

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HANDI QUILTER, INC. and TACONY CORPORATION
Petitioner

v.

BERNINA INTERNATIONAL AG
Patent Owner

Case IPR2013-00364
Patent 6,883,446 B2

Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

MEMORANDUM
Conduct of the Proceeding
37 C.F.R. § 42.5

On June 4, 2014, a conference call was held between the respective parties and Judges Bisk, Fitzpatrick, and Braden. The purpose of the call was the parties' request for guidance regarding the proper procedure for filing supplemental evidence that had previously been served pursuant to 37 C.F.R. § 42.64(b)(2).

During the call, Patent Owner explained that, in response to Petitioner's evidentiary objections to certain evidence filed with Patent Owner's Response (Paper 17), Patent Owner timely served supplemental evidence on Petitioner according to § 42.64(b)(2). As discussed in a previous conference call, this is the procedure contemplated by the Rules. *See* 37 C.F.R. § 42.64. The Rules do not provide for such supplemental evidence to be filed with the Board at the time it is served to the objecting party, because the Board anticipates that a party's objection to evidence may sometimes be overcome by the supplemental evidence. In such situations, the objection would not become the basis of a motion to exclude evidence under § 42.64(c), and the Board need not be made aware of the objection or the supplemental evidence.

In this case, Petitioner has filed a motion to exclude (Paper 20). Patent Owner explained its understanding that the previously-served supplemental evidence may be filed with Patent Owner's opposition to the motion to exclude. Petitioner's understanding, on the other hand, is that supplemental evidence may only be filed after a successful motion pursuant to § 42.123.

We explained that we agree with Patent Owner's understanding. Section 42.123 addresses the filing of supplemental *information*, not supplemental evidence. The difference 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. Such evidence may only be filed if a § 123 motion is both authorized and granted.

We also noted that the Scheduling Order (Paper 13) provides authorization for a reply in support of any motion to exclude. Thus, Petitioner will have an opportunity to address any supplemental evidence filed in conjunction with Patent Owner's opposition to the motion to exclude.

Finally, upon inquiry by Petitioner, we noted that the motion to exclude may or may not be decided prior to oral hearing. If the motion to exclude has not been decided, the parties will have the chance to address the motion during their presentation.

PETITIONER:

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