

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UATP IP, LLC,
Petitioner,

v.

SLICK SLIDE LLC,
Patent Owner.

Case PGR2024-00054
Patent 11,998,854

PETITIONER’S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

EXHIBITS

UATP-1001	U.S. Patent No. 11,998,854 to Schmit (“the ’854 patent”)
UATP-1002	Excerpts from the Prosecution History of the ’854 Patent (“the Prosecution History”)
UATP-1003	Declaration of Dr. Youjiang Wang
UATP-1004	U.S. Patent No. 7,896,779 to Phillips (“Phillips”)
UATP-1005	U.S. Patent Publication No. 2023/0129814 to Fallgatter (“Fallgatter”)
UATP-1006	<i>WN0400 – 400 Micron Nylon Mesh 45% Open Area</i> , Industrial Netting product page, archived by Internet Archive Wayback Machine on July 28, 2021 (https://web.archive.org/web/20210728222259/https://www.industrialnetting.com/wn0400-400-micron-nylon-woven-mesh.html) (“WN0400”)
UATP-1007	<i>Woven Mesh: Nylon, Polyester or Polypropylene Plastic Mesh</i> , Industrial Netting, archived by Internet Archive Wayback machine on June 21, 2021 (https://web.archive.org/web/20210621025620/https://www.industrialnetting.com/woven-mesh.html)
UATP-1008	<i>6.2 Friction</i> , University Physics Volume 1, openstax (retrieved from https://openstax.org/books/university-physics-volume-1/pages/6-2-friction)
UATP-1009	V.K. Kothari et al., <i>Assessment of frictional properties of some woven fabrics</i> , Indian Journal of Fibre and Textile Research, Vol. 19 (September 1994) 151-155
UATP-1010	W. Żurek et al., <i>Surface Frictional Resistance of Fabrics Woven from Filament Yarns</i> , Textile Research Journal, Vol. 55, No. 2 (1985), 113-121

- UATP-1011 W.D. Callister, *Materials Science and Engineering An Introduction*, ed. 7, John Wiley & Sons, Inc. (2007)
- UATP-1012 *WN0400 – 400 Micron Nylon Mesh 45% Open Area*, Industrial Netting product page, accessed at <https://www.industrialnetting.com/wn0400-400-micron-nylon-woven-mesh.html>
- UATP-1013 M. Watanabe, et al., *The Frictional Properties of Nylon*, *Wear*, 12 (1968) 185-191
- UATP-1014 British Patent Publication No. 402,259 to Wicksteed
- UATP-1015 *World's First Children's slide*, BBC NewsRound, April 17, 2012 (retrieved from <https://www.bbc.co.uk/newsround/17747678>)
- UATP-1016 A.F.W. Coulson, et al., *Frictional Properties of Nylon Yarn and Their Relation to the Function of Textile Guides*, *Journal of the Textile Institute Proceedings*, 46:1 (January 7, 2009), 101-111
- UATP-1017 R. Kisiel, *Somebody call elf 'n' safety, standards are on the slide!*, *DailyMail*, April 17, 2012 (retrieved from <https://www.dailymail.co.uk/news/article-2130923/Historians-discover-worlds-childrens-slide-built-90-years-ago-plank-wood.html>)
- UATP-1018 R. Allain, *Fair Physics: The Big Slide*, *Wired* (June 3, 2011) (retrieved from <https://www.wired.com/2011/06/fair-physics-the-big-slide/>)
- UATP-1019 L. Nichols, *The Physics of a Playground Slide*, *Sciencing.com* (April 24, 2017) (retrieved from <https://sciencing.com/physics-playground-slide-8657662.html>)
- UATP-1020 R. Allain, *The Physics of Going Fast –but Not Too Fast – on a Giant Slide*, *Wired* (September 23, 2022) (retrieved from <https://www.wired.com/story/the-physics-of-going-fast-but->

not-too-fast-on-a-giant-slide/)

- UATP-1021 PTC Windchill Risk and Reliability Desktop Help Center, *Friction Coefficients*, (retrieved from https://support.ptc.com/help/wrr/r12.0.2.0/en/index.html#page/wrr/ReferenceGuide/prediction/friction_coefficients.html)
- UATP-1022 U.S. Patent No. 5,246,401 to Boatwright
- UATP-1023 U.S. Patent No. 6,142,879 to Phillips
- UATP-1024 U.S. Patent No. 8,695,994 to Maratta
- UATP-1025 U.S. Patent No. 6,231,483 to Phillips
- UATP-1026 *Friction: Friction Coefficients and Calculator*, The Engineering Toolbox (2004) (retrieved from https://www.engineeringtoolbox.com/friction-coefficients-d_778.html)
- UATP-1027 P.J. Blau et al., *Appendix: Static and Kinetic Coefficients for Selected Materials*, ASM Handbook vol. 18 (1992) 70-75
- UATP-1028 N.P. Suh & M. Mosleh, *The Minimum Coefficient of Friction: What Is It?*, CIRP Annuals, Vol. 43, Issue 1 (1994) 491-495
- UATP-1029 *Kings Island's Ultimate Fansite!*, King Island Central (retrieved from <https://kicentral.com/parkhistory/past-attractions/scrappys-slides/>)
- UATP-1030 S. Murphy, *Is that the same giant slide we got on as children?*, Detroit Historical Society, September 9, 2022 (retrieved from <https://detroithistorical.org/blog/2022-09-09-%E2%80%9Csame-giant-slide-we-got-children%E2%80%9D>)
- UATP-1031 Declaration of Nathaniel E. Frank-White re Internet Archive record of Industrial Netting websites corresponding to UATP-1006 and UATP-1007

