies that the teachings of Exhibit 1005 are fully included in Exhibits 1027 and 1028. Ex. 1017 ¶ 12. We agree with Dr. Houh, that “every citation to EX1005 in [the] Petition [] and in [Dr. Houh’s] supporting declaration (EX1003) [are] fully included in both EX1027 and EX1028.” *Id.* Therefore, we agree with Petitioner, that Exhibits 1027 and 1028 show that the teachings of Exhibit 1005 relied on in the Petition were published in Computer Networks on February 11, 1999. *See Valve Corporation v. Ironburg Inventions LTD.*, 8 F.4th 1364, 1371–72 (Fed. Cir. 2021); *United Therapeutics Corp. v. Liquidia Techs., Inc.*, No. 2023-1805, 2023 WL 8794633 at **3–4 (Fed. Cir. 2023) (holding that petitioner’s “abstracts book” theory in the reply but not in the

petition were not impermissible new arguments, “because [the] arguments were not inconsistent with, and therefore not new over, the grounds raised in its IPR petition—that the . . . abstracts were publicly accessible prior to the critical date”).

The issue here is similar to that raised in *Liquidia*, at, where “Liquidia’s IPR petition asserted that each of the Voswinckel abstracts was publicly presented or published at least one year before the priority date of the [challenged] patent, making each of them printed publications within the meaning of § 102(b).” *Liquidia*, at *4. In *Liquidia*, UTC challenged the sufficiency of the evidence for public accessibility, and Liquidia presented additional evidence in its reply under an “abstract book” theory not in the petition asserting that the abstracts were publicly presented and disseminated at a conference prior to the critical date. *Id.* at **3–4. The Board found that Liquidia’s arguments and evidence raised in its reply were not untimely as they were made in direct response to UTC’s attack on the prior art status of the abstracts. *Id.* The Federal Circuit decided that the Board’s conclusion was not an abuse of discretion. *Id.* at 7–8 (citing *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380–82 (Fed. Cir. 2018) (explaining that the petitioner “may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner”); *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1380 (Fed. Cir. 2023) (explaining that a petitioner’s entitlement to respond to new arguments made in a patent owner response is consistent with *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018))). The Federal Circuit held that “Liquidia’s arguments were not inconsistent with, and therefore not new over, the grounds raised in its IPR petition—that the Voswinckel abstracts were publicly accessible prior to the critical date.” *Id.* at 8.

The Dissent does not adequately address or distinguish *Liquidia* or present sufficient support for its position that the term “relevant to a *claim* for which the trial has been instituted” in 37 C.F.R. § 42.123(a) includes a “*theory* for which the trial has been instituted.” Nor has the dissent explained how new evidence supporting the Petitioner’s theory that Exhibit 1005 is prior art to the ’682 patent because it was publicly accessible before the critical date is a new theory of unpatentability. Here, as in *Liquidia*, Petitioner’s arguments here are not inconsistent with, and therefore not new over, the grounds raised in its IPR Petition—that Exhibit 1005 was publicly accessible prior to the critical date. The supplemental information here does not change theories as it only supplements evidence as to the public availability of Exhibit 1005. Petitioner’s theory that Exhibit 1005 is prior art to the ’682 patent because it was publicly available before the effective filing date of the ’682 patent remains the same. Pet. 4; Motion 4. The supplemental evidence in support of its theory that Exhibit 1005 was publicly available before the effective filing date of the ’682 patent is evidence, not a new theory.

Further, regardless of whether Petitioner could have submitted the supplemental information earlier, the purpose of 37 C.F.R. § 42.123(a) is to allow filing of evidence relevant to a claim. Petitioner is not taking a wait and see approach to submitting supplemental information. Patent Owner raised publication issues with respect to Exhibits 1005 and 1007 in its Preliminary Response, and Petitioner responded with the Motion. Moreover, Patent Owner is able to argue any publication or evidentiary issues collectively with respect to Exhibits 1005, 1007, and 1016–1028 in the normal course of scheduled briefing.

Based on the foregoing discussion, 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 is *granted*.

McKONE, *Administrative Patent Judge*, dissenting-in-part.

Petitioner seeks to introduce new Exhibits 1016–1028. I would deny Petitioner’s motion as to all except Exhibit 1019. Accordingly, I dissent as to the Majority’s decision to allow Petitioner to submit Exhibits 1016–1018 and 1020–1028.

Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

- (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.
- (2) The supplemental information must be relevant to a claim for which the trial has been instituted.

37 C.F.R. § 42.123(a). However, “[t]he plain language of § 42.123(a) does not exclude the application of other general governing regulations,” including 37 C.F.R. § 42.1(b) (requiring USPTO regulations to “be construed to secure the just, speedy, and inexpensive resolution of every proceeding”). *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 443, 445 (Fed. Cir. 2015) (affirming Board decision to deny entry of an expert declaration in response to an institution decision determining that the petitioner failed to show a reasonable likelihood of success on the ground for which the new declaration was offered). The Federal Circuit observed that it is appropriate to deny supplemental information if that information changes the grounds on which we instituted or changes the evidence presented in the Petition. *Id.* at 448.

