

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE (ZHUHAI) TECHNOLOGY COMPANY, LTD.,
AND
INNOSCIENCE AMERICA, INC.
Petitioner,

v.

EFFICIENT POWER CONVERSION CORPORATION,
Patent Owner

Case IPR2023-01383
U.S. Patent No. 8,404,508

PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE

The Board should deny Petitioner's request to exclude Patent Owner's Exhibit 2008 (Paper 25), because Patent Owner's use of Exhibit 2008 is extremely limited in scope and includes relevant supplemental information for which it would be in the interest-of-justice for the Board to consider. Exhibit 2008 includes a contradictory position taken by Petitioner's counsel in a parallel ITC investigation involving the validity of U.S. Patent 8,404,508 (the "'508 patent") with respect to the qualifications of Patent Owner's expert Dr. Schubert. *See generally* EX2008.

I. GOOD CAUSE EXISTS TO CONSIDER THE SUPPLEMENTAL INFORMATION

Good cause justifies the Board considering Exhibit 2008. The information at issue is limited in scope and does not go directly to the merits of validity; instead, it relates primarily to Petitioner's credibility in view of the Petitioner's inconsistent positions. *Id.* Petitioner suffers no prejudice from the Board considering the information for this purpose.

The information is also relevant. Petitioner argues that Dr. Schubert's qualification in the parallel ITC investigation "has no bearing on the issue of Dr. Schubert's qualification disputed at this proceeding." Paper 25 at 2. This strained position further puts into question Petitioner's credibility. Both proceedings relate to the validity of the '508 patent. The claim at issue in the parallel ITC investigation (claim 1) is also at issue in this proceeding. And two of the prior art

references asserted by Petitioner here, Beach and Hikata³⁴⁷, were also asserted by Petitioner at trial in the parallel ITC investigation. EX1053 at 13:1-7.

Moreover, consideration of the information would be in the interest-of-justice, and Patent Owner respectfully requests that the Board waive 37 C.F.R. §42.123(b) to permit submission of Exhibit 2008. Failing to permit the Board to consider this kind of information incentivizes parties to belatedly change positions in different forums without consequence of impeachment. Denying the present motion would thus provide a more complete record of Petitioner's positions regarding Dr. Schubert's qualifications. *See Smartmatic USA Corp. v. Election Sys. & Software, LLC*, IPR2019-00531, Paper 32, at 5 (P.T.A.B. Mar. 13, 2020) (consideration of supplemental information "in the interests-of-justice" where "supplemental information may provide a more complete record"). Moreover, "[i]t is reasonable that Patent Owner should not have to deduce Petitioner's challenges and all of its supporting arguments before they develop during the course of a proceeding without a chance to respond in some fashion." *General Elec. Co. v. United Techs. Corp.*, No. IPR2018-01442, Paper 33, at 6 (P.T.A.B. Oct. 10, 2019) (permitting the submission of supplemental information with a Sur-Reply). Fairness dictates that the Board should be allowed to consider information reflecting Petitioner's changing position.

Lastly, the parties do not dispute that Petitioner declined to object to Dr. Schubert's qualifications in the parallel ITC investigation. Paper 25 at 2; Paper 20 at 32. Accordingly, regardless of whether Exhibit 2008 is excluded, the Board should be allowed to rely on this uncontested point.

II. CONCLUSION

For the aforementioned reasons, Petitioner's Motion to Exclude should be denied, and the Board should consider Patent Owner's supplemental information.

Dated: December 4, 2024

Respectfully submitted,

/s/ Walter D. Davis, Jr.

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE** is being served on counsel of record by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS), with a copy served via electronic mail to the following email address, as authorized in the Petition:

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