

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NORMAN INTERNATIONAL, INC.
Petitioner

v.

ANDREW J. TOTI TESTAMENTARY TRUST, RUSSELL L. HINCKLEY, SR.
(CO-TRUSTEE) and ROBERT F. MILLER (CO-TRUSTEE)
Patent Owner

Case IPR2014-00283
Patent 6,283,192 B1

Before TONI R. SCHEINER, LINDA M. GAUDETTE, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

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

On July 21, 2014, the Board granted Petitioner's request for authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a).¹ Paper 15. On the same day, Petitioner filed its Motion to Submit Supplemental Information. Paper 13 ("Mot."). In its Motion, Petitioner seeks to submit Exhibit 1010 as supplemental information to confirm the accuracy of the English translation of the Tachikawa reference (Ex. 1002), which serves as a basis of the grounds of unpatentability instituted in this proceeding. Mot. 1. On August 21, 2014, Patent Owner filed an Opposition to Petitioner's Motion to Submit Supplemental Information. Paper 20 ("Opp."). On September 16, 2014, Petitioner filed a Reply to Patent Owner's Opposition. Paper 26 ("Reply").

We note that neither party requested authorization to file its Opposition or Reply. *See* Paper 15, 5. Although we will consider both papers in this particular instance, in the future, the parties must seek prior authorization to file any responsive paper when the motion itself requires prior authorization.

For the reasons discussed below, Petitioner's Motion to Submit Supplemental Information under § 42.123(a) is granted-in-part in relation to certain portions of Exhibit 1010.

BACKGROUND

Exhibit 1002 was filed on December 20, 2013, together with the Petition. Paper 1 ("Pet.") at 2. Exhibit 1002 serves as a basis for the two grounds of unpatentability on which we instituted review of U.S. Patent No. 6,283,192 B1

¹ "Once a trial has been instituted, 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."

(“the ’192 patent”). Paper 9 at 22. Petitioner contends Exhibit 1002 includes “a copy of the original Japanese version of the Tachikawa reference” and “an exact copy of the English translation of Tachikawa that Patent Owner filed in a ‘Supplemental Information Disclosure Statement’ for submitting Tachikawa to the Office on June 13, 2013 in Patent Owner’s Patent Application No. 11/257,768—which claims priority to the application that led to the ’192 patent (Application No. 09/229,595).” Mot. 2, ¶¶ 4-5.

Petitioner also contends that on “July 7, 2014, Patent Owner served Objections to Evidence under 37 C.F.R. § 42.64(b)(1), which included an objection to Tachikawa [(Ex. 1002)] as being inadmissible for failure to satisfy the requirements of 37 C.F.R. § 42.63(b).” Mot. 1, ¶ 3; *see also*, Opp. 2, ¶ 4. In its Opposition to the Motion, Patent Owner does not dispute Exhibit 1002 includes an exact copy of the English translation of Tachikawa that was filed by Patent Owner in Patent Application No. 11/257,768. *See generally*, Opp. Rather, Patent Owner contends that because Petitioner did not file an affidavit attesting to the accuracy of the English translation of Tachikawa at the time Exhibit 1002 was filed, Exhibit 1002 is inadmissible for failure to comply with the requirements of 37 C.F.R. § 42.63(b).² Opp. 4 (citing 37 C.F.R. § 42.61(a) (“Evidence that is not taken, sought, or filed in accordance with this subpart is not admissible.”)).

In its Motion, Petitioner states that on July 21, 2014, it responded to Patent Owner’s objection to Exhibit 1002 by serving Exhibit 1010 in accordance with 37 C.F.R. § 42.64(b)(2) (“The party relying on evidence to which an objection is

² 37 C.F.R. § 42.63(b) provides that “[w]hen a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.”

timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.”). Mot. 3, ¶ 8. On the same day, Petitioner also timely filed its Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a), as well as Exhibits 1010 and 1011.

As indicated in the exhibit itself, Ex. 1010 includes the following documents:

- (a) a Japanese version of the Tachikawa reference (unmarked pages 1-4 of Ex. 1010);
- (b) a Supplemental Information Disclosure Statement dated June 18 2013, attaching an English translation of Tachikawa as filed in Patent Owner’s Application No. 11/257,768 (related to the ’192 patent, at issue here) (unmarked pages 5-12 of Ex. 1010);
- (c) an additional certified English translation of Tachikawa (unmarked pages 13-16 of Ex. 1010);
- (d) a “Translator Certification” from Morningside Translations, certifying the accuracy of the additional certified English translation of Tachikawa (unmarked page 17 of Ex. 1010); and
- (e) a comparison between the additional certified English translation of Tachikawa, i.e., (c) above, and the English translation of Tachikawa as filed in Patent Owner’s Application No. 11/257,768, i.e., presented in (b) as designated above (unmarked pages 18-22 of Ex. 1010).

