

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC.

Petitioner

v.

BELL SEMICONDUCTOR, LLC

Patent Owner

Case No.: IPR2024-00168

Patent No. 7,345,245

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

Petitioner NXP USA, INC. (“Petitioner”) respectfully moves to submit Exhibits 1021-1023 as supplemental information under 37 C.F.R. § 42.123(a). As shown in Exhibit 1020, the Board granted Petitioner’s timely request for permission to file this motion pursuant to §42.123(a)(1). The proposed supplemental information relates to the “prior art status” of exhibits relevant to claims for which trial has been instituted, thus meeting the requirements of §42.123(a)(2). All supplemental information Petitioner seeks to submit, has previously been served on Patent Owner in response to their evidentiary objections (*See* paper 12), on May 22, 2024.

II. ARGUMENT

A. LEGAL STANDARD

A party may submit supplemental information under 37 C.F.R. § 42.123(a) 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) the “supplemental information [is] relevant to a claim for which the trial has been instituted.”

Under § 42.123(a) the Board has considered whether the information changes “the grounds of unpatentability authorized in this proceeding” or “the evidence

initially presented in the Petition to support those grounds of unpatentability.” *Palo Alto Networks, Inc. v. Juniper Network, Inc.*, Case IPR2013-00369, (PTAB Feb. 5, 2014) (Paper 37 at 3); see also *Biomarin Pharma. Inc., v. Genzyme Therapeutic Prods Limited Partnership*, Case IPR2013-00534, (PTAB Jan. 7, 2015) (Paper 80 at 5) (considering the same factors under § 42.123(b)). The Board has also considered whether granting the motion would prevent the just, speedy, and inexpensive resolution of the proceeding, *Palo Alto Networks*, Case IPR2013-00369, Paper 37 at 4, or would prejudice the other party. *Unified Patents Inc., v. Dragon Intellectual Property, LLC*, Case IPR 2014-01252, (PTAB Apr. 14, 2015) (Paper 43 at 3).

In *Palo Alto Networks*, Case IPR2013-00369, Paper 37 at 5, the Board granted Petitioner’s motion to submit supplemental information which already had been served on Patent Owner as supplemental evidence, stating, “[g]iven 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”.

Where a party has sought to submit information that confirms the public accessibility of a prior art reference at issue in the trial, the Board has repeatedly found such evidence to be proper supplemental information. *See, e.g., Biomarin*,

Case IPR2013-00534, (PTAB Jan. 7 2015) (Paper 80 at 5) (granting motion under stricter standard of § 42.123(b)); *Valeo North Am., Inc. v. Magna Elecs, Inc.*, Case IPR2014-01204, (PTAB Apr. 10, 2015) (Paper 26 at 2-5); *Palo Alto Networks*, Case IPR2013-00369, Paper 37 at 2-5; *Motorola Sol'ns, Inc. v. Mobile Scanning Techs, LLC*, Case IPR2013-00093, (PTAB July 16, 2013) (Paper 39 at 2). As the Board has recognized, "...a trial is, first and foremost, a search for the truth." *Edmund Optics, Inc., v. Semrock, Inc.*, Case IPR2014-00599, (PTAB May 5, 2015) (Paper 44 at 4) (granting motion to submit supplemental information) (citing *TechSearch LLC v. Intel Corp.*, 286 F. 3d 1360, 1378 (Fed. Cir. 2002)).

**B. EX. 1021 IS RELEVANT AS REQUIRED BY § 42.123(A)
BECAUSE IT SUPPORTS THAT EX. 1008, EX. 1010, EX.
1011, EX. 1016, AND EX. 1017, ARE PRIOR ART**

Ex. 1021 is the Declaration of June Munford, dated June 5, 2024, supporting the authenticity and public availability of Exhibits 1008, 1010, 1011, 1016, and 1017. Ex. 1021 is relevant because it is evidence of the publication and public availability of Exhibits 1008, 1010, 1011, 1016, and 1017 prior to October 8, 2003, the filing date of Patent 7,345,245 ("the '245 Patent"), challenged in this case.

**C. EX. 1022 IS RELEVANT AS REQUIRED BY § 42.123(A)
BECAUSE IT SUPPORTS THAT EX. 1008 IS PRIOR ART**

Ex. 1022 is the 2nd Declaration of Dr. Jacob Baker, P.E., Ph.D., supporting the authenticity and public availability of Celeron (Ex. 1008). Ex. 1022 is relevant because it is evidence of the publication and public availability of Exhibit 1008, prior to October 8, 2003, the filing date of Patent 7,345,245 (“the ’245 Patent”), challenged in this case.

**D. EX. 1023 IS RELEVANT AS REQUIRED BY § 42.123(A)
BECAUSE IT SUPPORTS THAT EX. 1008 IS PRIOR ART**

Ex. 1023 is the Declaration of Elizabeth Jones, the Corporate Historian and Museum Curator at Intel Corporation, supporting the authenticity and public availability of Celeron (Ex. 1008). Ex. 1023 is relevant because as shown in Appendix A of Ex. 1023, the content of Appendix A is substantially identical to Ex. 1008, with the only known difference being metadata of Appendix A last being modified in March of 2003. Thus, Ex. 1023 is evidence of the publication and public availability of the content of Exhibit 1008, prior to October 8, 2003, the filing date of Patent 7,345,245 (“the ’245 Patent”), challenged in this case.

**E. ADDITIONAL FACTORS IN CONSIDERING
SUPPLEMENTAL INFORMATION**

The supplemental information provided by Petitioner satisfies other factors the Board has considered when evaluating motions to submit supplemental information. Submission of this supplemental information is consistent with the PTAB's statutory mandate for the just, speedy and inexpensive resolution of proceedings pursuant to 37 C.F.R. §42.1(b). Petitioner's exhibits provide additional evidence that the prior art for each of the instituted grounds are indeed prior art, and do not change "the grounds of unpatentability authorized in this proceeding" or "the evidence initially presented in the Petition to support those grounds of unpatentability." *See, e.g., Palo Alto Networks*, Case IPR2013-00369, Paper 37 at 3.

Petitioner seeks to submit supplemental information at this time in response to Patent Owner's Objections to Petitioner's pre-institution evidence (See Paper 12). Petitioner's supplemental information will not prejudice Patent Owner or delay the proceedings because Petitioner has previously served all of the supplemental information it seeks to submit on Patent Owner in response to Patent Owner's Objections. (*See Palo Alto Networks*, Paper 37 at 5)

III. CONCLUSION

Petitioner seeks to submit Exhibits 1021-1023 as supplemental information, in compliance with the requirements of 37 C.F.R. § 42.123(a). This evidence is consistent with the PTAB's statutory mandates and will not cause delay or prejudice. Petitioner respectfully requests permission to file Exhibits 1021-1023 as supplemental information.

Respectfully Submitted,

Dated: June 25, 2024

By: /Timothy D. Taylor/

Timothy D. Taylor (Reg. No. 76,643)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on June 25, 2024, the foregoing document was served via electronic service on the counsel of record for Patent Owner Bell Semiconductor, LLC; Bell-NXP-IPR@devlinlawfirm.com.

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