

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.  
and QUALCOMM INCORPORATED,  
Petitioner,<sup>1</sup>

v.

NETWORK SYSTEM TECHNOLOGIES, LLC,  
Patent Owner.

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IPR2024-00338  
Patent 7,373,449 B2

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Before CHARLES J. BOUDREAU, JOHN R. KENNY, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

ORDER  
Granting in Part Petitioner's  
Motion to Submit Supplemental Information  
*37 C.F.R. § 42.123(a)–(b)*

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<sup>1</sup> Qualcomm Incorporated filed a petition and a motion for joinder in IPR2024-01081 and has been joined as a petitioner in this proceeding. *See* Paper 16. After Qualcomm Incorporated was joined as a petitioner, Samsung Electronics Co., Ltd. was terminated as a petitioner. *See* Paper 17.

## I. INTRODUCTION

After receiving Board authorization, Qualcomm Incorporated (“Petitioner” or “Qualcomm”) moved for Board approval to submit supplemental information under 37 C.F.R. § 42.123(a)–(b). Paper 33 (“Mot.”); *see* Ex. 3005. Network System Technologies, LLC (“Patent Owner” or “NST”) opposes Qualcomm’s motion. Paper 34 (“Opp.”).

For the reasons explained below, we grant in part Qualcomm’s motion.

## II. BACKGROUND

On December 18, 2023, Samsung Electronics Co., Ltd. (“Samsung”) initiated this proceeding by filing Petition requesting an *inter partes* review of claims 1–6 and 9–16 in U.S. Patent No. 7,373,449 B2 (Exhibit 1001, “the ’449 patent”) under 35 U.S.C. §§ 311–319. *See* Paper 2 (“Pet.”). The Petition includes the following challenges to patentability:

| Claim(s) Challenged | 35 U.S.C. § | Reference(s)/Basis                            |
|---------------------|-------------|-----------------------------------------------|
| 1–6, 9–16           | 103(a)      | Goossens2002, <sup>2</sup> Drake <sup>3</sup> |
| 1–6, 9–16           | 103(a)      | Goossens2003, <sup>4</sup> Drake              |

Pet. 9, 15–68.

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<sup>2</sup> Kees Goossens et al., *Networks on Silicon: Combining Best-Effort and Guaranteed Services*, Proceedings of the 2002 Design, Automation and Test in Europe Conference and Exhibition, 1–3 (March 2002) (Exhibit 1005).

<sup>3</sup> U.S. Patent No. 5,461,611, titled “Quality of Service Management for Source Routing Multimedia Packet Networks,” filed on June 7, 1994, and issued on October 24, 1995, to John E. Drake, Jr. et al. (Exhibit 1006).

<sup>4</sup> Kees Goossens et al., *Guaranteeing the Quality of Services in Networks on Chip*, Chapter 4 in *Networks on Chip*, Kluwer Academic Publishers (Axel Jantsch & Hannu Tenhunen eds., 2003) (Exhibit 1007).

On March 28, 2024, Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). In the Preliminary Response, Patent Owner disputed that Goossens2002 and Goossens2003 qualify as prior art. *See id.* at 39–41.

On April 23, 2024, the Board authorized further briefing regarding whether Goossens2002 and Goossens2003 qualify as prior art. *See* Ex. 3001.

On April 30, 2024, Samsung filed a Preliminary Reply addressing whether Goossens2002 and Goossens2003 qualify as prior art. *See* Paper 8 (“Prelim. Reply”).

On May 7, 2024, Patent Owner filed a Preliminary Sur-reply addressing whether Goossens2002 and Goossens2003 qualify as prior art. *See* Paper 9 (“Prelim. Sur-reply”).

On June 21, 2024, the Board instituted an *inter partes* review of claims 1–6 and 9–16 in the ’449 patent on all challenges included in the Petition. *See* Paper 10 (“Inst. Dec.”). Among other things, based on testimonial and documentary evidence, the Board determined that Samsung established a reasonable likelihood that Goossens2002 and Goossens2003 are printed publications that were publicly accessible before the ’449 patent’s filing date. *Id.* at 28–30; *see* Pet. 8–9; Prelim. Reply 1–4; Ex. 1025 (MacPherson Declaration) ¶¶ 8, 11; Ex. 1026, 1; Ex. 1027 (O’Bryan Declaration) ¶¶ 5, 7; Ex. 1028, 4.

