

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Supplemental Evidence & Supplemental Information

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# Question/Comment Submission

To send in questions or comments during the webinar, please email:

[PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Distinguishing supplemental evidence and information

## Supplemental evidence

- Offered *solely* to support admissibility of previously filed evidence.

## Supplemental information

- Evidence to support an argument on the merits.
- May only be considered if a § 123 motion is both authorized and granted.

*See generally Handi Quilter, Inc. v. Bernina Int'l AG*, Case IPR2013-00364, slip op. at 2-3 (PTAB Jun. 12, 2014) (Paper 30).

# Overview

- I. Supplemental evidence
- II. Supplemental information
- III. Combined issues



# I. Supplemental evidence

# Supplemental evidence overview

## Process

- Objection(s)
- Service and filing
- Motion to exclude

37 C.F.R. § 42.64(b)(2)

# Supplemental evidence objections

- What is objectionable
- Timing
- Content



# Supplemental evidence objection - what

- Supplemental evidence is something offered to support admissibility of previously submitted evidence.
- Deposition evidence - 37 C.F.R. § 42.64(a)
  - Objections to admissibility of deposition evidence are made and cured at the deposition
- Other evidence - 37 C.F.R. § 42.64(b)
  - Objections for other than deposition evidence

# Supplemental evidence objection - timing

- Evidence submitted pre-institution.
  - Within 10 business days of institution.
- Evidence submitted post institution.
  - Within 5 business days of service of the evidence.
- 37 C.F.R. § 42.64(b)(1)

# Supplemental evidence objection - content

## Sufficient particularity

- All objections “must identify the **grounds** for the objection with **sufficient particularity** to allow correction in the form of supplemental evidence.”  
37 C.F.R. § 42.64(b)(1)

## Grounds

- Federal Rules of Evidence. 37 C.F.R. § 42.62.
- Admissibility. 37 C.F.R. § 42.61.

# Supplemental evidence service and filing

- Objections – **filed**, 37 C.F.R. § 42.64(b)(1).
- Supplemental evidence – **served**, 37 C.F.R. § 42.64(b)(2).

# Supplemental evidence service and filing

- "Supplemental evidence is not filed at the time of the objection, but simply served, and is filed only in support of an opposition to a motion to exclude. See § 42.64(b)(2)."
- Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 38,989 (Aug. 13, 2018); *Mitsubishi Plastics Inc. v. Celgard, LLC*, Case IPR2014-00524, slip op. at 2 (PTAB Oct. 15, 2014) (Paper 17).

# Supplemental evidence motion to exclude

- Procedure
- Admissibility only

# Supplemental evidence

## Motion to exclude - procedure

- A motion to exclude evidence should:
  - a) Identify where in the record the objection originally was made;
  - b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent;
  - c) Address objections to exhibits in numerical order; and
  - d) Explain **the basis and grounds for** each objection.
- Trial Practice Guide Update, 16 (August 2018), <https://go.usa.gov/xU7GP>;  
37 CFR § 42.64(c)

# Supplemental evidence

## Motion to exclude - admissibility

- A motion to exclude is not a vehicle for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents. Nor should a motion to exclude address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply.
- Trial Practice Guide Update, 16 (August 2018), <https://go.usa.gov/xU7GP>;



# Supplemental evidence

## Motion to exclude - admissibility

As explained by the Board, parties may raise issues related to admissibility of evidence (e.g., authenticity or hearsay) in a motion to exclude. See 37 C.F.R. §§ 42.64 and 42.62. In contrast, issues related to credibility and the weight of the evidence should be raised in responses and replies. Further, a motion to exclude may not be used to challenge the sufficiency of the evidence to prove a particular fact, or to present arguments that should have been presented in responses or replies. For instance, arguments related to the issue of whether a U.S. patent or U.S. application publication is prior art under 35 U.S.C. § 102(e) against a substituted claim should be presented in a reply rather than in a motion to exclude.

*Bloomberg Inc. v. Markets-Alert Pty Ltd.*, Case CBM2013-00005, slip op. at 5 (PTAB Nov. 15, 2013) (Paper 56).