- UATP-1032 Industrial Netting Home page, archived by Internet Archive on July 28, 2021
(<https://web.archive.org/web/20210728223652/https://www.industrialnetting.com/>)
- UATP-1033 Industrial Netting Nylon page, archived by Internet Archive on May 29, 2022
(<https://web.archive.org/web/20220529115425/https://www.industrialnetting.com/nylon.html>)
- UATP-1034 *Sailcloth*, Dictionary.com entry (retrieved from <https://www.dictionary.com/browse/sailcloth>)
- UATP-1035 Industrial Netting YouTube page, archived by Internet Archive on July 2, 2022
(<https://web.archive.org/web/20220702033025/https://www.youtube.com/user/IndustrialNetting/about>)
- UATP-1036 Industrial Netting Home page – screenshot of dropdown menu, archived by Internet Archive on July 28, 2021
(<https://web.archive.org/web/20210728223652/https://www.industrialnetting.com/>)
- UATP-1037 *Mesh*, Dictionary.com entry (retrieved from <https://www.dictionary.com/browse/mesh>)
- UATP-1038 *Fabric*, Dictionary.com entry (retrieved from <https://www.dictionary.com/browse/fabric>)

The following exhibits were not previously submitted:

- UATP-1039 Liu et al., *Preparation and Tribological Properties of Modified MoS₂/SiC/Epoxy Composites*, Materials 2021, 14, 1731
- UATP-1040 Brostow et al., *Modified Epoxy Coatings on Mild Steel: Tribology and Surface Energy*, European Polymer Journal, 2010, 46, 2181-2189
- UATP-1041 Kumar et al., *Tribological Studies of Epoxy Composites with*

Solid and Liquid Fillers, Tribology International, 2017, 105,
27-36

UATP-1042 Declaration of June Ann Munford

UATP-1043 Supplemental Declaration of Dr. Youjiang Wang

I. INTRODUCTION

Pursuant to 37 C.F.R § 42.123(a), and as authorized by the Board (Exhibit 3002), Petitioner hereby moves to submit Exhibit UATP-1043 (“Supplemental Declaration of Dr. Youjiang Wang”) and materials cited therein for corroboration (identified as Exhibits UATP-1039 to UATP-1042), as supplemental information.

Petitioner’s motion to submit supplemental information in the form of Dr. Wang’s supplemental declaration (UATP-1043) should be granted because this motion meets both requirements of §42.123(a). Consistent with the first requirement in §42.123(a), Petitioner requested authorization to file this motion within one month of the Institution Decision. Dr. Wang’s supplemental declaration (UATP-1043) is also relevant to a claim for which trial has been instituted, as per §42.123(a)’s second requirement. As explained below, UATP-1043 includes supplemental testimony addressing arguments presented by Patent Owner in Patent Owner’s Preliminary Response related to the enablement of claims 8-13 of the ’854 patent which the Board mentioned in the Institution Decision as contributing to concerns about Petitioner’s challenge to claims 8-13. *See* Paper 8 (Institution Decision), 32 (“After considering the parties’ arguments and evidence we have concerns about the sufficiency of Petitioner’s showing relating to enablement of claim 8.”).

UATP-1043 confirms that the Petition and Dr. Wang’s original declaration

(UATP-1003) demonstrate that claims 8-13 of the '854 patent are not enabled, and addresses arguments put forth by the Patent Owner regarding what a POSITA would have understood from the '854 patent description. Therefore, Petitioner submits that this motion should be granted and requests entry of UATP-1043 into evidence.

II. BACKGROUND

On October 9, 2024, Petitioner filed a Petition for *inter partes* review of claims 1-17 and 22-28 of the '854 patent. On April 8, 2025, the Board instituted a trial on claims 1-17 and 22-28, having determined that Petitioner had demonstrated a reasonable likelihood of prevailing with respect to at least one claim. Paper 8 (Institution Decision), 39-40. However, the Board indicated concern “about the sufficiency of Petitioner’s showing relating to enablement of claim 8” including concerns related to “Petitioner’s assertion that commercial epoxies suggested in the '854 patent for use in the dry lubricant composition would not provide a frictional coefficient between 0.03 and 0.06” in view of Patent Owner’s arguments to the contrary. Paper 8 (Institution Decision), 32. The Board also expressed concern related to “[Dr. Wang’s] assertion that a person of ordinary skill would have been unable to achieve the claimed range by increasing the amount of lubricant or adding copper,” in view of Patent Owner’s assertions to the contrary on this topic. Paper 8 (Institution Decision), 32; *see also id.*, 31 (summarizing Patent Owner’s

argument that “it would be a simple and routine matter to determine how much lubricant should be added to obtain a mixture with the lowest claimed range of frictional coefficients based on the ’854 patent description.”).

