

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION, ERICSSON INC.,
AND T-MOBILE USA, INC.,
Petitioner,

v.

GENERAL ACCESS SOLUTIONS, LTD.,
Patent Owner.

IPR2023-01416
Patent 6,947,477 B2

Before KEN B. BARRETT, BARBARA A. PARVIS, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

ORDER

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

I. INTRODUCTION

Petitioner, within a month of institution and in accordance with our rules, requested authorization to file a motion to submit supplemental information regarding the public availability of a reference relied on in the Petition. *See* 37 C.F.R. § 42.123(a)(1). We granted authorization and Petitioner filed the Motion. Paper 15 (“Motion” or “Mot.”). Along with the Motion, Petitioner filed the exhibits that it wishes to submit. *See* Exs. 1017–1035. According to Petitioner, “Exhibit 1035 is the Supplemental Declaration of Dr. Daniel van der Weide and Exhibits 1017–1023 are supporting exhibits,” and “Exhibit 1034 is the declaration of Carl Eklund, who is an employee at Nokia Corporation, and Exhibits 1024-1033 are supporting exhibits.” Mot. 2. Patent Owner opposes the Motion. Paper 16 (“Opposition” or “Opp.”).

For the reasons that follow, the Motion is *denied*.

II. BACKGROUND

The Petition relies on Exhibit 1006—identified as “WiMAX” by Petitioner—as a secondary reference in one out of five grounds, and in a ground challenging only dependent claims. *See* Paper 1 (“Pet.”), 28–40 (Ground 2).

WiMAX is titled, “Air Interface for Fixed Broadband Wireless Access Systems” and indicates that it is a document of the Institute of Electrical and Electronics Engineers (IEEE). Ex. 1006, 1.¹ The abstract on the first page of WiMAX states: “[t]his document is FOR COMMENT as a potential

¹ We cite here to the page numbers of the exhibit rather than the page numbers of the underlying document.

DRAFT standard” *Id.* WiMAX also states, in a footer repeated on almost every page, that “[t]his is an unapproved Task Group document being circulated for comment.” *See, e.g., id.* The header on the first page contains the following: “IEEE 802.16.1-00/01r4, September 2000.” *Id.* The document, at the bottom of that same first page, states “Published August 2000,” and has, for the International Standard Book Number (“ISBN”), “0-7381-xxxx-x.” *Id.; cf.* Paper 8 (“Prelim. Resp.”), 22 (Patent Owner referring to “a *placeholder* ISBN”). The header on some subsequent pages also has the September 2000 date, while the header on several other pages has a date of August 2000. *See, e.g.,* Ex. 1006, 2 (September); *id.* at 17 (August).

The Petition asserts that “WiMAX includes a 2000 Copyright stamp” and relies on the testimony of its technical expert, Dr. van der Weide, as support for the argument that the WiMAX reference was publicly available. Pet. 10–11 (citing Ex. 1006, 1; Ex. 1003 ¶¶ 54–56). Dr. van der Weide’s pertinent testimony begins with the statement: “I have been informed that I should assume WiMAX was published in September 2000 and qualifies as prior art under at least pre-AIA U.S.C. §102(a).” Ex. 1003 ¶ 54. Dr. van der Weide, after stating his foundational assumption that the document was published, refers to the WiMAX reference as a “draft standard[,]” goes on to discuss the public availability of *published draft* standards, but does not explain the import of the modifier “potential” in the document’s self-identification as a “potential DRAFT standard.” *See id.* ¶¶ 54–56; Pet. 10–11 (similar); Ex. 1006, 1. The Petition does not address the facial inconsistency of the two dates—August and September—on the first page of the document. *See* Pet. 10–11. The Petition identifies Carl Eklund as an

individual that has “direct knowledge of the importance and availability of the WiMAX draft standard to other relevant, interested POSITAs.” *Id.* at 11 n.2. As mentioned above, Petitioner now seeks to submit, as supplemental information, a declaration from Mr. Eklund.

Patent Owner argued in the Preliminary Response that Petitioner had not demonstrated adequately the public accessibility of WiMAX prior to the critical date. Prelim. Resp. at 21–26. Patent Owner first asserted that “any copyright date printed on the WiMAX potential draft standard document cannot be relied on to establish its purported publication date.” *Id.* at 23.

We, in the Institution Decision, stated:

Although both parties refer to a copyright stamp or date, we fail to see anything in WiMAX identified as such. We do, however, note that the header on the first page of the document states “IEEE 802.16.1-00/01r4, September 2000” and, at the bottom of that same page, states “Published August 2000.” Ex. 1006, 1. The listing of two different dates calls into question whether either is correct.

