

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.

IPR2024-00093
Patent 7,629,634 B2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER L. OGDEN,
and MARY C. HOFFMAN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

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

I. INTRODUCTION

This Order addresses Petitioner’s Motion to Submit Supplemental Information (Paper 15, “Motion” or “Mot.”) and Patent Owner’s Opposition (Paper 16, “Opp.”). We authorized these papers on June 24, 2024. Ex. 3003, 1.

Petitioner requests to file Exhibit 1018 as supplemental information relevant to the accuracy of a translation of a prior art reference submitted with the Petition. Mot. 5–6. Exhibit 1018 is a declaration by the person who translated Exhibit 1005 (Hirler¹) into the English translation filed as Exhibit 1006. *Id.*

For reasons that follow, we grant the Motion and authorize Petitioner to file Exhibit 1018 as supplemental information.

II. ANALYSIS

Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if the following requirements are met: (1) a request for authorization to file such motion must be made within one month of the date the trial was instituted; and (2) the supplemental information must be relevant to a claim for which trial has been instituted. In addition, we consider the Motion in light of our mandate “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

a. Timing

Petitioner satisfies the first requirement of Rule 42.123(a), which pertains to timing. Petitioner sought authorization to file the Motion on June 21, 2024, within one month of the date of institution on May 21, 2024. Ex. 3003, 1–2; Paper 13.

¹ Pub. No. DE 102004009083, published Sept. 22, 2005 (Ex. 1006) (certified translation, with no figures) and (Ex. 1005) (original version, with figures).

Patent Owner argues that the Board, nonetheless, should deny the Motion because Exhibit 1018 was available at the time of filing of the Petition and Petitioner fails to adequately explain why it waited to seek submission of Exhibit 1018 until “only a few days before the statutory deadline” established by Rule 42.123(a). Opp. 6–8. In Patent Owner’s view, Exhibit 1018 “would improperly refine or bolster Petitioner’s position as to arguments that could have been, and should have been, fully supported in the Petition,” and analogizes the instant situation to the facts at issue in the Board’s non-precedential decision in *Nokia of America Corp. v. General Access Solutions, Ltd.*, IPR2023-01416, Paper 18 (PTAB June 25, 2024) (“*Nokia*”). Opp. 5.

We disagree with Patent Owner that the facts in *Nokia* are analogous to those presented in this case. In *Nokia*, the Board denied a motion to submit supplemental information, relating to the public accessibility of a reference, because the petition failed to address conspicuous inconsistencies regarding the reference’s publication date. The Board stated, in determining that the petitioner in *Nokia* was attempting to improperly bolster the petition, “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.” *Nokia* 8–9.

The facts here, by contrast, do not involve inconsistent publication dates or a failure to meet the threshold showing. It does not appear that Petitioner seeks to change its merits case or evidence. Rather, Petitioner fairly seeks to supplement the record “to provide an adequate and rule-compliant affidavit of translation” in response to issues raised by Patent Owner. Paper 14, 1.

Patent Owner also argues that Petitioner fails to explain why Exhibit 1018 was not filed earlier. Opp. 2. On that point, however,

Rule 42.123(a) includes no requirement that a petitioner explain why information of the type proffered was not provided at the time of filing of its petition. Nor does Patent Owner persuade us that we should impose such a requirement under the particular facts presented on this record.

In that regard, Patent Owner argues that, like in *Nokia* and other similar cases, Petitioner “adopted the forbidden ‘wait-and-see’ approach” without adequate explanation. As discussed above, however, the instant situation is distinguishable from *Nokia*. In our view, the facts here align more closely with those presented in the *Palo Alto Network* case, cited by Petitioner, in which the Board granted a motion to file supplemental information relating to the public accessibility of a prior art reference, notwithstanding the patent owner’s argument that the “[p]etitioner did not attempt to explain why it did not submit this information with the [p]etition.” *Palo Alto Network, Inc. v Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3–4 (PTAB Feb. 4, 2014); see Mot. 4 (relying on the *Palo Alto Network* case).

