

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.

VL COLLECTIVE IP LLC,
Patent Owner.

IPR2023-00924
Patent 7,436,980 B2

Before KARL D. EASTHOM, JEFFREY S. SMITH, and
DAVID C. McKONE, *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 18, “Motion”), Patent Owner filed an Opposition (Paper 24, “Opp.”), and Petitioner filed a Reply (Paper 27, “Reply”). With its Motion, Petitioner filed (as supplemental information) Exhibits 1049 and 1050 containing information that “relates exclusively to the prior art status of Exhibit 1009 (reference entitled, ‘Tracking Loose-limbed People’ or ‘TLP’) and is relevant to the fourth obviousness ground for which trial was instituted.” Motion 1. For the following reasons, we *grant* the Motion.

The Motion moves to file the supplemental information in response to Patent Owner’s challenge to the sufficiency of Petitioner’s evidence as expressed in its Patent Owner’s Preliminary Response. Motion 1. According to Petitioner, “[e]ach exhibit submitted with this Motion is relevant . . . to the public accessibility of TLP.” Motion 4. 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 6.

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 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 supplemental information [is] relevant to a claim for which the trial has been instituted.” Motion 2 (quoting 37 C.F.R. § 42.123(a)).

Patent Owner contends that Exhibit 1050 is not relevant to the prior art status of Exhibit 1009, because Dr. Hall-Ellis does not testify that Exhibit 1009 was publicly available before the effective filing date of the ’980 patent.

Opp. 4. Patent Owner contends that Exhibits 1049 and 1050 aim to bolster deficiencies in the Petition that Patent Owner identified in its Preliminary Response. Opp. 5. Patent Owner contends that the supplemental information could have been obtained by Petitioner before filing the Petition. Opp. 10. Patent Owner contends that the supplemental evidence changes the evidence relied on in the Petition. Opp. 12. Patent Owner contends that permitting Petitioner to submit supplemental information is unjust and prejudicial. Opp. 13–14.

Petitioner contends that the supplemental information is not a new theory, but rather, addresses a specific issue relevant to a claim for which trial has been instituted—Patent Owner’s argument that Exhibit 1009 was not publicly available before the effective filing date of the ’980 patent and the Board’s statement that the Petition does not show a reasonable likelihood that Exhibit 1009 was published before the effective filing date of May 27, 2004.

Reply 1. Petitioner contends that Exhibits 1049 and 1050 are supplementing a position already taken in the Petition and known to Patent Owner. Reply 3. Petitioner contends that Exhibits 1049 and 1050 supplement Dr. Bajaj’s statements in Exhibit 2004 that Exhibit 1009 would have been publicly available before the effective filing date of the ’980 patent. Reply 3.

Petitioner contends that submitting testimony from a librarian is not unjust.

Reply 4. Petitioner contends that the supplemental information is not unfairly extending the length of the Petition because the supplemental information is limited to the issue of public accessibility of Exhibit 1009. Reply 4.

Petitioner contends that although Dr. Hall-Ellis testifies, in one paragraph, that Exhibit 1009 was available after the filing date of the ’980 patent, she also testifies that Exhibit 1009 was available before the filing date of the ’980 patent. Reply 5.

We agree with Petitioner. Exhibits 1049 and 1050 are supplemental information that provide evidence as to Petitioner's theory that Exhibit 1009 is prior art to the '980 patent because Exhibit 1009 was publicly available before the effective filing date of the '980 patent. The supplemental information here does not change theories as it only supplements evidence as to the theory that Exhibit 1009 is prior art due to the public availability of Exhibit 1009 before the effective filing date of the '980 patent. To be clear, we understand Petitioner's theory to be that TLP was made publicly available for the 2004 IEEE Computer Society Conference on Computer Vision and Pattern Recognition on April 9, 2004. Dec. 48; Pet. 6. We also understand Petitioner to argue that Mr. Black's purported publication of TLP on the ResearchGate website on January 31, 2004, makes it more likely that TLP was made publicly available for the 2004 IEEE Conference. Reply 3.

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 Exhibit 1009 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, 1049, and 1050 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. We caution Petitioner that granting the Motion does not mean we will entertain impermissible new theories in the Reply.

It is *Ordered* that the Motion is *granted*.

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