On June 21, 2024, after the Board instituted an *inter partes* review of claims 1–6 and 9–16 in the ’449 patent, Qualcomm filed the following papers in IPR2024-01081:

- (1) a petition challenging the same claims in the '449 patent on substantively identical grounds as those asserted by Samsung in the Petition; and
- (2) a motion for joinder seeking joinder as a party in this proceeding under 35 U.S.C. § 315(c).

*Qualcomm Incorporated v. Network System Technologies, LLC*, IPR2024-01081, Paper 1 (petition), Paper 3 (motion) (PTAB June 21, 2024).

On July 3, 2024, Patent Owner filed objections to evidence under 37 C.F.R. § 42.64(b)(1) and objected to twenty-three exhibits that Samsung filed with the Petition, including Exhibit 1005 (Goossens2002), Exhibit 1007 (Goossens2003, i.e., chapter 4 in the book *Networks on Chip*), and Exhibit 1014 (introductory material and chapters 1, 2, and 3 in the book *Networks on Chip*). *See* Paper 12. For Exhibit 1007 (Goossens2003), Patent Owner objected to the exhibit as “lacking authentication” and asserted that Samsung provided “no authenticating declaration explaining what Ex. 1007 is, how it was acquired, or how it was made.” *Id.* at 2.

On July 8, 2024, Samsung and Patent Owner filed a joint motion to terminate this proceeding based on a settlement between Samsung and Patent Owner. *See* Paper 13.

On October 1, 2024, the Board (1) instituted an *inter partes* review in IPR2024-01081, (2) granted Qualcomm’s motion for joinder in IPR2024-01081, (3) joined Qualcomm as a petitioner in this proceeding, and (4) ordered that “all further filings shall be made” in this proceeding. Paper 16, 50–51; IPR2024-01081, Paper 14 at 50–51.

On October 2, 2024, the Board granted in part the joint motion to terminate (Paper 13) and terminated Samsung as a petitioner in this proceeding. *See* Paper 17.

On October 16, 2024, Qualcomm asked Patent Owner to provide a copy of any supplemental evidence served by Samsung under 37 C.F.R. § 42.64(b)(2) to address Patent Owner's objections to evidence under 37 C.F.R. § 42.64(b)(1). Mot. 2. In response, Patent Owner informed Qualcomm that it had not received any supplemental evidence from Samsung. *Id.*

On October 28, 2024, Qualcomm served supplemental evidence under 37 C.F.R. § 42.64(b)(2) to address Patent Owner's objections to evidence under 37 C.F.R. § 42.64(b)(1). Ex. 1034, 6; *see* Mot. 2; Opp. 1. In particular, Qualcomm provided the following information to Patent Owner: (1) the Declaration of Dr. Sylvia Hall-Ellis and (2) the Attorney Declaration of Ryan D. Rypka and supporting exhibits. *See* Mot. 1–2; Opp. 1; Ex. 1034, 6.

On October 30, 2024, Qualcomm offered to make Dr. Hall-Ellis available for a deposition on November 6, 2024. Ex. 1034, 5–6.

Subsequently, on October 30, 2024, Patent Owner objected to Qualcomm's supplemental evidence as "not timely served." Ex. 1034, 4–5 (citing 37 C.F.R. § 42.64). Further, Patent Owner stated that to "the extent [Qualcomm] intended the Hall-Ellis declaration to be supplemental information, it is also untimely and [Qualcomm] did not comply with the Board's rules." *Id.* at 5 (citing 37 C.F.R. § 42.123). Regarding the deposition of Dr. Hall-Ellis, Patent Owner noted that if Qualcomm "chooses to submit the Hall-Ellis declaration as an exhibit with its Reply, then Patent Owner would take her deposition during that discovery period." *Id.* Patent Owner also noted that it "reserves all rights to object to the declaration and [Qualcomm's] reliance on it at that time." *Id.*

On October 31, 2024, Qualcomm’s counsel emailed the Board to request authorization to file a motion to submit the following supplemental information: (1) the Declaration of Dr. Sylvia Hall-Ellis and (2) the Attorney Declaration of Ryan D. Rypka and supporting exhibits, i.e., the information that Qualcomm served on Patent Owner as supplemental evidence on October 28, 2024. Ex. 3005, 1–2.

