

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.,
Petitioner,

v.

PANTECH CORPORATION,
Patent Owner.

IPR2025-00762
Patent 10,863,573 B2

Before JAMESON LEE, CHRISTOPHER L. OGDEN, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

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

On November 3, 2025, the Board authorized OnePlus Technology (Shenzhen) Co., Ltd. (“Petitioner”) to file a motion to submit supplemental information pursuant to 37 CFR § 42.123(a). Ex. 3004. Petitioner filed its Motion and Pantech Corporation (“Patent Owner”) filed an Opposition. Paper 13 (“Mot.” or “Motion”); Paper 14 (“Opp.” or “Opposition”). After considering the arguments and the evidence of record, the Motion is granted.

Under 37 CFR § 42.123(a), 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.

We instituted trial on October 15, 2025 and, Petitioner timely requested authorization to file the Motion within one month via an email dated October 31, 2025. *See* Paper 10 (Institution Decision); Ex. 3004 (email request). Patent Owner does not dispute that Petitioner’s request is timely. *See* Opp. Accordingly, the Motion meets the timing requirement of 37 C.F.R. § 42.123(a)(1).

Petitioner argues that the proffered supplemental information (proposed Exhibits 1054 and 1055) is relevant to the third ground set forth in the Petition, whether the challenged claims are unpatentable under the combination of Deenoo and Sammour. Mot. 1, 4–6. Specifically, Petitioner argues that the proffered supplemental information, consisting of provisional patent applications, establish that Deenoo has a priority date earlier than the priority date of the ’543 patent regardless of the priority date of the

challenged claims. *Id.* Petitioner further argues that the addition of the provisional patent applications do not constitute a new ground. *Id.* at 13–15.

We agree with Petitioner that the proposed supplemental information is relevant to a claim for which the trial has been instituted. As required by our rules, we instituted trial on all grounds and all claims set forth in the Petition. *See* Paper 10, 2, 25. Ground 3 is based, *inter alia*, on Deenoo. *Id.* at 7. As we stated in the Institution Decision, there is a typographical error on the face of Deenoo regarding the date that a PCT application was filed. *Id.* at 22–23. That typographical error raises a number of potential issues as to whether Deenoo qualifies as prior art. *Id.* at 23. Because Petitioner argues that Deenoo has an earlier priority date by claiming priority to the provisional patent applications (*see* Mot. 4–13), the supplemental information is relevant to the issue of whether Deenoo qualifies as prior art.

Patent Owner argues that although “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable,” the Petition does not mention those provisional patent applications. Opp. 2–4 (quoting *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (emphasis omitted)). Instead, according to Patent Owner, “instituted Ground 3 (obviousness over Deenoo and Sammour) at most relies only on Deenoo’s PCT filing date as its basis for prior art status—which is, as the Institution Decision notes, January 17, 2014.” *Id.* at 3 (emphasis omitted).

Patent Owner is factually correct that the provisional patent applications were not mentioned in the Petition. *See* Pet. 10. However, because of the shifting burden of production associated with determining whether a reference qualifies as prior art, we do not agree with Patent Owner that the failure to mention them in the Petition is controlling.

Specifically, in *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015), the United States Court of Appeals for the Federal Circuit held that a petitioner has the initial burden of production to establish a reference is prior art. After the petitioner satisfies that burden of production, it then shifts to the patent owner to refute the petitioner's argument by either showing the prior art does not actually render the claims unpatentable or does not qualify as prior art. *Id.* at 1380. The burden of production then shifts back to the petitioner to respond to the patent owner's argument. *Id.* The Board then evaluates all of the evidence and determines whether the petitioner has satisfied its burden of persuasion regarding unpatentability. *Id.*

In this proceeding, Petitioner satisfied its initial burden of production by demonstrating that the PCT filing date (whether the incorrect date listed on Deenoo or that actual filing date) is earlier than the filing date of the challenged '573 patent. That was sufficient to shift the burden of production to Patent Owner. *See Dynamic Drinkware*, 800 F.3d at 1379. In other words, there was no need for Petitioner to have argued in the Petition that Deenoo claims priority to the provisional patent applications.

