

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CRESTRON ELECTRONICS, INC.,
Petitioner,

v.

INTUITIVE BUILDING CONTROLS, INC.,
Patent Owner.

Case IPR2015-01379
Patent 5,945,993

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

FISHMAN, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.123(b)

Pursuant to our Order (Paper 30; dated Feb. 18, 2016), Petitioner timely filed an authorized motion for late submission of supplemental information (Paper 32; filed Feb. 19, 2016, “Mot.”). Patent Owner timely filed its authorized brief in opposition to Petitioner’s motion (Paper 33; filed Feb. 26, 2016, “Opp.”).

Petitioner proposes to submit Exhibit 1019 comprising a declaration by Mr. House further attesting to the publication date of the *House* reference (Exhibit 1011) and further comprising an attached exhibit (Exhibit A) — a copy of the House reference without artifacts of the duplication processes as allegedly published by publisher Circuit Cellar Ink in April 1995. Mot. 2. According to Petitioner, the proposed supplemental information of Exhibit 1019 was only available in early February 2016 after reaching out to Mr. House on December 23, 2015. *Id.* at 3. Petitioner maintains that it reached out to Mr. House in response to our Decision to Institute dated December 15, 2015. *Id.* Specifically, Petitioner argues, “In order to address the Board’s comments, Petitioner attempted to locate the author, Peter House. On December 23, 2015, Petitioner reached Mr. House, who suggested Petitioner contact the publisher, Circuit Cellar Ink, directly.” *Id.*

Patent Owner opposes the motion contending “Petitioner should reasonably have noticed these inconsistencies eight months ago before it filed its Petition. Petitioner should undoubtedly have noticed these inconsistencies *when Patent Owner pointed them out* in its Preliminary Response *over five months ago.*” Opp. 2–3. Patent Owner further contends that Petitioner was not under severe time constraints, relative to the one year time bar of 35 U.S.C. § 315(b), in preparing its Petition because the Petition was filed less than two months after Patent Owner filed a lawsuit against Petitioner. Opp. 3, n. 1.

Our rule regarding late submission of supplemental information provides, in pertinent part, “[t]he motion to submit supplemental information must show why the supplemental information reasonably *could not have been obtained earlier*, and that consideration of the supplemental

information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b) (emphasis added). We are not persuaded by Petitioner’s arguments that the proposed supplemental information (Ex. 1019) could not have been obtained earlier. We agree with Patent Owner that Petitioner should have appreciated the poor quality images of the originally filed *House* reference (Ex. 1011) and sought to remedy the situation much earlier in this proceeding. Instead, Petitioner apparently chose to wait until after our Decision to Institute to even attempt to remedy the discrepancies by contacting Mr. House. The seeming discrepancies in the dates on the pages of Exhibit 1011 are clear and Petitioner could have pursued a remedy before filing its Petition or at least shortly after Patent Owner raised a question regarding the dates on the pages of the *House* reference in its Preliminary Response.

ORDER

IT IS ORDERED that Petitioner’s motion for late submission of supplemental information under 37 C.F.R. § 42.123(b) is *denied*.

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Patent 5,945,993

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