

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

Inter Partes Review No. IPR2024-00094
U.S. Patent No. 7,812,409

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO SUBMIT SUPPLEMENTAL INFORMATION**

TABLE OF CONTENTS

I. INTRODUCTION 1

II. ARGUMENT.....2

 A. The Exhibits Petitioner Seeks to Introduce Should Be
 Supplemental Evidence Rather Than Supplemental Information.....2

 B. If Considered as Supplemental Information, Petitioner’s
 Submissions Would Improperly Refine or Bolster the Petition.....4

 C. Petitioner’s Submissions Were Available to Petitioner when the
 Petition Was Filed, and Petitioner Provides No Explanation Why
 the Submissions Were Not Provided with the Petition 6

 D. Granting Petitioner’s Motion Would Prejudice Patent Owner 7

III. CONCLUSION 9

Certificate of Service 37 C.F.R. § 42.6(e) 10

I. INTRODUCTION

The Board should deny Petitioner's Motion to Submit Supplemental Information (Paper 12) ("Motion" or "Mot.") for multiple reasons. Petitioner's Motion requests permission to file as Supplemental Information exhibits that are relevant to the admissibility of other exhibits and is presented by Petitioner as being served in response to Patent Owner's Objections to Evidence Submitted Prior to Institution. (Paper 11, "Objections"). Because the proffered new exhibits are directed to objections, they should be supplemental evidence under 37 C.F.R. § 42.64(b)(2) rather than supplemental information under 37 C.F.R. § 42.123(a). One distinction between the two is that supplemental evidence is served under § 42.64(b)(2) and only considered by the Board later, if a dispute regarding admissibility remains, in the context of a motion to exclude. In contrast, supplemental information is filed and considered by the Board in determining whether to grant Petitioner's Motion, and may require discovery prior to Patent Owner's upcoming Response. Because motions to exclude are not necessarily ultimately filed, considering the proposed new exhibits to be supplemental evidence promotes judicial economy by delaying resolution of disputes that may not ultimately ripen into contested motions to exclude.

However, if the Board considers the proffered materials as supplemental information rather than supplemental evidence, these materials improperly refine

and bolster arguments that could have been, and should have been, fully supported in the original Petition. Petitioner's delay in submitting the information until after institution represents an impermissible "wait-and-see" approach that the Board has repeatedly admonished.

Moreover, the proffered materials represent materials that were available to Petitioner at the time that the Petition was filed. Petitioner, despite having the burden of establishing why submission of the information should be allowed, provides no explanation as to why Petitioner did not submit or could not have submitted the proffered materials earlier.

Finally, Petitioner delayed submitting the proffered materials until near the statutory deadline of § 42.123(a) without explaining why they were not submitted earlier. Providing two additional declarations and additional documentary materials, with less than two months until the due date for Patent Owner's response, prejudices Patent Owner's ability to receive full discovery relating to these materials prior to the deadline for Patent Owner's response.

II. ARGUMENT

A. The Exhibits Petitioner Seeks to Introduce Should Be Supplemental Evidence Rather Than Supplemental Information

In Petitioner's discussion of facts, Petitioner acknowledges that, on June 4, 2024, Patent Owner filed Objections to Evidence Submitted Prior to Institution.

(Motion at 3). In its Objections, for example, Patent Owner objected to Dr. Hall-Ellis’s original declaration (Ex. 1008) as not having “personal knowledge regarding the contents or alleged publication” of a Kikkawa article (Ex. 1007). (Paper 11 at 2). Patent Owner similarly objected to Dr. Hall-Ellis’s original declaration (Ex. 1008) regarding the Kikkawa article as well as a Kim article (Ex. 1012) as lacking foundation regarding “the purported date of publication of each and the alleged disclosures of each.” (Paper 11 at 3).

The Board has explained the distinction between Supplemental Information and Supplemental Evidence. Specifically, the Board instructs that:

[S]upplemental *evidence*—served in response to an evidentiary objection and filed in response to a motion to exclude—is offered solely to support admissibility of the originally filed evidence and to defeat a motion to exclude that evidence, and not to support any argument on the merits (i.e., regarding the patentability or unpatentability of a claim). Supplemental *information*, on the other hand, is evidence a party intends to support an argument on the merits.

Handi Quilter, Inc. v. Bernina Int’l AG, IPR2023-00364, Paper 30 at 2-3 (PTAB June 12, 2024) (emphasis original). The Board has further explained that “supplemental information ... is information that Petitioner intends to rely upon as part of its case-in-chief to support an argument on the merits” and that “a motion to file supplemental information would need to explain why the information was not

included with the Petition.” *Generico LLC v. Dr. Falk Pharma GmbH*, IPR2016-00297, Paper 15 at 3 (PTAB July 15, 2016).

The proffered materials are directed to admissibility of other exhibits. Proposed Exhibit 1020 is a declaration from Petitioner’s expert Dr. Hall-Ellis which Petitioner argues supports public availability and accessibility of Kikkawa (Exhibit 1007) and Kim (Exhibit 1012). (Motion at 1). In the declaration, Dr. Hall-Ellis asserts that her Supplemental Declaration allegedly responds to Patent Owner’s Objections. (Proposed Exhibit 1020 at 1). Proposed Exhibit 1023 is a declaration from Petitioner’s technical expert Dr. Liu, in which Dr. Liu asserts that he responds to Patent Owner’s Objections. (Proposed Exhibit 1023 at 1). However, because these submissions are allegedly in response to objections, they should be only directed to admissibility and are therefore supplemental evidence under 37 C.F.R. § 42.64(b)(2) rather than supplemental information under 37 C.F.R. § 42.123(a).

