

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

QUANTUM IMAGING LLC,
Patent Owner.

IPR2023-00954
Patent 8,458,028 B2

Before SCOTT A. DANIELS, KEVIN W. CHERRY, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

BACKGROUND

Patent Owner seeks authorization to provide, by email to the Board, a list of rebuttal evidence to Petitioner’s alleged new arguments in the Patent Owner Reply for this proceeding. Ex. 3004, 1. Patent Owner seeks to provide this list “for appellate purposes,” “[i]n light of the Federal Circuit’s recent decision in *ZyXEL Communications Corp. v. UNM Rainforest Innovations*, 107 F.4th 1368” (Fed. Cir. 2024) (“*ZyXEL*”). *Id.* Petitioner opposes. *Id.* For the reasons discussed below, we deny authorization.

DISCUSSION

On July 8, 2024, Patent Owner filed a Sur-reply to Petitioner’s Reply. Paper 35.¹ Patent Owner then contacted the Board and stated that, because of complications from Hurricane Beryl, an old version of the Sur-reply was filed. Ex. 3005, 5. Patent Owner sought authorization to file a corrected Sur-reply and have the old Sur-reply expunged, along with Exhibit 2015. *Id.* at 4–5. In response, we directed Patent Owner to confirm that Petitioner did not object to these actions. *Id.* at 3–4.

Petitioner opposed the actions. Ex. 3005, 3. Patent Owner explained that it would file the Sur-reply it had intended to file on July 8, 2024, but also intended to include two footnotes “explaining what was eliminated for appellate purposes.” *Id.* at 3. Petitioner responded that it did “not oppose

¹ Prior to submitting the Sur-reply, we denied Patent Owner’s request for authorization to file a motion to strike certain portions of Petitioner’s Reply. Paper 34. The Order denying Patent Owner’s request states that “Patent Owner will be free to explain in its sur-reply how Petitioner’s argument is new and untimely and why we should disregard it. Thus, we disagree that a Motion to Strike is warranted.” Paper 34, 3.

Patent Owner’s request to expunge Ex[hibit] 2015 and all references to Ex[hibit] 2015 in its sur-reply. It also d[id] not oppose Patent Owner filing a corrected sur-reply removing the improper content.” *Id.* at 2. Petitioner explained that it objected to Patent Owner added the footnotes to explain the information that was removed from the Sur-reply. *Id.*

In an email correspondence, we ultimately authorized Patent Owner “to file a corrected Sur-reply and exhibit list that Patent Owner initially intended to file on July 8.” Ex. 3006, 1.² We ordered that “[t]he corrected Sur-reply shall not include footnotes explaining what was eliminated for appellate purposes.” We also stated that “[t]he originally filed Sur-reply will not be expunged, preserving a complete record for appeal.” *Id.*

It is in response to this authorization that Patent Owner requests to submit a list of rebuttal evidence to the Board for appellate purposes.

A party submitting any information to the Board by way of email does not place that information into a proceeding’s record. To be included in the record, the information must be part of a paper or exhibit. *See* 37 C.F.R. §§ 42.6, 42.20–42.23, 42.63 (2024). A reason for this requirement is that the record for a proceeding must be made available to the public. *See id.* § 42.14. As such, Patent Owner providing a listing of rebuttal evidence, untethered to a paper, by email to the Board does not include that information into the record for appeal.

Also, as our Order denying authorization for Patent Owner to file a motion to strike Petitioner’s Reply, we expressly identified an avenue for Patent Owner to address the alleged new evidence in a paper that would be part of the record. *See* Paper 34, 3.

² The corrected Sur-reply was filed on August 15, 2024. Paper 44.

Patent Owner's reliance on *ZyXEL* is misplaced. Patent Owner indicates that the Federal Circuit held that a patent owner in a proceeding before the Board "should 'point to any relevant evidence that it would have presented if the opportunity had been available.'" Ex. 3004, 1 (quoting *ZyXEL*, 107 F.4th at 1382–83). Patent Owner at least suggests that this statement requires a patent owner to somehow place this evidence in front of the Board. We do not read this statement in *ZyXEL* to require a patent owner to submit to the Board evidence that it may wish to "point to" later at the Federal Circuit, including evidence that is not entered as an exhibit and referenced in a paper in that proceeding. As Patent Owner quotes, the Federal Circuit states that "*ZyXEL* does not to point to any relevant evidence that it would have presented if the opportunity had been available." *ZyXEL*, 107 F.4th at 1382–83. By using the phrase "does not"—that is, the present tense referring to the appeal—we read the Federal Circuit as saying that *ZyXEL* did not identify any evidence to the Federal Circuit in its appeal upon which *ZyXEL* would have relied had it the opportunity to present it to the Board.

Also, we agree with Petitioner that "allowing Patent Owner to provide such a listing would result in the Board being overwhelmed with such requests going forward." Ex. 3004, 1. Such a scheme of managing evidence outside the record of a proceeding is beyond the structure established by the Board for these proceedings. Finally, we note that we have already allowed the original sur-reply containing all of Patent Owner's arguments to remain in the record to preserve its contentions for appeal. Patent Owner's current request fails to explain why that remedy is insufficient. If the intent is to add even more additional evidence beyond what was included in the original sur-

reply, Patent Owner has failed to explain why we should allow even a request for further supplementation more than a month after Patent Owner's sur-reply was due.

For these reasons, we deny Patent Owner's request.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Patent Owner's request for authorization to submit a listing of rebuttal evidence is *denied*.

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