

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
U.S. Patent No. 11,998,854

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO SUBMIT SUPPLEMENTAL INFORMATION**

I. INTRODUCTION

The Board should deny Petitioner’s Motion to Submit Supplemental Information (Paper 13) (“Motion”) because it constitutes an improper attempt to refine and bolster deficient arguments that Petitioner presented in its original Petition and also improperly raises new arguments Petitioner could and should have presented. With the Patent Owner’s Preliminary Response (POPR) and the Institution Decision (Paper 8) (“Institution Decision”) in hand, Petitioner now seeks to introduce over 125 pages of evidence into the record, contained in five new exhibits including a 22-page declaration, to refine and bolster its arguments in order to correct the identified deficiencies in the Petition that Petitioner could and should have addressed at the time the Petition was filed.

This is precisely the type of post-institution supplementation the Board has repeatedly disallowed. *See Hunter’s Manufacturing Company, Inc. v. Ravin Crossbows, LLC*, IPR2023-00407, Paper 32, 16 (PTAB Feb. 15, 2024); *American Well Corporation v. Teladoc Health, Inc.*, IPR2021-00748, Paper 23 at 17 (PTAB Feb. 28, 2022); *Triller, Inc. v. TikTok Pte.*, IPR2022-00180, Paper 18, 6 (PTAB Aug. 25, 2022) (“Triller”). Petitioner’s Motion represents a clear “wait-and-see” approach, using the POPR and the Institution Decision as a roadmap to cure deficiencies that should have been addressed at the time of filing. This strategy not

only violates the statutory particularity requirement of 35 U.S.C. § 312(a)(3), but it also prejudices Patent Owner.

II. ARGUMENTS

A. Petitioner Seeks to Improperly Change, Not Supplement, the Evidence Initially Presented in Their Petition in Response to Patent Owner’s Preliminary Response and the Institution Decision

Denying supplemental information that effectively changes the evidence relied upon in a Petition is consistent with 35 U.S.C. § 312(a)(3)(B) and 37 C.F.R. § 42.204(b)(5), which requires Petitioner to identify in the Petition, “with particularity, . . . the evidence that supports the grounds for the challenge to each claim,” including “affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions.” 35 U.S.C. § 312(a)(3)(B); *see also Yamaha Golf-Car Co. v. Club Car, LLC*, IPR2017-02142, Paper 43 at 5 (“Permitting a petitioner to supplement the record in a manner that effectively changes the evidence originally presented in a petition is not in accord with the statutory requirement that the petition identify with particularity . . . the evidence that supports the grounds for the challenge to each claim[.]”).

Petitioner seeks to submit new declaratory evidence in the form of a supplemental declaration by Dr. Youjiang Wang (“Supplemental Decl.”), along with four new supporting exhibits that are not currently cited anywhere in the record. This submission is intended to directly address arguments raised in the

POPR and issues identified by the Board in the Institution Decision, which found deficiencies in Petitioner's enablement challenge to claims 8-13; issues that should have been properly addressed in the Petition. *See* Paper 13, pp. 2-3. Such post-institution changes to Petitioner's evidence and arguments should not be permitted. *See American Well Corporation*, Paper 23 at 8-13.

As an initial matter, Petitioner's comparison of its supplemental information to that submitted in *Valeo* and *Motorola* is misplaced. *See* Paper 13, pp. 4-5. In those cases, the Board allowed supplemental materials solely to "confirm the public accessibility" or "authentication of non-patent documents." *Valeo*, IPR2014-01204, Paper 26 at 2; *Motorola*, IPR2013-00093, Paper 37 at 2. Here, by contrast, Petitioner introduces three new substantive documents (UATP-1039–1041) not cited in Dr. Wang's original declaration (or the Petition) on which Dr. Wang now relies to present new enablement arguments and opinions not previously raised in the Petition. As in *Triller*, Dr. Wang's Supplemental Decl. "introduces new citations and conclusions...that supplant, not supplement, the original...argument in the Petition," which are "specifically tailored to address the deficiencies identified by the Board." *Triller*, Paper at 10; *see also Nissan N. Am., Inc. v. Diamond Coating Techs., LLC*, IPR2014-01548, Paper 37 at 3 (PTAB July 15, 2015) (denying supplementation that would "change the evidence on which [the petitioner] relied in making its original challenge to claims . . . for which trial

was instituted,” by “includ[ing] new opinions with respect to what a person having ordinary skill in the art would understand is disclosed by [a reference]”).

