



PTAB Permits Submission of Evidence Midstream to Bolster Public Accessibility of References Despite Objections

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The Patent Trial and Appeal Board has granted a petitioner's motion to submit supplemental information, over patent owner's objections, concerning the public availability of references that were relied upon to support grounds of unpatentability in the petition.

Petitioner filed a petition challenging patent claims directed to a semiconductor power device. Petitioner relied upon the Kikkawa reference as primary reference for obviousness and the accompanying expert declaration referred to the Kim reference to further support petitioner's grounds of unpatentability. The PTAB instituted trial on all challenged claims and patent owner filed objections to evidence challenging the admissibility of petitioner's expert declaration and the alleged date of publication of Kikkawa and Kim.

In response, and with authorization from the PTAB, petitioner moved to submit supplemental expert declarations providing testimony to support the public availability and accessibility of the Kikkawa and Kim references. Petitioner argued that its submission constituted supplemental information under 37 C.F.R. § 42.123(a) that was timely disclosed and relevant to issues in the case concerning availability of prior art references and the reliability of its expert's testimony. *See* 37 C.F.R. § 42.123(a) (authorizing a party to move to submit supplemental information after trial is instituted if (1) the request is made within one month after institution date and (2) the supplemental information is relevant to a claim for which trial was instituted). Petitioner also contended that its proffered evidence would not create new issues or change the evidence initially submitted in the petition, impede a speedy resolution of the proceeding, or prejudice patent owner.

Patent owner disagreed. It argued that because the new exhibits were directed to patent owner's evidentiary objections, that material should be treated as supplemental **evidence** under 37 C.F.R. § 42.64(b)(2) for which the board should consider later if there remained an admissibility dispute. Relying on *Nokia of America Corp. v. General Access Solutions, Ltd.*, IPR2023-01416, Paper 18 (P.T.A.B. June 25, 2024) ("*Nokia*")—a non-precedential decision in which the PTAB denied a motion to submit supplemental information relating to public accessibility of a reference—patent owner further argued that allowing supplementation would unfairly bolster arguments that were available to petitioner at the time of filing and should have been included in the petition. Patent owner also criticized petitioner's motion for failing to explain why this information was not provided in the petition, and that petitioner's delay in submitting this information was prejudicial.

The PTAB was unpersuaded by patent owner's arguments and, therefore, granted petitioner's motion to submit supplemental expert testimony concerning the availability of Kikkawa and Kim references. In so holding, the PTAB observed that patent owner failed to identify any rule prohibiting a party from serving supplemental information in view of evidentiary objections and patent owner had not put forth any indication that the proffered evidence would be used by petitioner for purposes other than supplementing the record about public accessibility and the reliability of its challenged expert declaration. The PTAB also found that this proceeding was distinguishable from *Nokia* because, among other things, the petition did not ignore glaring inconsistencies regarding the reference's publication date. In the PTAB's view, it did not appear that petitioner was attempting to change the merits of its petition or accompanying evidence. The PTAB found that the facts were better aligned with *Palo Alto Network, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 (P.T.A.B. Feb. 5, 2014)—a case in which the PTAB granted a petitioner's motion to submit supplemental information regarding public accessibility notwithstanding the patent owner contending that petitioner failed to explain why it did not submit that information at the time of filing the petition. Finally, the PTAB reasoned there was little, if no, prejudice to patent owner who already had the supplemental information in its possession and would have sufficient time to address those exhibits before its patent owner response was due.

In granting petitioner's motion, the PTAB clarified that it was not reaching the question of whether the supplemental information is admissible, and any such admissibility challenges can be brought under 37 C.F.R. § 42.64

Practice Tip: Where a patent owner has challenged the availability and accessibility of prior art references, including through evidentiary objections regarding the reliability of expert opinions, the petitioner may be permitted to submit supplemental expert testimony directed to those challenges. A petitioner should anticipate arguments in opposition contending that the petitioner improperly used 37 C.F.R. § 42.123(a) as a “wait-and-see” opportunity to bolster and refine its arguments later in the proceeding. Although the PTAB noted § 42.123(a) does not require a petitioner to explain why information was not provided when it filed the petition, conspicuous issues absent from the petition will be scrutinized.

In conclusion, section 42.123(a) remains a viable option for petitioners to submit supplemental information, including expert testimony on the accessibility and availability of prior art references. It remains critically important, however, for petitioners to give careful thought and attention when preparing a petition as § 42.123(a) is not a vehicle to change the merits of a case or to permit the withholding of known information that should have been included in the petition.

Inergy Technology, Inc. v. Force MOS Technology Co., Ltd., IPR2024-00094, Paper 14 (P.T.A.B. July 19, 2024)

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