

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENCUBE ETHICALS PTV. LTD.,
Petitioner,

v.

DERMAVANT SCIENCES GMBH,
Patent Owner.

IPR2024-00834
Patent 11,590,088 B2

Before ROBERT A. POLLOCK, TAWEN CHANG, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

I. INTRODUCTION

On December 17, 2024, we held a conference call with counsel for both parties to discuss Petitioner’s request to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a). Upon our authorization (Paper 14), Petitioner filed the motion on December 24, 2024 (Paper 15, “Motion” or “Mot.”), and Patent Owner filed a corresponding opposition on January 3, 2025 (Paper 17, “Opposition” or “Opp.”). In its Motion, Petitioner seeks to submit certain webpages cited in paragraphs 62, 73, and 77 of the Sudhakar Declaration¹ as supplemental information. Mot. 1–3. Petitioner alleges that it also served copies of those webpages on Patent Owner on December 11, 2024 as Exhibits A–D of the supplemental declaration of Paul Sudhakar. *Id.* at 1 n.1.

For the reasons discussed below, Petitioner’s Motion is granted.

II. LEGAL STANDARD

A party may file a motion to submit supplemental information if the following requirements are met: (1) “[a] request for the authorization to file a motion . . . is made within one month of the date the trial is instituted,” and (2) “[t]he supplemental information must be relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a).

However, the Board is not precluded under 37 C.F.R. § 42.123(a) from consideration of additional criteria beyond timing and relevance or from exercising its discretion. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 443–447 (Fed. Cir. 2015); 37 C.F.R. § 42.5(b).

¹ Declaration of Paul T. Sudhakar, MS, MBA (Apr. 21, 2024) (Ex. 1032, “Sudhakar Declaration”)

Furthermore, “[t]he opportunity to submit additional evidence does not allow a petitioner to completely reopen the record, by, for instance, changing theories after filing a petition. Whether any additional evidence changes the theories presented in a petition will be determined under the facts and circumstances of that particular case.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 14–15 (PTAB Dec. 20, 2019) (precedential) (explaining, *inter alia*, that a petitioner may be afforded a “limited” opportunity to submit “new evidence” as part of a motion to submit supplemental information).

Finally, the moving party bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

We evaluate the parties’ arguments in view of the standards set forth above.

III. ANALYSIS

Patent Owner does not dispute that Petitioner’s request for authorization to file its Motion was timely under 37 C.F.R. § 42.123(a)(1). Nor does Patent Owner dispute that Petitioner served on Patent Owner the four documents/webpages that Petitioner moves to submit as supplemental information.²

² Petitioner moves to file as exhibits the webpages that it allegedly served on Patent Owner, on December 11, 2024, as Exhibits A–D of Mr. Sudhakar’s supplemental declaration. Mot. 1, n.1. Petitioner did not submit the webpages it seeks to file as exhibits or attachments to its Motion, instead including in the Motion only hyperlinks to these webpages. In deciding this motion, the Board has considered the webpages available at those hyperlinks as of the date of this Decision. To the extent there are changes to the contents of the webpages between December 11, 2024, and the date of this Order that are material to our findings here, the parties may request a

With respect to the relevance requirement of 37 C.F.R. § 42.123(a)(2), Petitioner argues that the webpages at issue in the Motion are relevant to claim 1, the only independent claim in the '088 patent, which recites the phrase “containing . . . about 1.0% tapinarof.” Mot. 1–3. More particularly, Petitioner argues that the webpage cited in ¶ 62 of the Sudhakar Declaration, which appears to describe “shorthand ways” for writing chemical structures, is relevant to why an ordinarily skilled artisan would understand the chemical structure disclosed in the asserted Sonti reference to be tapinarof. Mot. 2. Petitioner argues that the two webpages cited in ¶ 73 of the Sudhakar Declaration “recites various names used in the field for tapinarof,” such as Benvitimod and/or WBI-1001, that are also used in the references relied on in the Petition. *Id.* at 2–3. Finally, Petitioner argues that the webpage cited in ¶ 77 of the Sudhakar Declaration, which appears to explain what is meant by % v/v, % w/w, and % w/v, is relevant to how an ordinarily skilled artisan would understand references relied on in the Petition that “discuss administering a composition of 1% ‘w/w’ of tapinarof.” *Id.* at 3.

We are persuaded that the webpages at issue in the Motion are relevant to the claims on which trial has been instituted, at least as to the issue of whether references relied on in the Petition, including the references asserted to render the claims obvious, disclose the composition recited in the claims (i.e., “composition containing about 1.0% tapinarof”). We therefore disagree with Patent Owner’s argument that “Petitioner has not demonstrated how the webpages support its merits arguments and are thus relevant to any claim in the proceeding.” Opp. 2.

conference call so that such matters can be brought to the Board’s attention.

Patent Owner argues that “Petitioner already served what it purports are the same four webpages in its Motion as supplemental evidence in response to Patent Owner’s Objections to Mr. Sudhakar’s Declaration,” and the Motion is an attempt to circumvent the rules regarding submission of supplemental evidence. Opp. 1.