On November 1, 2024, the Board authorized Qualcomm to file a motion to submit supplemental information and authorized Patent Owner to file an opposition to Qualcomm’s motion. Ex. 3005, 1. The Board did not authorize Qualcomm to file a reply to Patent Owner’s opposition. *Id.*

On November 8, 2024, Qualcomm filed a motion to submit the supplemental information identified in the October 31, 2024, email to the Board. *See* Paper 33; Ex. 3005, 1–2.

On November 18, 2024, Patent Owner filed an opposition to Qualcomm’s motion to submit supplemental information. *See* Paper 34.

On November 19, 2024, Patent Owner filed a Response. *See* Paper 35 (“Resp.”). In the Response, Patent Owner disputes that Goossens2002 and Goossens2003 qualify as prior art. *See id.* at 64–68.

For instance, Patent Owner asserts that Qualcomm provides “no evidence that Goossens2003 was indexed, e.g., by subject matter, such that a skilled artisan would have been able to locate it in the relevant timeframe.” Resp. 67. Patent Owner makes that assertion even though the record includes a declaration from a librarian at the University of Texas Libraries who testified that the book *Networks on Chip* containing Goossens2003 as chapter 4 was “catalogued on April 16, 2003,” and that “the UT Libraries typically made newly catalogued items available to the public within 3

business days of cataloging,” i.e., several months before the ’449 patent’s October 7, 2003, filing date. Ex. 1027 (O’Bryan Declaration) ¶¶ 2, 5, 7; *see* Inst. Dec. 28–29; Ex. 1001, code (22).

### III. ANALYSIS

#### *A. Rule Regarding Supplemental Information*

Rule 42.123 addresses the filing of supplemental information. *See* 37 C.F.R. § 42.123 (2024). Subsections (a) and (b) read as follows:

(a) *Motion to submit supplemental information.*

Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(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.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

(b) *Late submission of supplemental information.*

A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information 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(a)–(b).

For subsection (a), satisfying the one-month requirement in subpart (a)(1) and the “relevant to a claim” requirement in subpart (a)(2) does not guarantee submission of supplemental information because the Board should also consider “the efficient administration of the Office” and “the ability of the Office to timely complete proceedings” when deciding a

motion. *See* 35 U.S.C. § 316(b) (2018); *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 443–45 (Fed. Cir. 2015).

*B. Burden of Proof*

Under the Board’s rules, the moving party “has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c).

*C. Submission Under 37 C.F.R. § 42.123(a)*

1. PETITIONER’S CONTENTIONS

Qualcomm contends that its motion satisfies the one-month requirement in 37 C.F.R. § 42.123(a)(1) because the Board instituted an *inter partes* review in IPR2024-01081 on October 1, 2024, and Qualcomm requested authorization to file a motion to submit supplemental information on October 31, 2024. Mot. 4.

Qualcomm contends that its motion satisfies the “relevant to a claim” requirement in 37 C.F.R. § 42.123(a)(2) because:

- (1) the Declaration of Dr. Sylvia Hall-Ellis addresses the authenticity and public accessibility of the book *Networks on Chip* containing Exhibit 1007 (Goossens2003 as chapter 4) and Exhibit 1014 (introductory material and chapters 1, 2, and 3); and
- (2) the Attorney Declaration of Ryan D. Rypka and supporting exhibits are “responsive to various exhibits that Patent Owner has objected to, including Goossens2003.”

Mot. 3–5; *see id.* at 7.