Indeed, Dr. Wang’s Supplemental Decl. does not simply clarify earlier opinions but offers new declaratory evidence concerning (1) what a POSITA would understand about commercial epoxies and the claimed COF range, and (2) whether achieving the claimed COF range would be simple and routine. These issues were plainly foreseeable and should have been addressed in the Petition.

Petitioner asserts in its Motion that it “does not seek to rely upon new prior art,” but that misses the point. Paper 13, p. 5. The issue is that Petitioner now seeks to introduce new arguments and opinions through additional declaratory evidence and supporting evidence that were readily available at the time the Petition was filed. Petitioner has not shown good cause for submitting a 22-page supplemental expert declaration and supporting evidence at this stage in the proceeding. Simply reciting the procedural standard for submitting supplemental information does not justify the admission of arguments and evidence that should have been included in the Petition. *See Triller*, Paper 18 at 2-3.

Moreover, Petitioner fails to address its reliance on three new substantive publications that were readily available at the time the Petition was filed. Petitioner offers no explanation as to why this supplemental evidence could not have been included with the original Petition, along with the new declaratory evidence. As

the Board has made clear, when a Petitioner “seeks to provide arguments via the supplemental declaration for issues addressed by Patent Owner in its Preliminary Response or by [the Board] in the Decision on Institution,” the Board “views [the supplemental declaration] as unwarranted.” *Triller*, Paper 18 at 4. Because this is exactly what Petitioner seeks to do here, the supplemental information is unwarranted and should be disallowed.

B. Petitioner Seeks to Refine and Bolster its Petition Post-Institution

Petitioner’s submission of supplemental information is a textbook example of an improper attempt to refine and bolster its Petition in response to arguments raised by Patent Owner in the POPR and concerns raised by the Board in the Institution Decision. Petitioner seeks to introduce 22 pages of new declaration testimony from Dr. Wang directed to issues that were foreseeable. This “wait-and-see” approach, raising an issue superficially in the Petition, then seeking to expand on it only after seeing the POPR and the Board’s analysis, is precisely the kind of procedural maneuvering the Board has consistently rejected.

The Board has made clear that a Motion to submit supplemental information is improper in instances in which “the petitioner sought to use the supplemental information to refine or bolster challenges originally presented in the petition.” *American Well Corporation*, Paper 23 at 6–7 (PTAB Feb. 28, 2022). The Board has also made clear that “[t]he filing of a petition for [] review should not be turned

into a two-stage process,” first to elicit arguments from the patent owner in a preliminary response, and second to complete the petition based on those arguments. *ZTE v. Contentguard Holdings*, IPR2013-00139, Paper 27 at 3 (PTAB July 30, 2013).

Here, Dr. Wang’s Supplemental Decl. addresses foreseeable issues covered in the POPR and the Institution Decision. Allowing Petitioner to proceed with such supplementation would endorse the very two-stage strategy the Board has cautioned against. The Board has rightly denied similar efforts where supplemental information sought only to bolster instituted challenges. *See Triller*, Paper 18 at 6.

C. Granting Petitioner’s Motion Would Prejudice Patent Owner

Patent Owner would be unduly prejudiced if Petitioner were permitted to supplement the arguments made in the Petition in view of the arguments and analysis set forth in the POPR and Institution Decision. Petitioner’s assertion that Patent Owner would not be prejudiced by the admission of supplemental evidence is unconvincing as Patent Owner strategically presented its arguments and evidence in its POPR based solely on the Petition. *See* Paper 13, at 5. Petitioner also has not provided any assurance that it will refrain from submitting additional declaration testimony from Dr. Wang or another expert in its Petitioner’s Reply to further address deficiencies in the Petition after reviewing Patent Owner’s response, as it has done here. The risk of ongoing supplementation after the benefit

of reviewing the POPR and Patent Owner's full response creates significant unfairness and results in clear prejudice to Patent Owner.

Moreover, Petitioner's attempted "wait-and-see" approach is particularly egregious given Petitioner's attempt to introduce additional lengthy declaration testimony while the Petition was near the word count limit (certifying 18,512 words). Pet., Word Count Certification. Allowing Petitioner to add an additional 22 pages of declaration testimony that extends beyond the Petition's arguments and that would not have fit into the Petition (without substantial reductions to other portions of the Petition) is highly prejudicial to Patent Owner and amounts to an end run around the word count limits set forth by 37 CFR § 42.24.

III. CONCLUSION

For the reasons set forth herein, the Board should deny Petitioner's Motion.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 27, 2025, a complete and entire copy of Patent Owner's Opposition to Petitioner's Motion to Submit Supplemental Information was provided via email to the Petitioner by serving the email correspondence addresses of record as follows:

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