

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MAXELL, LTD.
Patent Owner.

IPR2024-00777
Patent 11,017,815 B2

Before JAMESON LEE, TERRENCE W. McMILLIN,
and KEVIN C. TROCK, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Denying Motion to Submit Supplemental Information
37 C.F.R. § 42.123

I. Introduction

We instituted *inter partes* review on November 8, 2024. Paper 12. By email on December 5, 2024, Petitioner requested authorization to file a Motion to Submit Supplemental Information (“Motion” or “Mot.”). We granted authorization by email. Petitioner filed the Motion on December 20, 2024. Paper 16. Patent Owner filed an Opposition. Paper 17. Petitioner filed a Reply. Paper 20. The Motion is *denied*.

II. Discussion

The Motion seeks to submit Exhibits 1051–1057 as supplemental information. Mot. 1. Exhibits 1051 and 1052 are patents that refer to a product called “WinTV” (“WinTV product”). Mot. 5. Exhibit 1053 is a published US patent application that refers to a WinTV product. *Id.* According to Petitioner, Ex. 1054 is an archived web page from the manufacturer of WinTV product informing the public where to buy the WinTV product. *Id.* Also according to Petitioner, Exhibits 1055 and 1056 are archived webpages from the manufacturer of WinTV product, showing the WinTV product was for sale on September 15, 1999, and November 17, 1999, respectively. *Id.* Exhibit 1057 is a declaration from a record request processor at the Internet Archive. Petitioner submits Exhibit 1057 to authenticate Exhibits 1054–1056 as well as Exhibit 1011 which was filed together with the Petition.¹ Mot. 5.

¹ Petitioner identifies Exhibit 1011 as specifications of “WinTV PCI boards” archived on the manufacturer’s website. Pet. iii.

The governing rule for a motion to submit supplemental information is 37 C.F.R. § 42.123, which reads as follows:

§ 42.123 Filing of supplemental information

(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 interest-of-justice.

(c) Other supplemental information. A party seeking to submit supplemental information not relevant to a claim for which the trial has been instituted must request authorization to file a motion to submit the information. The motion must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interest-of-justice.

37 C.F.R. § 42.123.

The Motion seeks to file supplemental information under 37 C.F.R. § 42.123(a). Mot. 1. Because Petitioner sought authorization to file the motion within one month from the issuance of the institution decision, the timeliness requirement of 37 C.F.R. § 42.123(a)(1) is met. The relevance

requirement of 37 C.F.R. § 42.123(a)(2), for reasons discussed below, however, is not satisfied for Exhibits 1051–1057.

Exhibits 1051–1056

Petitioner refers to three alleged grounds of unpatentability in the Petition, i.e., (1) unpatentability of claims 20, 26, and 27 over “Horn, Baumgartner, Candelore, and **WinTV**”; and (2) unpatentability of claims 16–27 over “Horn, Baumgartner, Candelore, **WinTV**, and Chao”; and (3) unpatentability of claims 20, 26, and 27 over “Kaplan, Bryant, Wong, Candelore, and **WinTV**.” Mot. 4. Petitioner then asserts: “WinTV is therefore clearly relevant to this proceeding. Moreover, the Board also stated that ‘Petitioner may wish to supplement the record with additional evidence regarding WinTV’s accessibility, now that the issue is in dispute.’ Institution decision at 20” *Id.* at 5.

The argument is unpersuasive. The “**WinTV**” referred to in the asserted grounds of unpatentability is Exhibit 1010, identified by Petitioner in the Petition as “WinTV Installation and Reference Manual (June 30, 1999). Pet. iii. In contrast, the “WinTV” referred to in Exhibits 1051–1056 are not to any reference manual, but to products. Undisputably, Exhibits 1051–1056 do not refer to the WinTV reference manual that is Exhibit 1010. The Motion also does not explain whether Exhibit 1010 is the reference manual for any of the products mentioned in Exhibits 1051–1056. Even if it is, the motion does not explain how Exhibits 1051–1056 help to show the existence and public accessibility of Exhibit 1010 on a website. The following two statements in the Motion are inadequate for establishing relevance with respect to public accessibility of Ex. 1010:

EX1051-EX1053 are evidence that would have come to the attention of a POSITA looking for information on such products well before the alleged December 2, 2004 priority date of the '815 Patent.

Mot. 5.