Paper 12 (“Inst. Dec.”), 33.

Patent Owner also argued that “Petitioners have failed to meet their burden to show that members of the interested public outside of the IEEE 802.16 Working Group would have known about, and known how to request the WiMAX potential draft standard.” Prelim. Resp. 26. Patent Owner argued that:

Petitioners’ characterization of WiMAX as publicly accessible as an ‘IEEE draft standard[,]’ is inaccurate, at best. Rather, WiMAX’s abstract states: ‘This document is FOR COMMENT as a potential DRAFT standard,’ Petitioners have

provided no evidence of the public accessibility of *potential* draft IEEE standards.

Id. at 24. We additionally noted WiMAX’s footer stating that “[t]his is an unapproved Task Group document being circulated for comment.” Inst. Dec. 33–34 (citing Ex. 1006, 1).² We stated that “the document not only is not an issued standard, it indicates that it is not even a draft standard.” *Id.* at 34.

We determined, in the Institution Decision, that “Petitioner has not established adequately that WiMAX is prior art and, accordingly, that Petitioner has not demonstrated a reasonable likelihood of prevailing in its challenge to claims 2, 10–12, 14, and 18 as obvious over Genossar and WiMAX.” *Id.* at 34.

III. DISCUSSION

Patent Owner argues that the Motion should be denied “because it is solely offered to refine and bolster arguments Petitioners could have made in their Petition.” Opp. 1. Patent Owner further argues the supplemental information was available when the Petition was filed and Petitioner does not offer an explanation as to why it did submit the information at that time. *See id.* at 3–4. According to Patent Owner, Petitioner adopted a “wait-and-see” approach. *Id.* at 4.

² We acknowledge that Dr. van der Weide asserted that, “[b]y releasing this draft standard ‘FOR COMMENT,’ the IEEE 802.16 Working Group’s goal was to intentionally circulate the draft to the interested public in order to garner feedback on its contents from professionals and POSITAs in the relevant technical space.” Ex. 1003 ¶ 55 n.4. Dr. van der Weide does not identify a basis for this conclusory assertion as to the IEEE 802.16 working group’s goal or intent. *See id.*

We are not persuaded by Petitioners' argument that the Board should grant its request because it was made within one month from the institution date and the exhibits would be relevant to a claim for which trial had been instituted. *See* Mot. 2–3. The Board may consider other factors in determining whether to grant a motion to submit supplemental information.

Although a party may meet the requirements laid out in 37 C.F.R. § 42.123 so as to obtain authorization to file a motion to submit supplemental information, that does not, itself, guarantee that the motion will be granted. Indeed, the provision for submitting supplemental information is not intended to offer a petitioner a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary Response. To that end, a petitioner should not expect § 42.123 to present a “wait-and-see” opportunity to supplement a petition after initial comments or arguments have been laid out by a patent owner.

Pacific Mkt. Int'l, LLC v. Ignite USA, LLC, IPR2014-00561, Paper 23 at 3 (PTAB Dec. 2, 2014); *see also, e.g., Ooma, Inc. v. Deep Green Wireless LLC*, IPR2017-01541, Paper 14 at 3–4 (PTAB Jan. 23, 2014) (“Supplemental information is not intended to provide a petitioner an advantageous ‘wait-and-see’ opportunity to use a patent owner’s preliminary response and our decision on institution in order to refine or bolster petitioner’s position.”); *American Well Corp. v. TelaDocHealth, Inc.*, IPR2021-00748, Paper 23 at 6-7 (PTAB Feb. 28, 2022) (collecting cases) (“[T]he Board has denied such motions where the petitioner sought to use the supplemental information to refine or bolster challenges originally presented in the petition, based on information in the preliminary response or institution decision.”). Relatedly, the Board also has denied motions where the supplemental information was available at the time of the petition and petitioner failed to provide an adequate explanation for not doing so. *See, e.g., ClearOne, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-

00683, Paper 32 at 8 (PTAB Nov. 6, 2019) (“We find that the circumstances presented here, namely, that Petitioner could have submitted the supplemental information with the Petition and Petitioner has not provided sufficient explanation for not doing so, warrants denying Petitioner’s Motion as to Exhibits 1038–1041.”); *B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, IPR2014-01510, Paper 37 at 3 (PTAB May 26, 2015) (“Petitioner’s opportunity to have submitted the proffered information with the petition rather than as supplemental information is a permissible consideration in evaluation of a motion under section 123(a)”).