# Supplemental evidence example

- A party sought to file, prior to institution, a petition from another IPR as supplemental evidence. Permissible?
- Not permissible, “supplemental evidence” is a term of art in *inter partes* review proceedings, governed by 37 C.F.R. § 42.64(b)(2) and “is to be served . . . only in response to an evidentiary objection.” *Azure Gaming Macau, Ltd. v. MGT Gaming, Inc.*, Case IPR2014-01288, slip op. at 3 (PTAB Dec. 4, 2014) (Paper 9).
  - Also could not be supplemental information prior to institution



## II. Supplemental information

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# Supplemental information overview

- Timing
- Authorizing vs. deciding
- Filing
- Limits
- Admissibility
- Example

# Supplemental information - timing

- Not pre-Institution.
- Post institution
  - Up to a month after Institution.
  - More than one month after Institution.
- *See 37 CFR § 42.123(a); Azure Gaming Macau, Ltd. v. MGT Gaming, Inc., Case IPR2014-01288, slip op. at 3 (PTAB Dec. 4, 2014) (Paper 9); BioMarin Pharm. Inc. v. Duke Univ., Case IPR2013-00535, slip op. at 2 (PTAB Dec. 31, 2013) (Paper 15).*

# Supplemental information within a month of institution

37 C.F.R. § 42.123(a)

*(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.**

# Supplemental information more than a month from institution

37 C.F.R. § 42.123(b)

*Late submission of supplemental information.*

A party seeking to submit supplemental information more than one month after the date the trial is instituted, **must request authorization to file a motion to submit the information.** The 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.

# Supplemental information

## Responses to comments

- Comment 91: “Since the request must be made within one month of the date the trial is instituted, the patent owner will have sufficient time to address any new information submitted by the petitioner, except in the situation where the party satisfies the requirements of § 42.123(b)”
- Comment 92: “Petitioners are encouraged to set forth their best grounds of unpatentability and supporting evidence in their petitions, lest the petitioner risk a determination by the Board not to institute the review or deny the asserted grounds of unpatentability (§ 42.108(b)).”
- Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680, 48,707-48,708 (Aug. 14, 2012).



# Supplemental information

## Distinguish authorizing from deciding

- Authorization to file a motion does not necessarily mean the motion will be granted, it is not automatic.
  - *See, e.g., Pacific Mkt. Int'l, LLC v. Ignite USA, LLC*, Case IPR2014-00561, slip op. at 3 (PTAB Dec. 2, 2014) (Paper 23).
- Possibilities:
  - Denied
    - Deny request to submit motion
    - Authorize submittal of a motion and then deny the motion
  - Granted
    - Authorize submittal of motion and then grant the motion

# Supplemental information filing

FURTHER ORDERED that the supplemental information that is the subject of Petitioner's motion shall be submitted as one or more exhibit(s) with the motion; and

FURTHER ORDERED that the supplemental information exhibit(s) shall not be cited in any papers other than the motion and opposition being authorized by this Order, unless and until the motion is granted or leave to do so is otherwise granted.

*Goertek, Inc. v. Knowles Electronics, LLC*, Case IPR2013-00614, slip op. at 3 (PTAB Apr. 8, 2014) (Paper 25) (this proceeding terminated without a final written decision)

# Supplemental information limits

- May not change the grounds
  - *See, e.g., B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, Case IPR2014-01510 (PTAB Apr. 28, 2015) (Paper 28); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369 (PTAB Feb. 5, 2014) (Paper 37).
- May not bolster deficiencies
  - *Pacific Mkt. Int'l, LLC v. Ignite USA, LLC*, Case IPR2014-00561 (PTAB Dec. 2, 2014) (Paper 23).
- Must remain on schedule
  - *Rackspace US, Inc. v. PersonalWeb Techs., LLC*, Case IPR2014-00057 (PTAB Apr. 30, 2014) (Paper 16).

# Supplemental information limits

- Not information that could have been filed earlier.
  - *Rackspace US, Inc. v. PersonalWeb Techs., LLC*, Case No. IPR2014-00057, slip op. at 4 (PTAB Apr. 30, 2014) (Paper 16).
- Petitioner's reply is not a loophole.

"Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant's motion."

Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,620 (Aug. 14, 2012)

# Supplemental information admissibility

We note that our Decision here to grant Petitioner's Motion to submit the documents (b) – (e) of Exhibit 1010 is not an advisory decision on the admissibility of such evidence.

*Norman International, Inc. v. Andrew J. Toti Testamentary Trust*, Case IPR2014-00283, slip op. at 8 (PTAB Sept. 29, 2014) (Paper 29).

# Supplemental information permitted

Granting PO's motion to submit a supplemental declaration (123(b)) from its expert that addresses an inconsistency in a prior art reference that PO, and its expert, became aware of only after Petitioner's Reply.

*Edmund Optics, Inc. v. Semrock, Inc.*, Case IPR2014-00599 (PTAB May 5, 2015) (Paper 44).



# III. Combined Issues

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# Distinction

- Supplemental evidence
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# Combined issues – printed publications

- Petitioner alleges that something either disclosed on a public website or at a conference, or available in a library is prior art.

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**Thank You**

