

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED*
Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Patent No. 7,373,449

Inter Partes Review No. IPR2024-00338

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

* Qualcomm Incorporated filed a petition and a motion for joinder in IPR2024-01081 and was joined as a petitioner in this proceeding.

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Regulations

37 C.F.R. § 42.123(a)	5, 6, 7
37 C.F.R. § 42.123(b)	6, 7

Patent Owner hereby submits its Opposition to Petitioner's Motion to Submit Supplemental Information (Paper 33).

I. FACTUAL BACKGROUND

Petitioner's supplemental evidence served on October 28, 2024 included a new expert declaration opining on whether "Networks on Chip" (Ex. 1014) was publicly accessible ("Hall-Ellis Declaration") and an attorney declaration ("Rypka Declaration"). Petitioner unilaterally proposed that Patent Owner depose its new expert on November 6, 2024. Ex. 1034 at 6. Patent Owner replied that because the Hall-Ellis Declaration was not part of the record, it would depose Dr. Hall-Ellis if and when "Petitioner chooses to submit the ... declaration as an exhibit with its Reply." *Id.* at 5 (citing *Fanduel, Inc. v. CG Tech. Dev. LLC*, IPR2017-00902, Paper 45 at 83 (PTAB Oct. 4, 2018) ("supplemental evidence is served ... but does not become part of the record"))).

In response, Petitioner took the position that Patent Owner could take Dr Hall-Ellis's deposition "during the Reply stage rather than at this stage" only if Patent Owner agreed "not object to the Hall-Ellis declaration as untimely or otherwise procedurally improper." Ex. 1034 at 2. On October 31, 2024 at approximately 9:00 PM ET, Petitioner informed Patent Owner that it intended to request authorization to submit the Hall-Ellis as supplemental information. *Id.* at 3. Petitioner did not afford Patent Owner an opportunity to respond prior to emailing the Board. Ex. 3005.

After the Board authorized the Motion, Petitioner again asked Patent Owner whether it was “declining to take the deposition of Ms. Hall-Ellis at this time.” *Id.* Patent Owner explained that there was no reason to take the deposition since the Board had not ruled on the motion. *Id.* (citing *Actifio, Inc. v. Delphix Corp.*, IPR2015-00014, Paper 40 at 2 (PTAB Dec. 1, 2015) (“Cross-examining a declarant on evidence that may never be filed potentially wastes resources and time. A party cannot rely on an unfiled declaration as evidence”)).

II. ARGUMENT

A. Petitioner’s Request is Not Timely Under 37 C.F.R. § 42.123(a)

37 C.F.R. § 42.123(a) allows parties to request authorization to submit supplemental information “within one month of the date the trial is instituted.” 37 C.F.R. § 42.123(a). The Board issued its institution decision in IPR2024-00338 (“the Samsung IPR”) on June 21, 2024. Petitioner requested authorization to file its Motion more than 4 months later.

Petitioner argues that the operative institution date for purposes of 37 C.F.R. § 42.123(a) is the institution date for IPR2024-01081 (“the Qualcomm IPR”), which was October 1, 2024. Paper 16.¹ However, since joinder, both parties have been operating under the schedule in the Samsung IPR. *Id.* at 50 (“the Scheduling Order

¹ Unless noted otherwise, citations to Papers herein refer to the Qualcomm IPR.

entered in IPR2024-00338 ... shall continue to govern”). The Board instructed that “all further filings shall be made in” the Samsung IPR. *Id.* at 51.

Petitioner cites no authority holding that the 1-month deadline in 37 C.F.R. § 42.123(a) resets after joinder. Petitioner’s supplemental information would be submitted in both IPRs, so the Samsung IPR institution date should govern. Petitioner’s admission that it “has now stepped into Samsung’s shoes” illustrates the point. Mot. at 8. Having now “stepped into Samsung’s shoes,” Petitioner should be bound by the same deadlines that would have applied to Samsung.

Under a typical IPR schedule, a request to submit supplemental information must be at least two months prior to the patent owner’s response. 37 C.F.R. § 42.123(a). This makes sense, as patent owners would be prejudiced if petitioners were allowed to freely introduce new substantive evidence—including new expert testimony—throughout the proceeding. The Board’s rules impose a higher burden more than one month after institution. 37 C.F.R. § 42.123(b). In this case, the timing of Petitioner’s request prejudices Patent Owner as this opposition is being filed just *one* business day prior to the Response. Thus, § 42.123(b) should apply.

Petitioner suggests that if 37 C.F.R. § 42.123(a) applies, then there is nothing else for the Board to decide. *See* Mot. at 4-6. But as the Board has previously recognized, “[n]othing in the rule suggests ... that such a motion would be granted no matter the circumstance.” *Redline Detection, LLC v. Star Envirotech, Inc.*,

IPR2013-00103, Paper 24 at 4 (PTAB Aug. 5, 2013) (denying motion to submit supplemental information). By the time the Board decides the Motion, Patent Owner will have already submitted its Response. Petitioner can simply submit the supplemental information as exhibits with its Reply. *Redline*, Paper 24 at 5 (explaining that the “the proper course is for the Patent Owner to file a Patent Owner Response, followed by the filing of a reply by the Petitioner”). Instructing Petitioner to file its supplemental information with its Reply, as the Board did in *Redline*, will be more efficient and avoid the need for the Board to decide whether 37 C.F.R. § 42.123(a) or (b) applies to these facts.