As the Board has previously explained, supplemental *evidence*—served in response to any evidentiary objection and filed in response to a motion to exclude—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 argument on the merits (i.e., regarding the patentability or unpatentability of a claim). Supplemental information, on the other hand, is evidence a party intends to support an argument on the merits. Such evidence may only be filed if a § 123 motion is both authorized and granted.

Handi Quilter, Inc. v. Bernina Int’l AG, IPR2013-00364, Paper 30 at 2–3 (PTAB June 12, 2014). As noted above, Petitioner in this case has shown how the webpages at issue in its Motion support its arguments on the merits and qualify as “supplemental information.” Patent Owner’s citation to *ServiceNow, Inc. v. BMC Software, Inc.*, IPR2015-01176, Paper 15 (PTAB Dec. 29, 2015) (“*ServiceNow*”), is inapposite. Unlike here, petitioner in *ServiceNow* “did not articulate any bases beyond admissibility to justify its proposed motions to submit supplemental information.” *ServiceNow*, 4.

As to the specific webpages at issue, Patent Owner argues that clicking on the first link discussed in the Motion “leads to a webpage that doesn’t exist.” Opp. 2.

We are not persuaded the Motion should be denied for this reason. Although it is true that clicking on the link in Petitioner’s brief (which link

bridges two pages of the motion) leads to a “no page here” message, either typing the URL (uniform resource locator) into a web browser or clicking on the link in ¶ 62 of the Sudhakar Declaration leads to what appears to be the web page referred to in the Motion. Furthermore, Petitioner has represented that the webpage was previously served on Patent Owner as Exhibit A to Mr. Sudhakar’s supplemental declaration.

Patent Owner argues that the second and third webpages “allegedly relate to the term ‘Benvitimod’ in EX1016-EX1018, yet ‘Benvitimod’ appears nowhere in the Petition.” Opp. 2. Patent Owner further argues that, although Petitioner asserts “these webpages relate to ‘the Chen references,’ . . . supplemental information cannot be used to bolster deficiencies.” *Id.* at 2–3.

Although the term “Benvitimod” does not appear in the Petition, the Petition cites to Exhibits 1016 and 1018 in support of its argument that Physician Global Assessment (PGA), recited in independent claim 1, is one of several “well-known metrics for assessing plaque psoriasis severity and treatment response.” Pet. 7–8. The Petition more specifically cites these exhibits as part of “a series of clinical trials in China in the early 2010s [that] treated plaque psoriasis patients with a topical 1% tapinarof composition and also used PGA score as a ‘primary outcome.’” *Id.* at 8. These exhibits describe the composition used in the study as “benvitimod cream.” Ex. 1016, 1; Ex. 1018, 1. These clinical trials are also discussed in the Liem Declaration³ in support of the Petition. Ex. 1003 ¶¶ 52–53. As to Patent Owner’s argument that the Motion is an improper attempt to bolster

³ Declaration of Wieke H. Liem, M.D., F.A.A.D. (Apr. 23, 2024) (Ex. 1003, “Liem Declaration”).

deficiencies in the Petition, we do not find the proposed exhibits amount to, or result in, an improper change to Petitioner's theory in the case. Patent Owner will, of course, have a full opportunity to address Petitioner's theories, including to the extent allegedly bolstered by the supplemental information, in the Patent Owner Response at trial.

Patent Owner argues that "the third webpage [discussed in the Motion] is from Wikipedia, whose entries can be modified by anyone at any time, without any check of veracity." Opp. 2. Patent Owner argues with respect to the fourth webpage discussed in the Motion that Petitioner is "relying on the opinion of someone with a marketing background who posted the blog a year prior to entering the chemical manufacturing field, without showing how such opinion would be relevant to the knowledge of the person of ordinary skill." *Id.* at 3.

We find these arguments to go more to the weight to be given to the evidence, and do not undermine Petitioner's contentions that such evidence is relevant to the instituted claims. Patent Owner, furthermore, has had or will have the opportunity to cross-examine Petitioner's declarants on their reliance on these webpages. Patent Owner may also file objections to these exhibits pursuant to the procedure set forth in 37 C.F.R. § 42.64(b)(1).

Patent Owner's argument that Petitioner has not "shown that the webpages linked in the Motion contain the same content now as when Mr. Sudhakar formed his opinions" is similarly unavailing. *Id.* Our order requires Petitioner to file as exhibits, within five days, the same webpages already served on Patent Owner on December 11, 2024. Mot. 1, n.1. Petitioner has had or will have opportunity to cross-examine Mr. Sudhakar on any discrepancies between the webpages as they existed at the time of the

service of Mr. Sudhakar's supplemental declaration and the time of his original declaration, as well as to file any evidentiary objections pursuant to 37 C.F.R. § 42.64(b)(1). Finally, as noted above, to the extent there are changes to the contents of the webpages between December 11, 2024 and the date of this Order that are material to our factual findings as to the content of the webpages, the parties may bring such differences to our attention.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to submit supplemental information is GRANTED.

FURTHER ORDERED that Petitioner shall file as exhibits, within five days, Exhibits A–D of the supplemental declaration of Paul Sudhakar previously served on Patent Owner on December 11, 2024.

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