

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

WILLOW LABORATORIES, INC.,  
Patent Owner.

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IPR2024-00296  
Patent 10,984,911 B2

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Before RICHARD H. MARSCHALL, DAVID COTTA, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

ORDER  
Granting Patent Owner's Motion to File Supplemental Information in  
Support of its Sur-reply  
*37 C.F.R. § 42.123*

With our authorization (Ex. 3001), Patent Owner filed a Motion to File Supplemental Information in Support of its Sur-reply (Paper 19, “Mot.”). According to Patent Owner, in Petitioner’s Reply, Petitioner relied on Kimura (Ex. 1081) and excerpts of the rebuttal report of Patent Owner’s expert from co-pending litigation (Ex. 1082) in support of arguments addressing the claim limitations reciting an “opening”/“window” with a smaller area than the detection surface area. Mot. 1. Patent Owner now moves to submit as supplemental information pages of the same rebuttal report (Ex. 2082) which address Kimura and these claim limitations. *Id.* Also pursuant to our authorization, Petitioner filed an Opposition (Paper 20, “Opp.”).

A party seeking to submit supplemental information more than one month after the date the trial is instituted must show “why the supplemental information reasonably could not have been obtained earlier” and “that consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b). With the respect to the requirement to show why the supplemental information reasonably could not have been obtained earlier, Patent Owner argues Petitioner first raised its arguments based on Kimura and the rebuttal report in Petitioner’s Reply such that the sur-reply is Patent Owner’s first opportunity to respond to those arguments. Mot. 1. Petitioner argues Patent Owner knew of the rebuttal report since December 15, 2023, and could have submitted the report earlier. Opp. 1. Even if Patent Owner knew of the rebuttal report prior to Petitioner filing its Reply, the arguments based on rebuttal report and Kimura were not presented in this case until Petitioner’s Reply. Thus, we are persuaded that the rebuttal report reasonably could not have been

obtained earlier for purposes of filing supplemental information pursuant to 37 C.F.R. § 42.123(b).

Turning to the requirement to show that consideration of the supplemental information would be in the interests-of-justice, Patent Owner argues that the pages of the rebuttal report allow Patent Owner to respond to Petitioner’s argument that Kimura would have motivated a person of ordinary skill in the art to make an “opening”/“window” with an area smaller than the detection surface area, as recited in the claims. Mot. 1. Petitioner argues the pages of the rebuttal report are not relevant to this argument. Opp. 1. Although the parties dispute the relevance of the pages of the rebuttal report, there is no dispute that Petitioner relies on Kimura and the rebuttal report in its Reply. Patent Owner’s use of the rebuttal report is responsive, in a broad sense at least, to Petitioner’s arguments relying on that evidence. Accordingly, we are persuaded that consideration of the pages of the rebuttal report would be in the interests-of-justice.

In view of the foregoing, Patent Owner has persuaded us that it is entitled to file pages of the rebuttal report as supplemental information pursuant to 37 C.F.R. § 42.123(b). We, therefore, grant Patent Owner’s Motion.

It is hereby,

ORDERED that Patent Owner’s Motion to File Supplemental Information in Support of its Sur-reply is *granted*.

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