

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOWE'S HOME CENTERS, LLC,
Petitioner,

v.

MAUREEN REDDY,
Patent Owner.

Case IPR2015-00306
Patent D677,423

Before JOSIAH C. COCKS, PHILLIP J. KAUFFMAN, and BRIAN P. MURPHY,
Administrative Patent Judges.

MURPHY, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
Late Submission of Supplemental Information
37 C.F.R. § 42.5; 37 C.F.R. § 42.123(b)

On December 8, 2015 at 9:20 p.m., Patent Owner Maureen Reddy (“Patent Owner”) sent an email to the Board with Patent Owner’s proposed demonstrative exhibits attached, pursuant to our oral hearing Order. Paper 14, 2 (“Hearing Order” or “Order”). On December 9, 2015 at 4:13 p.m., Petitioner Lowe’s Home Centers, LLC (“Petitioner”) sent an email to the Board with Petitioner’s Objections to Patent Owner’s demonstrative exhibits 27–31 attached, pursuant to our Hearing Order. Order, 3. Petitioner indicated that the parties were unable to resolve the objections.

On December 10, 2015, we sustained Petitioner’s objections to demonstrative exhibits 27, 30, and 31, and ordered the parties to be prepared to argue, after the conclusion of oral arguments on December 11, 2015, whether the statements, images, and documents referenced in demonstrative exhibits 28 and 29 were appropriately the subject of a motion by Patent Owner for late submission of supplemental information under § 42.123(b).¹

On December 11, 2015, we heard oral argument from the parties regarding the statements, images, and documents referenced in demonstrative exhibits 28 and 29.² Patent Owner confirmed that she was requesting authorization to file a motion for late submission of supplemental information under § 42.123(b) in an effort to have the statements, images, and documents referenced in demonstrative exhibits 28 and 29 made of record in this proceeding. Petitioner opposed authorization of such a motion.

¹ The parties were informed of this decision by email on December 10, 2015 and at the oral hearing. An order with this guidance was filed the next day. *See* Paper 15.

² A transcript of the proceeding is being prepared by the court reporter but is not yet available.

Under 37 C.F.R. § 42.123(b), a 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. The statements, images, and documents referenced in demonstrative exhibits 28 and 29 relate to Patent Owner's allegations of copying by Petitioner and/or Petitioner's lighting vendor. Resp. 36–40. Patent Owner represents that she first became aware of the images and documents in late September 2015, approximately three months after Patent Owner filed her Corrected Response in this proceeding on June 30, 2015 (Paper 10). Patent Owner further represents that the images and documents were not previously available to her. Patent Owner also indicates that her statements concerning alleged copying, made in her Corrected Response (pages 36–40), are supported by her sworn deposition testimony in a co-pending district court action between the parties, *Reddy v. Lowe's Companies, Inc.*, No. 13-CV-13016-IT (D. Mass. Nov. 25, 2013).

Patent Owner's deposition testimony was submitted by Petitioner in this proceeding (Ex. 1009) and relied upon by Petitioner in support of its Reply to Patent Owner's Response. Paper 11, 2–3. A review of Patent Owner's sworn deposition testimony indicates that the testimony was taken in accordance with our rules. 37 C.F.R. § 42.53(f); Ex. 1009, 6:1–7:14, 93:19–139:22, 221–222. Patent Owner's deposition testimony is contrary to Petitioner's assertion that there is no evidence in the record to support Patent Owner's allegations. *See* Reply 14–15. Petitioner also specifically objects to the proposed supplemental information as untimely, not in the evidentiary record, not presented in Patent Owner's briefing before the Board, and, in certain aspects, protected as confidential business information in the co-pending district court action.

Having considered the preliminary arguments of the parties, we are persuaded that Patent Owner has made a sufficient showing for us to authorize filing of a motion for late submission of supplemental information under § 42.123(b). Patent Owner's allegations and arguments bear on the question of whether the design claimed in Patent Owner's U.S. Patent D677,423 ("the '423 patent") is obvious over the Cohrs reference,³ as asserted by Petitioner. Pet. 22–23; Reply 12–15. Evidence of secondary considerations, such as copying, "must be considered before determining whether the claimed invention would have been obvious to one of skill in the art at the time of invention." *Apple, Inc. v. ITC*, 725 F.3d 1356, 1365 (Fed. Cir. 2013). Therefore, Patent Owner will be given the opportunity to make the requested motion pursuant to 37 C.F.R. § 42.123(b).

Patent Owner's motion must: i) separately identify all proposed images and documents that form the supplemental information, ii) provide evidentiary support to authenticate all images and documents pursuant to Fed. R. Evid. 901, in the form of a declaration[s] subject to the penalty of perjury (28 U.S.C. § 1746), sworn deposition testimony, or the like, iii) make any statements of fact in a declaration subject to the penalty of perjury, and iv) explain 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). In view of Petitioner's objections based on the designation of certain supplemental information as confidential information pursuant to a protective order in the co-pending district court action, the Board also will require Patent Owner to file a motion to seal confidential information pursuant to 37 C.F.R. § 42.14 and for entry of the Board's Default Protective Order, set forth in Appendix B to the Office

³ U.S. Patent No. 7,156,537 to Cohrs, issued on January 2, 2007. Ex. 1002.

Patent Trial Practice Guide, pursuant to 37 C.F.R. § 42.54(a).⁴ Instructions for filing a motion to seal and for entry of the default protective order may be found in the Office Trial Practice Guide at Fed. Reg. Vol. 77, No. 157, 48756, 48760–61, 48769–71 (August 14, 2012). We include the URL link for ease of access. http://www.uspto.gov/sites/default/files/ip/boards/bpai/trial_practice_guide_74_fr_48756_081412.pdf

Patent Owner and Petitioner are reminded to prepare, execute and file the Standard Acknowledgement Form as an exhibit in this proceeding. *Id.* at 48771.

For the reasons given above, it is:

ORDERED that Patent Owner is authorized to file a Motion for Late Submission of Supplemental Information, along with any supporting declaration[s] and evidence, not later than December 30, 2015, such motion not to exceed seven (7) pages;

FURTHER ORDERED that Petitioner is authorized to file an Opposition to Patent Owner's Motion for Late Submission of Supplemental Information, along with any supporting declaration[s] and evidence, not later than fifteen (15) days after Patent Owner submits her motion, such opposition not to exceed seven (7) pages;

FURTHER ORDERED that Patent Owner shall not file any reply to Petitioner's opposition papers without authorization from the Board;

⁴ The Board understands from Petitioner's argument that there may be an objection to Patent Owner's use of certain supplemental information in this proceeding, because the information was designated as confidential information pursuant to a protective order in the co-pending district court litigation. Resolution of any such objection is within the province and power of the district court, not the Board.

FURTHER ORDERED that Patent Owner must file a motion to seal confidential information pursuant to 37 C.F.R. § 42.14 and for entry of the Board's Default Protective Order, set forth in Appendix B to the Office Patent Trial Practice Guide, pursuant to 37 C.F.R. § 42.54(a), contemporaneous with Patent Owner's Motion for Late Submission of Supplemental Information; and

FURTHER ORDERED that all papers filed by Patent Owner and Petitioner pursuant to this Order shall be filed in the Patent Review Processing System (PRPS) as "Board and Parties Only." Any questions regarding the appropriate procedure to follow should be directed to the telephone number or email address listed at the top of the first page of this Order.

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