But, Patent Owner argued in its Preliminary Response that the '573 patent can claim priority to Republic of Korea patent application 10-2013-0053408. If that argument is maintained in the Patent Owner's Response and sufficient evidence presented,¹ then the burden shifts back to Petitioner.

¹ We remind Patent Owner that if it wishes to continue to make this argument, Patent Owner must do so in its Response and should submit sufficient evidence, such as a translation of the priority application and testimonial evidence, to show that the '543 is entitled to claim priority to that patent application.

Petitioner can satisfy that burden of production by showing that Deenoo is entitled to an earlier filing date, such as by showing Deenoo is entitled to rely on the priority claim to the provisional patent applications. That is, under the burden shifting framework set forth in *Dynamic Drinkware*, Petitioner would be able to argue in its Reply that Deenoo is entitled to an earlier priority date. Because Petitioner would be able to argue in its Reply that Deenoo is entitled to claim priority to the provisional patent applications, including submitting those applications as evidence, Petitioner is equally able to do so via this motion as supplemental information.²

Patent Owner also argues that Petitioner is improperly modifying Ground 3. Opp. 4–5. Specifically, Patent Owner argues that “Petitioner’s attempt is similar to the attempt rejected by the Board in *Microsoft Corporation v. ThroughPuter, Inc.*, IPR2023-00852, Paper 15 at 3–9 (PTAB Oct. 11, 2023).” *Id.*

We do not agree with Patent Owner. The issue in *Microsoft* was whether Petitioner could submit a preliminary reply with factual evidence regarding the public accessibility of a potential prior art reference. *Microsoft*, Paper 15, 2–3. According to *Microsoft*, the petition in that proceeding was “devoid of any substantive explanation as to how Tuan qualifies as prior art to the ’948 patent. . . . As such, Petitioner’s intended reply brief and evidence would, in essence, set forth from scratch Petitioner’s contentions for qualifying Tuan as prior art.” *Id.* at 6. In other words, the petitioner in that proceeding did not satisfy its initial burden of

² The Board suggested that Petitioner make such a submission in order to provide Patent Owner an opportunity to address it, including by the submission of testimonial evidence, in its Response. *See* Paper 10, 23 n.7.

production. That is a far cry from this case where the evidence in the record (the dates identified on the face of Deenoo and the filing date of the '543 patent) is sufficient for Petitioner to meet its initial burden of production.

Nor does reliance on Deenoo's priority claim to the provisional patent applications change the ground. Petitioner has not argued that either Deenoo provisional patent application is prior art. Instead, the supplemental information only goes to the prior art status of one of the previously identified Deenoo references.

Finally, Patent Owner's argues that the Deenoo provisional patent applications do not provide sufficient written description support for a priority claim. *See* Opp. 5–8. Patent Owner also argues that Petitioner relies on improper attorney argument to support the claim to priority. *Id.*

At this stage of the proceeding, and for purposes of deciding the Motion, we do not reach a determination of whether the provisional patent applications are sufficient to support a priority claim. There is no need to do so as we must simply determine at this time whether the proposed supplemental information is relevant, not dispositive, to an issue. Because we do not decide the ultimate issue regarding priority, the parties should present any arguments regarding the prior art status in Patent Owner's Response, Petitioner's Reply, and Patent Owner's Sur-Reply. In ultimately deciding if the Deenoo priority patent applications support an earlier filing date, we will consider all evidence and arguments submitted by the parties in those papers. But we will not consider arguments made only in either the Motion or Opposition. In addressing the issue, the parties should keep in mind that “[a]ttorney argument is not evidence’ and cannot rebut other admitted evidence.” *Elbit Systems of America, LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1359 (Fed. Cir. 2018) (quoting *Icon Health & Fitness, Inc. v.*

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Strava, Inc., 849 F.3d 1034, 1043 (Fed. Cir. 2017)); *see also Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) (unsworn attorney argument is not evidence).

ORDER

Accordingly, it is:

ORDERED that Petitioner's Motion to Submit Supplemental Information Pursuant to 37 C.F.R. § 42.123(a) is *granted*.

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