Patent Owner argues that the instant case is readily distinguishable from *Palo Alto Network*, “because, in that case, there was ‘no indication . . . that the supplemental information . . . was withheld intentionally.’” Opp. 8. Similarly, however, Patent Owner has not shown on this record that Petitioner intentionally withheld Exhibit 1018, and we will not infer an improper intention to withhold, particularly where the Motion was timely filed at the beginning of the trial phase of this proceeding.

b. Relevancy

Petitioner also satisfies the second requirement, pertaining to relevancy. Hirler is asserted in two of the four grounds of unpatentability set forth in the Petition. Pet. 4. We agree with Petitioner that the declaration of the person who

translated Exhibit 1005 (Hirler) into the English translation (Exhibit 1006) is relevant to a claim at issue in the trial. Mot. 5–6.

On this point, Patent Owner argues that “Petitioner fails to explain how” Exhibit 1018 “is relevant to any accuracy issues beyond admissibility.” Opp. 4. “As such,” Patent Owner continues, Exhibit 1018 “should not be admitted as supplemental information rather than supplemental evidence in this case.” *Id.* We are not persuaded by this argument. Patent Owner identifies no rule that prohibits a party from submitting supplemental information in response to objections, provided that the supplemental information meets the timing and relevancy requirements set forth in Rule 42.123(a).

In a nutshell, we agree with Petitioner that the Board may treat declaration evidence, directed to the accuracy of a translation of a prior art reference that serves as the basis for one or more grounds of unpatentability, as supplemental evidence. Mot. 4 (citing *Mom Enterprises, LLC v. Elaine and Reinhold W. Vieth*, IPR2023-00726, Paper 35 at 2–4 (PTAB Nov. 17, 2023)).²

c. Just, Speedy, and Inexpensive Resolution

We next turn to whether granting the Motion serves our mandate “to secure the just, speedy, and inexpensive resolution of” this proceeding. 37 C.F.R. § 42.1(b). Petitioner submits that the submission of Exhibit 1018 would not interfere with this mandate and, to the contrary, “would permit early

² Patent Owner counterargues that “*Mom Enterprises* is distinguishable because, in that case, the underlying accuracy of the translation was substantively at issue from the preliminary response.” Opp. 4 (citing *Mom Enterprises*, Paper 35 at 2). We disagree with Patent Owner’s characterization. Similar to the petitioner in *Mom Enterprises*, Petitioner argues that Patent Owner challenges “the accuracy of Petitioner’s English translation of Hirler.” Mot. 2 (citing Paper 14 (Patent Owner’s Objections to Evidence Submitted Prior to Institution (objections going to “the accuracy of the translation”))).

consideration” of the issues surrounding the evidence “and either obviate the need for, or allow more efficient, briefing on the issue of the accuracy of the translation.” Mot. 7. Patent Owner, for its part, counterargues that granting the motion would prejudice Patent Owner, “requiring Patent Owner to substantively respond to the proposed supplemental information in Patent Owner’s Response” when the supplemental information was received “less than two months before the deadline for Patent Owner’s Response.” Opp. 8.

We do not agree that Patent Owner would be unfairly prejudiced by our grant of the Motion in this case. Given that Patent Owner already has possession of the supplemental information, there is little, if any, prejudice to Patent Owner if the information is allowed into the record. Patent Owner does not explain why granting the relief requested would deny Patent Owner sufficient time to address the supplemental information before filing its Patent Owner Response by August 12, 2024. Moreover, Patent Owner has not established that Petitioner seeks to use Exhibit 1018 for anything other than to overcome the objections advanced by Patent Owner in Paper 14.

For these reasons, we determine that securing “the just, speedy, and inexpensive resolution of the” proceeding favors allowing the submission earlier, rather than later, and promotes the fair and efficient development of a robust and accurate record. 37 C.F.R. § 42.1(b).

III. ORDER

It is
ORDERED that Petitioner's Motion to Submit Supplemental
Information (Paper 15) is granted; and
FURTHER entered that Exhibit 1018 is entered into the record of this
proceeding.

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