

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Inergy Technology, Inc.,

Petitioner

v.

Force Mos Technology Co., Ltd.,

Patent Owner

Patent No. 7,629,634 B2

Issue Date: December 8, 2009

Title: TRENCHED MOSFET WITH TRENCHED SOURCE CONTACT

Inter Partes Review No. IPR2024-00093

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION**

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PROPOSED NEW EXHIBIT

EXHIBIT NUMBER	DESCRIPTION
1018	Translator's Certificate of Translation for Exhibit 1006, attaching Exhibit 1006

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.123(a), and under the authorization granted by the Board on June 25, 2024, Petitioner, Inergy Technology, Inc., hereby timely moves to submit Exhibit 1018 (a translation certificate with a signed declaration by the translator regarding the translation of Hirler (Exhibit 1005) into English (Exhibit 1006) and attaching Exhibit 1006) as supplemental information. This Exhibit provides further testimony supporting the accuracy of the translation for Hirler, which was filed with the Petition (Paper 1) as Exhibit 1006. Hirler is a primary reference submitted by Petitioner with respect to Grounds 1 and 2 and claims 1-9 for which trial has been instituted. For at least these reasons, Exhibit 1018 is relevant to a claim for which trial has been instituted. Petitioner respectfully requests that it be permitted to supplement the information in the record with Exhibit 1018 at least because: (1) Exhibit 1018 constitutes supplemental information; (2) both requirements of § 42.123(a) have been met; (3) Exhibit 1018 does not change the grounds of unpatentability or evidence initially presented in the Petition; (4) Exhibit 1018 does not limit the Board's ability to satisfy its mandate for the just, speedy, and inexpensive resolution of this proceeding; and (5) there is little to no prejudice to Patent Owner that would arise from Petitioner's submission of Exhibit 1018 well-before Patent Owner's Response is due (August 12, 2024).

II. BACKGROUND

Petitioner challenged the claims of U.S. Patent No. 7,629,634 (the “’634 Patent”) on five grounds, one of which included challenging claims 1-2 and 6 as anticipated by Hirler and another of which included challenging claims 3-5 and 7-9 as obvious over Hirler in light of Kobayashi and the knowledge of the POSITA. Paper 1 at 21-36. Hirler was published before the ’634 Patent’s priority date in the German language. *See* Exhibit 1005. Petitioner submitted an English translation of Hirler (*see* Exhibit 1006) and a corresponding Certificate of Translation by Questel-Orbit (*see* Exhibit 1007).

On May 21, 2024, the Board instituted trial on “all challenged claims based on all grounds asserted in the Petition” upon determining that “Petitioner demonstrates a reasonable likelihood that the subject matter of at least one challenged claim is unpatentable.” (Paper 13 at 25.)

On June 4, 2024, Patent Owner filed Patent Owner’s Objections to Evidence Submitted Prior to Institution. (Paper 14.) With its objections, Patent Owner challenged the certificate of translation (*see* Exhibit 1007) and the accuracy of Petitioner’s English translation of Hirler (*see* Exhibit 1006), alleging that “the statements in Exhibit 1007 are not statements made by an individual with personal knowledge of the accuracy of the translation” and that “Exhibits 1006 and 1007 fail to provide an adequate and rule-compliant affidavit of translation.” (*Id.* at 1.)

On June 18, 2024, Petitioner served Patent Owner with a translation certificate including a signed declaration by the translator regarding the translation of Hirler (Exhibit 1005) into English (Exhibit 1006) and attaching Exhibit 1006.¹ The same day, on June 18, 2024, counsel for Petitioner requested a meet and confer on Petitioner's forthcoming request for authorization to file a motion to submit Exhibit 1018 as supplemental information. On June 20, 2024, counsel for Petitioner and Patent Owner met and conferred to determine whether Patent Owner would oppose Petitioner's request. On June 21, 2024, Patent Owner confirmed that it opposed Petitioner's request, and Petitioner requested authorization from the Board to file the motion to submit Exhibit 1018 as supplemental information and included Patent Owner's statement of opposition in Petitioner's request to the Board. On June 25, 2024, the Board authorized Petitioner to file this motion to submit supplemental information by June 28, 2024, and provided that Patent Owner may file an opposition to the motion by July 8, 2024, and that no further briefing is authorized. Petitioner hereby moves the Board for authorization to file Exhibit 1018. In accordance with the Board's direction that no further briefing is authorized, Petitioner has not presently filed Exhibit 1018 herewith pending the Board's decision on Petitioner's motion.

¹This translation certificate, and its attachment (Exhibit 1006), comprise the proposed Exhibit 1018.