UATP-1043 offers discussion of three academic papers that provide information related to what a person of ordinary skill would have understood about the coefficients of friction and other properties of epoxies containing lubricant materials at the time of filing of the ’854 patent to provide context related to arguments Patent Owner advanced in the Preliminary Response. *See* Prel. Resp., 59-60.

Petitioner timely requested authorization to file this motion on May 8, 2025, within one month of the institution decision of April 8, 2025). The Board subsequently authorized Petitioner to file a motion to submit supplemental information. EX3001. Per the Board’s authorization, Petitioner hereby moves to submit UATP-1043 (Supplemental Declaration of Dr. Wang) and the documents discussed therein (UATP-1039 to UATP-1042).

III. ARGUMENTS

Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information in accordance with the following two 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”; and (2) the

“information must be relevant to a claim for which the trial has been instituted.”

This Motion meets both prongs. First, Petitioner requested authorization to file this motion on May 8, 2025, within one month of the institution decision. Second, UATP-1043 provides testimony relating to what a POSITA would have understood about commercial epoxies containing lubricant materials based on academic papers related to such epoxies in response to assertions made by the Patent Owner in the Preliminary Response about the coefficients of friction allegedly already possessed by commercially-available epoxies and the ease with which a POSITA would have determined an appropriate amount of additional lubricant material to add. *See* Prel. Resp., 59-60. This testimony informs analysis of the ground challenging enablement of claims 8-13 set forth in the Petition and, therefore, UATP-1043 is relevant to at least claims 8-13 for which trial has been instituted. *See, e.g., Valeo v. Magna Elecs.*, IPR2014-01204 Paper 26 at 5 (PTAB Apr. 10, 2015); *Motorola Solutions, Inc. v. Mobile Scanning Tech.*, IPR2013-00093 Paper 37 at 2-3 (PTAB Jun. 28, 2013).

Moreover, like the supplemental information admitted in *Valeo* and *Motorola*, UATP-1043 does not change the grounds of unpatentability authorized in the proceeding, and instead UATP-1043 clarifies what a POSITA would have understood from the '854 patent description and from the prior art relating to coefficients of friction of commercial epoxies including lubricant materials and

how a POSITA's understanding confirms that claims 8-13 are not enabled as argued in the Petition and in UATP-1003.

While Petitioner could enter an affidavit addressing these issues with its Petitioner's Reply, Petitioner requests entry of UATP-1043 at this time to facilitate full and early consideration by the Patent Owner and the Board of the issues addressed. Paper 8 (Institution Decision), 30-33. Indeed, Patent Owner will be in possession of the supplemental information contemporaneous with this motion's filing, which is more than one month before the July 1, 2025 due date of the Patent Owner's Response. Thus, far from being prejudiced or burdened by entry of this supplemental evidence into the record as supplemental information, Patent Owner stands to benefit in being able to address the testimony provided at an early stage of the proceeding (including in its Patent Owner Response and its Sur-Reply). Such a thorough vetting is warranted given issues raised by the Board. Similarly, the entry of UATP-1043 now would not limit the Board's ability to complete this proceeding in a timely fashion.

Further, Petitioner does not seek to rely upon new prior art or uncited portions of the same prior art. Indeed, the issues on which Dr. Wang now offers testimony address positions already taken in the Petition and his prior declaration. UATP-1003, ¶¶283-284 (describing that coefficients of friction in the range of 0.03-0.06 are achieved only in ideal conditions involving pure materials), 285

(describing what a POSITA would have understood from the '854 patent's description of commercial epoxies), 286 (describing what a POSITA would have understood from the '854 patent's instruction to add lubricant to a commercial epoxy); Petition, 86-89. UATP-1043 provides context for analysis of whether claims 8-13 are enabled in view of the '854 patent's instructions and Patent Owner's arguments that the commercial epoxies mentioned in the '854 patent would themselves reach the lowest claimed range of frictional coefficients and that a POSITA would have simply determined the amount of lubricant to add to a commercial epoxy to reach the lowest claimed coefficient of friction range of 0.03-0.06. Thus, the grounds remain the same.

IV. CONCLUSION

For the foregoing reasons, Petitioner requests grant of this motion to submit UATP-1043 (and materials cited therein for corroboration and identified as Exhibits UATP-1039 to UATP-1042) as supplemental information and entry of the same into evidence.

Date: May 16, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on May 16, 2025, a complete and entire copy of this Petitioner's Motion to Submit Supplemental Information and Accompanying Exhibits were provided by email, to the Patent Owner, by serving the correspondence address of record as follows:

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