

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SALVACION USA, INC.,
Petitioner,

v.

TRUTEK CORP.,
Patent Owner.

IPR2024-00711
Patent 8,163,802

Before ULRIKE W. JENKS, SHERIDAN K. SNEDDEN, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

In an email to the Board dated August 7, 2025, counsel for Patent Owner requested authorization to file a motion to submit supplemental information under 37 CFR § 42.123(b). The relevant portion of the email reads as follows:

Patent Owner respectfully requests leave to file a Motion to Submit Supplemental Information under 37 CFR § 42.123(b). The information is in the form of evidence of commercial success of a product protected under U.S. Patent No. 8,163,802. Information regarding commercial success as a mitigating factor for a determination of obviousness of the patent's claims was submitted in the form of argument both in Patent Owner's preliminary response and in its response to the petition. Thus, there was no intent to waive this issue. However, the information may have been submitted in the wrong evidentiary format. Although this information may have been submitted in the wrong format, said omission was inadvertent. Patent Owner attempted to submit the information in the correct evidentiary format in its sur-reply. Petitioner filed a motion to strike Patent Owner's submissions, and that motion is pending before the Board. Obviousness is an issue in this inter-partes review. Consideration of the supplemental information is in the interests of justice because it will further the efforts for the Board to objectively determine the patentability of the asserted claims.

Patent Owner further indicated that it is prepared to make Ashok Wahi, the testifying witness, available for cross-examination.

Petitioner opposes Patent Owner's request.

II. LEGAL FRAMEWORK

As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. Under 37 C.F.R. § 42.123(a)(1), a request for the authorization to file a motion to submit supplemental information must be made within one month of the date the trial is instituted. We

instituted trial on December 6, 2024. The Patent Owner sought authorization on August 7, 2025, beyond one month of the date institution. We consider Patent Owner's Motion as a "late submission" under 37 C.F.R. § 42.123(b).

Section 123(b) states: "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." Here, because Patent Owner seeks to submit supplemental information beyond one-month of institution, it must show that the information could not have been obtained earlier and that its consideration is in the interest of justice. As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c).

III. ANALYSIS

On this record, and in the particular circumstances of these proceedings, we deny Patent Owner's request. Patent Owner acknowledges that the information it seeks to introduce has already been submitted with Patent Owner's Sur-Reply and therefore is of record. Paper 13, 4. Accordingly, we determine that Patent Owner has failed to show why the supplemental information reasonably could not have been obtained earlier for the purposes of 37 C.F.R. § 42.123(b).

Moreover, we do not discern how allowing the information to come into the record under a motion to submit supplemental information would, at this late stage of the proceeding, bolster the evidentiary weight to be given to the information previously submitted in Patent Owner's briefing. Based on

Patent Owner's explanation and our understanding of the posture of the current record, it appears the pending motion to strike (Paper 19) is the proper vehicle for us to assess the alleged new evidence of commercial success submitted in Patent Owner's briefing. Taken together, we determine that Patent Owner has not met its burden to show why consideration of the supplemental information under 37 C.F.R. § 42.123(b) is appropriate and in the interests of justice.

Accordingly, it is

ORDERED that Patent Owner's request for authorization to submit supplemental information is *denied*.

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