B. If Considered as Supplemental Information, Petitioner’s Submissions Would Improperly Refine or Bolster the Petition

To the extent that the Board considers allowing Petitioner to file the proffered materials as supplemental information as opposed to serving the materials as supplemental evidence, the materials are necessarily being offered in order to improperly refine and bolster Petitioner’s position as to arguments that could have been, and should have been, fully supported in Petition. The Board has explicitly

recognized “that [s]upplemental information, under 37 C.F.R. § 42.123, 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.” *Hunter’s Manufacturing Co., Inc. v. Ravin Crossbows, LLC*, IPR2023-00407, Paper 32 at 5-6 (PTAB Feb. 15, 2024) (internal quotation marks omitted); *see also Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 21 at 3 (PTAB Sept. 10, 2018) (“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”); *Pacific Mkt. Int’l, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 3 (PTAB Dec. 2, 2014) (“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.”). Allowing submission of Petitioner’s proposed supplemental information related to public availability would impermissibly bolster arguments that could have been, and should have been, fully explained in the Petition.

In a recent analogous case, the Board denied a motion to submit supplemental information relating to the public availability of a draft standard. *See Nokia of America Corp. v. General Access Solutions, Ltd.*, IPR2023-01416, Paper 18 at 2-4

(PTAB June 25, 2024). The Board held that the issue of public availability “was ripe at the time of the filing of the Petition.” *Id.* at 7. The Board further stated that “Petitioner now seeks to file declarations from [] 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.” *Id.* at 9. For the same reasons as in *Nokia*, the Board should deny Petitioner’s Motion here.

C. Petitioner’s Submissions Were Available to Petitioner when the Petition Was Filed, and Petitioner Provides No Explanation Why the Submissions Were Not Provided with the Petition

Petitioner offers no explanation providing any argument or explanation showing why it was unable to submit the proffered Information with the Petition. Indeed, such an attempt would be futile. The supplemental Hall-Ellis and Liu declarations are from Petitioner’s experts, both of whom previously submitted declarations with the Petition. (See Exs. 1003 & 1008). Further, proffered exhibits 1021 and 1022 appear to be documents relating to a symposium which Petitioner’s expert asserts is related to the Kim (Ex. 1003) reference. (Proffered Ex. 1020 at ¶39). As such, it appears that all of the proffered materials were available to Petitioner at the time that the Petition was filed.

Petitioner adopted the forbidden “wait-and-see” approach admonished by the Board. Recently, in a similar case involving supplemental declarations submitted after institution, the Board stated that it “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.” *Nokia*, IPR2023-01416, Paper 18 at 6 (*see also id.* at 9, finding that Petitioner “does not explain adequately why it did not, at the time of the Petition, come forward with the supplemental information”). In the present case, Petitioner’s Motion provides no explanation at all as to why Petitioner did not come forward with the supplemental information at the time of the Petition.

D. Granting Petitioner’s Motion Would Prejudice Patent Owner

Petitioner’s Motion fails to establish good cause as to why Petitioner should be allowed to submit the new proposed exhibits as supplemental information. Petitioner relies upon the fact that Petitioner requested authorization to file the Motion on June 21, 2024, the one month deadline recited in 37 C.F.R. § 42.123(a). (Motion at 4). However, only addressing the one month deadline for submitting supplemental information is insufficient because § 42.123(a) “does not provide that we must grant the motion so long as it is timely and relevant.” *Triller, Inc. v. TikTok Pte. Ltd.*, IPR2022-00180, Paper 18, 2 (PTAB Aug. 25 2022). This does not mean the Board “must grant the motion.” *Id.* at 3. “Petitioner bears the burden[] of

establishing why we should allow the submission of such evidence now.” *Id.* In the present case, Patent Owner first received the proffered materials on June 18, 2024, less than two months before the deadline for Patent Owner’s Response to the Petition due August 12, 2024. (Paper 10 at 11). Petitioner’s unexplained delay in submitting information available to Petitioner months ago, at the filing of the Petition, does not justify requiring Patent Owner to substantively respond to the proposed supplemental information in Patent Owner’s response, particularly where Petitioner does not fully explain how it intends to utilize the proffered materials.

Petitioner cites a prior decision in which the Board allowed supplemental information related to public accessibility. (Motion at 6) (citing *Palo Alto Network, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 2-3 (PTAB Feb. 5, 2014)). However, that case is readily distinguishable because, in that case, there was “no indication ... that the supplemental information ... was withheld intentionally. *Palo Alto Network* at 4. Here, in contrast, Petitioner seeks to introduce new declarations from experts which provided declarations supporting the original Petition, and relies on information that appears to have been available at the time of the filing of the Petition. The lack of any explanation from Petitioner regarding why this information was not submitted earlier, and indeed only a few days before the statutory deadline of § 42.123(a), readily distinguishes the present case.

III. CONCLUSION

For the reasons set forth herein, the Board should deny Petitioner's Motion.

Date: July 8, 2024

Respectfully submitted,

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Certificate of Service 37 C.F.R. § 42.6(e)

The undersigned certifies that on July 8, 2024, I will cause a true and correct copy of the foregoing Patent Owner's Opposition to Petitioner's Motion to Submit Supplemental Information to be served electronically upon the following attorneys who have consented to service via email.

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