

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SZ DJI TECHNOLOGY CO., LTD.

Petitioner,

v.

AUTEL ROBOTICS USA LLC,

Patent Owner.

IPR2019-00343

Patent 9,260,184 B2

Before ERICA A. FRANKLIN, JENNIFER MEYER CHAGNON, and
AVELYN M. ROSS, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for Late Submission
of Supplemental Information
37 C.F.R. § 42.123(b)

This proceeding involves challenges to certain claims of U.S. Patent No. 9,260,184 (Ex. 1001, “the ’184 patent”). On December 23, 2019, with Board authorization (*see* Paper 24), Patent Owner filed a Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(b). Paper 25¹ (“Mot.” or “Motion”). Petitioner filed an Opposition to the Motion. Paper 27 (“Opp.”). Having reviewed the record on this matter, we *grant* Patent Owner’s Motion.

Under 37 C.F.R. § 42.123, a motion to submit supplemental information more than one month after the date a trial is instituted² “must show why the supplemental information could not have been obtained earlier[] and that consideration of the supplemental information would be in the interest[] of [] justice.” *Id.* § 42.123(b). In its Motion, Patent Owner requests entry into the record of this proceeding excerpts of testimony from a parallel International Trade Commission investigation³ relating to the ’184 patent. Mot. 1. In particular, Patent Owner seeks to submit testimony of Petitioner’s expert witness Juan J. Alonso, Ph.D.⁴ (Proposed Exhibit 1) and

¹ Patent Owner appends the following documents to the Motion: Proposed Exhibit 1, Proposed Exhibit 2, and Motion Exhibit. Submission of these documents was authorized, however, these documents have not yet been entered as evidence of record in these proceedings. Paper 24, 3.

² Trial in this proceeding was instituted on May 22, 2019. Paper 7.

³ *Certain Unmanned Aerial Vehicles and Components Thereof*, Inv. No. 337-TA-1133 (“the ITC investigation”).

⁴ Petitioner does not rely on testimony from Dr. Alonso in this *inter partes* review proceeding. Petitioner’s positions in this *inter partes* review are supported by Declarations of Alfred Ducharme, Ph.D. (Ex. 1003; Ex. 1032).

testimony of Patent Owner’s expert witness Charles F. Reinholtz, Ph.D.⁵ (Proposed Exhibit 2) from the hearing conducted in the ITC investigation. *Id.*

Patent Owner contends that the supplemental information reasonably could not have been obtained earlier because the hearing in the ITC investigation was held on October 21–23, 2019, and that Petitioner’s reply brief, which contains arguments allegedly contradicted by the proposed supplemental evidence was filed on November 22, 2019. *Id.* at 2.

Patent Owner further contends that “[t]he testimony from Petitioner’s expert [in the ITC investigation] contradicts Petitioner’s arguments relating to Microdrones^[6] (Grounds 1 and 2) as applied to claim 1” of the ’184 patent and that “[t]he testimony is directly relevant to the exact same arguments and issues pending in the IPR, and is thus highly relevant.” *Id.* at 1. At issue in this proceeding, among other things, is whether Microdrones discloses the “engagement limitation”⁷ of claim 1 of the ’184 patent, which also implicates related claim construction arguments. *See id.* at 3; Paper 22 (Petitioner’s Reply to Patent Owner’s Response), 5–7. According to Patent

⁵ Patent Owner also submits testimony of Dr. Reinholtz in this proceeding (Ex. 2010).

⁶ Microdrones User Manual for md4-200 (Version 2.2) (Ex. 1004).

⁷ Claim 1 recites “the clockwise rotor blade is engageable only with the clockwise lock mechanism and cannot be engaged in the counterclockwise lock mechanism, and the counterclockwise rotor blade is engageable only with the counterclockwise lock mechanism and cannot be engaged in the clockwise lock mechanism,” which the parties refer to as the “engagement limitation.” Ex. 1001, 5:53–6:4.

Owner, Dr. Alonso's testimony from the ITC investigation is inconsistent with positions Petitioner has taken in this *inter partes* review. *See* Mot. 3–5.

As to timeliness, Petitioner contends that Patent Owner has “failed to establish that the proffered testimony could not be obtained earlier through cross-examination” of Dr. Ducharme⁸, or “why it waited six weeks after the ITC testimony to seek to submit this testimony.” Opp. 1.

As to whether consideration of the proffered testimony would be in the interests-of-justice, Petitioner argues that Patent Owner's Motion is “merely an attempt to substitute ITC cross-examination in place of cross-examination of the IPR declarant.” *Id.* at 2. In this regard, Petitioner asserts that, Patent Owner “never alleges any contradictions between [Dr. Ducharme's] testimony and the proffered ITC testimony,” but instead argues that the proffered ITC testimony “is inconsistent with [Petitioner's] positions in this IPR.” *See id.* (citing Mot. 2). Petitioner also argues that “Dr. Alonso's ITC testimony does not contradict [Petitioner's] positions.” *Id.* at 3; *see id.* at 3–5 (expanding on this contention). Finally, Petitioner argues that “admission of PE1 would be unduly prejudicial to Petitioner because it is an incomplete representation of Dr. Alonso's testimony.” *Id.* at 5. In particular, Petitioner notes that Patent Owner does not seek to introduce Dr. Alonso's witness statement submitted as his direct testimony in the ITC investigation, but only seeks to introduce his cross-examination testimony. *Id.*

⁸ As noted by Petitioner (Opp. 1), Patent Owner elected not to depose Dr. Ducharme in this proceeding.

Having considered the parties' arguments, we determine that Patent Owner has met the threshold required to show that the proposed supplemental information has relevance in this proceeding, that Patent Owner's request is timely despite the advanced stage of this proceeding, and that it would be in the interests-of-justice to grant the Motion. We are cognizant of the concerns raised by Petitioner, however we determine those concerns are outweighed by the relevance of potentially inconsistent testimony provided by Petitioner's expert in the ITC investigation.⁹ *Cf. Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272–73 (Fed. Cir. 2017) (“Ultratec sought to offer recent sworn testimony of the same expert addressing the same patents, references, and limitations at issue in the IPRs. A reasonable adjudicator would have wanted to review this evidence.”), 1273 (“There would have been very little administrative burden to reviewing more on-point testimony from the same expert on the same exact issues. Had the testimony been inconsistent, a reasonable fact finder would consider the inconsistencies. Had the testimony been consistent, the Board would not have had to spend any more time on the issue.”). Further, we determine that reviewing the testimony would place minimal additional burden on the Board. *See Ultratec*, 872 F.3d at 1273.

⁹ We note that we will be able to discern at the conclusion of trial whether Patent Owner's use of the supplemental information reveals actual inconsistencies in Petitioner's positions, as Patent Owner contends. Further, little weight may be given to this supplemental information in the context of assessing the credibility of Dr. Ducharme's testimony in this *inter partes* review, as it is not the cross-examination of Dr. Ducharme himself.

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