

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.,
HITACHI AUTOMOTIVE SYSTEMS, LTD., and
HYUNDAI MOTOR AMERICA,

Petitioner,

v.

DIAMOND COATING TECHNOLOGIES, LLC,

Patent Owner.

Case IPR2014-01548¹
Patent 6,354,008 B1

Before CHRISTOPHER L. CRUMBLEY and JO-ANNE M. KOKOSKI,
Administrative Patent Judges.

KOKOSKI, *Administrative Patent Judge.*

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

¹ Case IPR2014-01553 has been joined with this proceeding.

On June 5, 2015, with Board authorization, Petitioner filed a Motion to Submit Supplemental Information. Paper 33 (“Mot.”). Patent Owner filed an Opposition to the Motion. Paper 34 (“Opp.”). Having reviewed the Motion and Opposition, we deny Petitioner’s Motion.

In this proceeding, we instituted trial as to claims 3 and 5 of the ’008 patent based on anticipation by Hirano I, and as to claim 4 based on obviousness over the combination of Hirano I and Noda. Paper 22, 22. The Motion seeks to submit Exhibit 1021, the declaration of Dr. David B. Bogy (“the Bogy Declaration”), a purported expert who “explains one of ordinary skill in the art’s understanding of the teachings of Hirano I, particularly with respect to Hirano I’s description of how the rails of the magnetic head make sliding contact with the recording medium while it is rotating.” Mot. 3. Petitioner contends that the Bogy Declaration confirms the evidence submitted with the Petition and “does not change the grounds of unpatentability that were authorized.” *Id.* at 2.

Patent Owner responds that the Bogy Declaration “changes the type of evidence originally relied on in the Petition” at least by “attempt[ing] to show inherent anticipation of claims 3 and 5, when no testimonial evidence on inherent anticipation of claims 3 and 5 was included with the Petition.” Opp. 2–3. Patent Owner argues that it would be significantly prejudiced if it were required “to respond to this new evidence and address issues not previously presented in this proceeding.” *Id.* at 3.

Under 37 C.F.R. § 42.123, a party may file a motion to submit supplemental information if a request for authorization to file such a motion is made within one month of the date the trial is instituted. Nothing in the rule suggests, however, that such a motion would be granted no matter the

circumstance. For example, the Board has allowed the submission of supplemental information where the information was alleged to confirm the public accessibility of cited prior art, but did not change the grounds of patentability authorized in the proceeding, and did not change the evidence initially presented in the petition in support of those grounds. *See Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369, slip op. at 3 (PTAB Feb. 5, 2014) (Paper 37). In contrast, the Board has denied such motions where the petitioner sought to use the supplemental information at issue to bolster challenges originally presented in the petition, based on information in the institution decision. *See ZTE Corp. v. ContentGuard Holdings, Inc.*, IPR2013-00139, slip op. at 3 (PTAB July 30, 2013) (Paper 27) (denying entry of supplemental information where petitioner submitted information in response to Board's claim construction in the institution decision); *see also Redline Detection v. Star Envirotech*, Case IPR2013-00106, slip op. at 4 (PTAB Aug. 5, 2013) (Paper 24) ("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.").

We agree with Patent Owner that Petitioner seeks, effectively, to change the evidence on which it relied in making its original challenge to claims 3–5, for which trial was instituted. The Bogy Declaration includes new opinions with respect to what a person having ordinary skill in the art would understand is disclosed by Hirano I, which Petitioner concedes it seeks to submit because the decision to institute narrowed the scope of the proceeding to focus on magnetic heads. *See Mot. 2–3*. This is similar to the

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kind of information that the Board refused to allow in *Redline*, where the petitioner sought to submit an expert declaration after the Board narrowed the grounds submitted in the petition. *Redline*, slip op. at 4. Denying entry of supplemental information that 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).

It is therefore

ORDERED that Petitioner’s Motion to Submit Supplemental Information is *denied*; and

FURTHER ORDERED that Exhibit 1021 is expunged from the record.

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