My concern is that Exhibits 1016–1018 and 1020–1028 are not relevant to the theories Petitioner advanced in the Petition but, instead, support new theories that Petitioner intends to advance in the Reply. “It is of the utmost

importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). A petitioner typically is not permitted to introduce new theories or evidence in the reply that it could have introduced in the petition. Rather, “[t]he petitioner’s ‘reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.’” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1002 (Fed. Cir. 2023) (quoting 37 C.F.R. § 42.23(b)). “Any marked departure from the grounds identified with particularity in the petition would impose ‘unfair surprise’ on the patent owner and, consequently, violate both the APA and the IPR statute.” *Id.* (quoting *Arthrex Inc. v. Smith & Nephew, Inc.*, 935 F.3d 1319, 1328 (Fed. Cir. 2019)). Because the evidence Petitioner seeks to submit as supplemental information goes far beyond the allegations and evidence presented in the Petition, the supplemental information is improper and should not be admitted.

The theory Petitioner advanced in the Petition was that claims 1–28 would have been obvious over combinations involving Handley, Exhibit 1005, and that Handley, Exhibit 1005, “was published February 11, 1999, in the Computer Networks journal.” Ex. 1003 ¶ 59; Pet. 4–5. The Majority instituted a trial based on that theory only. Dec. 7, 15 (“We agree with Petitioner that there is a reasonable likelihood that Dr. Houh’s sworn testimony that Handley was published on February 11, 1999 in the Computer Networks journal is true.”), 38. The Majority now appears to view the Petition’s theory as a general allegation that the subject matter of Handley was publicly available some time prior to the ’682 patent’s filing date, rather than a

specific allegation that the document of Exhibit 1005 was published in a specific journal by a specific date. The Majority's broad view would permit a petitioner to provide no more than notice pleading in the petition, with theories and evidence to follow after institution of a trial, an approach the Board has found insufficient. *See Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential) ("This standard is far more than is required in typical notice pleading, which only requires that a party make plausible claims."). The supplemental information Petitioner seeks to submit does not support the Petition's theory and, instead, supports new theories, namely, that Handley was published in different sources and that a different document (Ex. 1028) related to Handley was published in the Computer Networks journal. Petitioner's use of supplemental information in this manner is an abuse of our process and is unfair to Patent Owner.

As to the specific new evidence Petitioner seeks to submit, Dr. Crowcroft, a co-author of Handley, testifies that Handley was published on his personal academic website. Ex. 1016 ¶¶ 7–15; Ex. 1020–1026 (Wayback Machine printouts of personal academic websites of Mr. Handley and Dr. Crowcroft). This is a new theory, and Petitioner does not explain how it is relevant to the theory Petitioner advanced in the Petition and the Majority accepted for institution. Dr. Crowcroft also testifies that a document similar to Handley was "available at Elsevier's Science Direct website." *Id.* ¶ 16; Ex. 1027 (document purportedly available at Science Direct website). This is also a new theory, as the Petition only contended that Handley was available in the Computer Networks journal. Ex. 1003 ¶ 59. Thus, I would not permit Petitioner to introduce Exhibits 1016 and 1020–1027 into the record.

Petitioner also offers Exhibit 1028 as a "physical copy of Handley as published in COMPUTER NETWORKS." Ex. 1016 ¶ 15. This also is a new

theory; indeed, it is an entirely new ground of unpatentability. The Petition contended that Handley, Exhibit 1005, was published in the Computer Networks journal. Ex. 1003 ¶ 59. Exhibit 1028, although it might be related to Handley and include similar material, is not the reference Petitioner advanced in the Petition or on which the Majority instituted a trial. Exhibit 1028 has a different title, different authorship, and changes to content, for example. Ex. 2003. It appears that Petitioner would like us to find that Exhibit 1028, a new reference, was published in the Computer Networks journal and gloss over that Handley, the reference advanced in the Petition, was not. Patent Owner is right to cry foul over this transparent “bait and switch.” Opp. 1. Dr. Hall-Ellis’s new testimony merely supports Petitioner’s new theory that Exhibit 1028, not Exhibit 1005, was published in the Computer Networks journal. Ex. 1018. Thus, I would not permit Petitioner to introduce Exhibits 1018 and 1028 into the record.

Dr. Houh’s new testimony (Ex. 1017) is similarly problematic. He testifies that he retrieved Handley from either Dr. Crowcroft’s personal academic website or Elsevier’s Science Direct website, not the Computer Networks journal. Ex. 1017 ¶¶ 7–8. He does not testify that Exhibit 1005 was published in the Computer Networks journal. Instead, he posits the new theory that “Dr. Crowcroft posted EX1005 on his academic website, which was subsequently edited by the publisher before being formally published in COMPUTER NETWORKS Volume 31, Issue 3.” *Id.* ¶ 13. Indeed, this testimony suggests, contrary to the Petition’s allegation, that Handley was not published in the Computer Networks journal. Dr. Houh’s new testimony introduces new theories of public accessibility and unpatentability and contradicts his prior testimony. Thus, I would not permit Petitioner to introduce Exhibit 1017 into the record.

Because Exhibits 1016–1018 and 1020–1028 do not support the theory Petitioner advanced in the Petition and, instead, support only new theories of public accessibility and unpatentability, I would deny Petitioner’s Motion as to these exhibits.

I do not have similar concerns as to Exhibit 1019, a supplemental declaration by Dr. Hall-Ellis regarding PacketCable (Exhibit 1007) and do not dissent from the Majority’s decision to permit Petitioner to submit Exhibit 1019.

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