

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CRESTRON ELECTRONICS, INC.,  
Petitioner,

v.

INTUITIVE BUILDING CONTROLS, INC.,  
Patent Owner.

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Case IPR2015-01379  
Patent 5,945,993

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Before KEN B. BARRETT, MICHAEL W. KIM, and  
DANIEL N. FISHMAN, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Petitioner filed a Motion to Submit Supplemental Information Pursuant to 37 C.F.R. § 42.123(a). Paper 24 (“Motion” or “Mot.”). Patent Owner opposed the Motion. Paper 26 (“Opposition” or “Opp.”). The Motion requests that supplemental information, represented by Exhibits 1016, 1017, and 1018 be made of record in the respective proceedings. Mot. 5.

## II. DISCUSSION

Section 42.123 provides:

(a) *Motion to submit supplemental information.* 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.

Patent Owner objects to the Motion asserting “Petitioner, as the moving party seeking to submit ‘supplemental information’ under 37 C.F.R. § 42.123(a), bears the burden of proof to establish that proposed Exhibits 1016–1018 are supplemental information, rather than supplemental evidence.” Opp. 2. Patent Owner further contends Petitioner failed to meet that burden and, thus, Petitioner’s motion should be denied “[b]ecause Petitioner’s proposed ‘supplemental information’ is actually supplemental evidence.” Opp. 3.

The Board has previously explained the difference between supplemental evidence under 37 C.F.R. § 42.64(b)(2) and supplemental information under 37 C.F.R. § 42.123(a):

[S]upplemental *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.

*Handi Quilter, Inc. v. Bernina Int’l AG*, Case IPR2013-00364, slip op. at 2–3 (PTAB Jun. 12, 2014) (Paper 30) (emphasis in original).

Petitioner requested authorization to file the Motion in an Initial Conference Call on January 15, 2016—within one month of December 15, 2015, the date trial was instituted. We granted permission to file the Motion in an Order mailed January 19, 2016. Paper 22.

Although Petitioner met the threshold requirements recited in subparts (a)(1) and (a)(2) of 37 C.F.R. § 42.123, and was authorized via email to file a motion to submit supplemental information, authorization does not guarantee that the motion will be granted. As correctly noted by Patent Owner, the burden of proof remains with Petitioner to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). In construing our Rules, we are guided by our mandate “to secure the just, speedy, and inexpensive resolution” to this proceeding. *See* 37 CF.R. § 42.1(b).

#### *A. Exhibit 1016*

Exhibit 1016, described by Petitioner as an Affidavit of Chris Butler, is offered as further supporting Petitioner’s contention that SavoySoft (Exhibit 1009), including any embedded images, is a prior art publication, i.e., an issue going to the substantive argument on the merits of whether SavoySoft is properly prior art, as opposed to whether or not SavoySoft is admissible. Mot. 3. SavoySoft is among the references upon which trial

was instituted. Thus, we conclude Exhibit 1016 is evidence Petitioner intends to support an argument on the merits—Exhibit 1016 is, thus, properly submitted as *supplemental information*. To that end, Patent Owner’s citation to *ServiceNow, Inc. v. BMC Software, Inc.*, Case IPR2015-01176, slip op. at 3-4 (PTAB Dec. 29, 2015) (Paper 15) is inapposite, as there, evidence was offered to cure objections that certain evidence was inadmissible because it lacked authentication and contained hearsay.

*B. Exhibit 1017*

Exhibit 1017, described by Petitioner as a copy of a cover page of Circuit Cellar Ink Magazine, Issue #57, is offered as further supporting Petitioner’s contention that House (Exhibit 1011) is a prior art publication. Mot. 3–4. House is among the references upon which trial was instituted. Thus, we conclude Exhibit 1017 is evidence Petitioner intends to support an argument on the merits—Exhibit 1017 is, thus, properly submitted as *supplemental information*.

*C. Exhibit 1018*

Exhibit 1018, described by Petitioner as a Declaration from Gerard P Grenier, is offered as further supporting Petitioner’s contention that Corcoran96 (Exhibit 1012) is a prior art publication. Mot. 4. Corcoran96 is among the references upon which trial was instituted. Thus, we conclude Exhibit 1018 is evidence Petitioner intends to support an argument on the merits—Exhibit 1018 is, thus, properly submitted as *supplemental information*.

III. SUMMARY AND CONCLUSION

We are persuaded that all of the supplemental information (Exhibits 1016–1018) proffered by Petitioner under 37 C.F.R. § 42.123 (a) relates to

the substantive arguments on the merits of the public accessibility of Exhibits 1009, 1011, and 1012—references upon which trial was instituted in this proceeding. This supplemental information provides additional evidence that the prior art references for each of the instituted grounds are indeed prior art and does not change “the grounds of unpatentability authorized in this proceeding” or “the evidence initially presented in the Petition to support those grounds of unpatentability.” *Palo Alto Networks, Inc v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (PTAB Feb. 5, 2014).

On the facts in this case, we determine that Petitioner has established that all of the supplemental information should be filed and considered as part of the trial in this proceeding. Petitioner is reminded of rule 42.6(d), which provides “[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.” Thus, Exhibits 1016–1018 should not include any duplicates of pages already filed in documents of other exhibits.

#### IV. ORDER

ORDERED that Petitioner’s Motion to Submit Supplemental Information under 37 C.F.R. § 42.123 (a) is *granted*.

Case IPR2015-01379

Patent 5,945,993

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