Further, Qualcomm explains that the Hall-Ellis declaration Qualcomm proposes to submit is “nearly substantively identical to the Hall-Ellis declaration regarding” the same book *Networks on Chip* filed in December 2023 in IPR2024-00343 challenging another of Patent Owner’s

patents. Mot. 3 (citing *Qualcomm Incorporated et al. v. Network System Technologies, LLC*, IPR2024-00343, Ex. 1014); *see id.* at 8; Ex. 1034, 1, 4. Qualcomm also explains that the parties in IPR2024-00343 “agreed on a deposition date for Dr. Hall-Ellis” and then “Patent Owner subsequently withdrew its deposition notice.” Mot. 3 n.2.

Further, Qualcomm asserts that the supplemental information “would not change the grounds of unpatentability or any of the evidence initially presented in the Petition to support those grounds of unpatentability” because “the supplemental information is limited to the issue of publication and authenticity of Goossens2003 and other exhibits.” Mot. 5; *see id.* at 8. According to Qualcomm, “[t]here is no risk that the supplemental information would create new issues or otherwise be inconsistent with the Petition.” *Id.* at 5.

Qualcomm also asserts that the supplemental information “would not interfere with the just, speedy, and inexpensive resolution of this proceeding, nor would it prejudice Patent Owner.” Mot. 6; *see id.* at 8. Qualcomm explains that (1) “Patent Owner was provided with the information on October 28,” (2) “Qualcomm offered Dr. Hall-Ellis for a November 6 deposition,” and (3) “Qualcomm has stated it is also willing to offer Dr. Hall-Ellis for deposition at a later time.” *Id.* at 6.

## 2. PATENT OWNER’S CONTENTIONS

Patent Owner contends that Qualcomm’s motion does not satisfy the one-month requirement in 37 C.F.R. § 42.123(a)(1) because the Board instituted an *inter partes* review in this proceeding on June 21, 2024, and

Qualcomm did not request authorization to file a motion to submit supplemental information in this proceeding until October 31, 2024, i.e., “more than 4 months” after institution in this proceeding. Opp. 2. Further, Patent Owner asserts that Qualcomm cites no authority for the proposition that the one-month requirement in 37 C.F.R. § 42.123(a)(1) “resets after joinder.” *Id.* at 3. According to Patent Owner, Qualcomm “can simply submit the supplemental information as exhibits with its Reply.” *Id.* at 4.

Patent Owner also contends that the timing of Qualcomm’s request “prejudices Patent Owner as this opposition is being filed just one business day prior to the Response.” Opp. 3 (emphasis omitted).

### 3. ANALYSIS

The Board’s rules regarding supplemental information (37 C.F.R. § 42.123) do not contemplate the unique circumstances here where the original petitioner settles shortly after institution of the *inter partes* review and a joined petitioner replaces the original petitioner after deadlines for the original petitioner to take various actions have passed.

That said, when joining Qualcomm as a petitioner in this proceeding the Board ordered that “all further filings shall be made” in this proceeding. Paper 16, 50–51; IPR2024-01081, Paper 14 at 50–51. Qualcomm’s motion does not satisfy the one-month requirement in 37 C.F.R. § 42.123(a)(1) because the Board instituted an *inter partes* review in this proceeding on June 21, 2024, and Qualcomm did not request authorization to file a motion to submit supplemental information in this proceeding until October 31, 2024. *See* Inst. Dec. 1; Ex. 3005, 1–2.

*D. Submission Under 37 C.F.R. § 42.123(b)*

1. PETITIONER’S CONTENTIONS

Qualcomm contends that the supplemental information could not reasonably have been obtained and submitted earlier because “Qualcomm was not joined to (and therefore was not part of and could not participate in)” this proceeding until October 1, 2024. Mot. 7. Qualcomm contends that it acted reasonably in obtaining the supplemental information and serving Patent Owner with the supplemental information on October 28, 2024, “which was within 10 business days of learning that Samsung did not serve any supplemental evidence.” *Id.*

Qualcomm contends that considering the supplemental information would be in the interests of justice because (1) the Hall-Ellis declaration “provides testimony regarding the publication and authenticity of Goossens2003,” i.e., the primary reference in the second of Qualcomm’s two patentability challenges, and (2) the Rypka declaration and supporting exhibits “confirm the authenticity of various documents Patent Owner objected to.” Mot. 7.

