

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITSUBISHI PLASTICS, INC.,
Petitioner,

v.

CELGARD, LLC,
Patent Owner.

Case IPR2014-00524
Patent No. 6,432,586 B1

Before FRANCISCO C. PRATS, DONNA M. PRAISS, and
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

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

Introduction

In the Initial Conference Summary in this proceeding, we authorized Mitsubishi Plastics, Inc. (“Petitioner”) to file a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a) (“Mot.”). Paper 22, 5. We authorized Celgard, LLC (“Patent Owner”) to file an Opposition to that Motion. *Id.* at 6.

In its Motion, Petitioner requests entry, into the record of this proceeding, expert witness declarations submitted in IPR2014-00679 and IPR-00692 by SK Innovations Co, Ltd. (“SKI”), and LG Chem, Ltd. (“LG”), the petitioners, respectively, in those proceedings. *See* Mot. 1 (Paper 23). Both IPR2014-00679 and IPR-00692 challenge the same patent under challenge herein, U.S. Patent No. 6,432,586 B1 (“the ’586 patent”). *Id.*

Having reviewed the Motion and Opposition, we deny Petitioner’s Motion.

Background

In this proceeding, we instituted trial as to claims 7–11 of the ’586 patent, based on obviousness under 35 U.S.C. § 103 over Tojo¹ and Kejha.² Paper 12, 26. We denied institution as to claims 1–6 and 12, however, including grounds based on one or both of those references. *Id.* at 11–14, 25. Petitioner requested rehearing of that denial. Paper 15, 1. We denied Petitioner’s request for rehearing. Paper 27 (“Rehearing Decision”).

In its Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a), Petitioner contends that the declarations and curricula vitae of

¹ JP Patent Pub. H11-080395 (Ex. 1005).

² U.S. Patent No. 5,705,084 (issued Jan. 6, 1998) (Ex. 1019).

the petitioners' experts³ in IPR2014-00679 and IPR2014-00692 "simply provide[] additional evidence, admissible as expert testimony under Fed. R. Evid. 702, supporting the grounds for which the present proceedings have been instituted (or will be instituted, pending a ruling on [Petitioner]'s Request for Rehearing)." Mot. 7. Petitioner contends that the Board has previously granted such motions where the motion "satisfies the requirements of § 42.123(a), does not change the grounds of unpatentability authorized in the proceeding, and does not change the prior art initially presented in the Petition to support those grounds of unpatentability." *Id.* at 6.

Patent Owner contends that, when deciding motions under § 42.123(a), rather than focusing solely on whether the supplemental information changes the prior art relied upon in the Petition, the Board has focused instead on "whether the motion will change the evidence originally presented with the petition." Paper 26, 4 ("Opp.") (citing *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369, slip op. at 3 (PTAB Feb. 5, 2014)). Thus, Patent Owner argues, because Petitioner seeks to change the evidence supporting its Petition, and thereby bolster its unpatentability challenges, the Motion should not be granted. *Id.* at 5–9, 12–14. Patent Owner contends also that the Motion does not adequately designate the portions of the Declarations that Petitioner seeks to rely upon,

³ The expert declarant in IPR2014-00679 is Dr. Craig B. Arnold. Paper 22, 6. The expert declarant in IPR2014-00692 is Dr. Kuzhikalail M. Abraham, the same expert relied upon by Petitioner in this proceeding. *Id.* The Declaration by Dr. Abraham submitted in this proceeding differs materially from the Declaration by Dr. Abraham submitted in IPR2014-00692, however. Rehearing Decision 3–5.

and that entry of the Motion will create a significant burden on Patent Owner. *Id.* at 9–12.

Analysis

As an initial matter, as noted above, we denied Petitioner’s Request for Rehearing after Petitioner filed the instant Motion. Accordingly, to the extent Petitioner argues that the supplemental information at issue is relevant to determining the patentability of claims 1–6 and 12, Petitioner’s arguments are moot in light of our Decision on Rehearing. 37 C.F.R. § 42.123(a)(1) (supplemental information must be “relevant to a claim for which the trial has been instituted”).

We turn, then, to the issue of whether to permit Petitioner, under the facts before us, to submit the proposed supplemental information when determining the patentability of claims 7–11 over Tojo and Kejha. Petitioner filed its request for authorization to file a Motion to Submit Supplemental Evidence within one month of the September 29, 2014, date of institution (*see* Paper 18 (entered October 29, 2014)). Patent Owner does not dispute that the expert declarations Petitioner seeks to submit are relevant to a claim for which the trial has been instituted. Accordingly, Petitioner has met the criteria enunciated in § 42.123(a) for filing a Motion to Submit Supplemental Information. *See* 37 CFR § 42.123(a)(1) and (a)(2).

As the Board has explained in several instances, however, meeting the criteria for filing a motion under § 42.123(a) does not mean that the Board will automatically grant that motion, and allow submission of the supplemental information at issue. *See Redline Detection, LLC v. Star Envirotech, Inc.*, Case IPR2013-00106, slip op. at 4 (PTAB Aug. 5, 2013);

ZTE Corp. v. Contentguard Holdings Inc., Case IPR2013-00139, slip op. at 2 (PTAB July 30, 2013); *Norman Int'l, Inc. v. Andrew J. Tosti Testamentary Trust*, Case IPR2014-00283, slip op. at 5 (PTAB Sept. 29, 2014). The Board has allowed submission of supplemental information, for instance, where the information was alleged to confirm the public accessibility of originally cited prior art, but did not change the grounds of unpatentability authorized in the proceeding, and did not change the evidence initially presented in the petition to support those grounds. *Palo Alto v. Juniper*, Case IPR2013-00369, slip op. at 3 (PTAB Feb. 5, 2014).

In contrast, the Board has denied motions under § 42.123(a) where the petitioner sought to use the supplemental information at issue to bolster the challenges presented originally in the Petition, based on feedback gleaned from the institution decision. *See ZTE v. Contentguard Holdings*, Case IPR2013-00139, slip op. at 3 (PTAB July 30, 2013)(denying entry of supplemental information where petitioner submitted information in response to claim construction by Board in institution decision); *see also Redline Detection v. Star Envirotech*, Case IPR2013-00106, slip op. at 4 (PTAB Aug. 5, 2013) (“We do not read 37 C.F.R. § 42.123 as permitting a petitioner to wait for the Board to narrow the grounds submitted in the petition in order to create a more focused declaration at less expense that will bolster its position in the chosen grounds.”). Denying entry of supplemental information which effectively changes the evidence originally relied upon in a petition is in accord with the statutory requirement that a petition must identify, with particularity, the evidence supporting 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).

In the instant case, Petitioner concedes that it seeks to use the expert declarations at issue from IPR2014-00679 and IPR2014-00692 to bolster the evidence originally submitted in support of the Petition in this proceeding. *See* Mot. 8 (“[T]he fact that two separate, qualified experts have reached the same conclusion regarding the validity of the asserted claims would bolster and corroborate Dr. Abraham’s assertions, giving them additional probative weight.”); *see also id.* at 9 (“Having both sets of testimony would allow the PTAB to refer to additional explanatory materials as it analyzes the patent and the prior art.”). Accordingly, we agree with Patent Owner that Petitioner seeks, effectively, to change the evidence it relied upon in making its original challenge to claims 7–11, for which trial was instituted. We, therefore, deny Petitioner’s Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a).

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 DENIED.

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