

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOPRO, INC.,
Petitioner,

v.

CONTOUR IP HOLDING LLC,
Patent Owner.

Case IPR2015-01078 (Patent 8,896,694 B2)
Case IPR2015-01080 (Patent 8,890,954 B2)¹

Before JUSTIN T. ARBES, MICHAEL J. FITZPATRICK, and
NEIL T. POWELL, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION

Patent Owner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

¹ This Decision addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue a single Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2015-01078 (Patent 8,896,694 B2)
IPR2015-01080 (Patent 8,890,954 B2)

As previously authorized, Patent Owner filed in each of the instant proceedings a Motion to Submit Supplemental Information, and Petitioner filed an Opposition. *See* IPR2015-01078, Papers 35 (“Mot.”), 37 (“Opp.”); IPR2015-01080, Papers 35, 37. Patent Owner seeks to submit as supplemental information a supplemental declaration (Exhibit 2014)² from Richard Mander, Ph.D. For the reasons stated below, Patent Owner’s Motion is *denied*.

ANALYSIS

As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Pursuant to 37 C.F.R. § 42.123(b), a party seeking to submit supplemental information more than one month after the date a trial is instituted “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.” We are not persuaded that the supplemental declaration of Dr. Mander should be filed now as supplemental information.

Supplemental information is not the same as supplemental evidence. Supplemental information may only be filed if a motion to submit supplemental information under 37 C.F.R. § 42.123 is granted. By contrast, supplemental evidence is served in response to an objection to the admissibility of evidence. 37 C.F.R. § 42.64(b)(2). If the supplemental evidence does not cure the objection and the opposing party files a motion to

² The facts of the two proceedings are similar. Unless otherwise noted, references to papers and exhibits herein are to those filed in Case IPR2015-01078.

IPR2015-01078 (Patent 8,896,694 B2)

IPR2015-01080 (Patent 8,890,954 B2)

exclude, the submitting party may file the supplemental evidence with its opposition to the motion to exclude. *See* 37 C.F.R. § 42.64(c).

Patent Owner filed, with its Response in each of the instant proceedings, a declaration from Dr. Mander regarding alleged secondary considerations of non-obviousness. Ex. 2006. Petitioner subsequently filed objections to the declaration pursuant to 37 C.F.R. § 42.64(b)(1). Paper 31. Among other things, Petitioner objected to various statements in the declaration under Federal Rule of Evidence 602, which provides that a fact witness “may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.” *See* Paper 31, 5–10. Patent Owner then served the supplemental declaration from Dr. Mander, and Petitioner cross-examined Dr. Mander regarding both declarations. *See* Ex. 1037.

As Patent Owner acknowledges, it served the supplemental declaration “[i]n response to Petitioner’s objections” to the admissibility of the original declaration. Mot. 1; *see* Ex. 2014 ¶ 2. Patent Owner in its Motion identifies five particular issues on which Petitioner asserted that Dr. Mander lacked personal knowledge, and cites responsive testimony in the supplemental declaration allegedly showing that Dr. Mander had the requisite personal knowledge for each. Mot. 2–3. In the supplemental declaration, Dr. Mander similarly identifies paragraphs in his original declaration, states that each paragraph is based on his personal knowledge and recollection, and explains why he believes that to be the case. Ex. 2014 ¶¶ 3–11. Thus, the supplemental declaration is more appropriately characterized as supplemental evidence, rather than supplemental information, because it was served in response to Petitioner’s evidentiary

IPR2015-01078 (Patent 8,896,694 B2)

IPR2015-01080 (Patent 8,890,954 B2)

objections and is responsive to Petitioner's objections regarding Dr. Mander's alleged lack of personal knowledge.

Patent Owner's arguments regarding the two requirements of 37 C.F.R. § 42.123(b) are not persuasive. First, Patent Owner contends that it reasonably could not have obtained the supplemental declaration earlier because it was unaware of Petitioner's objections until Petitioner made them. Mot. 3–4. As Petitioner points out, however, that is the case with every objection to the admissibility of evidence. Opp. 4–5. Patent Owner had access to Dr. Mander and certainly could have provided the additional testimony contained in the supplemental declaration at the time Patent Owner filed its Responses, as evidenced by the fact that Patent Owner submitted the original declaration from Dr. Mander at that time.

Second, Patent Owner contends that consideration of the supplemental declaration at this time would be in the interests-of-justice because the supplemental declaration “provides context and additional facts” regarding Dr. Mander's work for Patent Owner and alleged personal knowledge of the matters described in the original declaration. Mot. 1–2, 5. Patent Owner further contends that Petitioner would not be prejudiced by considering the supplemental declaration now because Petitioner had the opportunity to cross-examine Dr. Mander and could respond substantively in its Reply in each proceeding. *Id.* at 4–5. Having reviewed the content of the supplemental declaration, however, we are persuaded that it is directed solely to countering Petitioner's evidentiary objections, i.e., explaining why Dr. Mander allegedly had personal knowledge of the matters described in the original declaration. Thus, we consider it to be supplemental evidence, not supplemental information. If Petitioner files a motion to exclude

IPR2015-01078 (Patent 8,896,694 B2)

IPR2015-01080 (Patent 8,890,954 B2)

Dr. Mander's original declaration,³ Patent Owner will have the opportunity to file the supplemental declaration with its opposition to the motion to exclude. If Petitioner does not file timely a motion to exclude, its objection regarding Dr. Mander's alleged lack of personal knowledge (as well as any other evidentiary objections) will be waived.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Submit Supplemental Information is *denied*; and

FURTHER ORDERED that Dr. Mander's supplemental declaration (Exhibit 2014) is expunged from the record of the instant proceedings.

³ Petitioner has indicated, at least at this point, an intent to do so. *See* Opp. 4 (arguing that the supplemental declaration "does not cure the defects" in the original declaration); Paper 38, 23 ("The grounds for inadmissibility will be further detailed in Petitioner's Motion to Exclude, to be filed per the Board's Order not later than May 17, 2016.").

IPR2015-01078 (Patent 8,896,694 B2)

IPR2015-01080 (Patent 8,890,954 B2)

PETITIONER:

Patrick D. McPherson

David T. Xue

Karineh Khachatourian

DUANE MORRIS LLP

pdmcperson@duanemorris.com

DTXue@duanemorris.com

karinehk@duanemorris.com

PATENT OWNER:

Nicole M. Jantzi

Ian B. Brooks

Paul M. Schoenhard

ROPES & GRAY LLP

nicole.jantzi@ropesgray.com

Ian.Brooks@ropesgray.com

paul.schoenhard@ropesgray.com