Further, Qualcomm asserts that “because of the timing of Samsung’s motion to terminate the proceeding (occurring only five days after Patent Owner filed its objections to evidence), it appears that Samsung did not serve any supplemental evidence in response to the objections.” Mot. 7. Qualcomm explains that “the particular circumstances of this case gave rise to a situation where” Samsung “moved to terminate and did not have incentive to respond to Patent Owner’s objections to evidence” while “Qualcomm had not yet been joined and therefore could not yet participate.” *Id.* at 7–8. Qualcomm then contends that it would be in the interests of

justice to provide Qualcomm “a fair opportunity to participate” in this proceeding and “allow the Board to consider a complete record” given “the particular circumstances of this case.” *Id.* at 8.

Qualcomm asserts that the supplemental information will not affect the “Board’s ability to conduct a just, speedy, and inexpensive resolution of this proceeding.” Mot. 8.

Qualcomm asserts that the supplemental information will not prejudice Patent Owner because:

- (1) Patent Owner has had the supplemental information since October 28, 2024;
- (2) the Hall-Ellis declaration Qualcomm proposes to submit is “nearly substantively identical to the Hall-Ellis declaration regarding” the same book, *Networks on Chip*, filed in December 2023 in IPR2024-00343;
- (3) Qualcomm “offered Patent Owner an opportunity to depose” Dr. Hall-Ellis; and
- (4) Qualcomm “remains willing to provide” Dr. Hall-Ellis for a deposition at a later date.

Mot. 8.

Additionally, Qualcomm contends that it would be in the interests of justice to have the Rypka declaration and supporting exhibits “remaining as only served (but not filed) supplemental evidence at this time, so long as it is not considered untimely served,” for the reasons that considering the Rypka declaration and supporting exhibits as supplemental information would be in the interests of justice. Mot. 6 n.3.

## 2. PATENT OWNER’S CONTENTIONS

Patent Owner contends that Qualcomm “does not explain why it needed to know whether Samsung submitted supplemental *evidence* before it could obtain and submit its proposed supplemental *information*.” Opp. 5.

Patent Owner acknowledges that Qualcomm “submitted a ‘substantively identical’ version of the Hall-Ellis declaration in IPR2024-00343 in December 2023.” Opp. 5. Patent Owner contends that Qualcomm “actually obtained” the Hall-Ellis declaration “almost a year ago” and “chose not to seek to introduce” the Hall-Ellis declaration until just before that due date for the Response, despite “having the benefit of reviewing the petition, preliminary response, preliminary reply, preliminary sur-reply, and institution decision” in this proceeding. *Id.* (emphases omitted). Patent Owner contends that considering the Hall-Ellis declaration would not be in the interests of justice because Qualcomm “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 in IPR2024-01081. *Id.* at 6.

Additionally, Patent Owner asserts that the Hall-Ellis declaration does not respond to Patent Owner’s objections to evidence and instead “shore[s] up deficiencies in the Petition.” Opp. 6.

Further, Patent Owner asserts that the Hall-Ellis declaration will add new issues to this proceeding because (1) the Petition references “a declaration discussing a catalog date at one university” and (2) the Hall-Ellis declaration “purports offer expert opinions on public accessibility based on catalog dates in different libraries.” Opp. 6–7. Patent Owner also asserts that Qualcomm’s motion for joinder in IPR2024-01081 stated that joinder

“will not add new issues” to this proceeding. *Id.* at 6. According to Patent Owner, allowing Qualcomm 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.” *Id.* at 7.

Patent Owner contends that considering the Rypka declaration and supporting exhibits would not be in the interests of justice because the supporting exhibits include the transcript of an inventor’s deposition subject to a protective order in a related civil action. Opp. 8. According to Patent Owner, its “district court counsel” informed Qualcomm that “use of this deposition transcript in this IPR violates the district court protective order, which prohibits use of protected materials in other proceedings.” *Id.* Patent Owner does not identify any issue with any other supporting exhibit to the Rypka declaration. *See, e.g., id.* at 4–8.

### 3. ANALYSIS

As Qualcomm contends, the supplemental information could not reasonably have been submitted earlier because “Qualcomm was not joined to (and therefore was not part of and could not participate in)” this proceeding until October 1, 2024. Paper 16, 50; *see* Mot. 7. After joinder, Qualcomm diligently attempted to address Patent Owner’s objections to evidence under 37 C.F.R. § 42.64(b)(1).