B. Petitioner’s Cannot Meet its Burden under 37 C.F.R. § 42.123(b)

“A party seeking to submit supplemental information more than one month after the date trial is instituted ... must show why the supplemental information [1] reasonably could not have been obtained earlier, and [2] that consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b). Petitioner has not shown that either requirement is met.

i. Petitioner Could Have Obtained the Supplemental Information Earlier

Petitioner claims that it “could not have reasonably obtained and submitted the supplemental evidence earlier” because it “was not joined to” the Samsung IPR until October 1, 2024. Mot. at 7. But Petitioner avoids the most important question: why could it not have obtained the supplemental information earlier and submitted

it with its petition? Petitioner admits that it submitted a “substantively identical” version of the Hall-Ellis declaration in IPR2024-00343 in December 2023. Mot. at 3. In other words, Petitioner *actually obtained* the Hall-Ellis Declaration *almost a year ago*. Despite having the benefit of reviewing the petition, preliminary response, preliminary reply, preliminary sur-reply, and institution decision in the Samsung IPR prior to filing its own Petition, Petitioner still chose not to seek to introduce the Hall-Ellis Declaration until just before Patent Owner’s Response deadline.

Petitioner did not submit the supplemental information earlier because it needed to represent that its Petition was substantively identical to the Samsung IPR for purposes of its joinder motion. Paper 3 at 1 (representing “[t]he Petition and supporting evidence ... is substantively identical to the petition and supporting evidence filed in the Samsung IPR”); Paper 10 (characterizing its petition as a “copycat Petition”). The fact that Petitioner needed to file a carbon copy of the Samsung IPR to achieve joinder does not excuse its decision not to submit its supplemental information earlier.

In an attempt portray diligence, Petitioner argues it acted in just ten business days after learning that Samsung did not submit supplemental evidence. Mot. at 2. That is irrelevant. Petitioner does not explain why it needed to know whether Samsung submitted supplemental *evidence* before it could obtain and submit its proposed supplemental *information*, which includes a new expert declaration

opining on public accessibility. The new opinions are not responsive to Patent Owner's evidence objections; rather, they are intended to shore up deficiencies in the Petition. *Handi Quilter, Inc. v. Bernina Int'l AG*, IPR2013-00364, Paper 30 at 2 (PTAB June 12, 2014) (explaining that supplemental evidence "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 arguments on the merits").

ii. Considering the Hall-Ellis Declaration is not in the Interests of Justice

Petitioner cites no authority holding that submitting a new expert declaration at this stage is in the interests of justice. *See* Mot. at 7-8. Petitioner actually obtained a substantively identical version of the Hall-Ellis Declaration almost a year ago but deliberately chose not to submit it with the Petition. *Redline Detection*, IPR2013-00106, Paper 24 at 4-5 (rejecting petitioner's attempt to submit expert declaration as supplemental evidence when it chose not to include it with its petition).

Petitioner previously represented that its Petition was "substantively identical to the petition and supporting evidence" in the Samsung IPR and that it was relying on "the same expert testimony." Paper 3 at 1. Petitioner also represented that joinder "will not add new issues to the Samsung IPR." *Id.* at 7. Nevertheless, Petitioner now seeks to introduce new expert testimony. Petitioner claims "[t]here is no risk that the supplemental information would create new issues or otherwise be inconsistent with the Petition." Mot. at 5. This is simply not true. On the issue of public accessibility,

the Petition merely incorporates by reference a declaration discussing a catalog date at one university. *See* Petition, 10 (citing Ex. 1027). By contrast, the Hall-Ellis Declaration purports offer expert opinions on public accessibility based on catalog dates in different libraries. Allowing Petitioner to introduce a new expert declaration to support a different public accessibility theory despite its prior representations to the Board is not in the interests of justice.

Petitioner argues that there is no prejudice because Patent Owner “was provided with the information ... well before its current ... response date, Qualcomm offered Dr. Hall-Ellis for a ... deposition, and Qualcomm has stated it is also willing to offer Dr. Hall-Ellis for deposition at a later time.” Mot. at 6. There are several problems with this assertion. First, Petitioner’s deposition offer is meaningless because the declaration is not in the record. *Actifio*, IPR2015-00014, Paper 40 at 2. Second, Petitioner fails to inform the Board it conditioned its agreement “to offer Dr. Hall-Ellis for deposition at a later time” on Patent Owner agreeing to “not to object to the Hall-Ellis Declaration as untimely or otherwise procedurally improper.” Ex. 1034 at 2. Patent Owner never agreed to this.

By filing this Motion rather than simply waiting for its Reply, it appears Petitioner’s strategy is to argue that Patent Owner was obligated to respond to the Hall-Ellis Declaration in its Response, even though it is not evidence. Patent Owner also understands Petitioner may argue that the Board’s rules and precedent limiting

the scope of a reply do not apply to the Hall-Ellis Declaration if it is submitted as supplemental information. The Board should not allow this tactical gamesmanship and instruct Petitioner to file its supplemental information with its Reply so that it can be addressed in the normal course of this proceeding.

iii. Considering the Rypka Declaration is not in the Interests of Justice

Petitioner's supplemental evidence included the transcript of the deposition of one of the '449 Patent inventors that was produced to Petitioner with a "Highly Confidential – Outside Attorneys' Eyes Only" designation under the district court protective order. Patent Owner's district court counsel has informed Petitioner that its use of this deposition transcript in this IPR violates the district court protective order, which prohibits use of protected materials in other proceedings. The Rypka Declaration Petitioner seeks to publicly file as supplemental information cites to and discusses the same highly confidential deposition transcript. Patent Owner believes that filing the Rypka Declaration in its current form may also violate the district court protective order and therefore opposes its submission on that basis as well.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully submits that Petitioner's Motion should be denied.

U.S. Patent No. 7,373,449

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Opposition to Petitioner's Motion to Submit Supplemental Information** was served on November 18, 2024, via email:

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