Ex. 1010; Mot. 3, ¶ 7 (citing the Declaration of Sara Hare in Ex. 1011). As noted above, Petitioner contends that the English translation of Tachikawa filed in Patent Owner’s Application No. 11/257,768 , presented in document (b) of Exhibit 1010 as designated above, is the same English translation document submitted by Petitioner in Exhibit 1002. *Id.*

While Petitioner’s Motion does not move to submit Exhibit 1011, we note that Petitioner also filed this exhibit, which includes the Declaration of Sara Hare, cited by Petitioner in its Motion, as well as Appendices A-D. Appendices A-D

contain the same documents (a) - (e) presented in Exhibit 1010, discussed above.³

ANALYSIS

As an initial matter, we note that an authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) is not an authorization to file the information as exhibits. *See Handi-Quilter, Inc. v. Bernina Int'l AG*, Case IPR2013-00364, Paper 30 at 3 (PTAB June 12, 2014) (“Such evidence may only be *filed* if a § 123 motion is *both authorized and granted*.” (emphasis added)). Exhibits 1010 and 1011, which both contain information Petitioner seeks to submit by this Motion, were filed without authorization. The Board has authority under 37 C.F.R. § 42.7(a) to “expunge any paper directed to a proceeding or filed while an application or patent is under the jurisdiction of the Board that is not authorized under this part or in a Board order or that is filed contrary to a Board order.” Therefore, we will expunge both Exhibit 1010 and Exhibit 1011 from the record.

We additionally observe that Exhibits 1010 and 1011 were filed in violation of 37 C.F.R. § 42.6(d) and § 42.63(d)(2)(i). 37 C.F.R. § 42.6(d) states that “[a] document already in the record of the proceeding must not be filed again, not even as an exhibit or an appendix, without express Board authorization.” Exhibit 1010 includes the same documents as Exhibit 1011, with the exception of the Hare Declaration added to Exhibit 1011. Further, above-described document (a) and the English translation in document (b) of Exhibit 1010 (*see also* Appendix A and B of Exhibit 1011) are duplicates of the Japanese document and English translation included in previously filed Exhibit 1002. In addition, 37 C.F.R. § 42.63(d)(2)(i)

³ Appendix C in Exhibit 1011 corresponds to documents (c) and (d) in Exhibit 1010.

requires that when an exhibit is a paper, “[e]ach page must be uniquely numbered in sequence.” As indicated above, the pages of Exhibits 1010 and 1011 are not numbered in sequence. Moreover, the labels in Exhibit 1011 obscure information on certain pages. *See* 37 C.F.R. § 42.63(d)(2)(ii) (“The exhibit label must be affixed to the lower right corner of the first page of the exhibit without obscuring information on the first page or, if obscuring is unavoidable, affixed to a duplicate first page.”).

We turn now to the merits of the Petition.

As the moving party, Petitioner bears the burden of proof to establish that the Exhibit 1010 documents are supplemental information, rather than supplemental evidence, and that we should authorize the filing thereof under 37 C.F.R. § 42.123(a). The difference between supplemental information and supplemental evidence is that:

supplemental *evidence*—served in response to an 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.

See Handi-Quilter, Inc., Paper 30 at 2-3.

Petitioner contends Exhibit 1010 is supplemental information because it is being offered solely to confirm the accuracy of the Exhibit 1002 English translation of Tachikawa. Mot. 1. Patent Owner contends Petitioner’s Motion should be denied because Exhibit 1010 was served in response to Patent Owner’s objection under 37 C.F.R. § 42.64(b)(1), and its sole purpose is to provide the missing evidence needed to support admissibility of previously submitted Ex. 1002

(Tachikawa), i.e., to supply an English translation of Tachikawa and an affidavit attesting to the accuracy thereof as required by 37 C.F.R. § 42.63(b). Opp. 6.

We agree with Petitioner that certain documents presented in Exhibit 1010 do not address merely the admissibility of Tachikawa (Ex. 1002). Rather, documents in Exhibit 1010 address whether the English translation version in Exhibit 1002 represents an accurate translation of the Japanese version of Tachikawa, also included in Exhibit 1002. In other words, Petitioner requests to submit evidence to support its position that Tachikawa discloses what Petitioner purports it discloses in the Petition.

We are persuaded that Petitioner has met its burden to satisfy the requirements of 37 C.F.R. § 42.123(a) in relation to documents (b) – (e) in Exhibit 1010, as designated above. We conclude that such information meets the requirements of § 42.123(a), i.e., that: (1) Petitioner's request for authorization to file its motion was made within one month of institution; and (2) the information is relevant to a claim for which trial has been instituted. Regarding (2), the supplemental information Petitioner seeks to submit relates to claims for which trial has been instituted. The information is directed to what the Tachikawa reference actually discloses, and Tachikawa serves as the basis for the grounds of unpatentability authorized in this proceeding.

The supplemental information Petitioner seeks to submit does not change the grounds of unpatentability authorized in this proceeding, nor does it change the evidence initially presented in the Petition to support those grounds of unpatentability. In addition, there is no indication in the record that the supplemental information Petitioner now seeks to submit was withheld intentionally. Nor does the record suggest that the submission of such information at this juncture would limit our ability to complete this proceeding in a timely

manner. *See Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369, Paper 37 (PTAB Feb. 5, 2014).

As noted above, we will expunge Exhibits 1010 and 1011 from the record. However, we authorize Petitioner to re-file documents (b) – (e) of Exhibit 1010 as four separate exhibits, each with its own new exhibit number. We do not authorize Petitioner to file document (a) of Exhibit 1010, as it is a duplicate of the Japanese version of Tachikawa already presented in Ex. 1002.

We note that our Decision here to grant Petitioner’s Motion to submit the documents (b) – (e) of Exhibit 1010 is not an advisory decision on the admissibility of such evidence. Going forward, the parties are urged to cooperate in resolving disputes concerning the admissibility of evidence.

ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner’s Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a) is GRANTED with respect to documents (b) – (e) included in Exhibit 1010, as designated above, and DENIED with respect to document (a) included in Exhibit 1010, as designated above;

Further ORDERED that Exhibits 1010 and 1011 are *expunged* from the record of the instant proceeding.

PETITIONER:

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