On October 16, 2024, Qualcomm asked Patent Owner to provide a copy of any supplemental evidence served by Samsung under 37 C.F.R. § 42.64(b)(2) to address Patent Owner’s objections to evidence under 37 C.F.R. § 42.64(b)(1). Mot. 2. On October 28, 2024, after learning that Samsung served no such evidence, Qualcomm served supplemental evidence, purportedly under 37 C.F.R. § 42.64(b)(2), to address Patent

Owner's objections to evidence under 37 C.F.R. § 42.64(b)(1), i.e., the evidence that Qualcomm now proposes to submit as supplemental information. Ex. 1034, 6; *see* Mot. 2; Opp. 1. On October 31, 2024, after Patent Owner objected to Qualcomm's supplemental evidence as "not timely served," Qualcomm's counsel emailed the Board to request authorization to file a motion to submit supplemental information. Ex. 3005, 1–2; *see* Ex. 1034, 4–5.

In analyzing the interests of justice, we note the preference in federal courts for resolving disputes on their merits, rather than procedural grounds. *See, e.g., Krupski v. Costa Crociere S.p.A.*, 560 U.S. 538, 550 (2010); *Marfia v. T.C. Ziraat Bankasi, N.Y. Branch*, 100 F.3d 243, 249 (2d Cir. 1996); *Blake Constr. Co. v. United States*, 13 Cl. Ct. 250, 252 (1987). Further, both the Federal Circuit and the Supreme Court "have recognized that there is a significant public policy interest in removing invalid patents from the public arena." *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1354 (Fed. Cir. 2005).

Based on our review of the "substantively identical" version of the Hall-Ellis declaration in IPR2024-00343, we determine that considering the Hall-Ellis declaration Qualcomm proposes to submit in this proceeding would be in the interests of justice because the declaration will facilitate resolving the patentability of the challenged claims on the merits. *See* IPR2024-00343, Ex. 1014. Based on our review of the "substantively identical" version of the Hall-Ellis declaration in IPR2024-00343, the declaration addresses the authenticity and public accessibility of the book *Networks on Chip* containing Exhibit 1007 (Goossens2003 as chapter 4) and Exhibit 1014 (introductory material and chapters 1, 2, and 3). *See id.* at

¶¶ 41–48. Qualcomm relies on Goossens2003 as the primary reference in the second of its two patentability challenges. *See* Pet. 9, 48–68.

Regarding authenticity, Dr. Hall-Ellis stated as follows when discussing the book *Networks on Chip* (Exhibit 1009 in IPR2024-00343):

The text in Exhibit 1009 is complete; no pages are missing, and the text on each page appears to flow seamlessly from one page to the next; further, there are no visible alterations to the document. Exhibit 1009 is a true and correct copy in a condition that creates no suspicion about its authenticity.

IPR2024-00343, Ex. 1014 ¶ 41.

Here, Patent Owner objected to Exhibit 1007 (Goossens2003) as “lacking authentication.” Paper 12, 2. The Hall-Ellis declaration Qualcomm proposes to submit will address Patent Owner’s “lacking authentication” objection and facilitate resolving the patentability of the challenged claims on the merits. Patent Owner’s assertion that the Hall-Ellis declaration does not respond to Patent Owner’s objections lacks merit. *See* Opp. 6; Paper 12, 2.

The Hall-Ellis declaration Qualcomm proposes to submit will also address Patent Owner’s renewed arguments regarding the public accessibility of the book *Networks on Chip* and facilitate resolving the patentability of the challenged claims on the merits. *See* Prelim. Resp. 39–41; Prelim. Sur-reply 3–5; Resp. 67–68.

Additionally, Qualcomm “remains willing to provide” Dr. Hall-Ellis for a deposition, and Patent Owner may question her at a deposition. *See* Mot. 8.

