

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.

IPR2024-00094
Patent 7,812,409 B2

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

HOFFMAN, *Administrative Patent Judge*.

ORDER

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

I. INTRODUCTION

On May 21, 2024, trial was instituted in IPR2024-00094. Paper 9. We subsequently authorized Inergy Technology, Inc. (“Petitioner”) to file a Motion to Submit Supplemental Information (Paper 12, “Motion” or “Mot.”) and Force Mos Technology Co., Ltd. (“Patent Owner”) to file an Opposition (Paper 13, “Opp.”). Ex. 3003, 1.

Petitioner seeks to submit Exhibits 1020–1023. Mot. 1. Exhibits 1020 and 1023 are supplemental declarations of Dr. Sylvia Hall-Ellis and Dr. David Kuan-Yu Liu providing testimony “regarding the public availability and accessibility of Kikkawa (Exhibit 1007) and Kim (Exhibit 2012).” *Id.* Exhibit 1021 is an IEEE *Xplore* result and Exhibit 1022 is a symposium schedule and table of contents. *Id.* at ii. Exhibits 1021 and 1022 “support[] the testimony of Exhibit 1020 regarding the public availability and accessibility of Kim.” *Id.* at 1.

Upon consideration of the parties’ positions, and for the reasons stated below, the Motion is granted.

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 to these requirements, the Board considers the motion in light of its mandate under 37 C.F.R. § 42.1(b), i.e., “to secure the just, speedy, and inexpensive resolution of every proceeding.”

With respect to the first requirement of § 42.123(a), Petitioner requested authorization to file a motion to submit supplemental information on June 21, 2024, which was within one month of the institution date on May 21, 2024. Ex. 3003, 1–2; Paper 9.

With respect to the second requirement, Petitioner asserts that the proffered supplemental information would not change the grounds of unpatentability in the Petition. Mot. 7. Petitioner further asserts that the proffered supplemental information relates to the public accessibility of the Kikkawa and Kim prior art references and the reliability of Dr. Halls-Ellis’ declaration. *Id.* Petitioner explains that 1) Kikkawa “is a primary reference submitted by Petitioner with respect to Grounds 2 and 5 and claims 2, 5, and 6,” and that 2) Kim “is referenced in the Declaration of Dr. Liu (Exhibit 1003) to support that the ’409 Patent, Kobayashi, and Hshieh are all directed to solutions to similar problems with semiconductor devices with respect to Ground 4 and claims 1 and 2–5.” *Id.* at 1. Because Kikkawa and Kim serve as the basis of and support grounds of unpatentability in the Petition, we are persuaded, and Patent Owner does not dispute, that the proffered supplemental information relating to the alleged public accessibility of these references is relevant to instituted claims of the ’409 patent. *See Palo Alto Network, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 (PTAB Feb. 5, 2014) (“*Palo Alto Network*”) (granting a motion to submit supplemental information supporting the public accessibility of prior art references cited in the Petition).

Accordingly, Petitioner has met the two requirements listed in § 42.123(a) for filing a motion to submit supplemental information. Petitioner also asserts that the motion does not “interfere with the just, speedy, and

inexpensive resolution of this proceeding” because accepting the documents into the record now would “permit early consideration.” Opp. 7–8.

Patent Owner makes several arguments in opposing Petitioner’s motion, which we briefly discuss below.

First, Patent Owner argues that “because these submissions are allegedly in response to objections, they should only be directed to admissibility and are therefore supplemental evidence . . . rather than supplemental information.” Opp. 4. We are not persuaded by this argument. Patent Owner points to nothing in our Rules that prohibits a party from submitting supplemental information in response to objections, provided that the supplemental information meets the requirements set forth above.

Patent Owner also argues that the documents “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 with 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 *Nokia* is analogous to this case. In *Nokia*, the Board denied the petitioner’s 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 determined that the petitioner was attempting to improperly bolster the petition, and stated, “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. We find the facts here, which do not involve inconsistent publication dates or a failure to meet the

threshold showing, support Petitioner’s position. It does not appear that Petitioner seeks to change its merits case or evidence. Rather, Petitioner seeks to supplement the record on the public accessibility issue.

Patent Owner also argues that Petitioner failed to explain why the proffered supplemental information was not provided in the Petition when such information was available when the Petition was filed. Opp. 6. Patent Owner argues that, like in *Nokia* and other similar cases, Petitioner “adopted the forbidden ‘wait-and-see’ approach admonished by the Board” and failed to provide an adequate explanation for doing so. As discussed above, the instant situation is distinguishable from *Nokia*. Here, the facts align more closely with the *Palo Alto Network* case, in which the Board granted the petitioner’s motion for supplemental information relating to the public accessibility of a reference despite 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* at 4. We further note that § 42.123(a) does not articulate any requirement for a petitioner to explain why information was not provided at the time of its petition.

Patent Owner, however, asserts that this 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. We are not persuaded that Petitioner intentionally withheld its information, particularly when Petitioner’s motion was timely filed at the beginning of the trial phase of this proceeding and Patent Owner does not show that Petitioner’s delay was intentional.

Lastly, Patent Owner argues 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 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 will have sufficient time to address the supplemental information before filing its Patent Owner Response by August 12, 2024. Moreover, Patent Owner has not identified any indication that Petitioner seeks to use the proffered evidence for anything other than the limited purpose of supplementing the record with respect to the public accessibility of references and the reliability of the Dr. Halls-Ellis declaration.

In summary, Patent Owner does not identify any credible reason why the submission of Petitioner’s information in this proceeding would limit “the just, speedy, and inexpensive resolution” of this proceeding. 37 C.F.R. § 42.1(b). Because Petitioner has met its burden of proving it is entitled to the requested relief under § 42.123(a), Petitioner’s motion to submit supplemental information is granted.

Finally, we note that our decision does not reach the question of whether the proposed supplemental information is admissible. To the extent there are any challenges to admissibility, such challenges may be raised under 37 C.F.R. § 42.64.

III. ORDER

In consideration of the foregoing, it is hereby
ORDERED that Petitioner's Motion to Submit Supplemental
Information (Paper 12) is granted; and
FURTHER entered that Exhibits 1020–1023 are entered into the record
of this proceeding.

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