Patent Owner, in the Preliminary Response, argued that Petitioner failed to establish that WiMAX qualifies as prior art, Prelim. Resp. 21, and that “Petitioners have failed to show that a potential draft IEEE standard document would have been publicly accessible prior to the critical date of the ’477 patent,” *id.* at 24 (section heading with capitalization omitted). Petitioner asserts that, “[a]s a result of these evidentiary challenges, the issue of public accessibility is ripe and is properly addressed at this stage of the proceeding.” Mot. 3. Petitioner is incorrect. The issue was ripe at the time of the filing of the Petition. “[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential).

The Petition in this case failed to identify adequate evidence to meet the threshold showing at the institution stage. The Petition begins with the

conclusory assertion that the reference “was published in September 2000 and qualifies as prior art” and characterizes it as a “draft standard[.]”

Pet. 10. As mentioned above, the Petition relies on a purported copyright date and Dr. van der Weide’s testimony where he was instructed to assume to be correct Petitioner’s conclusory assertion regarding the reference’s status as a prior art publication and where he discusses the accessibility of *draft* standards. *See id.*; Ex. 1003 ¶ 54. The Petition failed to address adequately the document’s self-identification as a *potential* draft standard or the existence of inconsistent dates on the first page. *See* Pet. 10–11; *cf.* Mot. 1 (Petitioner continuing to characterize the reference as a “Draft Standard” without acknowledging the “potential” modifier).

Petitioner admittedly now seeks to respond to the Preliminary Response through the submission of supplemental evidence. *See, e.g.*, Mot. 4 (“[T]he supplemental information presented here responds to the challenges by Patent Owner.”). This is not a situation where a petitioner met the threshold showing of public accessibility but there remained a potential dispute on that issue that might be resolved via supplemental information. Rather, Petitioner here failed to satisfy that threshold burden and now seeks to make a showing after institution and after Patent Owner and our Institution Decision discussed problems with Petitioner’s initial case.

As mentioned above, the Petition identified Mr. Eklund as someone purportedly having “direct knowledge of the importance and availability of the WiMAX draft standard to other relevant, interested POSITAs.” *Id.* at 11 n.2. However, Petitioner did not file, with the Petition, the declaration from Mr. Eklund that it seeks now to submit as supplement information. Rather, Petitioner chose to rely on a declaration of a witness who was instructed to

assume that the WiMAX reference was published in September 2000 and qualifies as prior art—the very things that are at issue. *See* Ex. 1003 ¶ 54. Petitioner now seeks to file declarations from both witnesses along with purportedly supporting evidence. Petitioner does not explain adequately why it did not, at the time of the Petition, come forward with the supplemental information and present related arguments to which Patent Owner could have responded in the Preliminary Response. We agree with Patent Owner that Petitioner took a wait-and-see approach and now is attempting to improperly bolster the Petition after institution.

The Board also has considered the effect of the supplementation on the schedule. *See, e.g., Rackspace US, Inc. v. PersonalWeb Techs., LLC*, IPR2014-00057, Paper 16 at 5 (PTAB Apr. 30, 2014). Petitioner argues that “Patent Owner has sufficient time to address the supplemental information contained in Exhibits 1017–1035 and is therefore not prejudiced.” Mot. 5 (citing, but not analogizing to the facts in this case, a decision where, based on the specific facts in that case, two months was deemed sufficient for a patent owner’s consideration of supplemental information). Petitioner also argues that “entry of these exhibits will provide Patent Owner with the benefit of being able to respond to the supplemental information in its Response.” *Id.* at 5.

Patent Owner argues that there is insufficient time for it to depose the two declarants, including one that resides in Finland, and then prepare its Response. Opp. 5. We note that, had the supplemental information been submitted with the Petition, Patent Owner would have had more time to plan and execute discovery (including a potential international deposition), and both parties would have had the opportunity to brief the issues prior to

institution and before the opening of the twelve-month window for a trial. We also note that, if the supplemental information is allowed to be submitted now, Patent Owner likely would have to anticipate arguments not made in the Petition and/or treat the Motion as if it contains arguments incorporated retroactively into the Petition, depose Petitioner's witnesses based on its understanding of Petitioner's arguments, and then prepare a Response to the Petition and arguments in the Motion.

On the specific facts of this case, we determine that schedule considerations weigh against granting the Motion.

IV. ORDER

For the foregoing reasons, it is

ORDERED that Petitioner's request for leave to file a motion to submit supplemental information under 37 C.F.R. § 42.123 is *denied*.

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