As for Patent Owner's contention that considering the Hall-Ellis declaration would not be in the interests of justice because Qualcomm "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 in IPR2024-01081, we disagree. *See* Opp. 5. In the Institution Decision for this proceeding, the Board determined that Samsung established a reasonable likelihood that Goossens2003 is a printed publication that was publicly accessible before the '449 patent's filing date. Inst. Dec. 28–29. Qualcomm filed the petition in IPR2024-01081 on the same day that the Board entered the Institution Decision in this proceeding and more than a week before Patent Owner filed objections to evidence under 37 C.F.R. § 42.64(b)(1) in this proceeding. *See* Paper 12. When Qualcomm filed the petition in IPR2024-01081, Qualcomm had no reason to expect that Patent Owner would object to Exhibit 1007 (Goossens2003) as "lacking authentication" or that Patent Owner would renew its arguments regarding public accessibility, particularly in light of Patent Owner's previous admission in a related civil action that the book *Networks on Chip* "was publicly available as of January 31, 2003." *See* Ex. 1031, 5; Paper 12, 2; Resp. 67–68.

As for Patent Owner's assertion that the Hall-Ellis declaration will add new issues to this proceeding, we disagree. *See* Opp. 6–7. As discussed above, the Hall-Ellis declaration will address the authentication issue for Exhibit 1007 (Goossens2003) raised by Patent Owner when it filed objections to evidence under 37 C.F.R. § 42.64(b)(1) in this proceeding. *See* Paper 12, 2. Insofar as the Hall-Ellis declaration describes indexing and cataloging procedures for the book *Networks on Chip* at libraries other than

the University of Texas Libraries, the Hall-Ellis declaration will address the same issue as other evidence in the record, i.e., whether Goossens2003 is a printed publication that was publicly accessible before the '449 patent's filing date. *See* Inst. Dec. 28–29; Ex. 1027 (O'Bryan Declaration); Ex. 1028. Further, as Qualcomm asserts, the Hall-Ellis declaration will not change the grounds of unpatentability presented in the Petition. *See* Pet. 9; Mot. 5.

Hence, we grant in part Qualcomm's motion to submit supplemental information and authorize Qualcomm to submit the Declaration of Dr. Sylvia Hall-Ellis no later than five business days after the date of this order.

As for the Attorney Declaration of Ryan D. Rypka and supporting exhibits, Patent Owner does not identify any issue with any supporting exhibit other than a deposition transcript allegedly subject to a protective order in a related civil action.<sup>5</sup> *See, e.g.*, Opp. 4–8. We believe that further briefing will assist in evaluating whether, under the unique circumstances here, the Board should waive the “ten business days” requirement in 37 C.F.R. § 42.64(b)(2) and permit the Attorney Declaration of Ryan D. Rypka and supporting exhibits to “remain[] as only served (but not filed) supplemental evidence,” as Qualcomm proposes (*see* Mot. 6 n.3), or permit submission under 37 C.F.R. § 42.123(b) without the deposition transcript allegedly subject to a protective order in a related civil action.

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<sup>5</sup> Insofar as Patent Owner maintains that Qualcomm's service of that deposition transcript on October 28, 2024, violated a protective order, Patent Owner should seek relief from the appropriate district court.

#### IV. ORDER

Accordingly, it is

ORDERED that Qualcomm's motion to submit supplemental information is granted in part under 37 C.F.R. § 42.123(b), and Qualcomm may submit the Declaration of Dr. Sylvia Hall-Ellis as supplemental information no later than five business days after the date of this order;

FURTHER ORDERED that no later than five business days after the date of this order, Qualcomm may file a reply no longer than three pages that addresses whether, under the unique circumstances here, the Board should waive the "ten business days" requirement in 37 C.F.R. § 42.64(b)(2) and permit the Attorney Declaration of Ryan D. Rypka and supporting exhibits to "remain[]" as only served (but not filed) supplemental evidence" or permit submission under 37 C.F.R. § 42.123(b) without the deposition transcript allegedly subject to a protective order in a related civil action; and

FURTHER ORDERED that no later than ten business days after the date of this order, Patent Owner may file a sur-reply no longer than three pages that that responds to Qualcomm's reply authorized in the preceding paragraph.

IPR2024-00338  
Patent 7,373,449 B2

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