EX1054-EX1056 are further evidence that would have come to the attention of a POSITA looking for information on such products well before the alleged December 2, 2004 priority date of the '815 Patent.

Id.

For the foregoing reasons, Petitioner has not shown the relevance required by 37 C.F.R. § 42.123(a)(2).

Exhibit 1057

Petitioner submits the declaration of a Records Request Processor at the Internet Archive (Ex. 1057) to authenticate Exhibits 1054–1056 and Exhibit 1011. Mot. 5. The portion of Exhibit 1057 that applies to Exhibits 1054–1056 has not been shown by Petitioner to be relevant because Exhibits 1054–1056 have not been shown by Petitioner to be relevant.

Exhibit 1011 was filed by Petitioner together with the Petition. Petitioner identifies Exhibit 1011 as “Archived Specifications – WinTV PCI boards including the Wincast/TV and WinTV-pci (November 10, 1999) (https://web.archive.org/web/19991110153658/http://hauppauge.com:80/html/wc_data.htm).” Pet. iii. Regarding relevance, we understand Petitioner’s position to be that Exhibit 1057 authenticates Exhibit 1011 and that because Exhibit 1011 is relevant, Exhibit 1057 is relevant. *See* Mot. 5.

But the Motion does not adequately show that Exhibit 1011 is relevant to a challenged claim. The “WinTV” referred to in Exhibit 1011 is not to any reference manual, but to a product. Undisputably, Exhibit 1011

does not refer to the WinTV reference manual that is Exhibit 1010. The Motion also does not explain whether Exhibit 1010 is the reference manual for any of the products mentioned in Exhibit 1011. Even if it is, the motion does not explain how Exhibit 1011 helps to show the existence and public accessibility of Exhibit 1010 on a website. Thus, we do not find Petitioner to have shown relevance for Exhibit 1057 under 37 C.F.R. § 42.123(a).

Exhibits 1051–1057

Although the Institution Decision states: “Petitioner may wish to supplement the record with additional evidence regarding WinTV’s accessibility, now that the issue is in dispute,” Institution Decision at 20, the submission of supplemental information still has to proceed according to governing rule, 37 C.F.R. § 42.123.

Petitioner asserts:

Moreover, Petitioners submit that the board may take “judicial notice of the contents of webpages available through the Wayback Machine ‘as facts that can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.’” *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374 (Fed. Cir. 2021). Petitioners respectfully request that the Board do so here to the extent needed.

Mot. 6. The argument urging the Board to take judicial notice of contents of webpages available through the Wayback Machine is misplaced in the context of the Motion where Petitioner is attempting to show relevance of the proposed supplemental information to a claim. We also decline to take judicial notice of material which have not been shown as relevant.

Further, even if Exhibits 1051–1057 were somewhat relevant, the relevance is so far attenuated and minimal that it is counterproductive to allow their admission as supplemental information and we would still

decline their admission. The Board is not required to admit supplemental information under 37 C.F.R. § 42.123(a) whenever the requirements of 37 C.F.R. §§ 42.123(a)(1) and 42.123(a)(2) are satisfied. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015) (“Requiring admission of supplemental information so long as it was timely submitted and relevant to the IPR proceeding would cut against this mandate [ensure efficient administration of the office and the ability of the office to complete IPR proceedings in a timely manner] and alter the intended purpose of IPR proceedings.”).

Additionally, a separate and independent reason leads to not accepting Exhibit 1057 as supplemental information. Petitioner expressly indicates that Exhibit 1057 is submitted in part for authenticating Exhibit 1011. Mot. 5. But on November 22, 2024, Patent Owner timely objected to Exhibit 1011 on several basis including lack of authentication. Paper 15, 3. Petitioner has only ten business days from Patent Owner’s objection to serve supplemental evidence for the purpose of overcoming the objection. 37 C.F.R. § 42.64(b)(2). The period for serving supplemental evidence to cure the purported defect alleged by Patent Owner’s objection expired on December 9, 2024. Petitioner may not circumvent the time requirement of 37 C.F.R. § 42.64(b)(2) by submitting late supplemental evidence as supplemental information. *See ServiceNow, Inc. v. BMC Software, Inc.*, IPR2015-01176, Paper 15 at 3–4 (PTAB December 29, 2015).

III. Order

It is

ORDERED that Petitioner’s Motion to Submit Supplemental Information (Paper 16) is *denied*.

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