

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPTS TECHNOLOGIES LTD.,
Petitioner,

v.

PLASMA-THERM LLC,
Patent Owner.

Case IPR2017-01674
Patent 8,802,545 B2

Before WILLIAM V. SAINDON, ELIZABETH M. ROESEL, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Expunge
37 C.F.R. § 42.64(b)(2)

On February 15, 2018, counsel for Patent Owner contacted the Board by email, seeking a conference call to discuss Petitioner's filing of supplemental evidence, e.g., Paper 10 ("Submission of Supplemental Evidence Under 37 C.F.R. § 42.64(b)(2)") and Exhibit 1031 ("Supplemental Declaration of Dr. John E. Spencer"). Counsel indicated its position that filing of supplemental evidence is not permitted under 37 C.F.R. § 42.64(b)(2), and that Petitioner's filings should be expunged. Counsel also indicated that Petitioner did not object to expungement.

On February 26, 2018, also by email, the panel authorized the parties to file a Joint Motion to Expunge these filings.

On March 7, 2018, the parties filed a Joint Motion to Expunge Petitioner's Submission of Supplemental Evidence and Supplemental Declaration of Dr. John E. Spencer. Paper 12 ("Mot." or "Motion"). The Motion states that on February 9, 2018, Petitioner filed supplemental evidence, e.g., Paper 10 and Exhibit 1031, in response to Patent Owner's Objections to Evidence, which were filed on January 28, 2018. *Id.* at 1. The Motion recognizes that "Rule 42.64(b)(2) only permits service, not filing, of supplemental evidence," and requests expungement of these documents. *Id.* at 1–2.

As the parties correctly note, Rule 42.64(b)(2) does not authorize a party to *file* supplemental evidence. 37 C.F.R. § 42.64(b)(2) ("The party relying on the evidence to which an objection is timely served may respond to the objection by *servicing* supplemental evidence within ten business days of service of the objection.") (emphasis added). This process allows a party relying on evidence to which an objection is timely served, an opportunity to correct, by serving supplemental evidence within ten days of the service of

the objection. Supplemental evidence is offered solely to support admissibility of the originally filed evidence and not to support any argument on the merits. If, upon receiving the supplemental evidence, the opposing party is still of the opinion that the evidence is inadmissible, a motion to exclude the evidence may be filed. 37 C.F.R. § 42.64(c); *see* Paper 8, 7 (setting forth DUE DATE 4 for filing a motion to exclude evidence). The supplemental evidence may then be filed with an opposition to the motion (*see* Paper 8, 7 (DUE DATE 5 for opposition)), and the party objecting to the evidence may respond to the supplemental evidence in a reply to the opposition. *Id.* (DUE DATE 6 for reply).

Accordingly, we *grant* the parties' joint Motion to expunge Paper 10 and Exhibit 1031, which were filed without authorization.

ORDER

Accordingly, in consideration of the foregoing, it is hereby:

ORDERED that the parties' joint Motion is *granted* and Petitioner's Submission of Supplemental Evidence Under 37 C.F.R. § 42.64(b)(2) (Paper 10) and Supplemental Declaration of Dr. John E. Spencer (Ex. 1031) shall be expunged.

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