III. LEGAL STANDARD

Supplemental information includes information directed to the accuracy of a translation of a prior art reference that serves as the basis for one or more grounds of unpatentability for which trial has been instituted. *Mom Enterprises, LLC v. Elaine and Reinhold W. Vieth*, IPR2023-00726, Paper 35 at 2-4 (P.T.A.B. Nov. 17, 2023). A party may move to submit supplemental information once trial has been instituted if: “(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) [t]he supplemental information must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a). The Board may find that a Petitioner has met its burden as movant and allow Petitioner to submit supplemental information when Petitioner demonstrates it has satisfied the requirements of 37 C.F.R. § 42.123(a). *Palo Alto Network, Inc. v. Juniper Networks, Inc.* IPR2013-00369, Paper 37 at 3-4 (P.T.A.B. Feb. 5, 2014). The Board may also find that a Petitioner has met its burden when the supplemental information Petitioner seeks to submit does not “change the grounds of unpatentability authorized in th[e] proceeding” or “change the evidence initially presented in the Petition to support those grounds of unpatentability.” *Id.* Though “the Board must ensure ‘the just, speedy, and inexpensive resolution of every proceeding,’” the Board may find that a Petitioner has met its burden where Patent Owner is unable to present

sufficient or credible reasons why Petitioner’s submission “would limit [the Board’s] ability to satisfy that mandate.” *Id.* at 5 (citation omitted). And the Board may find that a Petitioner has met its burden where “there is little, if any, prejudice to Patent Owner if the information is allowed into the record” because “Patent Owner already has possession of the supplemental information” and “Patent Owner will have sufficient time to address the supplemental information before filing its Patent Owner Response.” *Id.* at 6. Finally, there is no requirement at this stage that Petitioner be “required to provide” the supplemental information in the Petition or that it “could have been presented” in the Petition because “whether ‘supplemental information reasonably could have been obtained earlier’ is a requirement under § 42.123(b) and (c)--not a requirement under § 42.123(a).” (*Id.* at 4.)

IV. ARGUMENT

Petitioner’s motion meets the requirements of 37 C.F.R. § 42.123(a), and Petitioner has met its burden as movant to submit Exhibit 1018 as supplemental information for the reasons provided herein.

Petitioner requested authorization to file this Motion on June 21, 2024, within one month of the May 21, 2024, institution date. Thus, Petitioner’s motion is timely under 37 C.F.R. § 42.123(a)(1). (*See also* Paper 12.)

Further, Exhibit 1018 is supplemental information that is relevant to a claim at issue in the trial. Exhibit 1018 is a declaration by the translator who translated

Exhibit 1005 (Hirler) into the English translation filed as Exhibit 1006 (and attaching Exhibit 1006). Exhibit 1018 states in part the translator's language competencies and that the translation filed as Exhibit 1006 "is a true, full, and accurate English translation" of German Patent Publication Number: DE 10 2004 009 083 A1 (Hirler). Exhibit 1018 is relevant to Patent Owner's argument regarding the accuracy of the Exhibit 1006 translation of Hirler, which is used to support the grounds for unpatentability involving the Hirler reference and thus relevant to a claim for which the trial has been instituted under 37 C.F.R. § 42.123(a)(2). Thus, Exhibit 1018 is not solely directed to evidence supporting admissibility but rather the accuracy and thus reliability of Exhibit 1006. This is appropriate supplemental information. *Mom Enterprises*, Paper 35 (granting Petitioner's motion to submit supplemental information, including declarations from the translators attesting to the accuracy of translations of prior art references submitted with the Petition).

In addition, Petitioner's submission of Exhibit 1018 would not change the grounds of unpatentability authorized in this proceeding or any evidence initially presented in the Petition to support those grounds of unpatentability. *Palo Alto*, Paper 37 at 3. Rather, the information is relevant to the limited issue of the accuracy of the previously submitted English translation of the Hirler reference (Exhibit 1006), which is relevant to, but does not change, the grounds and claims from the Petition involving Hirler and for which trial was instituted. Therefore, there is no

risk that the submission of Exhibit 1018 would create new issues or otherwise be inconsistent with the evidence submitted with the Petition or the Petition itself.

Petitioner's submission of Exhibit 1018 also would not interfere with the just, speedy, and inexpensive resolution of this proceeding. *Id.* at 4. In fact, accepting the submission of Exhibit 1018 now would permit early consideration (institution was only granted just over one month ago) and either obviate the need for, or allow more efficient, briefing on the issue of the accuracy of the Exhibit 1006 translation of Hirler in the parties' initial post-institution filings. Any briefing now has the additional benefit of avoiding briefing in piecemeal motion to exclude practice now or at a much later date in this proceeding. Further, Patent Owner's Response is due August 12, 2024, and Patent Owner has not taken any depositions. Therefore, allowing Exhibit 1018 into the record would not interfere with the Board's resolution of this proceeding.

Lastly, the submission of Exhibit 1018 would not prejudice Patent Owner. Patent Owner raised the issue of the accuracy of Exhibit 1006 on June 4, 2024. Patent Owner was served with the Exhibit 1018 supplemental information on June 18, 2024. Patent Owner's opposition to this motion, if any, is due July 8, 2024. But Patent Owner's Response is not due until August 12, 2024. As explained above, Patent Owner has not taken any depositions. Accordingly, Patent Owner has more than sufficient time to review and respond to the limited information provided in

Exhibit 1018 on the narrow issue of the accuracy of Exhibit 1006 in the current time period allotted for Patent Owner's Response. *Id.* at 5.

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests permission to submit Exhibit 1018 as supplemental information.

Respectfully submitted,

Dated: June 28, 2024

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CERTIFICATE OF SERVICE

I hereby certify that on June 28, 2024, I caused a true and correct copy of
Petitioner's Motion to Submit Supplemental Information to be served via email to:

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Dated: June 28, 2024

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